

## INDIA'S WELL-KNOWN TRADE-MARK PROTECTION: NEED FOR LEGAL ACTIVATION

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**Abstract:** Indian law has granted particular protection to well-known brands because of their established brand value. One of the key features of well-known brands that should be emphasized is the massive amount of attention they receive, regardless of how long they have been in use. The absence of legal protection for well-known trademarks is emphasized in the article along with a thorough analysis of the Intellectual Property Rights Regime for the protection of well-known marks. Without appropriate legislative action on discrepancies, the provisions pertaining to the prosecution and enforcement of well-known marks may inevitably deteriorate and weaken the protection that the Trade Marks Act of 1999 grants to well-known marks.

**KEYWORDS:** Well known marks, Intellectual Property, Trade Marks, Paris Convention, TRIPS agreement, World Intellectual Property organization.

### I. INTRODUCTION

Traditionally, intellectual property (IP) has been divided into two categories: copyright and industrial property. Patents, trademarks, industrial designs, and geographical indicators of origin are all considered forms of industrial property. Works of literature, art, and music are protected under copyright laws. Producers of phonograms in their recordings, broadcasters in their radio and television programs, and performing artists in their performances are all entitled to copyright protection. Most people agree that intellectual property rights are a collection of exclusive rights that belong to the legitimate owner.

The word "intellectual property" refers to the particular legal rights, not the actual piece of art. Understanding what these intellectual property rights are, how to safeguard them, and eventually how to capitalize on them is crucial.

Trademarks<sup>1</sup> have existed since the beginning of commercial activity. The markings are as old as religion and human history. Researchers have discovered items from ancient Egypt and other locations that have been unearthed and have a variety of religious and superstitious symbols etched on them. "Potters marks," which were found in artifacts from the Greek and Roman eras, were

<sup>1</sup> Trade Marks Act, 1999, s. 2(zb) "trade mark means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include shape of goods, their packaging and combination of colors." A mark can include a device, brand, heading, label, ticket, name, signature, word, letter, numeral, shape of goods, packaging or combination of colors or any such combinations

used to identify the potter who created a certain vessel. The studies pertaining to "potters marks" are well-known among those who specialize in studying the cultural legacy of marks.<sup>2</sup>

In addition to identifying the commercial origin of products and services, trademarks and trade symbols have historically served to ensure a specific degree of quality for customers and other stakeholders. Any performer wishing to compete on the world stage must have exclusive rights to trademarks and trade symbols in order to build a strong commercial brand.

Nordberg<sup>3</sup> asserts that it's critical to comprehend both the unique distinction between a trademark and a brand as well as their mutually beneficial relationship. The legal word "trademark" refers to a unique mark or symbol to which an owner may claim an exclusive right, but "well-known mark" is a wider phrase that also includes connections created by a trademark, such as goodwill, image, and prestige.

Well-known brands have the ability to draw in customers, workers, investors, and other stakeholders. They may also be utilized to build enduring connections in the marketplace. A well-known brand, in the opinion of Petrusson<sup>4</sup>, may be regarded as an intellectual phenomenon that symbolizes a company's capacity to increase value for customers and other stakeholders. Well-known trademarks are becoming more and more valued as a company's asset today. They serve mainly as channels of communication and bearers of the value that businesses have accumulated. It is crucial to understand that significant investments and activities that require strong legal protection are what give a well-known mark its worth. Given the significance of well-known trademarks in the modern day, it is imperative to acknowledge their evolution or development history. From the Paris Convention to the TRIPS Agreement and ultimately to the WIPO proposal, the famous marks' origins guide the road. The following is a discussion of the aforementioned significant stages in the formation of a trademark:

- **Paris Convention**

A multinational approach to industrial property protection is the Paris Convention. It became operative on July 7, 1884, after being signed in Paris on March 20, 1883. The theory of well-known marks was first developed in 1883 under Article 6bis of the Paris Convention, which stipulates that the Union's member states may reject or cancel registration of well-known marks and forbid the use of marks that could be interpreted as being a copy, imitation, or translation of a particular nation's well-known mark. Additionally, the clause is applicable where a significant part of the mark is a copy of a well-known mark. Due to the Paris Convention's lack of specific measures regarding the protection of well-known trademarks and their recognition processes, the signatory nations were free to handle these issues as they saw fit. As a result, the majority of countries do not process applications for the recognition of well-known trademarks unless the owners of those marks specifically demonstrate their need for recognition, and the majority of countries lack a separate, independent application procedure for well-known mark recognition.

