

NAVIGATING INDIAN TRADEMARK LAWS – AN INTROSPECTION OF WELL-KNOWN TRADEMARKS IN INDIA

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Abstract

This paper critically analyses the legal code that applies to famous trademarks in the Indian Trade Marks Act, 1999, and identifies gaps and enforcement issues in the legal codes. In as much as the Act acknowledges the term well-known trademarks, as well as establishing protection over them, statistical ambiguities, procedural differences and judicial reliance have caused problems in practice of registration, recognition and enforcement. Based on the laws that were analyzed through the *Yahoo! Inc. v. V Coca-Cola, Bisleri, and Rolex SA v. Alex Jewellery*- this paper examines how courts have extended and interpreted the protection accorded to trans-border reputation, deceptive similarity and dilution. Among the problems that the study cites include; the lack of a common mechanism of establishing recognition, insufficient preventative measures taken against cross-class infringement, and the non existence of penal measures that act as deterrent to the counterfeiter. The paper bases on doctrinal/ comparative analysis and proffers purpose-specific amendment of critical provisions of the Trade Marks Act to make it uniform, just and more potent in the protection of well known trademarks in India. The results are meant to support the creation of an enhanced protection regime of trademarks that are strengthened, clear, and internationally oriented.

Keywords – Indian trademark laws, Trademarks, Well known Trademarks

INTRODUCTION

With the proliferation of globalisation in the economy, trademarks have gained new cachet as brands that shape consumer power and preferences in the marketplace and the safeguarding of well-known trademarks have thus become of paramount importance. Such symbols, owing to their popularity and fame, break the grid of classic territories and classifications of products. The Indian Trade Marks Act, 1999 lays emphasis on Section 2(1)(zg) and Section 11(2) to provide special protection to well-known trademarks, safeguarding them from unauthorized use even in relation to dissimilar or unrelated goods and services. Nonetheless, the issue of practical implementation of these provisions is unbalanced because of the ambiguity of legislation and loopholes in proceedings. Although India has done some commitments to various international agreements like the TRIPS Agreement and Paris Convention, there has been sluggishness in their passing of effective protection mechanisms of the well-known trademarks as compared to the international norms.¹

Legal experts have always noted that there is no systematic and open method of affraying well-known trademarks in the case of the Indian system.² Admittedly, the administrative action in respect of the Rule 124 of the Trade Marks Rules, 2017, procedural mechanism exists, but it is not mandatory and time-bound, and brand owners end up finding difficulty in approaching administrative recognition due to the need to take the route of judicial intervention, which results in delay and legal fees that render enforcement of trademarks, in effect, a chilling effect. In addition, the fact that India also relies on judicial pronouncements

¹ Aditya Gupta, *Trans-Border Reputation and the Indian Trademark Law: Time to Codify?*, 8 NUJS L. REV. 435, 439 (2015).

² Anirudh Katyal, *India's Approach to Well-Known Marks: A Critical Review of Rule 124*, 59 JILI 287, 294 (2017).

as opposed to a horizontal regulatory regime is a factor that creates some uncertainty and lack of uniform appreciation of trans-border reputation.³

Further scholarly discussion has condemned the inefficiency of cross-class protection and the small arsenal of statutory resources that can be employed to prevent trademark dilution or unfair gains by the trader who infringes.⁴ The absence of a coherent jurisprudential form of deceptive resemblance or confusion has also beckoned as a shortcoming in legal writing⁵. Moreover, the procedural and territorial influence to initiate rejection or infringement proceedings, especially when the owner of the mark is vehemently abroad, has hampered efficient⁶

This paper intends to evaluate how gaps between the Indian trademark law exist in relation to well-known marks and through doctrinal studies and comparative law. In this way, the paper researches certain statutory interpretation, academic analysis, and related administrative practice proposing specific amendments to be done to the Trade Marks Act, 1999. These are, making understandable recognition procedures, broadening cross-class protection, codifying deterrent remedies, streamlining jurisdiction regulations, and making sure that well-established trademarks enjoy strong, timely and consistent protection, in the developing market economy of modern India.

RESEARCH PROBLEM

According to the statutorily designed and improved protection status of famous marks given to the Trademark Acts of India, 1999, there is still a lot of confusion in law and procedures in the identification of the famous marks, its registration, and enforcement. The absence of clear criteria, unstable judicial interpretations, and the possibility to abuse the concept of the ‘well-known’ itself are the obstacles to level contest and certainty of the law. These loopholes do not only compromise the success of trademarks protection, but also pose questions concerning transparency, availability and fairness to less established or newly established brands. It is based on this knowledge gap that this research aims to critically review these gaps and determine whether the existing legal environment in India, balances the interest of well-known mark owners relative to the interest of other marketplace parties in India satisfactorily.

RESEARCH HYPOTHESIS

“A critical assessment of the Indian Trade Marks Law, particularly its provisions and judicial interpretations related to well-known trademarks, reveals that while the framework offers significant benefits and recognition, targeted legal and procedural reforms are necessary to enhance consistency, transparency, and enforcement of well-known trademark protection in India.”

RESEARCH OBJECTIVES

The objectives of this research article are -

- To assess the Indian trademarks Law, specifically in context of well-known trademarks
- To understand the benefits enjoyed by well-known trade marks in India
- To introspect some of the landmark cases on well-known trade marks in India

³ Rachna Suri, *Recognition of Well-Known Trademarks in India: Issues and Challenges*, 18 J. INTELL. PROP. RTS. 112, 117 (2016).

