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Protection of Well-Known Trade Marks in India

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ABSTRACT

This Article is about, "Protection of Well-Known Trade Mark in India". It lays down all the necessary rules, regulation and laws which are required for protecting Well-Known trademarks. Trade Marks Act, 1999 recognizes Well-known trademarks and lays all the determining factors as well as the documents needed while filing for protection of well-known trademarks. There are also some renowned Indian case law regarding infringement and protection of well-known trademarks. This Article helped readers to understand the economic significance of Well-known trademarks and why it is necessary to provide protection which boost economy of our country.

I. INTRODUCTION

In the time of globalization, the world has come under a single roof and trade or business has no more boundaries that can confine them. These activities also necessitated the need to protect the 'Well-Known Trade Marks' existing throughout the whole world. Well Known Trade Marks in common parlance means marks which is recognized globally or throughout the globe, for instance 'Apple' is Well Known for its fine computer technology which exhibits a standard quality set by Apple Inc.

The first ever trace of 'Well-Known Marks'² was discussed in Paris Convention of Industrial Property in 1883. This convention however doesn't lay down the detail procedure on how to register for Well-known Marks. It entirely let the member countries to frame laws on how to give protection of Well-known Marks.

"The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the

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² Paris Convention for the Protection of Industrial Property (1883), Article 6^{bis},

benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.”³

India followed the Common law trend to protect Well-Known Trade Marks. The Trade & Merchandise Marks Act, 1958 doesn't protect Well-Known Trade Marks but it could be protected by way of passing off. Under this process of passing off the trader has to show that his mark has good will, the defendant made a misrepresentation that is likely to deceive the public, and this misrepresentation deceives the good will of the claimant.

In 1998, the Director General of World Intellectual Property Organization had notified that India became the signatory of Paris Convention of Industrial Property, 1883. In pursuant of this accession Government of Republic of India had passed, Trademark Act, 1999. Under this Act, Well-known Trade Mark was defined under Section 2(1)(zg) as,

*“in relation to any goods or services, means a mark which has become so 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.”*⁴

With the advent of new Trade Mark Rules, 2017, a whole new procedure was introduced by Government of India to file for protection of Well-Known Trade Marks. As per this new rule, the applicant can file for protection in the FORM No: TM-M to registrar to declare their mark as Well-Known Mark in India.

II. PROCEDURE AND CODITIONS REQUIRED TO FILE FOR PROTECTION OF WELL-KNOWN TRADE MARKS IN INDIA

(A) Rule 124 of Trade Mark Rules 2017⁵

This rule allows the trademark owners to file a request for the grant of a ‘well-known’ trademark to the Registrar. The owner has to file in the form no. TM-M. Before the coming up of this rule, a mark was declared well-known only after a long procedure of proceedings, rectification, and opposition held before the Hon’ble courts. With the help of this Rule 124(1)⁶ the owner can request for a well-known trademark without getting into any proceedings. This

³ Id., Article 6^{bis}(1)

⁴ Trademark Act, 1999, Section 2(1)(zg)

⁵ Trade Marks Rule, 2017, Rule 127

⁶ Id., Rule 127(1)

makes the owner to get the tag of well-known trade mark without any unnecessary proceedings and saving a lot of time.

The Registrar shall, while deciding any mark as well-known take into account⁷ of the provisions of sub-section (6) to (9) of Section 11.⁸ This helps the registrar to determine whether to grant that particular mark a tag of well-known mark or not.

Before granting the registrar may ask for any other relevant document as it thinks fit as well as may entertain any objections regarding the that said application from general public within 30days from the date of invitation of objection.⁹

If that mark gets the tag of well-known trademark then it will be published in the trademark journal and included in the list of well-known trademarks maintained by the Registrar.¹⁰

(B) TradeMarks Act, 1999

1. Protection of well-known marks across all classes¹¹

“A trade mark which-

(a) is identical with or similar to an earlier mark; and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered in the name of a different proprietor,

Shall not be registered if or to the extent the earlier trade mark is a well-known trade mark in India and the use of the later mark without due cause would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trade mark”¹²

This section clearly shows the importance of well-known trademark and how the unfair advantage can be taken but this protects any such unfair activities to be held by anyone.