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<sup>2</sup> Latha R. Nair, "Tracking the protection of Well known Marks in India: A Befuddled Path to Nirvana" 101 *TMR* 1419(2011).

<sup>3</sup> Interview with Karin Nordborg, available at [https://gupea.ub.gu.se/bitstream/2077/22651/1/gupea\\_2077\\_22651\\_1.pdf](https://gupea.ub.gu.se/bitstream/2077/22651/1/gupea_2077_22651_1.pdf).

<sup>4</sup> Petrusson, Ulf, *Intellectual Property and Entrepreneurship*, 220(2<sup>nd</sup> edn., 2003).



- **Trade Related aspect of Intellectual Property Rights**

The protection of well-known marks under Article 6bis of the Paris Convention is additionally enforced under the Trade Related Aspects of Intellectual Property Rights (TRIPS) agreement. Articles 16.2 and 16.3 of the TRIPS agreement have been incorporated into the TRIPS agreement. According to the articles, Article 6 bis may be used to services, and Article 6 bis may be applied to products or services that are not comparable to those for which a trademark is registered. From the Paris Convention to the TRIPS Agreement, the idea of well-known marks changed. By establishing criteria for determining whether a mark is well-known, the TRIPS Agreement improved our understanding of well-known marks. These criteria included member-specific knowledge gained through trademark promotion and knowledge of the mark in the relevant public sector. Furthermore, the Paris Convention only addressed goods and offered protection against identical or similar goods. In contrast, the TRIP agreement covers registered trademarks related to both goods and services, as well as dissimilar goods and services to the extent that a third party is found to have a relationship between the use of such dissimilar goods and services and the registered mark owner, which is likely to be detrimental to the owner's interests. Even though the concept of a well-known trademark has been significantly improved, neither agreement defined what a well-known mark was; therefore national laws in various nations were left to define it.<sup>5</sup>

- **World Intellectual Property Organization.**

During the Thirty-Fourth Series of Meetings of the Assemblies of the Member States of WIPO (September 20 to 29, 1999), the Assembly of the Paris Union for the Protection of Industrial Property and the General Assembly of the World Intellectual Property Organization (WIPO) jointly adopted the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, which includes the text of the provisions adopted by the Standing Committee on the Law of Trademarks, Industrial Designs, and Geographical Indications (SCT) at its second session, second part (June 7 to 11, 1999).<sup>6</sup>

The WIPO Committee of Experts on Well-Known Marks reviewed the draft during its first session (November 13–16, 1995), second session (October 28–31, 1996), and third session (October 20–23, 1997) and examined provisions on the protection of well-known marks. The first session of the Standing Committee on the Law of Trademarks, Industrial Designs, and Geographical Indications (SCT) took place from July 13 to 17, 1998; the second session took place from March 15 to 17, 1999; and the second session took place from June 7 to 11, 1999.

The recommendation is the first step in putting WIPO's strategy into practice to adjust to the rate of change in the industrial property sector by taking into account fresh possibilities for quickening the creation of globally harmonized common principles. The WIPO Program and Budget for the biennium 1998-99 addressed the issue of novel approaches to the advancement of international intellectual property law. Main Program 09 states:

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<sup>5</sup> TRIPS Agreement, art. 16.2.

<sup>6</sup> WIPO Joint Recommendation Concerning Provisions on the Protection Of Well-Known marks, adopted by the Assembly of the Paris Union in September 1999.



Given the practical need for expedited creation and application of specific globally harmonized common principles and regulations in industrial property law, the primary program's future plan takes into account alternatives to supplement the treaty-based approach. A more flexible approach to the harmonization of industrial property principles and rules, as well as the coordination of administration, may be taken if member states believe it is in their best interests to move forward. This would ensure that administrators and users of the industrial property system can benefit from this system sooner rather than later. In India, achieving the status of a well-known brand is seen as achieving "Nirvana," which is commonly defined as a state of happiness attained by removing oneself from outside influences such as desire, envy, hatred, ignorance, etc. Since the original goal of trademark protection is to shield customers against confusingly identical marks, the idea of well-known marks is now given a broader connotation and has beyond the understanding of conventional trademarks. Well-known trademarks concentrate on safeguarding a mark's unique qualities against tarnishment, free-riding, and dilution. When a well-known mark departs from the conventional notion of deceit, proof of confusion becomes secondary in the event of infringement and a passing-off action.