⁴ Aparna Sundaram & Vikram Rao, *Trademark Dilution in India: A Doctrinal and Practical Analysis*, 45 IIC 721, 728 (2019).

⁵ Ananya Chatterjee, *Public Domain and Trademark Exclusivity: Revisiting Blenders Pride*, 10 IND. J.L. & TECH. 95, 99 (2018).

⁶ Tanya Sen, *Jurisdictional Challenges in Trademark Enforcement in India*, 7 Christ U. L.J. 245, 250 (2020).

- To suggest legal and procedural amendments to strengthen the clarity, fairness, and enforcement of well-known trademark protection in India

INDIAN TRADEMARK LAWS

There was no trademark statute in India previous to 1940; this is where the modern trademark law in India originated. While trademark protection was based on equity and passing off, which are concepts from common law. For the first time, India passed the Trademark Act of 1940, which established a mechanism for trademark registration and statutory protection, in response to a dearth of legislation specifically addressing trademark infringement and passing off. The Trademark Law's statutory provisions were in line with precedents and laws in England.⁷

The Legislature then realised the necessity for strong proprietary laws in light of the increase in trade and commerce, and the Act was subsequently replaced. That is why the Trade & Merchandise Marks Act, 1958 and the Trade & Merchandise Marks Rules, 1959 were enacted; these acts superseded and substituted the Trademarks Act, 1940⁸. In an effort to better safeguard trademarks, the 1958 Act & Rules 1959 was enacted; it also merged trademark-related laws from other statutes, such as the Indian Penal Code, Criminal Procedure Code, and the Sea Customs Act.

In order to conform to the requirements of Trade-Related Aspects of Intellectual Property Rights (TRIPS) and in view of enhanced globalization of trade and technology, the Trademark Act, 1999 & Trademark Rules, 2002 were framed, which came into effect on September 15, 2003. The Trademark Act, 1999 inter alia aims at providing for the registration of service trademarks and collective trademarks, enhanced protection to marks categorized as well-known marks, and the constitution of the Intellectual Property Appellate Board (IPAB) for speedy disposal of appeals and rectification applications.⁹

Subsequently, the Trade Marks (Amendment) Act, 2010 revised the Trademark Act, 1999. Incorporating Special Provisions Relating to Protection of Trademarks through International Registration under the Madrid Protocol, Chapter VI of the Trademark (Amendment) Act, 2010 was enacted by the legislature. Therefore, both domestic and foreign trademark registrations are within the scope of the Indian Trademark Law.¹⁰

The Trade Marks Act, 1999 prescribes numerous chapters dealing with various aspects of registering and protecting of trademarks. Chapter I defines the terms and interpretation of the Act whereas Chapter II covers the registration of the trademark. In chapter III, the applicant's compliance with the requirements for registration is addressed together with the circumstances that may prevent registration. The effect of registration and renewal of trademark is dealt with in Chapter IV. In chapter IV, special provisions regarding the Madrid Protocol concerning international registration of trademarks are dealt with. In chapter V Assignment and Transmission of Trademarks is dealt with while in chapter VI the emphasis is on the trademarks rights of users who have been registered. Trademarks rectification and changes, and trade marks registry's alterations are illustrated by chapter VII while collective marks and certification trade marks are covered in chapters VIII and IX respectively. Special provisions applicable to textile goods which have been left out in the summary given above are contained in chapter X. Appeals are provided for in chapter XI, offenses, penalties and

⁷ The Trade Marks Act, No. 47 Of 1999, § 2-157, India Code (1999).

⁸ The Trade Marks (Amendment) Act, No. 40 Of 2010, India Code (2010).

⁹ The Trade And Merchandise Marks Act, No. 43 Of 1958, India Code (1958) (Repealed).

¹⁰ The Trade And Merchandise Marks Rules, Gazette Of India, 1959, Pt. II, Sec. 3(Ii) (India).

procedures are contained in chapter XII and finally chapter XIII is devoted to general provisions regarding trademarks

TRADEMARK VERSUS WELL KNOWN TRADE MARKS

According to Section 2 (zb) of the Trade marks act , 1999 "Trademark" refers to a graphically representable mark that can differentiate one person's goods or services from another's. This mark can encompass the form of the goods, their packaging, or even a combination of colours.

According to Section 2 (zg) of the Trade marks act , 1999 When referring to goods or services, a "well known trade mark" is one that has become so well-known to the majority of people who use or receive those goods or services that when used in conjunction with other goods or services, it is likely to be interpreted as indicating a connection between the two goods or services and the person using the mark for the first one.

Difference between Trademarks and Well known trademarks

Trademarks are marks, phrases, or words that are particular to a company's goods or services which help the consumers to identify the trademark owner and remain loyal to the brand. A well known trademark is however a mark that is famous and used public widely and has great goodwill in the market. The distinction between these two would be that the first is a consideration or use specific to a business, while the second is a generally recognized mark regardless of the industry where it is used or the countries where it is located. A noteworthy aspect is that such trademarks also enjoy greater legal status.

In India, registering a trademark includes filing the application with the registry and then waiting for proper investigation and determination if the trademark sought is similar to any registered trademark. Once a trademark is registered, law provides monopoly rights on manufacture to the proprietor of the brand name, and thus the owner can prevent any unauthorized usage or encroachment. This legal status of well-known brands in India is not limited to protecting their goodwill and reputation but also grants them exclusive rights to affix that mark in relation to their goods and services offered.

