

Position of Well Known Trademarks- A bewildering way to serenity

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Abstract

In the time of globalization, trademarks have gotten to the ever-increasing extent significant resources of organizations as well as of nations. The commitment of notable trademarks, for example, COCA-COLA, IBM, NOKIA, and HONDA into the national economies are enormous and very striking. The notable trademarks and the insurance of notable trademarks have progressively become significant points connecting with the contemplations of researchers everywhere throughout the world. This paper reveals insight into the assurance of notable trademarks in India opposite different parameters and proof necessities, principally by method of investigating applicable case laws.

Introduction

In the domain of trademark, accomplishing the status of "notable imprint" is maybe much the same as achieving Nirvana¹ because the insurance of notable imprints rises above the conventional measures and targets of trademark assurance. "Nirvana" alludes to a condition accomplished by freeing oneself from want, desire, and obliviousness. The security of notable imprints withdraws from the fundamental target of trademark insurance, in particular, ensuring purchasers against double-dealing; rather, it centres on saving the uniqueness of an imprint² by ensuring it against free-riding and tarnishment. Subsequently, confirmation of disarray and duplicity, which is one of the conventional prerequisites of trademark encroachment activities and going off activities, turns into an auxiliary thought in the security of notable imprints.

¹ Webster's Encyclopedic Unabridged Dictionary of the English Language at page 698 (1996) gives one of the meanings of "Nirvana" as "a place or state characterized by freedom from or oblivion to pain, worry and the external word."

² The Opening line of the United States Supreme Court decision in *Moseley vs. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003), read: "Unlike traditional infringement law, the prohibitions against trademark dilution are not the product of common-law development, and are not motivated by an interest in protecting consumers."

Things being what they are, when is an imprint qualified for security as a notable imprint? A Joint Resolution Concerning Protection of Well-Known Marks was received by the General Assembly of the World Intellectual Property Organization (WIPO) and the Assembly of the Paris Union in September 1999.³ The WIPO Resolution records a few variables for deciding if an imprint falls into the class of notable imprints. These variables incorporate the level of prestige of the imprint, the span and topographical degree of its utilization, the degree of exposure-related with the imprint, and the number of trademark enlistments around the world.

In 2003, India made successful its new Trademarks Act, 1999 (the TM Act), which contains arrangements for the security of notable imprints. The demonstration became effective in 2003, and has brought a few issues up in India, for example, the prerequisite that the level of notoriety reaches past the offended party's genuine field of exchange versus the high powerlessness of these imprints; the potential damage to rivalry versus the potential mischief to the offended party's imprint; the idea of the utilization of the notable imprint and the tested imprint, and so on. From late court choices, doubtlessly the security of notable checks in India is a high exercise in careful control since it includes many contending contemplations.

This article will audit the assurance of notable stamps in India to date, by looking at the advancing case law under the old trademark resolution, the Trade and Merchandise Marks Act, 1958 (the TMM Act) and the new rule, the TM Act.

Meaning of Well-Known Mark

The security of notable imprints was first presented by The Paris Convention in Article 6bis:

1. The nations of the Union embrace, ex officio if their enactment so allows, or in line with an invested individual, to won't or to drop the enlistment, and to disallow the utilization, of a trademark which comprises a proliferation, an impersonation, or an interpretation, obligated to make disarray, of an imprint considered by the skilled authority of the nation of enrollment or use to be notable in that nation as being as of now the characteristic of an individual qualified for the advantages of this show and utilized for indistinguishable or comparative merchandise.

³ WIPO Document No. SCT/3/8 dated Oct. 7, 1999, available at <http://www.wipo.org>.

Article 16.2 will apply, *mutatis mutandis*, to administrations. In deciding if a trademark is notable, individuals will assess the information on the trademark in the significant part of people in general.

Article 16.3 will apply, *mutatis mutandis*, to products or administrations which are not like those in regard of which a trademark is enrolled, given that utilization of that trademark according to those merchandise or administrations would demonstrate an association between those products or administrations and the proprietor of the enlisted trademark and gave that interests of the proprietor of an enlisted trademark are probably going to be harmed by such use.