In September 1999, the World Intellectual Property Organization (WIPO) General Assembly and the Assembly of the Paris Union enacted a Joint Resolution Concerning Provisions on the Protection of Well-Known Marks (henceforth referred to as the "WIPO Resolution").<sup>7</sup> The factors outlined in the WIPO Resolution are used to establish whether a mark qualifies as a well-known mark. This involves taking into account the mark's degree of repute, its length and geographic reach, its level of global trademark registration, its amount of exposure, and examples of effective mark enforcement.

For the first time, it was acknowledged in the *JG v. Stanford*<sup>8</sup> decision that the word "well known" in regard to a trademark comes from the term "reputation," and it was decided that the rule of passing off forbids traders from engaging in commercial dishonesty. The use of certain products or services in connection with business determines reputation when legislative provisions in a given country are silent on reputation or goodwill in respect to well-known trademarks.

In India, the protection of well-known marks is given more importance than that of common trademarks. At first, this protection was provided by the Common Law passing-off action, such as in the *Daimler Benz Aktiengesellschaft v. Hybo Hindustan*<sup>9</sup> case. The Mercedes-Benz company requested an injunction against the defendant for using their well-known "three pointed star in the circle" mark and the phrase "Benz." The court issued an injunction on the use of these well-known brands for clothing sales. Similarly, the Whirlpool brand had a global reputation, and the plaintiffs in *Whirlpool Co. & Anr v. N R Dongre*<sup>10</sup> sold their machines in the U.S. embassy in India and heavily advertised it in an international magazine that was distributed in India. Action was taken against the defendants when they began using the plaintiff's mark on their washing machines. The court determined that the plaintiff had developed a "trans border reputation" in India and that the

<sup>7</sup> WIPO Document No. SCT/3/8, WIPO, available at: <http://www.wipo.org>.

<sup>8</sup> *JG v. Stanford* [1617] 468, 79 ER 400(Cr HC)

<sup>9</sup> *Daimler Benz Aktiengesellschaft v. Hybo Hindustan* AIR 1994(Del)239

<sup>10</sup> *Whirlpool Co & Anr v. N R Dongre* PTC1998(Del) 698.

defendants were thus prohibited from using the same trademark on their goods. Over time, the Indian courts have begun to adopt a more comprehensive approach to the consideration of trans boundary reputation. In the cases of *Indian Shaving Products Ltd v. Gift Pack*<sup>11</sup> (about the plaintiffs' and defendants' use of the terms "Duracell-ultra" and "Ultra") and *Allergan Inc v. Milmet of the Industries*<sup>12</sup> (about the use of the word "ocuflux" for medicinal preparations), it was believed that the plaintiff had no business in India, but the Indian trade circles were well aware of the mark's reputation across international borders. The court issued injunction orders against the defendants and took on this trans border repute of mark.

Although the concept of a well-known trademark has been significantly improved, neither of the agreements defined the word, therefore the meaning was left up to the national laws of the various nations.

As a signatory to the Trade Related Aspects of Intellectual Property Rights (TRIPS) agreement and a member of the World Trade Organization (WTO) since 1995, India adopted the new Trade Marks Act 1999, which went into effect in 2003. It included provisions pertaining to well-known trademarks and introduced numerous statutory changes, such as the protection of well-known trademarks even if they are not registered or used in India, as well as giving the owner of a well-known trademark the unique right to file an opposition proceeding at the registration stage on the grounds that the mark is a well-known trademark.

## **II. PROBLEMS RELATED TO WELL KNOWN PROTECTION IN INDIA**

The Trademark Act 1999's section 2(1) (zg) defines a well-known mark in India. Well-known marks are expressly addressed in Sections 11(2), (6), (7), and (9) of the Trademark Act 1999, which also establish relevant grounds for denial of trade mark registration. On the other hand, the phrase "well known mark" is not specifically mentioned in Section 29 of the Act, which deals with trademark infringement, and it is only used under Clause 4 as "registered trade mark, that has a reputation." Because of this, it is often difficult to determine the legislature's true intentions regarding the protection of a well-known mark after registration. It undoubtedly shows that the legislature intended to protect the well-known mark only at the registration stage; otherwise, why are there differences in the language used in Sections 11(2) and 29(4) of the Act? In addition to the lacuna in Section 29(4), the following issues require the attention and clarification of the legislative areas:

1. The Act's definition of a well-known mark provides no criteria for judging whether a mark is well-known or not; instead, it uses vague language: "a mark which has become so to the substantial segment of the public which uses such goods or receives such services." This definition is left up to the courts' interpretation.