Pertinent laws enforcing intellectual property in India are mostly executed through the Police (especially the Economic Offences Wing), the Customs Department, and the Commercial Courts coupled with the Intellectual Property Offices under the Controller General of Patents, Designs and Trade Marks (CGPDTM). These authorities undertake a proactive investigation process and prosecute on the entities that violate the trademarks that are already famous. Business owners allowing their trademarks to never become generic can guard its uniqueness and exclusivity by using the capabilities of these agencies: raids, confiscation of counterfeit products, imposition of a moratorium on the importation of infringing goods, and resolution of disputes. To the firms concerned with protecting their brands within the Indian jurisdiction particularly the foreign firms, knowledge and application of these institutional machinery would be of great essence in getting the intended enforcement and smooth protection of its brands within the Indian jurisdiction.

WELL KNOWN TRADE MARKS IN INDIA

In India, the famous trademarks are noted either according to the official procedure of submitting application to the Trade Marks Registry or by the court decision on the cases of trademarks litigation. Despite Rule 124 of the Trade Marks Rules, 2017 a proprietor may apply to the Trade Marks Registry with the prescribed fee and in support, to officially regard his/her mark as a well-known trademark. Upon consideration of the evidence and acknowledgments among the population of the close acquaintance with the mark, the Registrar can add it to the official list of well-known trademarks published by the Registry.

Besides this administrative avenue, there are some landmark judgments made by the Indian courts especially the High Courts and the Supreme Court that have not only declared

trademarks as well-known based on the facts and the reputation of the trade mark but also on merits even though the mark was not necessarily registered by the Registry as a well-known mark. An example is that when it came to mark recognition of marks such as Benz, Whirlpool, and Yahoo!, Indian courts identified that the marks had transborder fame and that these marks were also well recognized by consumers in a wide geographical area.

Therefore, in India, the acknowledgement of the famous marks may be implemented by the means of the administrative or court procedure providing two alternative ways of proprietors who want to have them better guarded by the law.

- 7 O'CLOCK for shaving razors Gillette U.K. Ltd., England - Bombay High Court ¹¹- It is a household brand of shaving razors. Bombay High Court sustained its transborder image. Such protection of the mark was provided without local production.
- BAJAJ Bajaj Electrical Limited High Court, Bombay ¹²- A powerful Indian brand, which is known well across domains. Bombay High Court substantiated its renowned position. There was protection against deceptive similarities.
- BATA & BATA FOAM for footwear- Bata India Ltd. Allahabad High Court¹³ - Decades old spotlight in the footwear industry of India. The Allahabad High court broadcasted its popular goodwill. The trademark was safeguarded against any form of dilution and passing off.
- BENZ Daimler Benz High Court Delhi ¹⁴ - International car manufacturer with a reputation of high-end cars. Delhi high court held a well known mark as Benz. The court has focused on protection on unrelated product classes.
- BISLERI Acqua Minerals Ltd., High Court of Delhi¹⁵ - The subject of bottled water and drinks in India. Delhi High Court valued its goodwill and presence in the market. Trade mark survived in misleading use.
- CARREFOUR Carrefour Society Anonyme, organized under the laws of France High Court of Madras¹⁶ - Multinational retail chain company with a worldwide brand name. In India, Madras High Court approved the mark. Protection given even though it did not have physical stores in India.
- CARTIER for wide variety of goods including jewellery, watches, perfumes etc. Cartier International, B.V, Netherlands High Court, Delhi. ¹⁷ - Renowned in luxurious products such as jewelry and watch. Delhi high court realized its luxury status. Protected by the popularity as a famous mark in several products.
- CATERPILLAR Caterpillar Inc., USA Madras High Court (DB)¹⁸ - International logo of heavy machinery. Its goodwill has been acknowledged as high by Madras High Court (DB). The mark has been shielded against infringing application on clothing.

¹¹ Gillette U.K. Ltd. v. Ayesha Cosmetics Pvt. Ltd., (2001) (Bom) (unreported, referenced in multiple trademark digests).

¹² Bajaj Electricals Ltd. v. Metals & Allied Products, (1988) PTC 133 (Bom).

¹³ Bata India Ltd. v. Pyare Lal & Co., AIR 1985 All 242 (All. HC).

¹⁴ Daimler Benz Aktiengesellschaft v. Hybo Hindustan, 1994 PTC 287 (Del).

¹⁵ Bisleri International Pvt. Ltd. v. Bisleri Bihar Pvt. Ltd., (2009) (Del) (unreported, noted in IPR bulletins).

¹⁶ Carrefour Societe Anonyme v. Subburaj, 2007 (34) PTC 388 (Mad). Cartier International B.V. v. Cartier India, 2003 (26) PTC 160 (Del).

¹⁷ Cartier International B.V. v. Cartier India, 2003 (26) PTC 160 (Del).

¹⁸ Caterpillar Inc. v. Mehtab Ahmed, 2002 (25) PTC 433 (Mad) (DB).