2. Well known trade mark: Determining factors¹³

While determining whether a trade mark is a well-known trade mark or not, the Registrar is to take into account any fact which he considers relevant for such determination. These facts include-

⁷ Id., Rule 127(2)

⁸ Trade Marks Act, 1999, Section 11(6) to (9)

⁹ Trade Marks Rule, 2017, Rule 127(3) & (4)

¹⁰ Id., Rule 127(5)

¹¹ Trademarks Act, 1999, Section 11(2)

¹² *Ibid*

¹³ V K Ahuja, *Law Relating to INTELLECTUAL PROPERTY RIGHTS* (LexixNexis, Reprint 2021) at 299

- The knowledge or recognition of that trade mark in the relevant section of the public including knowledge in India obtained as a result of promotion of the trade mark;¹⁴
- The duration, extent and geographical area of any use of that trade mark;¹⁵
- The duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trade mark applies;¹⁶
- The duration and geographical area of any registration¹⁷ of or any application for registration of that trade mark to the extent they reflect the use or recognition of the trade mark;¹⁸
- The record of successful enforcement of the rights in that trade mark; in particular, the extent to which the trade marks had been recognized as a well known trade mark by any court or Registrar under that record.¹⁹

3. Conditions not required for well-known trademark registration

According to Section 11(9), the Registrar is not require as a condition, any of the following conditions for determining whether a trade mark is a well-known trade mark:²⁰

- That the trade mark has been used in India;²¹
- That the trade mark had been registered;²²
- That the application for registration of the trade mark had been filed in India;²³
- That the trade mark-²⁴

¹⁴ Trademarks Act, 1999, Section 11(6)(i)

¹⁵ Id., Section 11(6)(ii)

¹⁶ Id., Section 11(6)(iii)

¹⁷ In *S. Oliver Bernd Freier Gmbh & Co. Kg. v. Rasul Exports*, 2014 (57) PTC 475 (Del) at p. 486., the plaintiff filed copies of the registration certificate, invoices and recognition of the trade marks. OLIVER in many countries of the world. The Court held it to be well known trade mark; See also *S. Oliver Bernd Freier Gmbh & Co. Kg. v. Rasul Exports*, 2014 (58) PTC 630 (Del).

¹⁸ *Supra n. 14*, Section 11(6)(iv)

¹⁹ Section 11(6)(v) of the Trademarks Act, 1999. In *Castrol Limited v. Thakur Dassochani*, 2012 (52) PTC 580 (Del) at pp. 588-89, the court stated that the trade mark CASTROL satisfied the conditions of Section 11(6), *inter alia*, on account of the duration, extent and geographical area of its use, promotion, recognition in public. The trade mark CASTROL GTX was first registered in India in 1942 and the trade mark CASTROL CRB in 1984. The plaintiff had attached a record of successful enforcement of their rights in the form of over 150 orders by competent courts in their favour; See also *Castrol Limited v. Mahendra Automobiles*, 2011 (48) PTC 336 (Del) at p. 338.

²⁰ *Supra n.14*, Section 11(9)

²¹ Id., Section 11(9) (i)

²² Id., Section 11(9) (ii)

²³ Id., Section 11(9) (iii)

²⁴ Id., Section 11(9) (iv)

- (a) is well-known in; or
 - (b) has been registered in; or
 - (c) in respect of which an application for registration has been filed in any jurisdiction other than India; or
- That the trade mark is well known to the public at large in India.²⁵

While considering an application for registration of a trade mark and opposition filed in respect thereof, the Registrar shall (i) protect a well-known trade mark against the identical or similar trade marks; (ii) take into consideration the bad faith involved either of the applicant or the opponent affecting the right relating to the trade mark.²⁶

III. DOCUMENTS NEEDED WHILE FILING FOR WELL-KNOWN TRADE MARKS²⁷

- Statement of case – mentioning the claimant's right on the trademark and describing the claim of trademark to be a well-known trademark.²⁸
- Details of successful enforcement of rights in case the trademark has been recognized as well-known by the court in India or TM Registrar.²⁹
- Copy of judgment of any court or the Registrar wherein the trademark has been recognized as well-known.³⁰
- Evidences showing the claimant's right and justifying his claim. Such evidences shall include data/documents showing-³¹
 - Use of trademark, or any application filed for registration of trademark, or registration obtained.
 - Annual sale turnover of the business of the claimant.
 - Actual or potential number of customers under the said trademark.
 - Publicity and advertisement of the said trademark along with the expenses incurred thereof.