<sup>11</sup> *Indian Shaving Products Ltd v. Gift Pack* PTC 1998(Del) 698.

<sup>12</sup> *Allergan Inc v. Milmet of the industries* 1998 CAL 26.



2. Since there is no precise definition of a well-known mark, it is therefore unclear how to determine whether a mark qualifies as such under the section on its enforcement. Therefore, the extent of protection granted to well-known marks is negatively impacted in the lack of such appropriate rules on well-known marks for enforcement procedures.

3. Section 29(4) does not include ill faith when determining the parties' rights.

According to Rule 124 of the Trademark Rules of 2017, new regulations pertaining to the registration of well-known marks have been implemented in India provides for the Registrar to determine a well-known mark. Up until now, a trademark infringement issue in court might recognize a well-known mark. However, today, the trademark owner can apply to the Registrar to have the trademark determined as a well-known mark. Regarding the recognition and protection of well-known trademarks, the implementation of the current rule is seen as a significant advance. However, the primary issue that has not yet been resolved is whether Rule 124 of the Trademark Rules, 2017 is constitutionally valid. The parent statute serves as the source of legitimacy for rules, which are delegated legislation. The Trade Marks Act of 1999 serves as the legal foundation for the Trade Mark Rules of 2017. However, this law does not provide the Central Government the authority to establish a whole new process for identifying well-known trademarks. Regarding well-known trademarks, Section 157 of the Act, which outlines the Central Government's rule-making authority under the Trade Marks Act, 1999, remains silent. Section 157(xli) has a residuary clause that grants the Central Government the authority to establish regulations for "any other matter, which is required to be or may be prescribed." The two most crucial elements of delegating legislative authority nevertheless apply to residuary provisions, even if they are commonly worded like all other laws granting residuary powers: The first rule is that the provisions of the parent law cannot be in contradiction with the delegated legislation. Second, Parliament cannot give the Executive authority over a crucial legislative role. Both of these concepts are violated by the new Rule 124. A completely new policy to recognize "well-known" trademarks through a non-adversarial process is reflected in the regulation.

### **III. RESEARCH METHODOLOGY**

This study's approach, which is based on a critical evaluation of both primary and secondary sources, is fundamentally doctrinal. The basic material consists of the pertinent national laws as well as the official and judicial interpretations of those laws found in administrative rulings and case law. As much as feasible, the secondary information is based on contemporary legal developments and includes books, research, and commentary published in a variety of periodicals.

### **IV. FRAMEWORK OF TRADEMARK LAW FOR PROTECTING WELL KNOWN MARK IN INDIA**

The Trademark and Merchandise Act of 1958 was the law that controlled trademarks in India prior to the passage of the Trade Marks Act 1999. Section 47 of the Trademark and Merchandise Act allowed for both defensive registration of well-known marks and passing off actions against unlawful use of well-known trademarks prior to the Trade Marks Act's implementation in 2003. Section 47(1) reads as follows:

In cases where a trademark made up of an invented word has gained such recognition in relation to any goods for which it is registered and used that its use in connection with other goods would probably be interpreted as indicating a connection in the course of trade between those goods and a person who is authorized to use the trademark in connection with the first mentioned goods, the mark may, upon application in the prescribed manner by such proprietor, be registered in his name for those other goods as a defensive trade mark, and while so registered, shall not be subject to removal from the register with respect to those goods under the said section, even though the proprietor registered for the first-mentioned goods does not use or intend to use the mark in relation to those other goods, notwithstanding anything in Section 46.

It is clear from reading the section<sup>13</sup> above that the risk of deception was the determining element in assessing whether a well-known mark may be registered under this specific clause. Even in the absence of defense registration as a remedy against passing off, Indian courts have maintained the rights of well-known trademarks. The following significant instances serve as examples of such decisions:

In the case of *Honda Motors Co. v. Charanjit Singh*, the Delhi High Court issued a permanent injunction in a passing-off action against the plaintiff's use of the trademark HONDA for pressure cookers in relation to automobiles and power equipment. The court based this decision on the fact that the plaintiff had been using the word HONDA for the past five decades, and that it had not only gained international recognition and goodwill but also become a household name in India.