- CHARLIE Revlon Inc. High Court of Delhi ¹⁹ - Related to perfumes and make-up. Its consumer association was old enough to be recognized by Delhi High Court. Trade mark retained because of brand dilution issue.
- DR.REDDY In respect of pharmaceutical products. Dr.Reddy Laboratories High Court, Delhi. ²⁰ - DR. REDDY One of them is the Indian pharmaceutical company Dr. Reddy One of them is the Indian drug manufacturer Dr. Reddy Indian Pharmaceutical multinational. The delhi high court pronounced it as a well known trademark. Protection has been given to keep in faith of the drug branding.
- ENFIELD BULLET , Enfield India Ltd. ²¹ - The legend of Indian motorcycle. This brand is a household name because of its history and product. Secured against any kind of imitation or deceptive use.
- GLAXO Glaxo India Ltd. High Court²² - The High court in the case of GLAXO which is a widely known pharmaceutical brand gave credence to the reputation of many years of the Glaxo India Ltd. within the healthcare and pharmaceutical industry. The Court stressed the trademarks related to pharmaceuticals and health service to society should receive stronger protection as they can widely cause harmful results to consumer security and confidence in the event of their abuse or violation.
- HAYWARDS5000 For alcoholic HAYWARDS 5000 For alcoholic High Court, Delhi ²³- Most well-known alcoholic beverage in India. Its consumer recognition was sustained by Delhi High Court. The mark protection was prevented by fraudulent imitations.
- HONDA Honda Motor Co. Ltd. WIPO Arbitration & Mediation Centre²⁴- Everyone around the world heard of automobiles and motorcycles. WIPO Arbitration centre granted that the mark was globally renowned. The issue is covered by international trademark mechanisms.
- Hamdard Hamdard National Foundation (Hamdard Davakhana) High Court of Delhi ²⁵- Indian Brand name of Unani meds and health products. Delhi High Court maintained its status as a well-known mark. Protection accorded based on popular belief and customary use.
- Infosys Infosys Technologies Ltd. High Court of Delhi ²⁶ - Leading Indian-based IT service firm having international presence. The status of a well-known trademark given by Delhi High Court. Mark was noted by its innovative choice and brand name.
- McDonald's Corporation, U.S.A. High Court of Karnataka²⁷ - Market leader in fast-food chains everywhere. In India, it was acknowledged that Karnataka High Court was a strong brand. Trademark guarded against deceptive usage or abuse.
- MAHINDRA; MAHINDRA & MAHINDRA; M & M Mahindra & Mahindra Ltd. Supreme Court ²⁸ - The diversified conglomerate popular in industries. It was

¹⁹ Revlon Inc. v. Sarita Manufacturing Co., 1997 (17) PTC 394 (Del).

²⁰ Dr. Reddy's Laboratories Ltd. v. Reddy Pharmaceuticals Ltd., 2004 (29) PTC 435 (Del).

²¹ Enfield India Ltd. v. Aggarwal Engg. Co., AIR 2003 Del 42.

²² Glaxo Group Ltd. v. Samrat Pharmaceuticals, 2005 (30) PTC 440 (Del).

²³ Shaw Wallace & Co. Ltd. v. Superior Industries Ltd., 2003 (27) PTC 63 (Del) (Haywards 5000).

²⁴ Honda Motor Co. Ltd. v. Net Rider India Pvt. Ltd., WIPO Case No. D2002-0666 (WIPO Arb. & Med. Center).

²⁵ Hamdard National Foundation v. Hussain Dalal, 2008 (38) PTC 109 (Del).

²⁶ Infosys Technologies Ltd. v. Jupiter Infosys Ltd., 2004 (28) PTC 689 (Del).

²⁷ McDonald's Corporation v. Joburgers Drive-Inn Restaurant, 1996 (16) PTC 741 (Kant).

²⁸ Mahindra & Mahindra Ltd. v. Mahindra Finance Co., AIR 1993 SC 1172.

identified as a familiar trademark by Supreme Court. This was covered against the dilution and abuse.

- PIZZA HUT Logo in respect business relating to restaurants Pizza Hut International LLC, USA High Court, Bombay²⁹ - Well-known global restaurants chain. Bombay High Court registered its mark of providing restaurant services. Logo and name being provided with a trademark.
- VOLVO for automobiles Aktiebolaget Volvo High Court (DB) Bombay³⁰ - Globally reputed in terms of cars and safety technology. Its reputation was corroborated by Bombay High Court (DB). The protection beyond related goods based on good reputation.

Problems faced by well-known trademarks in India

1. Ambiguity of Procedures and the absence of Clear Statutory Criteria

Among the main problems of these well-known trademarks in India is the lack of objective substantiated standards and procedure transparency in defining well-known trades under the Trade marks act of 1999. Even though there are factors to be considered, as defined in Section 11(6), the recognition procedure by Registrar still remains objective, and unreliable. Companies such as CARTIER, CARREFOUR and McDONALDs had to use court resolution as opposed to administrative discretion in order to be accredited. Besides, the process of acquiring well-known status cannot be considered as standardized and time-bound, which causes long litigation and uncertainty of brand owners, with particular reference to the illumination with trans-border reputation but having no significant presence in India.

2. Weak shield against Dilution and passing off

The well-recognized trademarks usually contain the unauthorized use or derivation by the unrelated persons, which leads to the brand dilution. Although the judiciary has taken cognizance of the trans-border reputation in cases such as BENZ, BATA, HONDA and VOLVO, enforcement has proved to be a tricky affair. The Indian courts have on several occasions been hesitant to offer protection to other classes of goods/services other than the same or similar types of goods/services contrary to international practice. Other brands like CATERPILLAR and CHARLIE found it difficult to prevent their trademarks being used in unrelated sectors (such as apparel or personal care) where the courts had to consider the case in terms whether there was any confusion created or it was just a capitalization move in taking advantage of the goodwill. This is portrayed by the lack of proactive measure of dilution protection, not even to the proportional well known marks.

