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Consumer Perception & Protection of Well-Known Trademarks: A Comparative Study

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ABSTRACT

Consider that you are visiting overseas and looking for a coffee cafe. You come upon a Starbucks coffee shop and have a cup of coffee and lunch there. You later discover that you grew ill as a result of the coffee or food you consumed at the coffee shop. Normally, you may contact the main headquarters of the brand to protest and seek compensation. In this situation, however, you learn that Starbucks does not have any coffee shops in the nation you are visiting, and a local trademark thief has taken advantage of your familiarity with the brand, spoilt your vacation, and jeopardised your health. How could this have occurred? The above instance highlights how important trademarks are. A trademark identifies a product or service, ensuring its quality and origin, and protects the company's crucial investments. Consumers have the right to be free of deceit and uncertainty in the marketplace. This research tells us how important it is for businesses to safeguard their well-reputed marks or risk becoming victims of trademark infringement or misappropriation. The comparative study aims to identify similarities, differences, strengths, and weaknesses in the approaches taken by various countries in recognizing, defining, and protecting well-known trademarks.

I. INTRODUCTION

Globalization has made the globe more interdependent, and companies no longer have boundaries that may limit them. With the expansion of international business, it became essential to safeguard the world's 'Well-Known Trademarks'. In common language, well-known trademarks are those that are recognized internationally. For example, 'Volkswagen' (a German automobile manufacturer) is well-known for its long-lasting and dependable vehicles that meet the company's high-quality standards.

If a person or business owner comes up with the concept of establishing a mark, and it gains popularity over time and the general public begins to recognize it, he or she must take steps to protect the trademark. As technology advances, publicly acknowledged trademarks are at risk of being infringed. Infringements cause owners emotional agony, anxiety, and financial losses

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that are considerably more devastating than physical hurt.

In 1883, the Paris Convention for Protection of Industrial Property introduced the concept of 'Well-Known Marks'.³ Although the agreement does not specify the registration procedure for well-known marks. The agreement allows member nations to create legislation for protecting well-known trademarks.

II. ORIGIN AND DEVELOPMENT OF WELL-KNOWN TRADEMARKS IN INDIA

“Your brand or your name is simply your reputation, you have to fight in life to protect that as it means everything. Nothing is more important”- Richard Branson

A trademark is a type of intellectual property that includes signs, logos, words, and symbols that distinguish it from others. A trademark uniquely identifies a product as belonging to a certain company and acknowledges that company's ownership of the brand. It is optional whether to register a trademark or not but in order to file a suit for infringement and seek legal rights it should be registered. Trademarks are identified by the ® and ™ symbols. By using a trademark, companies prevent others from using a company or individual's products or services without their consent. They also ban marks that may cause confusion with an existing one. This implies that a company cannot use a sign or brand name that looks, sounds, or has a similar meaning to one that is already registered—especially if the goods and/or services of the marks are connected. For example, a burger-making company cannot legally make use of a symbol that looks like the ‘M’ of McDonald’s i.e. the golden arches logo and cannot make use of the same.

Well-known trademarks are also known as marks that are widely known by the public and it is associated with a company or a brand. Well- Known trademarks have a higher level of protection under the Trademarks Act, 1999. So the concept of well-known trademarks in India was recognized from the year 1969.

(A) Evolution of well-known trademarks

History

The notion of a well-known trademark emerged from the Paris Convention of 1925. According to Article 6bis of the Paris Convention, any trademark that is identical or similar to a well-known trademark and is likely to cause confusion in the minds of the public will not be registered. The scope of well-known trademarks was limited to similar goods and it did not include services. However, in 1967, the TRIPS Agreement expanded the scope of well-known

³ Paris Convention for the Protection of Industrial Property (1883), Article 6bis.

trademarks to include services. After the Paris Convention and the TRIPS Agreement, the majority of nations changed their trademark laws to provide special protection for well-known marks.

In the year 1958, the Trade and Merchandise Marks Act was passed. Since then it has been amended several times, after a point of time it was necessary to bring comprehensive legislation related to the subject. For the same, the Trade Marks Bill, 1999 was introduced in the parliament.⁴ Before 2003, Well-Known Trademarks were protected under Section 47 of the Trademark and Merchandise Act of 1956, which allowed for the registration of well-known marks for their protection and passing-off actions. The eligibility for the registration was that if the use of the same or similar mark in other class of goods and/or services would cause confusion in the mind of the public and deceive the public about the real owner of the mark, and use of such mark would suggest a connection of goods and/or services with the Well-Known Trademark.⁵

The first case dealing with a well-known trademark in India was *Sunder Parmanand Lalwani & Ors v. Caltex (India) Ltd.*⁶ The Bombay High Court held that CALTEX which is a well-known mark is capable of creating confusion and deception in the minds of people even though the two disputed parties' goods and services are registered under different classes. The court stated that the applicant had no genuine grounds to adopt the Opponent's mark CALTEX, which is a well-known mark across India, and that the prospective sales channel of the Applicant's and Opponent's goods is similar, which can create doubt regarding the product's authentic origin.

In *Bata India Ltd. v. Pyarelal & Co.*⁷, the plaintiff Bata India Limited filed an appeal against an order dated December 24th, 1983 passed by First Additional District Judge, Meerut for a permanent injunction against the company using the term 'Bata'.

whereby the court, although challenging the defendant's use of the term 'BATA' in *Batafoam*, found that the plaintiff's mark was a well-known mark and that any use of the same, even in a different class, would deceive people and cause confusion in the minds of the public regarding

⁴ BASANT LAL WADEHRA, LAW RELATING TO INTELLECTUAL PROPERTY: PATENTS, TRADE MARKS, COPYRIGHT, DESIGNS, GEOGRAPHICAL INDICATIONS, SEMICONDUCTOR INTEGRATED CIRCUITS LAYOUT-DESIGN, PROTECTION OF PLANT VARIETIES AND FARMERS RIGHTS, TRIPS 129–131 (5th ed. 2021).

⁵ Akhil Goyal, *TIME TO REVISIT THE CONCEPT OF WELL-KNOWN TRADEMARKS IN INDIA*, THE DAILY GUARDIAN (2021), <https://thedailyguardian.com/time-to-revisit-the-concept-of-well-known-trademarks-in-india/> (last visited Jan 14, 2024).

⁶ *Sunder Parmanand Lalwani & Ors v. Caltex (India) Ltd.*, AIR 1969 Bom 24 (India).

⁷ *Bata India Ltd. v. Pyarelal & Co.*, AIR 1985 All 242 (India).

the real owner of the mark and cause injury to the plaintiff.

In the case of *Daimler Benz Aktiengesellschaft v. HyboHindustan*⁸ In this case, the plaintiff was a Mercedes-Benz automobile manufacturer, and the defendant sold undergarments under the mark 'BENZ'. The plaintiff filed an appeal for injunction against the defendant on the grounds of using their famous symbol the iconic '3-point star' and the word 'Benz'. In determining the case, the Court recognised the plaintiff's logo as a well-known trademark and consequently barred the defendant from using the disputed mark. The court also stated that there was no valid reason for the defendant to adopt the name "Benz," which is associated with one of the world's finest engineered cars and has a trans-border reputation and goodwill.⁹

In *Bharati Cellular Ltd. v. Jai Distillers (P) Ltd.*¹⁰ In this case, The plaintiff was carrying on a business in the field of telecommunication services with the well-known popular brand name 'Airtel'. The defendants were also using the label along with the same word Airtel with an identical color scheme And almost similar writing on their products which was related to alcoholic beverages.

The court held that the plaintiff had created the innovative word 'Airtel' by joining two English words 'Air' and 'Tel' which are not a common English word and acquired an exclusive reputation for the said brand in their favor. The court held that the usage of this identical mark by the defendants is dishonest and the explanation given by them did not provide a genuine reason for their usage. It was held that the defendant is passing off the copyrighted work of the plaintiff by using the said label and they must be stopped from using the same.

III. LEGAL PROCEDURE AND PROTECTION OF WELL-KNOWN TRADEMARK

Well-known trademarks are also known as famous marks, it can be recognized by the general public and it is associated with a company or a brand. When compared to standard registered trademarks, they (well-known trademarks) have a higher level of protection under the Trademarks Act. The protection of well-known trademarks is essential not only for the individual companies holding these trademarks but also for maintaining a fair and competitive market environment while safeguarding consumer interests and choices.

Definition and Criteria for Well-Known Trademarks

The concept of well-known trademark is sated in Section 2(zg) of the Trade Marks Act, 1999.

⁸ Daimler Benz Aktiengesellschaft v. HyboHindustan, AIR 1994 Del 2369 (India).

⁹ Khurana & Khurana, *How To Recognize Well-Known Trademarks In India*, KHURANA & KHURANA (2020), https://www.khuranaandkhurana.com/2020/03/28/how-to-recognize-well-known-trademarks-in-india/#_ftn2 (last visited Jan 15, 2024).

¹⁰ Bharati Cellular Ltd. v. Jai Distillers (P) Ltd, AIR 2007 Bom 33 (India).

It says that–

“It is in relation to any goods or services, such Mark which has become so as to the substantial segment of the public, which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services.” (Illustration– Airtel, Reliance, Raymond, Parle, Britannia, Bata, Colgate, etc.)

Protection of well-known marks throughout each class and determining factors of the same

Section 11(2) of the Trade Marks Act of 1999 states that well-known trademarks must be recognized and protected across all classes of goods and services, while Section 11(6) lists some of the considerations to examine when determining whether a mark is a well-known trademark. In order to protect well-known marks from being misused and infringed, WIPO approved a Joint Resolution Concerning Provisions on the Protection of Well-Known Marks in 1999, which specified many factors to identify a well-known trademark. The factors are as follows:

1. The relevant public members are aware of the mark, including information gathered in India via promotion of the same.
2. The time frame, scope, and geographic area of use of that trademark;
3. The duration, scope, and geographic area of promotion of the trademark in relation to the products and services to which it pertains;
4. The trademark registration or application for registration should represent the trademark's user date and recognition.
5. The record of successful enforcement of the rights in that trademark including the record wherein it is stated that the trademark has been recognized as well-known by any court or Registrar.

Conditions not required for the registration of a Well-known trademark

There are specific conditions mentioned in Section 11(9) which talks about certain conditions that need not be required for the purpose of grant of a well-known trademark. Those conditions are as follows:

- a. Trademark has been used in India
- b. Trademark has been registered

- c. An application for trademark registration has been submitted in India.
- d. That is a trademark–
 - is a well-known in or
 - has been registered in or
 - The application for registration has been filed in, other jurisdictions apart from India
- e. In India, the public at large is aware of the trademark.

Section 11(10) of the Act, says that there is an obligation on the Registrar of Trade Marks that when considering an application for trademark registration and an opposition is filed,

- a. he shall protect a well-known trademark against identical or similar trademarks.
- b. he should evaluate the applicant's or opponent's bad faith in influencing the rights related to the trademark.