In *Sunder Permananad Lalwani v. Caltex India Ltd.*<sup>14</sup>, the Bombay High Court ruled that Caltex India had a legitimate objection to the registration of the watch trademark CALTEX. In this instance, Caltex Ind. Ltd. was the owner of the well-known and monopolistic Caltex brand, which was used for gasoline, kerosene, and other products. Even though the court determined that Lalwani was the owner of the mark for watches in India, it refused to register it because of the possibility of consumer confusion or deceit. In addition, Lalwani failed to establish an honest trademark selection for watches.

In *Bata India Ltd. v. Deputy Registrar of Trade Mark*<sup>15</sup>, it was permitted to register a trademark for sewing machine components that had the phrase "Artistic device with letters BSC" while the appellant-opposer had been using both "BATA" and "BSC" as a combined trademark for footwear. Since adopting BSC in 1975, the responder has improved the mark's reputation and goodwill throughout the Punjab state. According to the appeal board, there was no issue of misunderstanding or deceit because the appellant had not utilized the BSC mark independently and the items were of entirely distinct type.

<sup>13</sup>*Honda Motors co. v. Charanjit Singh* [2003] 26PTC 1 (Del)

<sup>14</sup> *Sunder Permananad Lalwani v. Caltex India ltd* [1969] 24,36AIR (Bom.)

<sup>15</sup> *Bata India ltd. V. Deputy Registrar of Trade mark* [2004] 29 PTC 468 (IPAB)

The plaintiff in *Caterpillar Inc. v. Jorange*<sup>16</sup> was the owner of the trademarks "CAT" and "CATERPILLER" for heavy machinery, construction, and agricultural equipment. They began selling a variety of clothing items in 1996, including coats, sweaters, sunglasses, and athletic equipment. The plaintiff relied on the trans border reputation that resulted from its use of the trademark in other countries, even though it had not yet launched the trademark in India on clothing. Additionally, they asserted that when grant is applied to various products, it may cause confusion in cases of well-known brand names. The defendant was prohibited by the court from using the "CAT" and "CATERPILLER" trademarks. The aforementioned instances were among the significant court rulings that helped popular trademarks become legally protected under the Trade Mark Act of 1999, which eventually went into effect in September 2003.

In order to recognize a trademark as a well-known trademark, section 2(1)(zg) of the TM Act defines a well-known mark as "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 the services between those goods or services and a person using the mark in relation to the first mentioned goods or services."

Before determining whether a trademark is well-known, Section 11 of the TM Act specifies some factors that must be taken into account:

**I.** Awareness of the purportedly well-known mark's recognition among the pertinent demographic, which demonstrates awareness gained through trademark advertising. In the case of *HariPuttar*<sup>17</sup>, a trademark dispute arose over the name of an Indian film that was based on the popular Harry Potter novel series. The court determined that similar names would not cause confusion because the Harry Potter films are meant to satisfy the entertainment needs of a select and affluent audience who can easily distinguish between a film based on the book and one that relies on Punjabi comedy. Even after watching the film, they would never associate it with the original Harry Potter book or film.

Likewise, in *Rolex S A v. Alex Jewellery pvt. Ltd.*<sup>18</sup>, the plaintiff was the proprietor of the globally renowned Rolex trademark for watches. The defendants were engaged in the sale of fake jewelry under the Rolex brand. Examining section 2(1)(zg)'s definition of a well-known trademark According to the Delhi High Court, a well-known trademark is defined by section 2(1)(zg) as a mark that, in relation to goods, has become so well-known to the significant portion of the public that uses those goods that using the mark in relation to any other goods would likely be interpreted as indicating a connection in the course of trade between those goods and the person using the mark in relation to the first mentioned goods. Therefore, the public segment that purchases Rolex watches in a certain category due to price is highly likely to assume that jewelry carrying the Rolex logo is associated with the plaintiff.

**II.** The geographic scope and duration of any use of the trademark. Although the length of time a trademark is used might vary, courts have been quite accommodating when it comes to establishing

<sup>16</sup> In *Caterpillar Inc. 100 NE v. Jorange* [1999] 570 PTC (Mad).