The arrangements tending to the security of notable imprints advanced fairly from the Paris Convention to the TRIPs Agreement. The Paris Convention manages notable checks about products alone and gives assurance just against use regarding indistinguishable or comparable merchandise. Both the Paris Convention and TRIPs Agreement don't characterize what establishes a notable imprint, leaving its definition to the individual Member States. Even though the articulation utilized in the Paris Convention and TRIPs Agreement is "notable imprint," various purviews utilize various articulations to indicate marks falling into the class of notable checks, for example, "acclaimed marks," "marks having notoriety," or "infamous imprints." Under the TM Act, while there is a meaning of "notable imprint" and "an enlisted mark has notoriety" are likewise utilized.

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Protection of Trademark under Old Indian Trademark Statute

Before the order of TM Act, the resolution overseeing trademarks in India was the TMM Act. The TM Act came into power in September 2003. Before that date, notable imprints were secured under Section 47 of the TMM Act, which gave for guarded enrollment of notable checks just as passing off activities.

Section 47(1) of the TMM Act says: Where an exchange mark comprising of any developed word has become so notable as regards any products corresponding to which it is enrolled and has been utilized, that the utilization thereof comparable to different merchandise would probably be taken as demonstrating an association over the span of exchange between those products and an individual qualified for utilizing the exchange mark connection to the first referenced merchandise, at that point, despite that the owner enlisted in regard of the first-referenced products doesn't utilize or propose to utilize the exchange mark connection to those different products and despite anything

in Section 46, the imprint may, on the application in an endorsed way by such owner, be enlisted in his name in regard of that different merchandise as a protective exchange mark and keeping in mind that so enrolled, will not be subject to be removed the register in regard of those products under the said segment.

The test for qualification for the cautious enlistment of a well-known mark under Section 47(1) was whether the utilization of the imprint regarding products other than the enrolled merchandise or products being used would almost certainly be seen as demonstrating an association over the span of exchange between such merchandise and the notable imprint's owner.

Notwithstanding, even without a protective enrollment, Indian courts have maintained rights in a few notable imprints stated by trademark proprietors through going off activities. These court choices and India's worldwide commitments to execute security of notable imprints prompted the codification of the well-known marks arrangements under the TM Act. Here are some audits of the court choices under the old rule, the TMM Act, which is viewed as achievements in the development of Indian case law on notable checks and made ready for its codification under the new rule.

- **The Caltex Case⁴**

The main notable imprints case was chosen by the Division Bench⁵ of the High Court of Bombay in 1965 on request from the Order of the Single Judge of a similar court. The Single Judge had permitted the intrigue of the rival Caltex (India) Limited's (Caltex) of a request for the Deputy Registrar of Trade Marks dismissing Caltex's restriction to an outsider enrollment of the imprint CALTEX for " Horological and other Chronometric instruments and parts thereof" in Class 14.

The Deputy Registrar had dismissed Caltex's restriction on grounds that the contending merchandise and exchange channels were unique; consequently, there was no association over the span of exchange between the contending products; the adversary's notoriety was built up just in regard of the products for which its imprints were utilized and in this way, despite the notoriety of the rival's imprint CALTEX, the utilization of the candidate's imprint would not probably bamboozle the general population. The rival's dispute that the candidate embraced the culpable

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

⁵ A two-judge Bench of an Indian High Court is referred to as a "Division Bench."

imprint in dishonesty was dismissed by the Deputy Registrar. The Single Judge permitted the intrigue and certified the Deputy Registrar's finding that there had been no probability of disarray. In any case, the Court found that the candidate chose the imprint in dishonesty and thus it conceded the restriction.