In accordance with Rule 124 of the Trade Marks Rules, 2017, anybody can register a request to obtain a well-known trademark. The cost of filing the same in India will be INR 1,00,000 per mark and the application can be filed online. Such request should be supported by a statement of case, as well as any evidence and documents relied on by the applicant to support his claim. The owner may apply Rule 124(1) to request a well-known trademark without having to go through any sort of legal measures. This allows the owner to obtain the identification of a well-known trade mark without any extra procedures and saves a significant amount of time.¹¹

DOCUMENTS NEEDED WHILE FILING FOR WELL-KNOWN TRADE MARKS¹²

The application must be filed solely online using the secure e-filing services for trademarks made accessible on the official website, www.ipindia.nic.in. The application should be accompanied by the following documents:-

1. Statement of the case - stating the claimant's trademark rights and explaining the assertion that a trademark is well-known.
2. The details of successful enforcement of rights in case the trademark has been recognized as well-known by the court in India or Trade Marks Registrar.
3. A copy of any court or Registrar's judgement recognising the trademark as well-known.

¹¹ Trade Marks Rules, 2017, Rule 127 (India).

¹² Government Of India & Controller General Patents, Designs & Trademarks, *Public Notice*, IPINDIA (2017), https://ipindia.gov.in/writereaddata/Portal/IPOtherNotice/1_31_1/Public-Notice.pdf (last visited Apr 13, 2024).

4. The pieces of evidence showing the claimant's right and explaining his claim. Such pieces of evidence shall include data/documents exhibiting-
 - a. Use of a trademark, or any application for trademark registration filed or acquired.
 - b. Annual turnover of sales of the business of the claimant.
 - c. Actual or probable number of clients using the said trademark.
 - d. The documents of Publicity and advertising for the trademark submitted for registration, as well as the costs involved.
 - e. The trademark is known or recognised by the relevant segment of the global public.

THE DOCTRINE OF DILUTION OF A TRADEMARK

An article by an influential law review published in 1927 by renowned New York lawyer Frank Schechter, proposed that the main objective of trademark law should be to preserve the individuality of merchant's trademarks rather than discourage customer confusion.¹³

Schechter also argued that strong trademarks should be protected like how a property is protected, He also mentioned that others should be prevented from using a well-reputed mark even if that mark contains unrelated goods. From here, the term of dilution emerged. In 1932, Congress considered bringing in legislation to enact a trademark law for dilution, Then in 1947, Massachusetts became the first state in the United States to enact it slowly. Many American jurisdictions adopted statutes related to dilution. There were many cases wherein the courts interpreted these state dilution laws with a narrow construction –For example: Sometimes the plaintiff was asked to establish the likelihood of confusion of their mark. Despite a clear mention of it in the legislation not to do the same.

A trademark dilution is an unauthorised use of a well-known trademark which can harm the reputation and weaken the magnetism of the well-known trademark. When such a well-reputed mark is used unlawfully, it can create confusion in the minds of the public/ consumers. In dilution there are two types, Blurring is the most common type of dilution, while the other type is tarnishing. Blurring of a trademark takes place if a well-known trademark's uniqueness is undermined by a mark created by an unauthorised party. For example– When a skincare brand utilises the well-known "ADIDAS" symbol on its goods, consumers may begin to associate it

¹³ Roger E. Schechter & John R. Thomas, Schechter and Thomas' Intellectual Property: the Law of Copyrights, Patents and Trademarks 695–696 (1st ed. 2008).

with that skincare brand. Tarnishing of a trademark takes place when the reputation of a well-known or similar mark in relation to a trade name is damaged.

In the Trade Marks Act 1999 there has been no specific mention about dilution but Section 29(4) of the Act talks about the concept of dilution of a trademark. Every trademark has a reputation in India, The above-mentioned section says that If the use of a mark is identical with or similar to it, even if the goods or services are different, it constitutes infringement as such kind of use would take unfair advantage of the reputation of that trademark and harm its magnetism. The above-mentioned section claims that a registered trademark is infringed by marks that:

- a. Identical or similar to a registered trademark that has already developed a reputation in India and is used for goods or services other than those for which the trademark was registered.
- b. When someone takes unfair advantage of a well-known mark or has distinguishing characteristics.

Exceptions to Dilution of Trademarks

There can be some cases wherein a mark not necessarily be considered a dilution of a trademark. In such cases, the mark is used in a news report, commentary, criticism, educational and entertainment purposes. The above-mentioned cases can be related to descriptive or fair use and cannot be considered as a delusion of a trademark. When it comes to advertisements, the companies do not infringe on the mark but they compare the mark to those of others.

The case laws are cited here for a good understanding,

A. *Caterpillar Inc. vs Mehtab Ahmed And Ors*¹⁴

- In this case, a suit for permanent injunction was filed against the defendant to restrict them from selling various things, including footwear and using the plaintiff's registered trademark cat and Caterpillar. The important part of the doctrine is that there is a presumption that the relevant customers associate the mark or trademark with a new and different source and it further amounts to reducing the value of the reputed trademark. Such dilution of a reputed mark is not considered a fair practice in commerce.
- It was held that the Delhi High Court passed an order in favour of the plaintiff.

¹⁴ Caterpillar Inc. vs Mehtab Ahmed And Ors, 99 (2002) DLT 678.

B. *Bayerische Motoren Werke AG v. Om Balajee Automobile (India) Private Limited*¹⁵

- In this case, the plaintiff filed A suit for restricting the defendants for using their mark in automobile goods. In this case, the defendant used the mark ‘DMW’ which the plaintiff claimed as an infringement to their reputed trademark ‘BMW’. The court passed an ad interim injunction in favour of the plaintiff and against the defendant’s use of the trademark in question.

The concept of dilution is the power granted to the proprietor of a well-known trademark to protect the reputation and goodwill of a well-known trademark so that the third parties don’t use it in an unauthorised manner. The court protects well-known trademarks by preventing other/third parties from diluting them and engaging in unfair commercial practices in the sector. The worth of the well-known brand is also considered when obtaining a decree. This concept is based on the court’s interpretation and the conditions that they set forth.

REMEDIES FOR INFRINGEMENT OF A WELL-KNOWN TRADEMARK

As it happens in every IP infringement case, in the case of infringement or passing off of a WKM, the proprietors have to approach the court to seek relief or damages. It is very crucial for a well-known mark to be registered if it wants to claim it’s legal rights. A well-known mark is protected regardless of the identity or similarity of the goods or services, provided that the use of that trademark in relation to other goods or services indicates a connection between the goods or services in question and the owner of the registered well-known trademark and that the owner's interests are likely to be injured by such use. If the owner of the registered well-known trademark wants to restrain the use of their mark on goods which are not similar, the proprietor has to prove infringement and that the interests of the owner will be damaged. In trademarks, there are civil and criminal remedies. The aggrieved party can ask for:

a. Injunction

- An injunction is an order of the court that provides a remedy to the aggrieved party. There are two types of injunction that can be granted to the defendant, permanent and temporary injunction.
- In a temporary injunction, a certain time period is considered, which will be until the court issues its final decisions on the matter.

¹⁵ Bayerische Motoren Werke AG v. Om Balajee Automobile (India) Private Limited, CS(COMM) 292/2017 (India).

- In permanent injunction the order of the court is final and no further applications will be entertained.
- b. Damages
- When an aggrieved party's trademark has been infringed h/she can claim damages stating their exclusive right on the usage of the mark. Also claiming that the infringement has led to a huge loss.
- c. Seize & destroy the goods that are infringing the impugned mark
- The Hon'ble Court will order the authorities to seize and destroy the goods that are infringing the impugned mark.
- d. Section 103 of the Trade Marks, Act 1999 prescribes a criminal penalty for the violation of any individual's or entity's trademark, which includes a six-month jail sentence that can be extended up to three years for trademark infringement.
- e. Section 104 of the Act, prescribes the penalties that are imposed on the wrongdoer.

Examples of Well-known Trademarks

To get the status of a well-known trademark, you have to prove the substantial popularity of your brand among the general public, preferably worldwide. The method entails showing considerable proof of the mark's reputation, taking into account elements such as the duration of usage, marketing, registrations, effective enforcement of intellectual property rights, and commercial value linked with the mark. The official website of [Intellectual Property India](http://www.ipindia.gov.in) provides information regarding well-known trademarks. The following are some of the examples of well-known trademarks considered by the Registry.

LIST OF WELL-KNOWN TRADEMARKS				
S. No	Trademark	Proprietor	Determining Authority	Reference to case
1.	BENZ	Daimler Benz	High Court of Delhi	1994 PTC 287
2.	CATERPILLAR	Caterpillar Inc., USA	Madras High Court (DB)	1998IPLR 326

3.	WHIRLPOOL	Whirlpool Corporation, USA	High Court of Delhi	1996 PTC 476
4.	HALDIRAM	Haldiram India Private Limited	High Court of Delhi	CS(COMM) 495/2019 decided on 3 April 2024
5.	KALPATARU	Kalpataru Properties Private Limited, Santacruz Mumbai	Bombay High Court	Suit No 2976/2010 decided on 29th July 2011
6.	AMUL	Kaira District Co-Operative Milk Producers Union Ltd.	IPAB	OA/56/2011/ TM/ KOL
7.	MOTHER DAIRY	Mother Dairy Fruit & Vegetable Pvt. Ltd.	High Court of Delhi	CS (OS) 2399/2010
8.	BUKHARA	ITC Limited	High Court of Delhi	CS(COMM)-781/2022
9.	BURGER KING	Burger King LLP	High Court of Delhi	C.O. (COMM.IPD-TM)-709/2022
10.	MANKIND (with reference to the goods and services related to	Mankind Pharma Limited, Delhi	Registrar of Trade Marks	

	Pharmaceutical preparation, Business administration & retail outlet and Research & Development, related filed.)			
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IV. ROLE OF THE INDIAN JUDICIARY IN THE PROTECTION OF WELL-KNOWN TRADEMARKS

When a well-known business is widely known to the public, seeking special protection for the same is not wrong and such businesses should be protected for their well-being. Trademark protection is crucial for safeguarding the identity and reputation of a well-known brand. Additionally, a registered trademark provides strong legal grounds for you to take action against any infringement, including the right to seek damages and injunctions to stop unauthorized use of your mark.¹⁶ Furthermore, trademark registration can serve as a valuable asset for your business, potentially increasing its importance and providing licensing opportunities. It was for the first time that the term 'well known' was recognised in the case of *JG v. Stanford*.¹⁷ It was said that the said term originates from the term 'reputation' and it was held that the law of passing off prevents commercial dishonesty on the part of trades.

There are many situations where large businesses must contend for their rights to trademarks, some of which are listed here:-

A. *Whirlpool Co & Anr v N. R. Dongre*¹⁸

In this case, the court held that the Whirlpool Co. i.e. The plaintiff earned a 'transborder prominence' in India by large-scale commercials of the mark in circulation, so the defendants were barred from using identical trademarks on their products and washing machines. Because of the large-scale commercials, the court ruled that the mark was well-known, allowing the goods to reach the general public even though it was hardly present in the Indian market.

¹⁶ Kusum L. Ailawadi & Kevin Lane Keller, *Understanding retail branding: conceptual insights and research priorities*, 80 JOURNAL OF RETAILING 331 (2004), <https://www.sciencedirect.com/science/article/pii/S0022435904000648> (last visited Apr 13, 2024).

¹⁷ *JG v. Stanford* (1617) Cr Jac 468, 79 ER 400.

¹⁸ *Whirlpool Co & Anr v. N R Dongre* PTC1998(Del) 698 (India).