<sup>17</sup> *Warner Bros Entertainment inc. and anr v. HarvinderKohli and ors.* [2008]38 185PTC (Del)

<sup>18</sup> *Rolex S A v. Alex Jewellerypvt. Ltd*[2009] 41 284PTC (Del)



the plaintiff's degree of usage, whether it be high or low. The court noted in *Indian Shaving Product Ltd. v. Gift Pack*<sup>19</sup>, also referred to as the *Duracell Ultra* case, that even though the goods' sale period was less than a year, the plaintiff had achieved high sales and had heavily advertised, so the need to prove a lengthy sale period was not relevant.

**III.** The length, scope, and geographic reach of any trademark promotion, including publicity, advertising, and the display of the goods or services that bear the name at fairs. When it comes to passing off charges involving well-known marks, the courts consider advertising materials to be crucial evidence. Even though the company's product was completely absent from the Indian market, the plaintiff court in the *Whirlpool* case<sup>20</sup> determined that the mark was a well-known one based on the volume of the product's advertising, which was adequate to reach the relevant section's public.

**IV.** To the extent that they represent the use of the trademark recognition, the time frame and geographic scope of any trademark registration or publication for trademark registration under this act.

**V.** The history of successfully enforcing the rights in that trademark, namely the degree to which any court or registrar has acknowledged the trademark as well-known. *Shaw Wallace and Co.*, a well-known alcohol production firm, successfully enforced its trademark rights over the numerical portion of the brand name "5000" in the instances of *Shaw Wallace and Co. v. Superior Industries Ltd.*<sup>21</sup> and *Shaw Wallace and Co. v. Mohan Rocky Spring Water Breweries Ltd.*

**VI.** In the recent *Aveda Corp. v. Dabur India Ltd.* case, the number of actual or future customers of the goods and services.<sup>22</sup> The plaintiff utilized "Aveda" as a trade name for their cosmetics company. In contrast, the defendant began marketing their own cosmetics under the trade name "Uveda." The Delhi High Court took into account that the plaintiff beauty product had a very small market in India because it was only available at one spa in the country, Rishikesh. Because the plaintiff could not be said to have a large consumer base in comparison to the defendant, the court gave the defendant only minor suggestions to increase the font size of their name "Dabur" to make it more prominent in order to reduce the likelihood of confusion. As a result, the chances of people becoming confused are extremely low.

**VII.** The quantity of people engaged in the channels used to distribute the goods or services.

**VIII.** The company that deals with the goods or services that are covered by the trademark.

**IX.** The registrar will consider a trademark as well-known for registration under this Act if a court

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<sup>19</sup> 1998 PTC 698 (Del)

<sup>20</sup> *N R Dongre v. Whirlpool corp.* (1996) PTC (16) 583 SC.

<sup>21</sup> *Shaw Wallace and co. v. Superior Industries Ltd* [2003] 27 PTC (Del)

<sup>22</sup> *Aveda Corp. v. Dabur India Ltd*[2010] 14808 CS (OS) (Del)

or registrar has determined that the trademark is well-known in at least one pertinent segment of the Indian public.

A trademark that is similar to or identical to a "well known mark" cannot be registered to dissimilar goods or services, according to Section 11(2) of the Trade Mark Act, which deals with the relative grounds of trade mark registration refusal. However, Section 29(4), which deals with trademark infringement, does not specifically mention well-known marks; instead, it refers to a mark having "reputation in India," which indicates the legislature's intention to protect well-known marks only at the registration stage.

## **V. DEFENSE OF HONEST CONCURRENT USER IN TRADEMARK ACT 1999**

Since a trademark is meant to indicate that the goods come from a single source, concurrent use of the same brand by two or more people for the same items is completely contrary to the intent of trademark law. Section 12 of the Trademark Act 1999, however, has provisions to handle extraordinary circumstances arising from separate people's lawful concurrent use of the same or a similar mark.

**SECTION 12:-** In the event of legitimate concurrent usage, registration, etc.— If there is honest concurrent use or other special circumstances that the Registrar deems appropriate, he may allow multiple owners of identical or similar trademarks (whether or not any of these trademarks are already registered) to register them for the same or similar goods or services, subject to any restrictions and conditions the Registrar deems appropriate.