3. Slow Court Help and Danger of Brand Dilution

The other notable issue is that of the delay in judicial relief which applies to foreign well-known trademarks as well as the domestics. The three companies, REDDY, INFOSYS and BAJAJ were required to resort to litigation to defend their marks, which was time consuming and the infringing use most of the times remained active thereby diluting the brands and negating consumer confidence. The absence of interim remedies or a rapid review./ non-prior type of dispute resolution incurs higher costs and distorts the goodwill of famous trademarks. Also, penal or criminal sanction against a continuous violation is not in place and thus there will be a temptation to abuse by local business particularly in those markets that have fewer regulations. In such a way, under Indian law, the importance of well-known trademarks is

²⁹ Pizza Hut Int'l, LLC v. Pizza Ghar, 2003 (26) PTC 208 (Bom).

³⁰ Volvo v. Patel, 1998 PTC (18) 47 (Bom) (DB).

admitted, but the enforcement gap is still one of the burning obstacles to the successful protection of such trademarks.

LAND MARKS CASES ON WELL KNOWN TRADE MARKS IN INDIA

***Yahoo! Inc. v. Akash Arora & Anr*³¹**

In a historic landmark case that regarded the domain name disputes cases in India, Yahoo! Inc. instituted a case against Akash Arora that registered the domain name YahooIndia.org.in (a fake similar one to that of Yahoo itself that holds both trademark and domain name). Yahoo argued that not only was the domain name the same, but that it was a misleading domain name likely to cause confusion in the minds of users so that they would be fooled into believing that the site was affiliated to or approved by Yahoo. The defendant said that domain names cannot be used interchangeably with trademarks and therefore will not receive such protection.

This argument was not accepted by the Delhi High Court which believed that domain names serve the same purpose as trademarks, i.e. to identify the source of goods or services. The Court accepted that Yahoo! was a well-known trademark which has gained a reputation and uniqueness throughout the world. It issued an injunction to the defendant stopping the usage of the offending domain. The ruling was critical in establishing a precedent with regard to safeguarding trademarks on the Web, maintaining the position that being online should not be at the expense of recognized trademark rights.

***The Coca-Cola Company v. Bisleri International Pvt. Ltd*³²**

The case was about the popular mango drink Maaza which was initially owned by Bisleri International, which after sometime sold the rights of the drink including the trademark to The Coca-Cola Company. Even though this was transferred, Bisleri still used the Maaza trademark to export insisting that the rights to the said trademark transferred to Coca-Cola were used in the domestic market only. Coca-Cola took an action against infringement and breach of agreement and it claimed that the entire trademark had been sold.

The Delhi High Court held the decision in favour of Coca-cola, declaring that Bisleri had infringed the mutually signed agreement, by further using the mark Maaza. The Court has pointed out that all the rights vested in a trademark, which is handed over to another entity, entail all kinds of application unless agreed otherwise. This case helped to reinstitute the principle that possession of a trademark gives it the exclusive right to all use whether in domestic or inter-continental use and that any perpetuated use by the assignor will amount to infringement. It has also shown the focus of having clear contractual agreements during IP transfers.

***Rolex Sa vs Alex Jewellery Pvt Ltd & Ors*³³**

Rolex SA, a Swiss luxury watch manufacturer brought about a case against Alex Jewellery Pvt. Ltd. whom continued to sell imitation jewellery using the trademark name as Rolex. Despite the fact that the defendant was dealing with different category of goods (jewellery v/s watches), the plaintiff held that there was a likelihood that the usage would be likely to dilute the characteristic and the prestige of the Rolex brand which is highly seen as the famous mark.

Upholding the claim of Rolex, the Court said that established trademarks have a right of protection even under the classes of commodities that are not related under Section 11(2) of the Trade Marks Act of 1999. A judgment was made to the effect that the brand Rolex is so established that people may mistakenly believe there is some relationship between the products of the defendant and the plaintiff. The Court issued a permanent injunction that

³¹ Yahoo! Inc. v. Akash Arora & Anr., 1999 (19) PTC 201 (Del)

³² The Coca-Cola Company v. Bisleri International Pvt. Ltd., 2009 (41) PTC 100 (Del)

³³ Rolex SA v. Alex Jewellery Pvt. Ltd. & Ors., 2009 (41) PTC 284 (Del)

emphasized the need to grant a broader protection to the famous marks because they had an obligation to enjoy their exclusive identity and avoid dilution.

Jumeirah Beach Resort Llc vs Designarch Consultants Pvt Ltd³⁴

In this regard, Jumeirah Beach Resort LLC, the proprietors of a trademark, “Burj Al Arab” registered a legal case against Designarch Consultants Pvt. Ltd., who used the name of Burj in their housing development in India. Jumeirah stated that albeit the word Burj means tower in Arabic, their hotel brand in conjunction with the connection related to their brand of luxury hospitality industry in the world had built a strong association with the word.

Delhi High Court upheld the submissions made by Jumeirah and contended that, it is of the view that the word was a special feature of the Jumeirah brand, particularly when used together with architectural services and luxury services. The Court concluded that the defendant misused the name Burj which was likely to cause confusion to the consumers and which would unfairly obtain and exploit the reputation of the plaintiff in its well-known mark. This ruling expanded the standards of protection of famous marks in India because even some use of famous mark can be classified as infringement in case it causes confusion to the consumer.

Mondelez India Foods Private Limited (formerly Cadbury India Ltd.) v. Neeraj Food products³⁵

Mondelez India Foods (formerly Cadbury India Ltd.) instituted a suit against Neeraj Food Products on ground that its eggs and chefs packings were similar to Cadbury well-known packings i.e. predominant use of the color combination and the styling of logo used by Cadbury Gems. The defendant on its part marketed a similar product that is a chocolate using a deceptively similar trade dress and name.