- **The Mercedes Benz Case⁶**

Chosen in 1993 by the High Court of Delhi, this was maybe the Principal Indian decision that glanced in detail into the idea of weakening of notable imprints. The issue for this situation was the utilization of the imprint BENZ alongside a "three-pointed individual in a ring" and the words "German flawlessness. It need not be confined to insignificant machines. Or on the other hand, skylines," regarding clothing made by an Indian company. Daimler Benz Aktiengesellschaft, Germany, the offended party, who possesses the acclaimed three-pointed star BENZ logo, sued the Indian clothing organization for going off. The offended party's logo was enlisted in India in 1951.

Disregarding the barrier of legitimate simultaneous use by the respondent, the High Court of Delhi conceded the offended party's order and discovered that it would be extraordinary depravity of the law identifying with trademarks if an imprint, for example, MERCEDES BENZ with the three-pointed star were lowered by aimless impersonation by anybody including people like the litigant who made undergarments.

This judgment is still viewed as an achievement choice on trademark weakening in India and its discoveries keep on being referred to in trademark debates including notable imprints. This is maybe the sole case in India charging a respondent from utilizing the offended party's notable blemish on the sole ground of free-riding, without examination of probability of disarray or duplicity. Truth be told, the High Court precluded disarray and double-dealing by recognizing the universal notoriety of the name BENZ regarding vehicles.

- **The Honda Case⁷**

⁶ Daimler Benz Aktiengesellschaft & Anr. v. Hybo Hindustan [AIR 1994 Del. 239].

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

Chosen by the High Court of Delhi in 2002, this case concerned the utilization by a neighbourhood litigant of the imprint HONDA regarding pressure cookers. Indeed, even before the recording of the claim, the gatherings had secured horns 1991 preceding the Trade Marks Office. Resistance by the offended party, Honda Motors Co. Ltd., Japan, was allowed by the Registrar of Trade Marks against the respondent's application to enlist HONDA regarding non-electric weight cookers. The offended party expected that after the dismissal of its application, the litigant quit utilizing the imprint HONDA regarding pressure cookers. Be that as it may, in 1999, the offended party went over another application for the enlistment of the imprint HONDA in Class 21 concerning "pressure cookers."

Notwithstanding documenting a restriction, the offended party recorded a moment suit for going off, asserting; bury alia, earlier rights dependent on use in India returning to the 1950s and worldwide notoriety and altruism remembering for India. The respondent tested the offended party's fundamental directive solicitation on different grounds, charging, bury alia, that: its utilization of the imprint at issue dated back to 1985; that the litigant was the earlier client of the imprint in association with pressure cookers; that the gatherings' products were unique and consequently there would not be any disarray or misdirection; and that the offended party's cases were banished by laches because of its deferral in recording the suit.

Holding for the offended party and ordering the respondent, the Court found that HONDA had gained notoriety for prevalent quality items in the field of vehicles and force gear and that the litigant's utilization of this imprint regarding pressure cookers would misdirect the general population into accepting that the litigant's business and merchandise started from the offended party. The Court found that such client by the respondents had likewise weakened and corrupted the generosity and notoriety of the plaintiff.

Protection of well-known marks under the TM Act

Under the TMM Act concerning the assurance of notable denotes, the case law talked about above remains the most critical and most depended upon in later choices. As can be seen from the reviews above, Indian courts have applied giving standards to arrive at discoveries of weakening, which is a demonstration of uncalled for rivalry. Segment 47 of the TMM Act itself says, that there is no reference to weakening of an imprint's uniqueness; rather, express reference is made to the tested

use on different products being "taken as demonstrating an association over the span of exchange between those merchandise and an individual qualified for utilizing the trademark according to the first referenced merchandise." except for the Mercedes Benz case,⁸ the various cases depended on the components of turmoil and double-dealing caused to shoppers by the litigants' culpable use, aside from the weakening brought about by the damage to the imprint's notoriety.

It is additionally of noteworthiness that under the TMM Act, there would be no representing an encroachment activity except if the notable imprint had a cautious enrollment in the class of merchandise for which the respondent decided to utilize the imprint. In any case, the cure of giving was as yet accessible to a bothered trademark proprietor even without a guarded enrollment. All the cases talked about above were either requests from the Trade Marks Office's requests in restriction procedures or going off-court activities.