B. Indian Shaving Products Ltd. v. Gift Pack¹⁹

In this case, the court held that the defendants could not use the mark 'Ultra' in their batteries because it was deceptively similar to the plaintiff's trademark. Previously, the defendants asserted that the plaintiffs had used the mark for a very short period of time and could not have acquired a strong reputation and goodwill, but the court observed that the plaintiff had achieved high sales and promoted heavily, and removed the specification for a long duration of sale.

C. Rolex SA v. Alex Jewellery Pvt. Ltd.²⁰

In this case, the court held that the plaintiff's trademark 'ROLEX' was well-known and that the general public who uses watches is aware of it. The defendant's use of the same name for artificial jewels would lead the general public to presume that the plaintiffs likewise deal in artificial jewellery. The court granted an injunction against the defendant's use of the aforementioned trademark.

D. Microsoft Corporation v. Kurapati Venkata Jagdesh Babu²¹

In this case, the court held that the mark 'Microsoft' was a well-known trademark since it is in use and the general public is aware of it worldwide. There is evidence of its commercials and publicity in India. The defendants were not allowed to use the same mark as a trademark or as part of their trading style in connection with similar or different businesses since the aforementioned trademark has a unique goodwill and reputation.²²

E. Yahoo Inc v. Firoz Nadiawala²³

In this case, the court held that 'YAHOO!' had gained the status of a well-known due to its long and consistent usage, The subject mark was not just connected with the internet and broadband, but also with apparel, food, and a variety of other things. Initially, the plaintiff gave the defendant a cease and desist notice, which they disputed. Following that, the plaintiff filed a permanent injunction against the defendants.

It also observed that the defendant had attempted to create an association with the Plaintiff's mark by making a movie under the title YAHOO!, that would cause confusion in the general public and they would believe that it is the Plaintiff's production.

¹⁹ Indian Shaving Products Ltd v. Gift Pack PTC 1998(Del) 698 (India).

²⁰ Rolex SA v. Alex Jewellery Pvt. Ltd, 2009 (41) PTC 284 (Del) at p. 292 (India).

²¹ Microsoft Corporation v. Kurapati Venkata Jagdesh Babu, 2014 (57) PTC 601 (Del) at p. 615.

²² IIPRD, Rolex Sa V Alex Jewellery Pvt. Ltd. & Ors – IIPRD Blog – Intellectual Property Discussions, IIPRD Blog - Intellectual Property Discussions (2020), <https://iiprd.wordpress.com/tag/rolex-sa-v-alex-jewellery-pvt-ltd-ors/> (last visited Apr 13, 2024).

²³ Yahoo Inc v. Firoz Nadiawala, 2014 (58) PTC 352 (Del) at p. 357 (India).

F. *Tata Sons Limited v. Gina Kilindo*²⁴

In this case, the court held that ‘TATA’ is a “well-known mark enjoying an expansive reputation and goodwill breaking barriers of geography, language, ideology and class, and that the TATA companies promoted by the plaintiff and their subsidiaries/associates are engaged in a wide spectrum of activities using the trade mark TATA and the said trade mark has come about to be exclusively recognized as the source indicator of the goods and business of the plaintiff and companies promoted by it...”

One defendant owned Tata Agro Holding Ltd, while another registered the impugned domains, such as tataagro.com, tataagro.biz, and tataagro.net. The plaintiff claimed that both defendants were attempting to take advantage of unaware consumers and the general public. The defendants have utilised the plaintiff's well-known trademark across all of their domains and corporate entity, Tata Agro Holding Limited. The accused also had pages on popular social media platforms such as Facebook and Twitter. It was held that the defendant's illegal actions caused the plaintiff to suffer losses and irreparable harm to its company and image.

G. *ICICI Bank Ltd. v. Chuandong XU*²⁵

In this case, the court restricted the defendant i.e. the Chinese entity from using the domain name ‘icicigroup.com’. Previously, the WIPO panellist ruled that the defendant was making valid use of the domain name as among Chinese internet users, the phrase indicates a 'community of like-minded netizens with common interests' and the letter 'i' denotes 'love'.²⁶

It was observed by the Delhi High Court that the trademark 'ICICI' was frequently used and quite unique. Furthermore, as a result of widespread awareness and usage of the mark across the world, the trade mark has achieved the status of a well-known mark.

H. *Honda Motors Co. v. Charanjit Singh*²⁷

In this case, the court issued a permanent injunction against the trademark ‘HONDA’ for pressure cookers which the plaintiff was using in respect to automobile and power equipments. The plaintiff also gave ground that they have been using the said word ‘HONDA’. Since the last five decades, they have acquired international goodwill and reputation and have also become a household name in India.

²⁴ Tata Sons Limited v. Gina Kilindo, 2014 (57) PTC 415 (Del) at p. 421 (India).

²⁵ ICICI Bank Ltd. v. Chuandong XU, 2013 (49) PTC 291 (Del) at p. 302 (India).

²⁶ Anand and Anand, *Delhi High Court Restrains Chinese Entity from Using Domain Name*, WWW.WORLDTRADEMARKREVIEW.COM (2012), <https://www.worldtrademarkreview.com/article/delhi-high-court-restrains-chinese-entity-using-domain-name> (last visited Apr 13, 2024).

²⁷ Honda Motors co. v. Charanjit Singh [2003] 26PTC 1 (Del) (India).

I. Kalpataru Properties Private Limited v. Kalpataru Agro India Limited²⁸

In this case, the plaintiff restrained the defendants from using the mark “KALPATARU”. The plaintiff learned about the mark's use through a 2014 lawsuit. The plaintiff asserts that the aforementioned mark is a well-known trademark and that they have been using it since 1975 and also claimed that it is a well-known trademark. The plaintiff claimed that such use of their mark by the defendants would dilute it and lead to confusion and deceit in the marketplace. The court held that the defendants, their servants, agents, representatives or any other person claiming through or under them or otherwise howsoever be restrained by a temporary order and injunction directly or indirectly. It was also held that the defendant's mark is deceptively similar to the mark or word “KALPATARU” and infringes the plaintiff's well-known trademark.

J. Aktiebolaget Volvo & Ors. v Hari Satya Lubricants & Anr.²⁹

In this case, the plaintiff filed for trademark infringement against the defendants to restrict them from manufacturing, selling, offering for sale in India, offering for export, packaging, advertising, directly or indirectly dealing in manufacturing and supplying the lubricating oil products or any goods under the mark ‘VALVO’ or any other trademark identical and/or deceptively similar to the plaintiff's well-known trademark VOLVO amounting to infringement of the plaintiff's well-known trademark VOLVO. The court held that the plaintiff has an exclusive right and is a well-known trademark in India. The plaintiff's claim that the term "VOLVO" is a crucial, integral, and prominent component of the corporate names and trading names of the vast majority of their enterprises. The plaintiff's have emphasised their international goodwill and reputation, especially in India. The court determined it to be a clear case of trademark infringement and passing-off the order was passed in favour of the plaintiff, and they also received damages.

K. UltraTech Cement Limited v. Ultratech Solar Technologies Pvt. Ltd.³⁰

In this case, the plaintiff filed a suit for infringement of trademarks and passing off and unfair trading committed by the defendants by using the mark ‘UltraTech’ related to the solar water heater and also their corporate name. The plaintiff's argued that the trademarks ‘UltraTech’ are registered in the name of the Plaintiff's and the registration of the same is valid and subsisting; that by virtue of extensive use and heavy advertisements and promotions of the goods bearing the marks ‘UltraTech’ by the Plaintiff's, the same are exclusively and solely associated with the

²⁸ Kalpataru Properties Private Limited v. Kalpataru Agro India Limited, 2015 SCC OnLine Bom 7864 (India).

²⁹ Aktiebolaget Volvo & Ors. v Hari Satya Lubricants & Anr., (2016) 234 DLT 524 (India).

³⁰ UltraTech Cement Limited v. Ultratech Solar Technologies Pvt. Ltd., 2018 SCC OnLin Bom 8644 (India).

Plaintiffs. It was also submitted that the mark ‘UltraTech’ is a well-known mark in India and has also acquired a secondary meaning in the market. Therefore, the court ruled in favour of the plaintiffs and against the defendants and awarded punitive damages to be awarded to the plaintiff.

***L. Dharampal Satyapal Sons Private Limited v . Akshay Singhal and Others*³¹**

In this case, the plaintiff filed a suit for a permanent injunction restricting the defendants from using the trademark ‘PLUSS’ other trademark deceptively similar to the plaintiff’s trademark and unique trade dress in relation to the candies and/or leading to dilution of the plaintiff’s ‘PULSE’ trademark overall colour scheme and uniqueness. Plaintiff is a private limited company having an annual turnover of more than Rs. 6500 crores with a strong presence in a high growth sector, Plaintiff’s candies under the trademark ‘PULSE’ were launched on 13 December 2014 and have enjoyed tremendous popularity amongst all classes of the public ranging from the working class to school going children to the elderly. The defendants were ordered to pay costs in favour of the plaintiff after the court issued a decision in the plaintiff’s favour. This was the case wherein PULSE was declared as a well-known trademark by the court of law.

***M. Havells India Private Limited v. Rajeev Chawla*³²**

In this case, the plaintiff prayed for a decree of permanent injunction to restrict the defendant, its partners, proprietors, officers, servants, agents, distributors, dealers, retailers or any other person acting for on their behalf from manufacturing, selling, offering for sale, advertising directly or indirectly from using services regarding the trademarks or logos ‘LLOYD’ with themselves or with other variants which are deceptively similar to the plaintiff’s trademark and the artistic style, layout, get up, colour scheme, trade dress, etc. All of the intellectual property associated with the Lloyd brand, including its logo, trademark, goodwill, and reputation, has been exclusively acquired by the plaintiff. According to the plaintiff, LLOYD is currently among the top 3 brands in the air conditioning market. The defendant owns a company called Chawla Refrigeration, which sells electrical appliances. It was found that the defendant was selling an indoor unit of the LLOYD split air-conditioner for sale without the outdoor unit and that the same could be connected to any outdoor unit, it was also found that the defendant was maintaining a website *www.chawlaref.com*. The defendant was using the plaintiff’s trademark ‘LLOYD’ in identical cursive font and style and further, it was found that the adoption and use

³¹ Dharampal Satyapal Sons Private Limited v . Akshay Singhal and Others, 2019 SCC OnLine Del 11478 (India).

³² Havells India Private Limited v. Rajeev Chawla, 2019 SCC OnLine Del 11480 (India).

by the defendant is a clear violation of the plaintiff's statutory rights. In this case, it was held that the logos devices or trademarks used by the plaintiffs are well-known trademarks. In addition to passing the order, the court awarded expenses against the defendants and in favour of the plaintiffs.

N. Indian Hotels Co. Ltd. v. Vivanta Hospitality (P) Ltd.³³

In this case the the plaintiff who was in hospitality services and the defendant also was in the same industry and provided customised holiday packages for its customers, the defendant sent a mail to the plaintiff to inform them that their mark has been infringed by the plaintiff. But it was found that the plaintiff was a part of TATA Group of Companies and they adopted the mark way before than the defendant i.e. in 2008 in Classes 42 and 43. Later on, it was held that the defendant was restrained from using the registered trademark and was awarded costs.

