

PROTECTION OF WELL-KNOWN TRADEMARK IN INDIA

Harish Kumar
Department of Law
Teerthanker Mahaveer University, Moradabad, Uttar Pradesh, India

Abstract: A new rules were developed with the development of contemporary Trade Mark Rules 2017 which really allows the Registrar to announce a specific trademark as "well known." Under the new law, a trademark owner can file a claim on Forms TM-M with only an application made to both the Registrar may declare that the mark is 'well-known.' Extraordinary rights and protections against all the passing off and misuse of certain trademarks have been given to a well-known trade mark. This article, together with various criteria and proof specifications, sheds light on either the defence of well-known trademarks in India in order to define a mark with a very well sign by means of a review of applicable case laws. In addition, this article discusses the judicial patterns that the court is pursuing when reviewing the cases and how vigilant the learned judge is in safeguarding a better trademark.

Key Words: - Well-Known Trademarks, Trademarks, Intellectual Property Rights, Indian Judiciary.

INTRODUCTION

In the field of trademarks, the achievement of the recognition of a 'well-known trademark' is close to the achievement of Nirvana because its protection of some well trademarks exceeds conventional trademark protection requirements and objectives. Nirvana," also known as MOKSHA, reflects its biggest companies of soteriological relaxation in Hindu philosophy." The security of well-known marks stems from the fundamental aim of the defence of a mark, not to stifle competition from fraud, but rather to maintain the individuality of the mark by shielding it from free-riding of tarnishment. Therefore, in the defence of well-known marks, evidence of misunderstanding and fraud, and it's one of the standard requirements of trademark infringement and pass-off acts, is becoming a secondary concern.

Consumers will become more and more cautious of trademarks identified with leading items as technology progresses and new channels arise. In building and preserving the goodwill and brand name of the globalising economy, the sales person spends vast amounts of money, energy and money.

DISCUSSION

Meaning of Well-known Marks

The regime for something like the enforcement of well-known marks was already adopted in Article 6bis of the Paris Convention and consequently, during in the composition of the TRIPs Agreement, provisions only for protection of well-known marks as provided for within Article 6bis of the Paris Convention became inserted as Articles 16.2 and 16.3 of the TRIPs.

Though the expression used in the Paris Convention and the TRIPs Agreement is "well known mark," then also different jurisdictions use different expressions to denote marks falling into the category of well-known such as marks having a reputation, famous marks or notorious marks etc. Under the Trademark Act. The rules dealing with the security of well-known trademarks have developed from the Paris Convention to the TRIP Agreement. The Paris

Convention works mostly with well-known marks in relation to goods and offers safeguards only against use in relation to similar or equivalent goods; on the other hand, the TRIPs Agreement allows Member Countries to extend protection to registered marks in relation being used in relation to goods and services. It also protects dissimilar goods and services to the degree that it is known that the contested usage by third parties implies a correlation between such dissimilar goods or services and indeed the owner of the registered trade mark, which is likely to affect the interests including its owner. Notably, the two conventions would not specify what constitutes a well-known label, leaving its meaning to each Member State.

Protection of well-known trademark in India.

Under the Indian Trademark Act, well-known trademarks are defined in relation to any 'goods or services,' meaning a trade mark which has become so for a significant sector of the population which uses or receives such goods that it is probable that the use of such a trade mark in respect to other goods or services will be taken as implying a link in the course of trade or rendering of services between those goods or services. Individuals who use the mark in relation to the products or services first listed." And, however according section 11 of the Indian Trademark Act, a mark must be considered as a "well-known trademark. Firstly, due to the heavy marketing by the trademark holders, there should have been awareness and acknowledgement of the supposed trademark, in particularly in the public section. In the case of *Rolex S A v Alex Jewellery Pvt Ltd*, the court found that even the defendant was engaged in the sale of artificial jewellery using the "ROLEX" trademark, which is a very common watch brand and a well-known brand. The Delhi High Court contended that 'Section 2(4)(c) defines a well-known stamp as a mark which, in terms of goods, means a mark and has become a significant segment of the public which requires those goods in a way that the use of those mark in relation to these other goods is likely to be regarded as indicating a link in the course of trade between goods and the individual who uses the mark in relation with the first good and services referred to.' In my opinion, 'Rolex' is a well-known trademark of that same public segment that uses several watches of the category/price category as the phones of the claimant. If the said segment of the public comes across jewelry/artificial jewellery also bearing the 'Rolex' trademark, it is likely not only that the jewellery has an association with the complainant. It was well justified by the court that awareness and acknowledgement of that same mark were significant.