In this section, the words "similar" and "depiction of merchandise" are used instead of "nearly resemble each other," and services are included. This section is similar to section 12(3) of the previous act, the Trade and Merchandise Marks Act 1958.

### **Scope of section 12**

Section 12 permits several proprietors to register same or similar trademarks in connection with identical or comparable goods. One It is an exemption to section 11's ban on the registration of comparable marks and supersedes the section 11's simplicity of rejection. The enclosure's "whether any such trademark is now enrolled or not" language makes it apparent that unregistered marks are also covered by the exclusion. The use of the phrase "he may allow registration" makes it evident that concurrent registration is optional. The registrar has the authority to impose any restrictions and conditions when granting registration. It is the candidates' responsibility to create an instance of registration under the provision. It goes without saying that the other provisions of the act must be completed in order for registration to be permitted on the basis of honest concurrent use, with regard to sample the need of distinct character or limit to recognize under section 9.2.

**User pertinent:-** Users who apply for section 12 before the date of use are kept apart from all other users who may be affected. The extended pendency of the application<sup>3</sup> prevents the group from taking advantage of the subsequent user.

Since the section calls for honest concurrent utilization, the use that is stated must be both concurrent and honest. The phrase "concurrent utilization" does not mean that the petitioner's use

has coincided with the competitors' registration, but rather that the petitioner's use must coincide with the opponents' use of the enrolled mark. The term contemporaneous is more important than concurrent. The purpose of Section 12 is to recognize and acknowledge that a significant open can, through commonality attained by concurrent users, recognize that two similar marks are being used. As a result, they are instructed to inspect them with more than the usual forethought and to recognize them accordingly. This requires that the same open have both marks in the marketplace and the ability to assess the degree of confusion that can be inferred from the marks' similarity, which is a major feature of the open hinder 4 measure. Such use would not be considered concurrent use if the goods of the opponents and searchers were marketed through different commerce routes. There has been no opportunity to determine what degree of bewilderment is mediocre in individuals in general premium when the competitors' mark has not been used or when the group's items have not been offered side by side in the same market. The registrar may decide to enroll the mark under the proviso "or other unique circumstances" in such a case. Two significant decisions established the defense of honest concurrent usage. First, the *Dent v. Turpin*<sup>23</sup> decision established that two users of a mark who shared a similar ancestor had a distinct right to seek an injunction against the third person that was using the mark without permission. Second, the *Dent* case was used to reach a similar result in *Southorn v. Reynolds*<sup>24</sup>, although neither case dealt with a disagreement between contemporaneous users.

In *Dewhurst & Sons Ltd*<sup>25</sup>, the court expressed the reasoning for the honest concurrent user, saying, "Let us then consider what the position of register will be, and how far the interests of the public will be protected if this mark is registered." Regarding the consents, I don't think they matter. They are valuable since they provide some proof that there won't be any deceit.

Five variables that contribute to successful concurrent user defense were given forth in *John Fitton and Co.*<sup>26</sup>

1. The amount of usage in time, quantity, and the region of commerce.
2. The degree of uncertainty that is anticipated to result from the mark's appearance is a significant indicator of the level of public annoyance.
3. Concurrent use's honesty.
4. Whether any cases of misunderstanding have been proven to exist.
5. The proportional inconvenience that would result from registering the mark.

According to the aforementioned justification, section 12 of the Indian Trade Mark Act 1999 allows for the registration of a trademark in the event of honest concurrent use. It states that "in the case of honest concurrent use or of other special circumstances which in the Registrar's opinion make it proper so to do, he may permit the registration by more than one proprietor of the trade marks which are identical or similar (whether any such trade mark is already registered or not) in respect of the same or similar goods or services, subject to such conditions and limitations, if any, as the Registrar may think fit to impose." It is evident from reading the section alone that the

<sup>23</sup> *Dent v. Turpin* [1861] 2 139 ER (J&H)

<sup>24</sup> *Southorn v. Reynolds* [1865]12 75LT.

<sup>25</sup> *Dewhurst & Son's Ltd* [1896]2137CH.

<sup>26</sup> *John Fitton & co.*[1949]66 110 RPC .



registrant is not required to register an honest concurrent user; instead, it is entirely up to his subjective description. of section 12(3) of the Trade & Merchandise Marks Act 1958, which is ejusdem generis to section 12 of the current Act, the case of Kores (India) Ltd. V. M/s Khode Eshwarsa & Son<sup>27</sup> established the law of honest concurrent usage. The court concluded that the aforementioned factors must be taken into account in order to determine whether a trademark can be registered as an Honest Concurrent Use mark.