O. Tata Sia Airlines Limited v. Pilot18 Aviation Book Store and Another³⁴

The plaintiff operated airlines by the name VISTARA since 2014 and is also a registered proprietor of the same in India and other countries. Defendant No. 1 operates an aviation studies portal called pilot18.com, defendant No. 2 is the proprietor of Defendant no 1. Internet searches revealed that the defendants are selling a range of name tags, badges, and other accessories, such as luggage tags, mugs, and more, all of which have the mark "VISTARA" and the same device mark or logo shape. The plaintiff filed the present suit seeking a permanent injunction, restraining infringement of its registered trademarks, dilution, damages, rendition of account, etc. After looking into the matter, it turned out that the defendants were selling these goods on their website and claiming that they supplied those goods to the plaintiff. The plaintiff had denied those claims. The defendant claimed to be unfamiliar with the legal prohibition against selling such goods. In this case, VISTARA was declared a well-known trademark as it is quite popular in India and enjoys huge goodwill and reputation in the industry itself. The court held that the sale of merchandise with several airline names violates the rights of the parties but also poses a threat to the security of the airport. The court directed defendant No. 1 to pay Rs. 2 lakhs to the Plaintiff within a period of one month as costs and the goods to be seized by the Local Commissioner and brought to the court.

P. Haldiram India (P) Ltd. v. Berachah Sales Corpn.³⁵

In this case, the plaintiff filed a lawsuit for seeking a permanent injunction against the defendant

³³ Indian Hotels Co. Ltd. v. Vivanta Hospitality (P) Ltd., CS(COMM) 507/2022 (India).

³⁴ 2019 SCC OnLine Del 9535

³⁵ Haldiram India (P) Ltd. v. Berachah Sales Corpn., 2024 SCC OnLine Del 2265 (India).

and for the protection of its mark 'HALDIRAM' and to declare the same as a well-known mark as the defendant was infringing their well-reputed mark by using 'HALDIRAM BHUJIWALA'. The Delhi High Court awarded a decree pronouncing the mark 'HALDIRAM', as well as the oval-shaped mark, to be a 'well-known' mark in respect of food products in restaurants and eatouts and ordered the defendant to pay damages.

Through the cases mentioned above, it has been proven that the Indian Judiciary has been flexible in interpreting the laws related to well-known trademarks and has also considered some factors as important such as— spillover effect, transborder reputation, honest and concurrent use, extensive use and commercials etc. for the purpose of acquiring a status of well-known trademark.

V. ROLE OF CONSUMERS IN WELL-KNOWN BRANDS/TRADEMARKS

In the world of business and marketing, the relationship between consumers and well-known brands/trademarks is the foundation of contemporary business dynamics. Consumers are more than just passive recipients of marketing messaging; they actively define the narrative and perception of well-known companies and trademarks. Their inclinations, behaviours, and interactions play a major role in developing, maintaining, and evolving brand recognition and loyalty. In this case, the symbiotic relationship is defined as a continuous exchange of values in which consumers or shoppers achieve meaning, identity, and fulfilment from well-known brands/trademarks, and these brands, in turn, rely on consumer involvement and loyalty for survival and growth. Thus, understanding consumers' diverse roles in the context of well-known brands/trademarks is critical for businesses, marketers, and lawmakers attempting to negotiate the complexities of the modern marketplace. This section will look into many different aspects of consumer influence, specifically how customers contribute to the success, reputation, and longevity of well-known brands/trademarks in today's hyperconnected and consumer-driven world.

CONSUMERS AND WELL-KNOWN BRANDS/TRADEMARKS

Consumer perception plays an important role for well-known brands/marks because it drives consumer behaviour, shapes market competitiveness, enables the expansion of a brand, and adds considerably to a brand's overall success and longevity in the market. Brands frequently invest extensively in marketing, product quality, customer service, and reputation management to build a good consumer perspective. Nordberg emphasizes the need to distinguish between

trademarks and brands, as well as their mutually beneficial relationship.³⁶

Customers, not companies, control brand perception. Brands have their unique identities, own image, physical characteristics, and personalities. The statements that they make also have an impact on the industry's marketing and branding. The protection of well-known trademarks is critical to brand validity and consumer confidence.³⁷ Consumers rely on trademarks to identify and distinguish items in the marketplace, and they expect these trademarks to appropriately reflect the origin and quality of the goods or services they are purchasing. Brand perception is what consumers feel a product or service represents, not what the business that owns the brand claims it does. Brand perception comes from consumer usage, experience, functionality, reputation, and word-of-mouth recommendations - both on social media channels and face-to-face. Trademark infringement may significantly reduce consumer's trust in well-known brands. When consumers come across counterfeit or knockoff items with well-known trademarks, their faith in the brand might be affected. This may result in a decline in consumer perceptions of brand reputation, quality, value for money, and trustworthiness.³⁸

A brand is more than its products. It has a distinct personality that embodies its parent company's vision, mission, or culture. So it's not unexpected that the brand's personality resonates with people on a personal level, creating a psychological impression or perspective. Consumers cognitively process sensory signals from brands to form their own perceptions, and marketers capitalise on this by exposing them to all of our senses. The examples of the same are as follows:

- a. **Visual:** Instantly recognisable logos such as that of Coca-Cola, McDonald's, Mickey Mouse from Disney, and Siren from Starbucks etc. It also includes high-budget entertaining advertisements.
- b. **Auditory:** This includes catchy musical jingles such as that of Intel, Raymond, Airtel etc. Some also include catchphrases like- "Give Me a Break!" of Kit Kat, "Because You're Worth It" of L'Oreal, "I'm Lovin' It" of McDonald's etc.

Along with a business's name and logo, the catchphrase completes the three elements of brand identification. The catchphrases attract the attention of people and help them to differentiate

³⁶ PETER OTTOSSON, *Graduate School Master of Science in Intellectual Capital Management Master Degree Project No, 121* (2010), https://gupea.ub.gu.se/bitstream/handle/2077/22651/gupea_2077_22651_1.pdf (last visited Apr 13, 2024).

³⁷ Martin S. Roth, *The Effects of Culture and Socioeconomics on the Performance of Global Brand Image Strategies*, 32 JOURNAL OF MARKETING RESEARCH 163 (1995), <https://journals.sagepub.com/doi/10.1177/002224379503200204> (last visited Apr 13, 2024).

³⁸ Yulia W. Sullivan & Dan J. Kim, *Assessing the effects of consumers' product evaluations and trust on repurchase intention in e-commerce environments*, 39 INTERNATIONAL JOURNAL OF INFORMATION MANAGEMENT 199 (2018), <https://www.sciencedirect.com/science/article/abs/pii/S0268401217305352?via%3Dihub> (last visited Apr 13, 2024).

between brands.³⁹ Making a change in advertising catchphrases/slogans improves market value rapidly. Furthermore, the growth in market value is related to the alignment of changes in advertising catchphrases/slogans with the company's marketing strategy and commercials.⁴⁰

In the example of Nike's "Find Your Greatness" campaign, they were successful in encouraging everyone who wants to accomplish their own moment of greatness in sports with the help of their products, branding, and personalisation. With 8.5 million worldwide followers in this campaign, they were able to outperform themselves by personalising and linking their goods with something thrilling, motivating, and strong. In the case of catchphrases, they are intended to be the most remembered aspect of advertisements. For example, you might not recall every PULSE's ad you've ever watched, but you definitely remember "Pran Jaaye par, PULSE na jaaye."

Here are some key reasons highlighting the importance of consumer perception related to well-known brands:

- a. **Being Loyal to the Brand and Have Trust:** A Positive consumer impression results in heightened brand loyalty. When people have a good perception of a brand, they are more inclined to trust it, continue to be loyal to it, and prefer its products or services over competitors. This loyalty frequently withstands price variations and the arrival of new competitors.
- b. **Competitive Advantage:** A well-established positive impression by the consumer provides a competitive advantage. Brands with a strong, positive image are often chosen by customers even in a competitive market, providing them an edge over competitors.
- c. **Price Flexibility:** A positive impression of a well-known brand can cut down the price sensitivity among consumers. They may be willing to pay extra for goods or services that are related to a brand that they see as trustworthy, reliable, and of high quality.
- d. **Brand Extensions and Diversification:** Positive consumer impression enables well-known businesses to expand their product or services. Consumers are more inclined to try new products or services from a trusted brand, allowing the brand to grow its market share.

³⁹ Cobalt Communications, *The Psychology of Slogans: What They Are & How They Work*, MARTECH.HEALTH (2019), <https://martech.health/articles/the-psychology-of-slogans-what-they-are-how-they-work> (last visited Apr 13, 2024).

⁴⁰ Somayeh Abdi & Abdollah Irandoust, *THE IMPORTANCE OF ADVERTISING SLOGANS AND THEIR PROPER DESIGNING IN BRAND EQUITY*, 2 INTERNATIONAL JOURNAL OF ORGANIZATIONAL LEADERSHIP 62 (2013), https://ijol.cikd.ca/article_60321_8353fdde4f5d13114d31f7aad1c64c00.pdf (last visited Apr 13, 2024).

- e. **Influence on Purchase Decisions:** Consumer impression has an enormous impact on purchasing decisions. Perceptions about a brand's reputation, values, quality, and image frequently influence consumer's buying choices.
- f. **Word-of-Mouth and Advocacy:** A customer's positive opinion of a well-known brand encourages positive word-of-mouth marketing. The consumers who are Satisfied become advocates for their choices and brands, recommend the brand to others and help it to develop organically.
- g. **Resilience to Crisis:** Brands with a positive customer reputation are more likely to be resilient amid crises or unpleasant occurrences. A strong loyal consumer base and trust may help a brand overcome obstacles while minimising the harm to its reputation.
- h. **Sustainability of a Brand:** Brands that consistently maintain a positive perception among consumers throughout time are more likely to be sustainable. Continuously meeting or surpassing consumer expectations promotes good opinions and keeps the brand relevant over time.

To summarise, consumer perception and its impact on trademark protection are significantly more complex than surface-level findings suggest. As brand owners negotiate the complicated terrain of consumer psychology, they must dig into the depths of human cognition and emotion in order to really understand and protect their trademark.

VI. DATA ON THE BASIS OF THE SURVEY CONDUCTED

The author conducted a survey questionnaire to get information on consumers and well-known brands/trademarks. It was undertaken to collect and analyse data on what individuals think about well-known brands and their preferences. The survey was administered using Google Forms in an online format. The questionnaire was standard in length, and the author included reference frames in several of the questions. The surveys were designed with open and closed-ended questions. In most cases, the responder was given a minimal number of answer alternatives, such as four or five.

The Consumer's Perception

After conducting the online survey, the author discovered that customers trust goods and services that have legal protection for their well-known trademarks. When offered the option of purchasing branded or non-branded goods and services, 38% of respondents said they preferred branded things because they are of high quality, sustainable, and provide outstanding customer service. According to the survey, 31 respondents out of 49 chose a legacy brand over a new-age

How much do you trust products or services from brands that have legal protection for their well-known trademarks?
49 responses

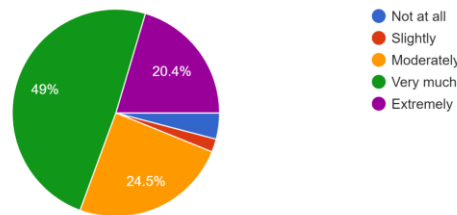


Figure 1

brand. People frequently choose legacy brands over new-age businesses for a variety of reasons, including trust and familiarity, perceived quality and prestige, heritage and tradition, brand loyalty, perceived reliability and consistency, testimonials on social media platforms and endorsements, and availability and accessibility. Legacy brands have a long history and established reputation, which gives consumers trust and confidence. They have a track record of consistently providing high-quality and dependable products, helping customers feel more at ease and safe about their purchases. Legacy brands are often associated with high-quality products or services, as well as a sense of prestige and exclusivity. Consumers may see these brands as symbols of status or poise, which increases their desire to be associated with them.