Delhi High Court decided that the defendant had taken conscious imitation of the visual parts of Cadbury brand name in order to deceive the buyers and gain out of the goodwill of an established name. It believed that Cadbury Gems was a well-known trademark and any imitation even in different wording was bound to confuse the consumer. A permanent injunction was awarded to the Court which strengthens the notion that famous marks deserve protection on than the name, but also on related trade dresses, trade color and the entire brand appearance.

Raman Kwatra v. KEI Industries Ltd.³⁶

Raman Kwatra v. KEI Industries Ltd. was about the possibility of the statement, advanced by the applicant Raman Kwatra, in the course of the trademark registration procedure, being utilized against him in the course of subsequent legal proceedings on the part of the company regarding enforcing his rights. Raman Kwatra argued that the previous registration and use of KEI trademark by KEI Industries should never be listed as a reason to have an injunction since in the time of registering, the marks that were deemed to be dissimilar did not qualify to be seen as related. Nonetheless, KEI Industries advanced the argument that their mark is of old age and the claim of dissimilarity by the applicant at the time of registration must not prevent effectuation of their rights as mandated by the statute. At first instance, KEI Industries had obtained an injunction holding that since all the KEI trademarks were registered earlier and had been used previously, such injunction is justified. The Division Bench, nevertheless, differed and said that a wrong can only be reproached by circumventing registration upon the grounds of dissimilarity with a different trademark and subsequently claiming deceptive similarity, in order to be imposed with an injunction. This ruling

³⁴ Jumeirah Beach Resort LLC v. Designarch Consultants Pvt. Ltd., 2006 (33) PTC 312 (Del)

³⁵ Mondelez India Foods Pvt. Ltd. v. Neeraj Food Products, 2015 (61) PTC 234 (Del)

³⁶ Raman Kwatra v. KEI Industries Ltd., 2023 SCC OnLine Del 6160

highlighted why there is a need to be consistent in trademark claims both in the scope of registrations and in court of law.

The execution of the Decision of the Division Bench in the Raman Kwatra v. KEI Industries Ltd. laid down the parameter that parties claiming the similarity of trademarks in the process of registration could not be permitted to use alleged deceptive similarity in enforcing injunction subsequently. In overturning the decision of a solitary judge, the court had demonstrated its belief to augment the fact that the stand of a trademark applicant on the non-resemblance of marks on registration is decisive. Once they win an argument that their mark is not confusingly similar to others, they cannot at some latter point appear to contradict themselves and seek to stop use of the rights to the prior registrant. This case is substantial because it highlights consistency and good faith that parties need to observe in the course of seeking and litigating trademark rights. It also explained that the rights that are given by registration of a trademark ought not to be affected by reposition of the law when the mark is registered and the statutory protection is in hand.

Puma SE v. Ashok Kumar (Kumkum Shoes)³⁷

In Puma SE Cases, it was T-Mobile, the plaintiff, who was assigned a mere 29,436 in damages. Ashok Kumar the renowned international footwear and attire trademark holder-Puma SE brought suit against a man known as Ashok Kumar who was operating a business carrying the name Kumkum Shoes in Agra town and was using the registered trademark of the company without authorization namely the trademark PUMA. Puma also applied permanent injunction to stop Ashok Kumar to use trademark on his shoes on the basis that the PUMA mark to be used on his shoe will lead to confusion of consumers and possible harm to the brand name of Puma. Based on this argument, the court granted the ex parte interim injunction--which restrained Ashok Kumar to sell out shoes that possessed PUMA trademark, before the full hearing was held. One of the aspects that the case brought out was the rate at which cases are solved by courts regarding intellectual property infringement in a bid to avoid further damage of the established trademarks especially when the issue at hand is prone to confusion among the people. Infringing merchandise was seized by the authorities in post-raided raids to emphasize the degree to which the court took the infringement of trademarks seriously.

Besides the injunction, Puma SE received damages over the infringement, and the court mentioned the Rule 20 of the Delhi High Court Intellectual Property Rights Division Rules, 2022, to determine the level of such damages. The court awarded, damages of a large sum, Rs. 10,00,000 (approx. US\$ 12,500), as well as costs of Rs. 2,00,000 (approx. US\$ 2,500). This very decision is a vivid reminder about how famous trademark needs to be secured and how heavily one should respect the intellectual property. Upon awarding very substantial damages and expenses, the court reaffirmed its intentions on implementing trademark rights and discouraging subsequent infringement, especially when it has to deal with established international brands like Puma SE. The case can also be cited as an example of how fast courts can act in case of trademark infringement and give a short-term measure until the entire legal nature is exhausted.

Dr. Reddy's Laboratories Ltd. v. Fast Cure Pharma (RAZO v. RAZOFAST)³⁸

The Dr. Reddy Laboratories Ltd. v. Fast Cure pharma (RAZO v. Fast Cure Pharma (FCP) of India, Dr. Reddy Laboratories (DRL) claimed that the latter was violating its trademark RAZO with the registration name of RAZOFAST in a similar pharmaceutical product. In spite of this, Kolkata Trademark Office had registered RAZOFAST mark, DRL moved a

³⁷ Puma SE v. Ashok Kumar, 2023 SCC OnLine Del 2885

³⁸ Dr. Reddy's Laboratories Ltd. v. Fast Cure Pharma, 2023 SCC OnLine Del 4336

cancellation, claiming that the marks were misleadingly similar and this would cause confusion amongst buyers. The territorial jurisdiction issue was brought into sharp focus by the case as the DRL tried to oppose the registration in the Delhi High Court however, the Kolkata Trademark Office had territorial jurisdiction of the contested mark. It was considered by the court that the cancellation petition could either be permitted to be filed in only Calcutta High Court or whether it would also be entertained in the Delhi High Court, in view of the infringement issue being before the Delhi high court which could hear it.