²⁵ Id., Section 11(9) (v)

²⁶ *Supra*, n.13 at 301

²⁷ https://ipindia.gov.in/writereaddata/Portal/IPOtherNotice/1_31_1/Public-Notice.pdf (last visited 15 June 2021 at 1:36am)

²⁸ *Ibid*

²⁹ *Ibid*

³⁰ *Ibid*

³¹ *Ibid*

- Knowledge or recognition of the trademark in relevant section of public across the globe.

All the documents along with the evidence is needed to be submitted in a PDF format with resolution of 200 X 100 dpi on A4 size paper and the total size of the documents not exceeding 10 MB.

IV. SOME INDIAN CASE LAWS ON PROTECTION OF WELL-KNOWN TRADE MARKS

A well-known trade is widely known to the relevant general public who are consumers, manufacturing and business circles and persons involved in the sale of the goods or service carrying such a trade mark. Due to the advancement of technology people in general has come across such things like well-known trade marks. There are many instances where big companies have to fight for their rights over trade mark some of them are as below:

(A) Microsoft Corporation v. Kurapati Venkata Jagdesh Babu³²

In this case the court stated that, “it was evident that the trade mark Microsoft was a well-known trade mark. The name was known to most of the people in the entire world. No one was entitled to use the same wither as a trade mark or part of its trading style/corporate name in relation to similar or dissimilar business as the said trade mark had got a unique goodwill and reputation.”

(B) Rolex SA v. Alex Jewellery Pvt. Ltd.³³

The court stated that ROLEX is a well-known trade mark from the point of view of that segment of the public which uses the high quality watches. It would be the infringement of their rights if someone else uses the same name to do their business at the cost of reputed company reputation.

(C) Yahoo Inc v. Firoz Nadiawala³⁴

The court stated that YAHOO! had become a household name in India and had acquired the status of a well-known trade mark by virtue of long and continuous use and that the defendant by making a film under title YAHOO! would cause the members of the public believe the defendants’ production was in some way endorsed, sponsored and associated with plaintiff.

³² 2014 (57) PTC 601 (Del) at p. 615

³³ 2009 (41) PTC 284 (Del) at p. 292

³⁴ 2014 (58) PTC 352 (Del) at p. 357

(D) ICICI Bank Ltd. v. Chuandong XU³⁵

The court observed that the trade mark ICICI was used extensively and widely and was highly distinctive. Further by virtue of extensive publicity and use of the mark around the world, the trade mark had acquired significance of a well-known mark.

(E) Tata Sons Limited v. Gina Kilindo³⁶

The court stated 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...”

V. CONCLUSION

Trademarks can be treated as lifetime income for any person. It a goodwill, reputation from which customer recognize the good or services of any particular trader. It assures the customer about specific quality or standard that they used to expect from any product. The concept of well-known trade mark was first discussed in Paris Convention of Industrial Property in the year 1883. Paris Convention recognizes the existence of well-known trade mark but does not prescribe any particular procedure for its implementation to the member countries. Member states have to frame laws as per their requirements to protect the well-known trade marks. It is generally seen that infringement of trademarks happened with globally recognized brands like Nike, TATA, Microsoft etc. Imposters try to gain unjust enrichment by deceiving the general public at large by making similar goods or by providing similar services. They make huge amount of money by doing this fraud to mass at large across whole globe.

India become the member of Paris Convention in the year of 1998. Then in compliance with the same Indian government had passed Trademarks Act, 1999 and Trademark Rules 2017 in order to provide the substantive as well as procedural protection to trade marks in India. Section 11 and Rule 124 provide almost all the necessary requirement for the protection of well-known trade marks in India. Then there are plenty of Indian cases which also helped in shaping the well-known trade marks in India. Currently almost 97 trade mark has been recognized as well-known trade mark in India which shows the result and effort of Indian government in recognizing the well-known trade marks. This also encourages multi-national companies to

³⁵ 2013 (49) PTC 291 (Del) at p. 302

³⁶ 2014 (57) PTC 415 (Del) at p. 421

come and trade in India without any fear of infringement of their trade marks. This ultimately boosts the Indian economy in long run.