Legacy brands appeal to many consumers because of their history, reputation, and established track record of quality and reliability. Legacy brands frequently earn consumer confidence and loyalty owing to their history in the market and continuous supply of products or services over time. These brands offer excellent product return and exchange policies, as well as excellent customer service. The respondents had an opinion on which industry's well-known trademarks are more significant, beginning with technology, followed by automotive, food and beverage, health and wellness, and finally fashion. People believe that e-commerce websites also have an influential, well-known trademark. Furthermore, given the topic of loyalty to branded versus non-branded items, the majority of respondents stated that they would choose branded products over non-branded ones, while some favoured non-branded products. There are various reasons for choosing branded items, which are as follows:

- a. Quality of the product
- b. Value for money
- c. Good customer services

While other respondents prefer non-branded products, some of them are of the opinion that they don't want brand dominance in the market, and some feel if they are getting the same quality and same product at a cheaper price then they will go for it. While 7% of consumers do not care about goodwill or brand awareness as long as they get the exact same things as the branded ones. Many consumers feel that well-known trademarks indicate higher quality goods or services. Respondents connect well-known brands with a variety of attributes, beginning with the highest quality, comfort, value for money, and sustainability, and finally to trendy and popularity.

Consumers frequently identify their preferred items or products with certain characteristics that appeal to them on both cognitive and emotional levels. Understanding consumer psychology may help explain why people are drawn to specific items and how their purchase decisions are impacted. Through this survey, the author learned that consumers assign specific characteristics to their preferred goods. In terms of athletic goods companies, respondents feel that those goods should be trustworthy, lifestyle-oriented, and sustainable. In terms of respondents believe that their preferred garment companies should be reliable, lifestyle-oriented, minimalistic, sustainable, and empowering. In terms of their preferred automotive brands, respondents say that they should have quality, durability and reliability, comfortable seating, long-term resale value, and so on.

Many purchase decisions are motivated by emotions rather than rational factors. Consumers may be lured to things that elicit pleasant feelings like happiness, enthusiasm, or nostalgia. Marketers use emotional appeal, narrative, imagery, and brand experiences to build stronger relationships with customers. Brands that consistently manufacture high-quality goods are more likely to be preferred by customers looking for confidence and good value.

Environmental and Social Responsibility

Environmental & Social Responsibility To what extent do you consider a well-known brand's commitment to environmental and social responsibility in your purchasing decisions?
49 responses

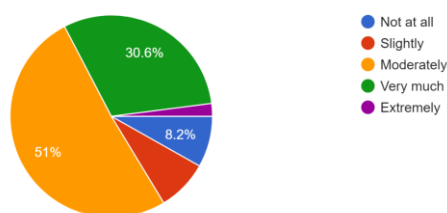


Figure 2

Are you more likely to support a well-known brand that actively engages in environmentally friendly or socially responsible practices?
49 responses

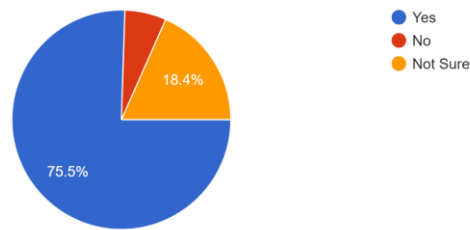


Figure 3

In today's world, customers place a high value on identifying with well-known companies that prioritise environmental and social responsibility. As people become more conscious of environmental and social concerns, they want to make purchases that reflect their values and views. According to the survey, 51% of respondents moderately base their purchase decisions on a well-known brand's commitment to environmental and social responsibility. While 75% of respondents are also more willing to support a well-known brand that actively promotes environmental or social responsibility. Here's why customers should engage with firms that prioritise environmental and social responsibility:

- a. Consumers are more inclined to support companies that reflect their values and show dedication to causes they care about, such as environmental sustainability, social justice, and ethical business practices. Associating with responsible businesses helps customers express their beliefs via their purchase decisions, creating a sense of congruence and authenticity.
- b. Supporting companies that prioritise environmental and social responsibility can lead to significant change on a larger level. Consumer demand for sustainable and ethical products drives companies to improve their environmental policies, lower their carbon footprint, and promote socially responsible activities.
- c. Consumers are becoming increasingly concerned about the ethical consequences of purchasing choices, such as labour rights, animal welfare, and environmental sustainability. Choosing to support companies that adhere to high ethical standards helps customers to feel good about their purchases while reducing their impact on harmful social and environmental effects.
- d. In today's interconnected world, customers, activists, and regulatory organisations are all scrutinising companies more closely than ever before. Negative publicity on

environmental or social issues can harm a brand's reputation and undermine consumer trust. By proactively addressing environmental and social problems, companies may reduce reputational risks and ensure long-term profitability.

As a consumer, will your decision to purchase a product from a well-known brand be influenced if they are exposed/called out for participating in unfair and unethical practices/ bad branding?
49 responses

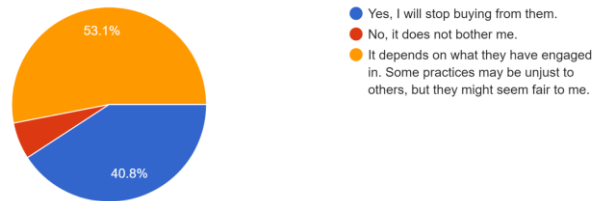


Figure 4

When respondents were asked if their decision to buy a product from a well-known brand would be influenced if the brand was exposed/called out for engaging in unfair and unethical practices/bad branding, there was a clear divide between 53% who answered that it depends and the other 40.8% who said they would stop buying from them.

Personalisation and Customisation

Personalization and Customization Do you appreciate or value personalized or customized products/services offered by well-known brands? ...n engraving on some of the products while buying.
49 responses

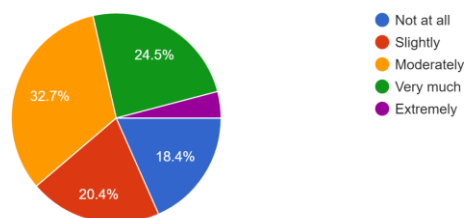


Figure 5

In this world, who does not like personalisation and customisation at their level best? Many people do. Personalisation enables customers to show their personalities, preferences, and distinctive sense of style. Customising things allows consumers to create something that embodies their individuality and identity, resulting in a stronger emotional connection to the product. Customised items provide buyers with a sense of ownership and control over their purchases. Participating in the design process gives them a deeper sense of investment in the product and satisfaction in having something that is uniquely theirs. It also improves the whole shopping experience and promotes an emotional connection to the brand. Whereas there are

some who not necessarily want to customise or personalise their products as the process of personalising items involves several choices, which might be confusing for some customers. Personalisation frequently comes with an added expense, since customised items may be more expensive than their conventional equivalents. Budget-conscious customers may be hesitant to pay a premium for customisation, particularly if they believe it is superfluous or non-essential. In terms of personalisation and customisation, respondent's perspectives vary: 32% have a moderate preference, 24% prefer it very much, 20% prefer it little, 18.4% do not prefer it at all, and only 4% have a severe affinity for personalising their goods. In my analysis, some are for and some are against personalisations and customisations. Understanding these motivations and barriers can help brands develop effective customization offerings that cater to consumer's needs and preferences.

Based on survey findings and consumer experiences with well-known trademarks, it is clear that the relationship between consumers and brands is multifaceted driven by a range of elements ranging from product quality and brand reputation to emotional involvement and social responsibility. The survey revealed both good and bad experiences that consumers had with well-known trademarks, emphasising the necessity of knowing customer views and preferences when developing relationships with brands. Brands must prioritise consumer satisfaction, respond quickly to complaints, and demonstrate a real commitment to fulfilling their needs and expectations. Well-known brands may develop their customer connections and prosper in an increasingly competitive environment by providing great brand experiences, creating trust, and interacting responsibly with consumers.

VII. A COMPARATIVE ANALYSIS OF WELL-KNOWN TRADEMARK PROTECTION LAWS IN SEVERAL JURISDICTIONS

In today's ever-expanding global economy, protecting well-known trademarks is vital for sustaining brand identification, encouraging innovation, and maintaining customer trust. The recognition and safeguarding of well-known trademarks vary significantly across jurisdictions, reflecting the diverse legal landscapes and cultural nuances that shape intellectual property frameworks. As businesses expand globally, knowing the comparative elements of well-known trademark protection becomes essential for both practitioners and regulators.

This research takes an in-depth glance at every nuance of well-known trademark protection legislation, diving into the legal systems in various nations. the author want to explore the complexities that control the recognition, definition, and enforcement of well-known trademarks through an analytical approach. By examining the legal landscapes of various

locations, this research hopes to find commonalities, differences, and developing trends, offering insight into the changing dynamics of trademark protection in the twenty-first century.

PROTECTION LAWS IN THE UNITED STATES OF AMERICA

The two most essential legislations exist to protect well-known brands internationally and those are the Paris Convention and the TRIPS Agreement. Countries that are members of the aforementioned legislation must adhere to the provisions outlined in the statutes. The Paris Convention was signed in Paris on 20th March 1883 and entered into force on 7th July 1884. It was introduced for the protection of industrial property and it is the oldest treaty. In 1883, the Paris Convention established the doctrine of well-known marks. Article 6bis of the 1967 Paris Convention for the Protection of Industrial Property urges member nations, including the United States, to provide some protections to well-known trademarks, not matter whether the marks are registered or not.⁴¹ In addition, member countries have the power to refuse or cancel the registration, as well as prohibit the use, of a well-known mark when applied for or used by another party but the owner illegally for identical or similar goods, when such use or registration is likely to cause confusion in the minds of the public.

The Trade-Related Aspects of Intellectual Property Rights (TRIPS) agreement also protects well-known marks under Article 6bis of the Paris Convention. The TRIPS agreement includes Articles 16.2 and 16.3 of the TRIPS agreement. Article 6 bis applies to services and items that are not identical to registered trademarks. The Paris Convention only protects identical or similar goods, but the TRIPs agreement protects registered trademarks for both goods and services. It also covers dissimilar goods and services if third-party use indicates a relationship with the owner of the registered mark, potentially harming the owner's intellectual property. Article 16.3 of the TRIPS Agreement extended the protection of Article 6bis to well-known marks when used on unrelated goods or services in circumstances where the well-known mark is registered if such use shows an association with the owner, and the owner of the well-known mark is likely to suffer injury.

The Well Known trademarks in the United States of America are protected under the Lanham Act. The United States Patent and Trademark Office (USPTO) refuse to register a mark that is in conflict with a registered or unregistered well-known mark whether international or domestic. A third party can also attempt to oppose or cancel the registration of the conflicting mark that fulfils the test of Lanham Act's Sections 2(a) and (d). Section 2(a) states that a mark will not be registered if it is misleading or indicates that the disputed mark is associated with individuals,

⁴¹ (WIPO, 1979)

institutions/organisations, beliefs, or national symbols. To receive protection under the aforementioned provision, it is not necessary for a mark to be registered; nonetheless, the mark must indicate to a known or unknown source, such that customers would be misled if the products or services are of the applicant. According to Section 2(d) of the Act, a mark's registration would be rejected if it is likely to be confused with a previously registered mark.