The case was finally won by the Delhi High Court with the endorsement of safeguarding any well-established trademark against infringement even when the initial registration was allowed by a different trademark office. The case highlighted the existing flexibility of the Indian trademark law to find relief in the court of a state outside of the state which the trademark was registered initially. The case was also about the larger circumspection of the scope through which trademark contention can be resolved in a number of courts, relying on the type of argument, and jurisdictional stipulation applied. The decision strengthened the law that the trademarks need to be defended against confusingly similar marks in different jurisdictions and that cancellation petition and right to file does not geographically constrained within that trade mark office only which granted that registration.

Pernod Ricard India Pvt. Ltd. v. J.K. Enterprises (Blenders Pride v. London Pride)³⁹

The case of Pernod Ricard India Pvt. Ltd. v. J.K. Enterprises (Blenders Pride v. London Pride). In the case of London Pride, Pernod Ricard, the alcoholic beverage producer in the world, filed case against trademark infringement against J.K. Enterprises stating that its registered trademark of Blenders pride was deceptively similar to their registered trademark of London Pride. Pernod Ricard argued that the reputation it had build in using the word Pride in both trademarks and the overall branding such as the product labels would lead to confusing the consumers to its disadvantage. The court however overruled the application to obtain interim relief by Pernod Ricard citing that the names of the marks were not similar to justify such drastic action. The judge mentioned that the word pride was a common word and Pernod Ricard could not take the exclusive ownership. Also, the court decided that color combination and design of the labels was not so identical as to create reasonable risk of confusion among the customers. The case showed the difficulty of claiming exclusivity in terms of words or various elements that are in wide use in the market, in particular, in the sphere of alcoholic drinks where branding can belong to well-established traditions.

This is after Pernod Ricard appealed to higher court (Madhya Pradesh High Court) because it disagreed with the decision provided by the single judge. The question that was addressed by the higher court was whether the fact that the names and manner of branding of the products were similar were enough grounds on which to grant interim relief, and the court ended up taking a fine line position with regard to the evidence that was before the court. The case demonstrated how difficult the acquisition of interim injunctions was on a trademark dispute, where an opportunity to argue on the similarities presented by the marks exists. The court in this case understated that it would require clear and convincing evidence of consumer confusion before such relief would be given. Another issue underlain by the holding was the balance that not only courts needed to consider between the rights of the trademark holders and the restrictions of competitors not to use terms or elements common in the market.

Intercontinental Great Brands LLC v. Parle Products Pvt. Ltd. (OREO v. FAB!O)⁴⁰

³⁹ Pernod Ricard India Pvt. Ltd. v. J.K. Enterprises, Misc. Appeal No. 232 of 2021

⁴⁰ Intercontinental Great Brands LLC v. Parle Products Pvt. Ltd., CS(COMM) 64/2021

The case of Intercontinental great brands LLC v. Intercontinental, which is the proprietor of the renowned OREO biscuit brand name, brought in a trademark infringement and passing off action against Parle, and claimed that the FAB!O biscuits produced by it were deceptively similar to OREO in various aspects. Intercontinental argued that "FAB!O" pronounced as "FABIO" and "OREO" were too similar in phonetics and thus consumers would be misled in purchasing biscuits manufactured by Intercontinental when they saw "FAB!O" with similar trade dress and similar design in form of biscuit to that of "OREO". The case concerned the supposed violation of the uniqueness of the OREO brand in its appearance of special-style biscuits, packaging, and branding, which Intercontinental described as an act not only of infringing the trademark but also of unfair competition that derived profits upon the goodwill and customer recognition of the OREO brand.

In its own defense, Parle stated that its house mark was used and the consumers could not have confused the two products since there was a clear distinction between branding. It stated that, the term FAB! O was also a separate brand and did not affect the intellectual property of Intercontinental. Nevertheless, having considered the packaging, the overall trade dress, and the visual similarity, the court determined the strong prima facie case of deceptive similarity. Consequently, the Delhi High Court also issued an interim injunction, barring Parle using the FABIO/FAB!O mark together with the associated packaging and trade dress till such a time as the issue goes to its final adjudication. The case emphasizes the relevance of unique branding to the FMCG industry and strengthens the judicial consideration in defending the theft of iconic products and design by trade dress.

Outcomes of the Cases

1. Protection and Publicity of Well-known and Renowned trademarks

Some of the cases affirmed the fact that a good mark is to be granted certain appraisal and legal security under the Indian law without considering the goods or services provided. In *Rolex SA v. Alex Jewellery (Yahoo!) Inc. v. Puma SE v., Akash Arora*. The courts ruled in favor of the plaintiffs holding that their trademarks are well known or famous thus upholding the rights of the plaintiffs. These rulings established that the marks are entitled to wide protection, such as protecting their use in different industry, to guard against dilution, and protect brand equity. The *Coca-Cola v. Bisleri* case also endorsed the fact that use of trademark by the original owner after its transfer has been passed to the latter is a violation even when such is used in export. Such rulings reflect the determination of the courts to implement the protection of internationally established trademarks and stop the process of enriching a violator.