At the point when the TM Act got viable in September 2003, the security of notable imprints obtained another shade in India. The TM Act contains five arrangements alluding to notable imprints, to be specific, Sections 2(1) (g), 11(2), 11(6), 11(7), and 11(9).⁹

⁸ See *Daimler Benz Aktiegessellschaft & Anr. v. Hybo Hindustan* [AIR 1994 Del. 239]

⁹ Section 2(1) (zg) states: "well-known trade mark," in relation to any goods or service, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person using the mark in relation to the first-mentioned goods or services."

Section 11- Relative grounds for refusal of registration 11(2)—A trade mark which— (a) is identical with or similar to an earlier trade mark; and (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered in the name of a different proprietor, shall not be registered, if or to the extent, the earlier trade mark is a well-known trade mark in India and the use of the later mark without due cause would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trade mark.

11(6)—The Registrar shall, while determining whether a trade mark is a well-known trade mark, take into account any fact which he considers relevant for determining a trade mark as a well-known trade mark including— (i) the knowledge or recognition of that trade mark in the relevant section of the public including knowledge in India obtained as a result of promotion of the trade mark. (ii) The duration, extent and geographical area of any use of that trade mark. (iii) The duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trademark applies.

(iv) The duration and geographical area of any registration of or any publication for registration of that trade mark under this Act to the extent they reflect the use or recognition of the trade mark.

(v) The record of successful enforcement of the rights in that trade mark, in particular, the extent to which the trade mark has been recognized as a well-known trade mark by any court on Registrar under that record.

11(7)— The Registrar shall, while determining as to whether a trade mark is known or recognized in a relevant section of the public for the purposes of sub-section (6), take into account:

- (i) The number of actual or potential consumers of the goods or services.
- (ii) The number of persons involved in the channels of distribution of the goods or services.
- (iii) The business circles dealing with the goods or services. to which that trade mark applies.

Additionally, under Section 29(4)¹⁰ of the TM Act, managing trademark encroachment, there is a particular arrangement to secure enlisted trademarks that have notoriety in India" against outsider use regarding unique products and ventures. In characterizing a "notable imprint," Section 2(1) (zg) utilizes, to some extent, a language that is intently like that utilized by Section 47 of the TMM Act to lay out the boundaries for protective enrollment of a notable imprint. Segments 11(6), (7), and (9) of the TM Act give certain rules to the Registrar of Trade Marks for choosing whether or not an imprint is notable.

In any case, while Section 11(2) of the TM Act, managing relative grounds of refusal of trademark enlistment, gives that a trademark that is indistinguishable or like a "notable imprint" can't be enrolled for unique merchandise or administrations, its partner under Section 29(4), managing trademark encroachment, doesn't refer "notable imprints" and simply alludes to an imprint having " notoriety in India."

Certain cases are evolving under these Sections-

- **The Ford Case¹¹**

This case went ahead intrigued before the Division Bench of the High Court of Delhi from a request for the Single Judge allowing the respondents' movement to excuse the offended party's protest. The litigants documented their movement on a few grounds, asserting entomb alia that the respondents were not dependent upon the ward of the High Court of Delhi, that there was no encroachment and that the offended party's grievance didn't express a case for which help could

11(9) – The Registrar shall not require as a condition, for determining whether a trade mark is a well-known trade mark, any of the following, namely:-

- (i) that the trade mark has been used in India;
- (ii) that the trade mark has been registered;
- (iii) That the application for registration of the trade mark has been filed in India;
- (iv) That the trade mark— a. Is well known in; or b. has been registered in; or c. In respect of which an application for registration has been filed in, any jurisdiction other than India; or
- (v) that the trade mark is well-known to the public at large in India

¹⁰ Section 29 – Infringement of registered trade marks

29(4) – A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which –

- (a) is identical with or similar to the registered trade mark; and
- (b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and
- (c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

¹¹ Ford Motor Co. & Anr. v. Mrs. C R Borman & Anr. [2008 (2) CTMR 474 (Delhi) (DB)].

be allowed. The request for the Single Judge contained perceptions about the value of the offended party's case under Section 29(4) of the TM Act such that the very reason for a solitary class trademark enrollment was to save the open door for enrollment in different classes. Further, the Single Judge held that if the governing body expected that once a trademark was enrolled distinctly in one class of products, a similar trademark couldn't be utilized by some other individual for some other class, at that point there would have been no characterization of merchandise under the TM Act.