It can be opposed or cancelled by an interested third party while its prior, confusingly similar mark is still in use in business and has not been abandoned. The USPTO does not make a particular conclusion as to whether a mark is 'well-known' during its examination; rather, it assesses the strength of the mark and determines what protection to offer a previously registered or unregistered mark against an undecided application. Section 43(a) of the Lanham Act allows the owner of a well-known mark to sue for trademark infringement. When determining infringement, the court will consider the probability of causing confusion.

There are 13 elements outlined in the case of *E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973), which are used to determine the possibility of confusion.⁴² The factors are as follows:

- Resemblance of the marks
- the likeness of the goods or services
- the similarity of existing trade channels
- the dominance of the registered mark
- the sophistication of purchasers
- the quantity and character of similar marks in use on similar goods and services.

What cannot be registered as a trademark in the United States?

As we make a lot of registrations with respect to trademarks and we have so many categories as to what we can register as a trademark, It is also important to know what cannot be trademarked. When introducing goods and/or services, it is important to look for competing trademarks before registering one's own trademark. This process is called Prior-Art Search.

The refusal of a trademark on the basis of descriptiveness is mentioned in 15 U.S.C. §1052 (Section 2 of the Lanham Act).

A generic and a descriptive term cannot be trademarked, eg- if you are selling apples you cannot

⁴² Winthrop & Weinstin, *Overcoming Likelihood of Confusion Refusals*, WINTHROP & WEINSTINE, <https://winthrop.com/bold-perspectives/registering-trademarks-overcoming-section-2d-likelihood-of-confusion-refusals/> (last visited Apr 13, 2024).

trademark apples as marks. The attorney who is examining the mark can refuse the registration of the same if the mark is merely descriptive and deceptively misdescriptive, for example– If you are selling burgers then the mark ‘WORLD’S BEST BURGERS’ would be considered as merely descriptive for burgers. In the latter case, if a book, magazine, an article has a mark titled ‘DARK DAYS OF INDIA, 1975’ and does not contain events related to the same then it would be considered as a deceptively misdescriptive mark. The attorney who is examining the mark can refuse the registration of the same if the public is buying a mark that contains a surname i.e. a family name or a last name, for example– the mark “BIDEN PHARMACEUTICALS” would be considered primarily merely a surname.⁴³

Terms that are misleading or that misrepresent the products or services, their contents, or their place of origin will not be registered as trademarks. If a mark is similar in sound, appearance, or meaning, it may be sufficient to sustain a determination of the risk of confusion. It will not be eligible for trademark registration. If your mark includes any flags, coats of arms, or other symbols of the United States, a foreign nation, or a United States state or municipality. the same prohibition applies to government officials.

Well-Known/ Famous Trademarks

Under US law well-known trademarks are also referred to as ‘famous marks’. Under US law, there are two categories of trade marks that can be considered 'famous'. The first category includes familiar names and marks on objects of daily use, such as Nike or Pepsi. The second category includes luxury items (luxury brands) that are widely recognised and recognised by a large portion of the public, but are not available to everyone, such as LOUIS VUITTON. The owners of well-known trademarks work hard to prevent the once-valued trademark from becoming generic. Xerox's ad campaign "*when you use 'Xerox' the way you use 'aspirin,' we get a headache*" aims to maintain the individuality of the XEROX® brand. (Bouchoux, 2012, 26-27) In general, marks should be used as adjectives, such as "I need a KLEENEX tissue." Using a trademark as a noun, such as "I need a Kleenex," might result in the mark becoming generic and losing its trademark protection.

In *Grupo Gigante v Dallo*⁴⁴, a Mexican grocery chain was operating under the mark ‘GIGANTE’ and had a goodwill and reputation in the market. They sued a grocery store to restrain them from using the mark ‘GIGANTE’ in San Diego. The US Court of Appeals for the

⁴³ USPTO, *Possible Grounds for Refusal of a Mark*, WWW.USPTO.GOV (2016), <https://www.uspto.gov/trademarks/additional-guidance-and-resources/possible-grounds-refusal-mark> (last visited Apr 13, 2024).

⁴⁴ *Grupo Gigante v Dallo*, (391 F3d 1088, 1108, 9th Cir 2004)

Ninth Circuit recognised the principle of territoriality which means that the priority of rights in the United States is determined by their usage in the States, rather than their priority in other nations. However, the court also acknowledged that the Well-known marks are an exception to this principle. The court applied and determined that *“even though the foreign user did not use the mark in the United States until after the domestic user, given that consumers in the United States recognised the foreign user's mark as having achieved a certain level of fame, the territoriality principle did not deny priority to the foreign user.”* Further, the court held that applying the principle would amount to more confusion and fraud among consumers.

In *ITC v Punchgini*⁴⁵, The US court of Appeals for the Second Circuit reached the opposite ruling from the above-mentioned case. In this case, ITC was the owner and operated the ‘BUKHARA’ restaurant in India, Singapore and other countries, as well as a franchise outlet in the United States. After the franchised location was closed, the employees from both the Bukhara restaurant in India and the franchisee branch in the United States founded ‘BUKHARA GRILL’ in New York City. ITC filed a case against the owner of Bukhara Grill to restrain them from using the mark Bukhara, Based on the principle of territoriality, the court held that *“absent some use of its mark in the United States, a foreign mark holder generally may not assert priority rights under federal law, even if a United States competitor has knowingly appropriated that mark for his own use”*. The court determined that the well-known marks exception did not apply because Congress had not specifically integrated the concept into US law.

*ITC Ltd. v. Central Park Estates Private Ltd.*⁴⁶, The decision rendered in this case was an important milestone in evaluating the relevance of well-known marks under Indian law, and it prompted a debate on the territoriality concept and the famous marks theory under US law.

The Plaintiff's registered trademark, "Bukhara" was used in connection with a famous restaurant that had built up a reputation and been in the hospitality sector since 1975. As a result, the Defendants used the trademark ‘Balkh Bukhara’ for their restaurants. The Plaintiff's main argument was that "Bukhara" was a well-known mark under Section 2(zg) of the Act and hence entitled to protection under Section 11(2) of the Act. The Court examined the decision of the US Court of Appeals, in a suit against ITC for infringement of their trademark in India. The court found that the plaintiff's trademark had substantial goodwill and reputation among Indians and foreigners. India recognizes transborder reputation and "well-known mark" doctrines, so the US Court's judgments were not applicable in this case.

⁴⁵ ITC v Punchgini, (482 F3d 135, 142,2d Cir 2007)

⁴⁶ ITC Ltd. v. Central Park Estates Private Ltd., (2022 SCC OnLine Del 4132)

Timberland Company v Rohit Bajaj and Others⁴⁷

The plaintiff filed a lawsuit against the defendants seeking a permanent injunction to prevent trademark infringement, passing off, dilution, damages, delivering up, and so on. The plaintiff has engaged in the manufacture and marketing of branded apparel and footwear 'TIMBERLAND AND TREE DEVICE' since 1973. In 2002, the plaintiff found out that the defendants had a website on which they were said to provide stocks of branded products, and among those items, the defendants were shipping and offering to sell goods under the plaintiff's well-known trademarks to other nations. Defendant 1 was selling counterfeit products by giving the false impression that the things he sold were from the plaintiff. The Hon'ble court was of the view that infringement was committed by the defendants and ordered the defendants to pay the damages to the plaintiff.

Dilution of Well-known Trademarks

In the United States, 15 U.S.C. § 1125(c) regulates the cases of trademark dilution and protects against infringement of famous/well-known trademarks. After several amendments, the need to prove the actual dilution was eliminated by the Federal Trademark Dilution Act (FTDA) in cases of dilution. The owner of a well-known mark that has become "famous" may bring an action against another use of the mark in U.S. federal courts or seek to oppose or cancel another's application or registration for the mark based on the likelihood of dilution. Dilution is the unauthorised use of a famous brand to obscure its distinctiveness or degrade it in a negative way. For example— The use of the TIFFANY® mark by a restaurant in Boston was not likely to be confused with TIFFANY for jewellery shop services in New York. A common man would not assume the two uses were linked or that the restaurant services were endorsed by Tiffany jewellers. The use of the mark by the restaurant was held as a dilution of Tiffany Jewellery's well-known/famous trademark.⁴⁸ The *Grey v. Campbell Soup Co.*, 650 F. Supp.⁴⁹, is another well-known case, wherein the use of DOGIVA on dog biscuits caused damage to the plaintiff's business reputation and resulted in the dilution of trademark by the way of tarnishment. It still damaged the reputation of the plaintiff's mark although the consumers would not be confused if they saw the mark and assumed the dog biscuits were associated with GODIVA® chocolates.

The dilution act protects trademark owners' property rights and goodwill by preventing less experienced users from using the mark for unrelated items. Dilution occurs when a well-known brand loses its ability to differentiate products and services. The main difference between a

⁴⁷ Timberland Company v Rohit Bajaj and Others 2014 SCC OnLine Del 4558: (2015) 61 PTC 603.

⁴⁸ Tiffany & Co. v. Boston Club, Inc., 231 F. Supp. 836 (D. Mass. 1964).

⁴⁹ Grey v. Campbell Soup Co., 650 F. Supp. 1166 (C.D. Cal. 1986).

claim of infringement and a claim of dilution is that one can prove dilution without demonstrating the possibility of confusion. (Bouchoux, 2012, 133) The aggrieved party is awarded injunctive relief once dilution is proved. In order to succeed in a dilution lawsuit a plaintiff has to prove four factors. The factors are as follows:

1. The plaintiff's mark is well-known, either via inherent or acquired distinctiveness.
2. The defendant is using the plaintiff's trademark for commercial purposes.
3. The defendant's usage began after the plaintiff's mark gained a reputation.
4. The defendant's use of the mark could lead to dilution by blurring or tarnishing the well-known mark, regardless of whether there is actual confusion or economic harm to the plaintiff.

The Concept of parody Goods

There are some more types of marks in the United States of America that have received the judiciary's attention, they are non-competing items that mock or ridicule the trademark owner or their mark. Parody items can take several forms, including satirical T-shirts, bumper stickers, buttons, novels, movies, periodicals, websites, musical records, and live performances. To understand this concept we have to look into the case of *Anheuser-Busch, Inc. v. L & L Wings, Inc.*⁵⁰, Michael Berard was a university student who wanted to make additional funds by designing and selling T-shirts. He created t-shirts with illustrations inspired by the BUDWEISER beer mark, but honouring Myrtle Beach, South Carolina. His shirts included the phrase "King of Beaches," a pun on Anheuser-Busch's KING OF BEERS tagline, rather than the term BUDWEISER. His shirts were printed using the same colour scheme, layout, and visual features as the BUDWEISER labels. Anheuser-Busch filed a lawsuit for infringement. Following a three-day trial, the jury rendered a verdict for the defendant. The fourth circuit ruled that "*there was no chance of confusion and that Berard's tee-shirt was easily identifiable as a parody.*" In the case of *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*,⁵¹ The plaintiff manufactures luxury products such as luggage and handbags. The plaintiff alleged that the defendant had used their registered trademark and diluted it by developing and distributing a line of Chewy Vuitton dog chew toys that mimicked the plaintiff's handbags and trademarked designs. The defendants offer parodies of high-end brands, such as "Chewy Vuitton" (parody of Louis Vuitton), "Furcedes" (parody of Mercedes), and "Sniffany & Co." (parody of Tiffany &

⁵⁰ *Anheuser-Busch, Inc. v. L & L Wings, Inc.*, 962 F.2d 316 (4th Cir.1992), cert. denied, 506 U.S. 872, 113 S.Ct. 206, 121 L.Ed.2d 147 (1992).