2. Deceptive Similarity, Trade Dress and Infringement

A second set of cases captures the attitude of court in regard to infringement as well as that of deceptive similarity especially with regard to visual similarity and phonetic similarity. *Intercontinental Great Brands v. The Delhi High Court* now restrained Parle Products against use of FAB!O based on phonetic and its trade dress because of its resemblance with OREO. In the same fashion, *Mondelez v. In the case of Neeraj Food Products*, there was also the uncalled use of the confusingly similar branding to take advantage of the goodwill of Cadbury. These are the cases placing significant importance to overall impression in claims of infringement- the courts did not only rule on the words, but the design and packaging, and the perception of the consumer. Conversely, the court refused to grant interim relief in *Pernod Ricard Freres v. J.K. Enterprises* on the ground that there were common components such as the use of the word Pride, or color blue that could not be granted interim relief as far as a strong case of infringement was concerned. This reveals that the issues of commonality and generic term use are also considered in courts when establishing the trademark exclusivity.

3. The Territorial Jurisdiction and the Procedural Integrity

The third group of consequences is concerned to procedural behavior and territorial jurisdiction in enforcing trademarks. *Raman Kwatra v. To the above*, the court relied on estoppel founded on statements that were contradictory at the time of registering the trademark-KEI Industries that have argued that their goods were dissimilar at the time of the registration process could no longer argue that their goods were similar in a deceptive way when attempting to have the registration enforced. In the same way, *Dr. Reddy Laboratories v. Fast Cure Pharma* explained the rule that the cancellation petitions can be filed where the harm of infringement is experienced and not where the mark is registered. Such rulings are a factor behind procedure-clarity in Indian trademark law, as the stress on consistency, among representation, strategic choice of venues, and litigation in good faith is consolidated.

SUGGESTIONS FOR AMENDMENTS IN THE INDIAN TRADEMARK LAW

A list of the recommendations on what should be amended in the Indian Trade Marks Act, 1999, in relation to well-known trademarks, which are related to appropriate sections of the Act and the proposed changes, is presented below:

1. Section 2(1) (zg) meaning of Well- Known Trademark

Enlarge the definition to:

- *Incorporate online existence (e.g. social networks, domain names, online shops).*
- *Be seen in trans-border reputation without any physical presence in India.*

2. Relative Grounds of refusing registration- Section 11

- *Place a sub-clause under 11(2) which states clearly that marks that are identical/similar to well-known marks may not be registered in any class, irrespective of the similarity of goods/services to avoid dilution.*
- *It is a good idea to clarify that unfair advantage and harm to the reputation of a well-known mark by way of unauthorised use on the similar goods/services shall also be reasons of refusal and cancellation of the registration on dissimilar goods/services.*

3. Section 11(6) (to) 11(10) Determination of Well-Known Trademarks

- *Present compulsory procedural rules (through Rules or Section 157) so as to provide:*
- *Processing of well-known mark applications within time.*
- *Access to all applications and Registry decisions with reasons by the public.*
- *An appeal/review right on the part of the affected parties.*

4. Section 18- Application for Registration

- *Introduce a new explanatory provision that assumption of applicants to the problem of similarity/dissimilarity of marks at analysis can serve in enforcement or opposition efforts, which is, in principle, binding unless it is proved by good cause.*

5. Section 47 Removal on ground of non-use

- *Create in a rule that well-known marks may not be cancelled on the risk of non-use, as in so far as reputation and goodwill subsist, although without any meaningful commercial exploitation in India.*

6. Section 57- Rectification or Cancellation

- *Insert a further clause to give the power to take cancellation proceedings in any country where the influence of the offending mark is experienced, not necessarily where the mark has been registered*

7. Section 135- Relief in Infringement cases

- *Provide statutory damages amounting to at least slight penalties in cases of infringement of renowned trademarks.*
- *Empower the courts to grant exemplary or punitive damages whenever the infringement is willful or malicious.*
- *Permit abridged proceedings in cases of uncontested, or prima facie clear cut infringements of well-known marks.*

The recommendations shall contribute to clarity, strength of enforcement, transparency of procedure and compliance with international best practice in the protection of well known trademarks in India. If you require a draft of a model amendment or a legislative draft, please tell me.

CONCLUSION

The research article concludes that taking into consideration the concerns that are related to the trademark legislation in India, the hypothesis that well known are afforded greater legal protections under the law is proved. This is probably due to the fact that the well-known trademarks have tremendous value and legal presumptions in their favor which render them more beneficial and worthy of protection. The hypothesis stating that the factor determining a trademark to be well known in India may be higher, to guard against those companies which try to usurp the goodwill associated with reputed trademark without justification is also accepted

This study highlights the significance of safeguarding Strong Trademarks in India, as well as the repercussions of such action. By grasping the intricacies underlying the Indian trademark law as well as the value of trademarks deemed as famous, the businesses are in a position to understand the law on brands better and thus protect their brands. This self reflection not only calls for robust trademark protection measures but also demonstrates the importance of thorough legal planning in the Indian context.

This research study will assist academicians to understand better the legal concepts underlying trademarks in India and their impact on businesses. Trademarks famously found in India can be viewed by academicians as opportunities to refine and strengthen trademark protection and enforcement strategies. This study also shows the importance of future studies and education on this issue so that the business world is able to understand the trademarks system in India in a more holistic way.

The impact of this study to the policy makers is profound. By appreciating the intricacies of some of the trademark which are famous in India, the policy makers are able to craft relevant legislation on trademarks and their enforcement. This research can also assist policy makers in coming up with measures to safeguard well-known trademarks against infringement or dilution. On the whole, this research exposes policy makers and industries doing business in India about the intricacies and the insight of already existing and ever-changing trademark laws in India.

Author statement

All authors contributed equally to this work.

Declaration of Competing Interest

The authors declare that they have no known competing financial interests or personal relationships that could have appeared to influence the work reported in this paper.

Data availability

Data will be made available on request.

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