- **The Raymond Case¹²**

This case went up to the Supreme Court of India, the discoveries relating to Section 29(4) of the TM Act that merit conversation is found in the request for the Division Bench of the High Court of Bombay, which will be inspected here. The offended party's imprint RAYMOND is a well known Indian brand of men's proper wear, both for instant suits and suit textures. The offended party's grumbling under the watchful eye of the Single Judge and on a claim before the Division Bench was that the litigant, a pharmaceutical organization, utilized the offended party's enrolled trademark RAYMOND as a component of the respondent's corporate name, supposedly adding up to encroachment under Section 29(4).

While dismissing the offended party's case, the Single Judge held that the utilization of the imprint RAYMOND by the respondent showed up very fitting for an organization that fabricated therapeutic items and that it was incomprehensible how the litigant, by utilizing this imprint in its corporate name, could exploit [the third condition under Subsection (4) of Section 29 of the TM Act] the offended party's imprint, which was utilized for completely various items. It further held that from the purchaser's point of view, there could be no relationship between the gatherings' separate items because the two imprints were accessible through various exchange channels.

The impact of the Division Bench choice in Raymond is that, in a circumstance where an enrolled notable imprint is received as an exchange name or a corporate name by a litigant regarding disparate products, an offended party would not have the option to depend on the more extensive security offered under Section 29(4), which ensures notable detriments for use on different merchandise. Or maybe, such an offended party would need to depend on the smaller insurance

¹² Raymond Ltd. v. Raymond Pharmaceuticals Private Ltd. [2010 (44) PTC 25 (Bom.) (DB)]

offered under Section 29(5). Further, Section 11(2), which manages the relative grounds of refusal of enrollment, gives that a trademark that is indistinguishable or like a "notable imprint" can't be enlisted for different merchandise or administrations, while its partner under Subsection (4) of Section 29, managing encroachment, doesn't allude to "notable" marks.

A Bewildered way to Serenity?

At the point when an imprint is perceived as a notable imprint, the scope of assurance is expansive, reaching out to different merchandise and enterprises. Subsequently, such assurance frequently offers to ascend to the analysis that the proprietors of notable imprints are procuring where they have not planted. Without the help of a lot of target boundaries, it would, hence, be self-assertive or difficult to decide that a specific imprint is a notable imprint. Indeed, even with a lot of settled boundaries for notable denotes, the courts may need to consider other considerations to arrive at a choice, and the necessity that every individual case ought to be decided about dependent on its realities is specified even in the WIPO Joint Goals on notable imprints referenced previously.¹³

Preceding 2003, courts managing going off activities concerning notable imprints depended on disarray and trickiness (with some outstanding exceptions¹⁴) to discover weakening. With the codification of the law overseeing notable imprints into the TM Act, Indian case law went in a different direction.

Up to that point, the standards of going off were applied in these cases for deciding the privileges of the gatherings. Besides brief references to the mischief that could be caused to an imprint's notoriety, in the majority of the cases chose under the old law, overwhelming dependence was set on a respondent's distortion and the following disarray and double-dealing.