1. The concurrent user's honesty.
2. The amount of concurrent trademark usage demonstrated by the petitioner, taking into account the items in question as well as the length, region, and volume of commerce.
3. As a gauge of public interest or annoyance, the likelihood of confusion arising from the resemblance between the trademarks of the applicant and the opponent.
4. Whether any cases of misunderstanding have been proven to exist.
5. The parties involved may experience relative inconvenience.

Since the 1994 modification to the Trade Mark Act mandates that the owner of a previous mark to oppose an application for registration in an opposition action, the efficacy of the honest concurrent user argument has been significantly diminished. In the Road Tech v. UNISON<sup>28</sup> case, it was decided that the registrar must deny the concurrent user's application if the owner of the previous trademark submits an objection to the concurrent user's registration of the same mark. In the case of Re Majestic Distilling Co.<sup>29</sup>, Majestic further argued that they should be permitted to manufacture tequila since they had been using the trademark even before other companies, like Red Bull, but the court rejected this use on the grounds that it could cause confusion in the public's mind.

Regarding the adoption of trademarks pertaining to educational institutions, the court has been lenient. For instance, in the Goenka Institute of Education & Research<sup>30</sup> case, the high court upheld the defense of honest concurrent user, but it also directed the parties to provide additional information or a disclaimer to prevent students or the general public from being misled into believing that they both came from the same source. In a similar vein, the engineering school operating under the name of Skyline was permitted to remain in Satileela Charitable Society v. Skyline Educational Institute<sup>31</sup>, even if another party's Skyline Business School was present. The public interest and the necessity to protect students' interests are the main reasons why the courts provide such forbearance with regard to identical names of educational institutions.

<sup>27</sup> Kores (India) Ltd. V. M/s KhodeEshwarsa& Son[1984] 213LR (Bom.).

<sup>28</sup> Road Tech v. UNISON[1996] 805(FSR).

<sup>29</sup> Re Majestic Distilling Co. [2003] 315 1311 (F. 3d)

<sup>30</sup> Goenka Institute of Education & Research [2009]40 393 PTC (Del)

<sup>31</sup> Satileela Charitable Society v. Skyline Educational Institute /[2003], [6 October 2004 ] 213FAO (Delhi HC)

## **VI. CONCLUSION**

Indian law has granted particular protection to well-known brands because of their established brand value. No matter how old a brand is, one of the key features that should be emphasized is the massive quantity of attention it has received. In order to make their brand distinctive and, thus, more protected, trademark owners have been utilizing fancy names, numbers, or anything else that looks good.

Although the definition of a well-known mark is provided in Section 2(1)(zg) of the Trade Mark Act 1999, and Sections 11(2), (6), (7), and (9) deal specifically with the understanding of well-known marks and firms' relative grounds of refusal of trade mark registration, Section 29, which deals with the infringement of the registered trade mark, does not specifically mention the phrase "well known mark" in any of its clauses. Instead, it uses the phrase "registered trade mark, that has a reputation" in its clause 4. This makes it extremely difficult to determine the legislature's true intent regarding the protection of a well-known mark after registration. Does this imply that the legislature intended to protect the well-known mark only at the registration stage, and if not, why are there differences in the language used in sections 11(2) and 29(4)?

In addition to the contradiction in section 29(4), the legislature should take into account and clarify the following issues:

1. The Act's definition of a well-known mark provides no criteria for judging whether a mark is well-known or not; instead, it uses vague language that leaves it up to the courts to interpret, reading, "a mark which has become so to the substantial segment of the public which uses such goods or receives such services."
2. In the absence of a precise definition of a well-known mark, the part pertaining to its enforcement also makes it difficult to determine whether a mark qualifies as such. Therefore, the extent of protection granted to well-known marks is negatively impacted in the lack of such appropriate guidelines governing enforcement procedures.
3. Section 29(4) does not include ill faith when determining the parties' rights.

The provisions pertaining to the prosecution and enforcement of well-known marks may gradually deteriorate and weaken the protection that well-known marks are granted under the Trade Marks Act of 1999 if appropriate legislative action is not taken to address the aforementioned anomalies