Secondly, the length of the trademark could become short or long, but the essential aspect is that the appealing segment of the market and the geographical region should be well known. Which is shown in the *Duracell Ultra* case, where the sale showcased was for less over a year, the Court found that during that time the complainants had achieved high sales although advertised heavily. Advertising sometimes plays an important role in weighing, as seen in the historical case of *Whirlpool*, the well-known brand, although the company's product was completely missing again from Indian markets, that mark was covered by the Court on the ground that those amount of advertising was reasonable to enter the related segment of the public.¹

Third, the period and geographical area about any promotion of just the trade mark, namely advertisement or advertising, and now the display of the products or services through which the trade mark appears at exhibitions or fairs. In reality, promotion mostly in form of ads is a

¹ N R Dongre v Whirlpool Corp, (1996) PTC (16) 583 SC

significant factor when considering cases of well-known marks toward passing off. In the historical case of Whirlpool, even though the company's product appeared absent again from Indian markets, its trademark was covered by the Court of Justice on the basis that its advertisement volume was adequate to have entered the appropriate segment including its public.²

Fourthly, the number of potential or existing consumers of the products or services is another critical thing. In the very recent case of Aveda Corporation v Dabur India Ltd, for example, the complainants were engaged in the sale of beauty products under the name 'AVEDA' and indeed the defendants began selling that own beauty products under the name 'UVEDA'. The Delhi High Court found that the plaintiffs had no presence in India because they can only had supplies in one spa in India, in Rishikesh, and there will not be a question of misunderstanding in the minds of the customer. Compared to either the defendants, the plaintiff just doesn't have a large client base. The presumption of convenience was thus in favour including its defendants and only small recommendations were made by the Court to raise the font size of their name 'Dabur' to bring it more recognizable in immediately to protect any probable misunderstanding.³

Indian judiciary trends w.r.t well-known trademark

The Indian judiciary have always protected the well-known trademark and its interest from the one who tries to encase on their goodwill.

Sunder Parmanand Lalwani & Ors v. Caltex (India) Ltd⁴

In 1965, on appeal as from Order of the Single Judge of the same Court, the Division Bench of the High Court of Bombay addressed the first well-known Marks case. The Single Judge permitted Caltex (India) Limited (Caltex) (Caltex) to appeal another order of that same Deputy Registrar of Trade Marks rejecting Caltex's opposition to either the registration by a third party of the CALTEX mark for 'Horological and some other Chronometric instruments and parts thereof' in Class 14.

Bata India Ltd. v. Pyarelal & Co., Meerut City & Ors⁵

In this case, the District Court argued that the litigants had misled consumers and used the deceptively similar BATAFOAM label, but all bad-faith and dishonest actions led to tarnishing the goodwill and credibility of the plaintiff. The court noted that it is this perception that could potentially undermine the credibility of the plaintiff. The name "Bata" is not a fancy name, but instead a paternal name, but it is hardly related to the defendants in most every way. It wasn't the identification of a flower or wildlife. It is a fancy name of a visitor who has developed his business make shoes and the like products in this country. The name is quite well known on the market and will eventually cause serious damage to his goodwill by the defendant mark similar to the plaintiff.

Daimler Benz Aktiegessellschaft & Anr. v. Hybo Hindustan⁶

² Marico Ltd v Madhu Gupta, CS (OS) No 2275/2009

³ Aveda Corporation v Dabur India Ltd, CS(OS) No 2179/2009

⁴ Sunder Parmanand Lalwani & Ors v. Caltex (India) Ltd., AIR 1969 Bom. 24, 36

⁵ Bata India Ltd. v. Pyarelal & Co., Meerut City & Ors , AIR 1985 All. 242

⁶ Daimler Benz Aktiegessellschaft & Anr. v. Hybo Hindustan, AIR 1994 Del. 239.

Decided in 1993 by the High Court of Delhi, it therefore was really the first Indian case that discussed the notion of dilution of well-known marks in depth. In this case, the problem hence the use of the BENZ symbol and with a "three-pointed humanoid being in a ring" and now the words "perfection through Germany. It shouldn't be limited to mere machines. Or horizons, in conjunction with an Indian company's underwear. Daimler Benz Aktiegessellschaft, which owns the famous three-pointed star BENZ logo shown above, sued the Indian undergarment company for passing off. In 1951, the logo including its plaintiff was registered in India. "

By denying the protection of the defendant's practical and positive use, the Delhi High Court issued an injunction in favour of the plaintiff's and found that if a label also including MERCEDES BENZ with the three-pointed star is invaded by anybody, including all the defendant who made undergarments, it would be a significant misappropriation of its law relating to trademarks.

*Honda Motors Co. Ltd. v. Charanjit Singh & Ors*⁷

Decided in 2002 by the Delhi High Court, this case focuses with the use of the HONDA label in relation to the defendant's pressure cookers. The Court noted that HONDA had a recognition mostly in automotive industry for high-quality products and the use of this label by the defendant in association with pressure cookers would deceive the voters into thinking also that goods came from the complainant.

CONCLUSION

It is evident from the above discussion that due to their 'market image' the well-known brand enjoys different protection under the law. The trademark has developed quite drastically over the years and the significance and need to secure the well-known mark have begun to be recognised by the Indian judiciary. Sharing of information seems to be much easier for customers to endorse their brand and reach the masses with the development of information technology and emerging modes of communication and social media that have become visible, as observed in the whirlpool case in which even before having any position in the Indian market, Only by ads did the Indian judiciary recognise the mark for such a well symbol. In India and maybe even abroad, it is the duty of the judiciary and indeed the customers to protect their rights.

⁷ Honda Motors Co. Ltd. v. Charanjit Singh & Ors , 2003 (26) PTC 1 (Del.)