⁵¹ *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 84 U.S.P.Q.2D (BNA) 1969

Co.). The Court of Fourth Circuit concluded that “*Haute Diggity's marks, while "undeniably similar" to LVM's marks, were successful, effective parodies that obviated any likelihood of confusion and thus, trademark infringement.*”

But in some cases the parody can backfire on the individual or the proprietor making them like in the case of *Coca-Cola Co. v. Gemini Rising, Inc.*⁵² wherein the defendant sold a poster that replicated the plaintiff's 'Coca-Cola' trademark and style, but changed the letters 'ine' for '-Cola', resulting in the poster reading 'Enjoy Cocaine.'" The plaintiff produced proof of customer complaints and threats of boycott, alleging that the plaintiff funded posters advertising a potentially life-threatening drug.

Similarly in a recent case of *Jack Daniel's Properties, Inc. v. VIP Products LLC*⁵³, a well-known Tennessee whisky brand, Jack Daniel's, brought an infringement lawsuit against the defendant's chewy dog toy “Bad Spaniels”. The defendant's bottle design was comparable in size and form to the plaintiff's conventional bottle. The Supreme Court determined that the defendant's toy misled customers into believing that it was approved for manufacturing by the plaintiff and constituted an infringement of their trademarks.

The Supreme Court's most recent decision on trademark parody highlighted that while parody is not a distinct category of trademark use that is entitled to protection, it yet plays a role in trademark law. A trademark can be mocked only if it is not used to differentiate a product, or if it is, the parody is done in such a way that consumers believe that the trademark owner has allowed so. From the above text, we have gathered that the proprietor's use of a high-end brand or well-known brand's famous trademark as a parody will not be regarded as an infringement because it is considered a form of expression. These parodies are a sort of amusing or satirical commentary that uses a well-known trademark in a playful or critical context. If a well-known mark owner considers that a third party's use of its trademark may harm its reputation, the corporation may take legal action against the parody mark to defend its reputation and trademark rights. The owner can only prevent the other person from using their mark if the owner proves that the plaintiff owns a well-known mark that is distinctive, that the defendant has begun using a mark in commerce that allegedly is diluting the same, that a similarity between the impugned mark and the well-known mark gives rise to an association between the marks, and that the association is likely to impair the uniqueness of the well-known mark or likely to harm the reputation.

⁵² *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F.Supp. 1183 (E.D.N.Y.1972).

⁵³ *Jack Daniel's Properties, Inc. v. VIP Products LLC*, No. 22-148 (Supreme Court June 8, 2023)

PROTECTION LAWS IN THE UNITED KINGDOM

Article 6bis of the Paris Convention and Article 16 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs) provide the standards of protection of well-known marks across the globe. However, neither statute provides information on what constitutes a well-known mark, just limited advice. In the UK the Registrations and infringements of trademarks are governed by the Trademarks Act 1994. Section 56 of the Trademarks Act, 1994 clearly applies Article 6bis and Article 16. It applies to well-known marks in the United Kingdom, regardless of whether the brand owner does business or has goodwill there or not.⁵⁴ The owner of the well-known mark must either be a national of a Paris Convention country, be domiciled in a Convention country, or have a real and effective industrial or commercial establishment in a country signatory to the Convention. The first proceeding to determine what is considered a well-known mark under Section 56 was discussed in the case of *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Limited*⁵⁵, wherein the mark ‘CIPRIANI’ which was owned by the plaintiff. The plaintiff filed a suit to prevent the defendant from using their trademark, which they were using for their London restaurant, Cipriani London.

Section 56 of the Act permits the brand owner to protect the use of their mark while restricting the other mark in an issue that is similar to the owner's mark (which can be an essential part of the mark), and the protection is sought in the case where in both the marks are related to identical or similar goods. Section 10(2) of the Act seeks to protect the infringement of well-known trademarks. When obtaining protection for using a well-known trade mark under Section 56, the plaintiff does not need to be in business or have goodwill in the United Kingdom.⁵⁶ In *Le Mans Autoparts Limited v. Automobile Club De l’ouest de la France*⁵⁷, The applicant filed to get the trademark registration of the mark “LE MANS” in classes 6,7, 9 and 12. Initially, it was opposed by the ACO on several grounds involving Sections 3 and 5 of the Act. Hon’ble Justice Richard Arnold found that the LE MANS was a well-known mark in the United Kingdom in terms of services related to organising and managing motor racing events both among consumers of, and traders in, such services and among the public at large. He also found that the mark was the name of a famous race and had been widely used and marketed for several

⁵⁴ Vicky Butterworth & Jason Chester, *United Kingdom: Protecting and Enforcing Renowned Trademarks in non-registration Jurisdictions*, WWW.WORLDTRADEMARKREVIEW.COM (2016), <https://www.worldtrademarkreview.com/article/united-kingdom-protecting-and-enforcing-renowned-trademarks-in-non-registration-jurisdictions> (last visited Apr 13, 2024).

⁵⁵ *Srl v Cipriani (Grosvenor Street) Limited* ([2008] EWHC 3032 (Ch))

⁵⁶ Government of UK, *Trade Marks Act 1994*, LEGISLATION.GOV.UK (2022), <https://www.legislation.gov.uk/ukpga/1994/26/section/56> (last visited Apr 13, 2024).

⁵⁷ *Le Mans Autoparts Limited v. Automobile Club De l’ouest de la France*, (O-012-05).

years. The court found that there was an obvious connection between the parts for motor cars sold by the applicant and the organizing of motor races by the opponent, which could lead consumers to believe that the applicant's goods were approved, endorsed, or licensed by the opponent. Consequently, the court concluded that the use of the mark by the applicant would give rise to a misrepresentation. Previously, the Act prohibited the use of identical or similar competing trademarks in relation to similar or identical products or services that are likely to cause confusion. The new section 56(2A) (and revised section 56(2)) now allows the owner of unregistered well-known marks to ban the unfair use of their well-known marks on different goods or services. In *Tiffany & Co. v. Philip Morris*, the plaintiff had filed a suit to restrain the defendant from registering their mark "TIFFANY" for cigarettes. The plaintiff filed evidence which portrayed that they have a great reputation and their mark is a well-known mark. The defendant argued that they have been using the same mark for a long period of concurrent use in various countries. However, the UK Trademark Office rejected the registration application on grounds that their use would likely deceive or cause confusion in the general public.

Dilution of Trademarks

The concept of dilution differs from other forms of infringement in that it provides the owner of a trademark the authority to prohibit any person from using their mark in markets wherein there is no competition, dissimilar goods, or goods that have no competition with the owner's trademark. For example– If a company uses a trademark related to automobile products might be diluted if another company uses a similar mark for sleep products and pillows. The laws related to the dilution of trademarks do not resolve confusion about who owns the goods and/or services, but rather attempt to safeguard sufficiently strong trademarks from losing their unique association among the public.

In the United Kingdom, the registration of the trademark is under the UK Trademarks Act 1994. Under this act "Likely to confusion" is an essential requirement for the finding of infringement under section 10(2) of the Act. This includes a possibility of an association, which states that if an identical or similar sign is used in combination with the same or similar goods for which a mark is registered, there is infringement if there is a risk of public confusion.

The court uses a three-part test in certain cases. First, To assess the identity resemblance of the mark with the sign. Second, To examine the concept of similarity between the various goods and services. Third, To determine if there was a probability of confusion due to that similarity.

In *Decon Laboratories Ltd., v. Fred Baker Scientific Ltd*⁵⁸ The case was with the plaintiff's

⁵⁸ Decon Laboratories Ltd v Fred Baker Scientific Ltd And Another, CHD 28 FEB 2001w

"Decon" mark. The defendant used to offer similar items including the name "Decon". This act by the defendant was found to be infringing since the primary function of the term was to describe the product, and they did not separate the defendant's products from those of the plaintiff.

Section 10(3) of the Act provides that a registered trademark is infringed in the UK if a similar or identical mark is used which is too similar to those which are already registered, where the trade mark has a reputation and the use of the sign takes advantage. This section is actually focusing on the dilution of the trademark.

***Navway Limited v Caryn Mandabach Productions Limited*⁵⁹**

On February 26, 2022, the applicant requested to register the trade mark illustrated on the front cover of this judgement in the United Kingdom in class 25 (clothing products). On July 1, 2022, the application was contested by the opponent, who is a co-producer and owner of the rights to the TV series Peaky Blinders. The opponent claimed that the applicant's mark "PEAKY CLOTHING" does not convey a different overall reputation and that the impugned mark is visually and phonetically similar to the earlier mark, resulting in a possibility of confusion. The Hon'ble Court considered the opposition of the opponent refused the registration of the mark of the applicant and ordered the applicant to pay damages to the opponent.

***Eureka Education v Eureka! The National Children's Museum*⁶⁰**

The applicant wanted to register the mark EUREKA EDUCATION on April 8, 2022, in classes 16, 35, 41, and 42. On September 12, 2022, the opponent filed an extensive opposition to the application, claiming that the applicant's mark is identical and substantially similar, which may cause confusion in the public. The opposition under section 5(2)(b) has been partially successful. The applicant was allowed to register for class 35. The court ordered the plaintiff to pay damages to the opponent.

PROTECTION LAWS IN AUSTRALIA

In Australia, the Registrations and infringements of trademarks are governed by the Trademarks Act 1995. There is a concept of defensive registration in Australia that is mentioned in Part 17 of the Act. Such defensive registration is available for 'well-known' or 'famous' trademarks. There are several brands that are protected by a defensive registration and that include—Kellogg's, Billabong, the Wiggles and Vegemite. The defensive trademarks can be registered by the applicant without any intention to use the mark for goods or services. The registration of

⁵⁹ Navway Limited v Caryn Mandabach Productions Limited, (0/0178/24)

⁶⁰ Eureka Education v Eureka! The National Children's Museum, (O/0087-24)

the mark will not be cancelled if it is not used ever. The rationale behind defensive registrations is to come up with a broader protection and prevent deception and confusion in the marketplace. Although there is a provision of passing off as well but there is an advantage of defensive registrations that no actual deception needs to be proved. The question is simple—"That has the defendant used the same or similar mark for the same or similar goods?" The notion of damaging the reputation of a registered mark into goods or services that are not related is not new in this field. Back in 1898, KODAK a camera company, filed a suit against a bicycle company for use of their trademark. The UK Court restricted the bicycle company from using the well-known word 'KODAK' as it would lead the consumers to believe that the mark up for registration is associated with the KODAK Company.⁶¹

Defensive/well-known trademarks in Australia

Defensive registration is a helpful instrument to facilitate a company to enforce its rights against proprietors who misuse well-known marks in fields unrelated to the company. Part 34 of the Trade Marks Manual of Practice and Procedure talks about Defensive trademarks. Lately, 'BOTOX' a defensive mark of Allergan was allegedly infringed by another proprietor by using 'PROTOX'. But later on, the court held that the Allergan's trademark was not infringed.⁶² The IP authorities of Australia does not grant defensive registration that easily and to register such a mark there are some prerequisites to be met— The prerequisites are that the mark up for registration is a well-known mark or famous mark in Australia; and the mark has been used so extensively on previously registered products that its usage in relation to the broader goods/services mentioned in the defensive application is likely to be interpreted as implying an affiliation with the applicant.