Segment 11 of the TM Act manages relative grounds of refusal of an imprint. Subsections (6), (7), and (9) thereof give rules to the Registrar of Trade Marks for choosing whether or not an imprint

¹³ Article 2(1) (c) of the Resolution reads as follows:

2(1) (c) —The above factors, which are guidelines to assist the competent authority to determine whether the mark is a well-known mark, are not pre-conditions for reaching that determination. Rather, the determination in each case will depend upon the particular circumstances of that case. In some cases all of the factors may be relevant. In other cases some of the factors may be relevant. In still other cases none of the factors may be relevant, and the decision may be based on additional factors that are not listed in sub-paragraph (b), above. Such additional factors may be relevant, alone, or in combination with one or more of the factors listed in subparagraph (b), above.

¹⁴ The Mercedes Benz case decided by the High Court of Delhi (Daimler Benz Aktiegessellschaft & Anr. v. Hybo Hindustan [AIR 1994 Del. 239]).

is a notable imprint. Under Section 11(10), while considering an application for enrollment of a trademark and a resistance documented against it, the Registrar may secure a notable detriment for indistinguishable or comparable trademarks and over any dishonesty, either concerning the candidate or on that of the adversary, influencing the rights in the trademark.¹⁵ Section 29(4) of the TM Act, managing encroachment of an imprint by use regarding different products, in any case, utilizes the articulation "enrolled exchange mark has notoriety in India" to allude (maybe) to a notable imprint.

Further, without an unmistakable definition for notable checks under the TM Act, the areas managing implementation in a perfect world ought to have comparable rules for deciding if a given imprint is a notable imprint. Without such rules for implementation procedures, the extent of assurance stood to notable stamps under the TM Act could be antagonistically influenced. Without legal explanation or authoritative change to carry consistency to the language of Sections 11 and 29(4), notable imprints could get diverse treatment by the Registrar and the courts.

Taking into account that these issues are now being brought under the watchful eye of courts up in other jurisdictions,¹⁶ whose pertinent laws additionally utilize different articulations, it is just a short time before such issues are returned to under the steady gaze of the Indian courts.

¹⁵ Under Article 3(2) of the WIPO Resolution, bad faith is an important element for determining the conflicting interests of parties involved in a proceeding. The article reads: "3(2) [Consideration of Bad Faith] Bad faith may be considered as one factor among others in assessing competing interests in applying Part II of these provisions."

¹⁶ General Motors Corp. v. Yplon SA, Case C-375/97 (ECJ). General Motors Corporation, the owner of the Benelux mark CHEVY for motor vehicles, claimed that the use of the mark CHEVY by Yplon on detergents and cleaning products amounted to dilution of its trademark. The European Court of Justice was essentially asked to explain the meaning of the expression "has a reputation" used in Article 5(2) of the European Directive 89/104. Article 5(2) reads as follows:

5(2)—Any Member State may also provide that the proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with, or similar to, the trade mark in relation to goods or services which are not similar to those for which the trade mark is registered, where the latter has a reputation in the Member State and where use of that sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

The only reference to well-known marks in the directive is in Article 4(2)(d) (in the context of defining an "earlier trade mark") to mean a well known mark as used in Article 6bis of the Paris Convention. General Motors contended that in order to have a reputation within the meaning of Article 5(2) of the Directive, the earlier mark must be known by the public concerned, but not to the extent of being "well-known" within the meaning of Article 6bis of the Paris Convention. It was argued by the Belgian Government that a "trade mark having a reputation" should be construed flexibly and that there is a difference of degree between a mark with a reputation and a well-known mark; and that the degree to which a trade mark is well known cannot be evaluated in the abstract by setting a percentage. The ECJ held that Article 5(2) must be interpreted as meaning that, in order to enjoy protection extending to dissimilar goods or services, a registered trademark must be known by a significant part of the public concerned by the products or services which it covered.

Conclusion

Today, notable trademarks appreciate extraordinary insurance under the law due to their 'image esteem.' Over the years, the law has changed so much that a trademark proprietor can restrict a misleadingly comparative trademark even at the phase of last's enrollment. With the headway in innovation and advancing methods of correspondence, the entrance to data has gotten simple for trademark clients and law, and in this manner, anticipates that them should be 'sensibly very much aware' of other trademarks before going for the enlistment of their imprints.