There are some defensive trademarks that are registered in Australia, those are as follows--

- CHANEL in the name of Chanel Limited
- No. 5 in the name of Chanel Limited
- PLUMM in the name of Joval Pty Ltd as trustee for Joval Brands Trust⁶³
- ACCENTURE in the name of Accenture Global Services Limited
- CPA in the name of CPA Australia Limited

⁶¹ Eastman Photographic Material Co Ltd v Griffiths Cycle Corp Ltd (1898) 15 RPC 105.

⁶² Allergan Australia Pty Ltd v Self Care IP Holdings Pty Ltd (2021) FCAFC 163.

⁶³ Jürgen Jürgen Beber, Chris Sgourakis & Sarah Catania, Protecting well-known brands: Utility of Defensive Trade Mark Registrations, Corrs Chambers Westgarth (2021), <https://www.corrs.com.au/insights/protecting-well-known-brands-utility-of-defensive-trade-mark-registrations> (last visited Apr 13, 2024).

The Trademarks Act provides provisions for infringement, granting owners of "well-known" marks more privileges. For obtaining such broader protection, the marks should be registered and must be well-known in Australia. Sections 120(3) and 120(4) of the Act provide protection for well-known marks in an instance of infringement.⁶⁴ As per Section 120(3) of the Act, a person infringes a registered mark if:

- a. The proprietor infringes on a well-known trademark by using a mark that is substantially identical or deceptively similar to unrelated goods or services.
- b. The registered owner's interests are unflatteringly affected.

As per Section 120(4) of the Act, For the purposes of determining whether a trademark is well-known in Australia requires taking into consideration the extent to which the trademark is recognised within the relevant sector of the public, whether as an outcome of trade mark promotion or for any other reason. The above-mentioned sections of the Trademarks Act, 1995 clearly apply Article 6bis and Article 16 of the Paris Convention and TRIPS Agreement to ease the enforcement of the registered proprietor's rights in well-known marks. Section 60 of the 1995 act allows the owner of a registered or unregistered mark that has a reputation in Australia to oppose the registration of a deceptively similar mark if it is likely to create confusion or deception. With the increasing importance of trademark registration and the number of the same, Protection against similar marks aiming to capitalise on a well-known mark's reputation has increased. In 2001, Pfizer applied for registration of the trade mark 'VIAGRA' as a defensive trade mark in ten classes.⁶⁵ However, the examiner rejected the mark on the grounds that it was not demonstrated that the public was likely to make an association between the applicant and the use of the mark in relation to the goods/services determined by the defensive trade mark. The original application claimed priority. As a result, the priority date of the applicable defensive trade mark application was moved forward by three years. Pfizer then provided proof of usage for the three years spanning the previous priority date and the new priority date. The Hearing Officer acknowledged the mark's 'deepening fame' throughout the extended three-year term, implying that the public was more likely to associate it with a broader set of goods/services. Later on, the Hearing officer also believed that the application should be allowed. In Australia, a proprietor of the well-known trademark can claim their rights and file a suit for infringement under various provisions of the said Act, the provisions are Section 60,

⁶⁴ Government of Australia & IP Australia, *34.1. Australian trademarks law and defensive trade marks / IPA Manuals*, MANUALS.IPAUSTRALIA.GOV.AU (2022), <https://manuals.ipaustralia.gov.au/trademark/1.-australian-trademarks-law-and-defensive-trade-marks> (last visited Apr 13, 2024).

⁶⁵ Re Pfizer Products Inc (2004) 61 IPR 165.

62A, 43 and 44. Section 60 has been made use of as a basis for opposition and is the subject of several rulings. For example– Pfizer strongly opposed the Trademark registration of HERBAGRA for herbal medications, highlighting the reputation of VIAGRA.⁶⁶

Many Australians acknowledge to having a close connection to specific marks and identify the value of strong trademarks in contributing to product success and national economic growth. Some of the well-known trademarks are–

- a. ABC (Australian Broadcasting Corporation)
- b. Vegemite
- c. Qantas
- d. Arnott's

Boot Dispute⁶⁷

It is one of Australia's most famous trademark infringement lawsuits, with the parties involved being American Sheepskin Company Deckers Outdoor Corporation and family-owned Australian firm Luda Production. Luda Production has been making and selling winter sheepskin boots for decades under the company's name and had gained wide scale reputation in Australia. The consumers in Australia believed that those are 'UGG Boots' and the name is a local slang. But Luda Production did not get a trademark registration for this name, the Deckers Outdoor Corporation did and was making profits on the reputation and popularity of those boots. Deckers claimed exclusive rights to use the impugned term and actively used to send notices to Luda's company to stop them from selling goods under this name. Despite being able to establish that they had made and marketed sheepskin boots under this brand for decades prior to Decker's trademark, Luda lost the lawsuit and was compelled to pay Deckers Outdoor Corporation \$450,000 in damages.

Taylor v Killer Queen, LLC⁶⁸

This is a famous and elongated conflict between singer Katy Perry and Australian designer Katie Jane Perry. Since 2007, the designer has designed and marketed clothes in Australia using her birth name "Katie Perry". In 2008, the Designer sought to register the trademark "KATIE PERRY" (KATIE PERRY Mark) for 'clothes' in class 25. In May 2009, the Popstar noticed

⁶⁶ Pfizer Products v Karam (2006) 219 FCR 585

⁶⁷ Barry Meskin, *Famous Trademark Infringement Cases | IP Guardian*, IP GUARDIAN (2022), <https://ipguardian.com.au/resource-centre/famous-trademark-infringement-cases/#:~:text=An%20Ugg%2Dly%20Dispute%20Over%20A%20Boot> (last visited Apr 13, 2024).

⁶⁸ Taylor v Killer Queen, LLC, (No 5) [2023] FCA 364

about the Designer's application for the KATIE PERRY Mark. The Popstar's career had lately taken off, and she was gaining popularity across the world, especially in Australia. She was concerned that the Designer was seeking to profit from the Popstar's reputation; thus, the Popstar opposed registration of the KATIE PERRY Mark and addressed a cease-and-desist letter to the Designer over the use of the mark. After the lengthy processes, the singer could not proceed to register the mark 'KATY PERRY' in class 25. The Federal Court of Australia held that the designer's trademark 'KATIE PERRY' was infringed by companies owned and operated by the singer.

***Twentieth Century Fox Film Corp & Matt Groening Productions Inc v South Australian Brewing Co Ltd & Lion Nathan Australia Pty Ltd*⁶⁹**

In this case the defendant adopted the name "Duff Beer" for promotions of their product. The plaintiffs invented and utilised the fictional 'Duff Beer' in the popular television show 'The Simpsons'. The S.A. brewing i.e the defendant then used the name 'Duff Beer' on its goods without TCF's authorization or a licence to make use of their intellectual property. The court ruled that because the series was replayed on TV at peak broadcasting hours for several years, and the beer's target market group was the same as those who watched the show, the defendant did not take sufficient precautions to separate its 'Duff Beer' from that of the show. Customers are likely to identify the S.A brewery with the programme. Furthermore, TCF also had a policy against utilising their merchandising rights to promote alcohol, therefore using 'Duff Beer' in this manner might possibly harm TCF's reputation.

Finally, the comparative analysis of well-known trademark protection regulations across multiple jurisdictions highlights the critical role consumers play in influencing the success and recognition of these trademarks. Across various legal frameworks, it is clear that consumer perception and engagement are critical elements influencing the efficacy of trademark protection measures. While recognition criteria and legal protections are comparable across countries, Consumers are the final judge of brand's reputation, goodwill, by contributing by being loyal, and having trust on the brand. Some nations have a broader view of how to protect well-known trademarks and recognise when a brand has been diluted. And the others do not have a much broader interpretation to include or exclude trademark parody as an infringement.

VIII. CONCLUSION & SUGGESTIONS

Well-known trademarks are those that are recognized internationally and are associated with

⁶⁹ Twentieth Century Fox Film Corp & Matt Groening Productions Inc v South Australian Brewing Co Ltd & Lion Nathan Australia Pty Ltd (1996) FCA 1484

well established brands. The research has shed light on the complex link between consumers and well-known trademarks and the regulations for protection of them in several jurisdictions. It is indeed right, that the consumer runs the brand and makes the brand well-reputed. The extensive comparative analysis in the research provides insight into the factors that impact consumer perceptions, behaviours, and attitudes towards well-known trademarks, as well as the legal frameworks that regulate their protection and enforcement. Thus it can be concluded that well-known trademarks should be given preferential treatment when they want to register their marks and to seek protection against infringement by looking at the reputation and goodwill and the usage of the same, For a well-known trademark to keep up it's reputation and goodwill, it takes lot of resources. If such marks are not prioritised and safeguarded, they may cause issues across borders, potentially damaging international relations. This calls for long-term and strategic decisions. Authorities have to work together to create effective measures for reducing infringement of well-known trademarks. The authors of this research concluded that well-known trademarks play an important role in the field of intellectual property rights and should be given preferential consideration to promote fairness, transparency and integrity in the marketplace.

If the suggestions made below are correctly implemented by the government, owners, and other parties, can all work together to avoid this malpractice and ensure that no infringement occurs. This will also guarantee that fair trade practices are followed and that no harm is done to the owner of the well-known trademarks and will promote creativity and innovation for the benefit of everyone.

Sustainable Solutions to Prevent and Stop Infringement of Well-Known Trademarks

a. Improved synergy between technology and legal framework

To ensure that there are no more infringements in this sector, technology and the legal framework should be properly integrated. There should be an automatic monitoring system that can identify infringement. The enhanced database method fosters openness, allowing for transparent information sharing across several networks.

b. The timely publication of well-known trademarks in the journal

Many times, when a third party chooses a mark, they are unable to locate data on well-known trademarks on the website in the journal. The data should be published in the journal on time because there is minimal information available on the website, leading others to assume that they can register their mark. Timely publication makes it easier for third parties/ others to cross check.

c. Stronger consequences for infringement

When someone infringes on a well-known trademark, there should be stronger consequences. When this occurs, the first and second copies of the mark should be confiscated and penalties should be increased or doubled. The sale of counterfeit items and dupes is quite popular in India, which has a detrimental impact on customer faith in the brand. It frequently creates misunderstanding, which can be quite harmful in the case of pharmaceutical and food brands. Such brands must be subjected to more stringent checks and confiscation. Infringement can harm overseas brands entering the Indian market.

d. Uniformity of Legal Standards

There is a need for greater harmonization of legal standards and recognition criteria for well-known trademarks across jurisdictions. Establishing standard principles and criteria for evaluating a trademark's well-known status can help to improve uniformity, clarity, and effectiveness in trademark protection activities.

e. Enhanced Consumer Education

There should be initiatives to educate consumers about the importance of well-known trademarks and their role in promoting legitimate and well known companies in order to prevent counterfeiting and infringement. It can also empower consumers to make informed purchasing decisions and support brands that uphold ethical standards.
