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WHITE BLACK LEGAL is an open access, peer-reviewed and refereed journal provided dedicated to express views on topical legal issues, thereby generating a cross current of ideas on emerging matters. This platform shall also ignite the initiative and desire of young law students to contribute in the field of law. The erudite response of legal luminaries shall be solicited to enable readers to explore challenges that lie before law makers, lawyers and the society at large, in the event of the ever changing social, economic and technological scenario.

With this thought, we hereby present to you

WELL-KNOWN TRADEMARKS ITS PROTECTION **UNDER TRADEMARK LAW**

AUTHORED BY - DHRUV SAXENA

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INTRODUCTION

Historically, trademarks have fulfilled two primary functions: to indicate the origin of a product's commercial manufacturing and to provide confidence to purchasers and other relevant stakeholders regarding the product's excellence. In order to contend on an international platform, a performer must possess a unique commercial persona, and trademark exclusive rights are an essential component of that. It is essential, according to Nordberg, to distinguish between brands and trademarks and to recognize their mutually advantageous relationship.¹ As it encompasses the more comprehensive concept of a trademark, the term "well-known mark" is more suitable for discussing the associations that a trademark establishes, including reputation, image, and benevolence. Customers, investors, employees, and anyone else with whom a business may develop enduring relationships are drawn to recognizable brands. According to Petrusson, widely recognized marks are intellectual phenomena that represent the capacity of a company to deliver value to its stakeholders, including customers.² Contemporary businesses are placing a growing economic value on renowned trademarks. They are essentially the carriers of the organization's capital between different locations. Sophisticated trademarks require robust legal safeguards due to the substantial financial investments and operational efforts that contribute to their value. An imperative exists to acknowledge the evolution or historical lineage of renowned trademarks in light of their growing prominence in contemporary society.

¹ interview with Karin Nordborg, goodwill protection for well-known trademarks April 23.2019.
https://gupea.ub.gu.se/bitstream/2077/22651/1/gupea.visited_on (29.2.23)

² Petrusson Ulf, Intellectual Property and Entrepreneurship, (New York University Press), 4th edn, New York,2003)

The Source of Well-Known Trademarks.

Numerous well-known trademarks in use today originated with the WIPO proposal, the Paris Convention, or the TRIPS Agreement. The subsequent paragraphs will elaborate on the aforementioned turning points in the evolution of well-known trademarks:

Convention of Paris

On the subject of industrial property, no agreement is older or more comprehensive than the Paris Convention, which was signed on March 20, 1883, and formally implemented on July 7, 1884. Protection for trademarks was instituted in 1883 with the ratification of Article 6. This provision granted EU member states the authority to deny or revoke registrations, in addition to prohibiting the use of potentially misleading trademarks.

IPR Protections Under the TRIPS Agreement and Related Safeguards in International Trade Consistent protection for renowned trademarks is required under Article 6 of the Paris Convention. Articles 16.2 and 16.3 of the TRIPS Agreement have been revised to expand its scope.

As specified in Section 16, Article 6 of the Paris Show (1967) is applicable to services, albeit with specific modifications. While the Member's familiarity with a mark is significant, any endorsement the Member may have obtained due to the mark's public exposure is also pertinent.³

Article 6 pertains to services and products that are not identical, while Article 6bis specifies which services and products fall under its jurisdiction. The Paris Convention and the TRIPS Agreement are two instances that illustrate the evolution of our understanding of what constitutes a well-known trademark. Incorporating criteria for gauging the notoriety of trademarks into the TRIPS Agreement increased public awareness of well-known marks. Due to the absence of a standardized definition of "well-known mark," this matter was left to the discretion of the laws of each country under both accords.

A 2005 court decision established the "famous mark exception" as the legal basis for recognizing

³ Article 16.2 of the Agreement on Trade-Related Elements of Intellectual Property Rights

well-known marks in the United States.

WIPO is the World Intellectual Property Organization.

The World Intellectual Property Organization (WIPO) gathered a panel of experts on well-known brand names for its first, second, and third sessions in order to discuss the most effective strategies for safeguarding these trademarks. The World Intellectual Property Organization and the Paris Union for the Protection of Industrial Property convened for a second time on June 7, 1923, with the intention of deliberating on trademark legislation and potentially formulating new standards.

Priority is given in India to safeguarding a well-known brand over a generic trademark. **In the legal matter of Daimler Benz Aktiengesellschaft v. Hybo Hindustan⁴**, Mercedes-Benz petitioned the court to forbid the defendant from employing the corporation's "Benz" and "triangular star within a circle" insignia. This defense was previously established in the common law case of passing off³⁴. As a result of the defendant's apparel sales involving these renowned trademarks, the court issued an injunction against the enterprise.

Likewise, considering **N R Dongree v. Whirlpool Co.**⁵ & Anr Undoubtedly, the plaintiff's "Whirlpool" brand enjoyed widespread recognition internationally; in fact, the US embassy in India showcased the company's washing machines in public, and the plaintiff's name appeared frequently in international publications that were also widely circulated in India. This complaint was prompted by the defendants' distribution of washing machines bearing the plaintiff's trademark. The defendants were issued a prohibition from utilising the plaintiff's trademark due to the plaintiff's "international reputation," as stated by the Indian court.

Despite substantial advancements in the field of internationally recognized trademarks, neither accord provided a precise definition of the term, permitting its meaning to be shaped by the customary legislation of different nations.

India endorsed an additional Exchange Imprints Act in 1999, which subsequently became effective

⁴ AIR 1994Del239

⁵ (1996) 5 SCC 514

in the same year.

Significant statutory revisions pertaining to established brands were implemented in India in 2003. These revisions introduced various legal adjustments, including the provision of protection for renowned trademarks, irrespective of their formal registration status or domestic usage. Owners of registered trademarks were additionally granted preferential treatment. India ratified TRIPS in 1999 as a means of protecting intellectual property subsequent to its accession to the World Trade Organization (WTO) in 1995.

Factors determining well-known status

Act on Indian Trademarks. The Act grants the Registrar broad discretion in regard to the registration and protection of any widely recognized trademark. The Act is designed to furnish the Registrar with adequate direction regarding the "subjects he ought to consider relevant" or which may be subject to investigation. He must conduct an investigation into the following matters: Does a considerable proportion of the populace possess knowledge of this trademark?

- Consideration was given to both the time period and location during which it was utilized by the members of that specific subset.
- The degree to which companies have promoted and advertised the use of the aforementioned brand.
- The extent to which the proprietor's products are distributed and advertised at each trade show where the aforementioned brand is present.
- The Trademark Act lists, among other things, the products and services that are permissible for trademark use, as well as the jurisdictions in which such use is permitted. ; Any legal claim supported by a final judgment in a lawsuit pertaining to trademarks. The esteem and veneration accorded to a particularly renowned brand name by a court or recorder.
- The Act offers comprehensive instructions on assessing the level of public awareness and comprehension regarding a trademark..⁶

⁶ Trademarks (act 47 of 1999) Section 11(7).

The following considerations and requirements need to be paid close attention to:

1. The number of consumers who actually utilize the product or service in question within the relevant territory.⁷
2. Number of people engaged with the dispersion of the item or administration, whether or not the brand name is attached to the item or administration.
3. Third, the scope and scale of the company behind the production of the trademarked products or provision of the trademarked services⁸ is linked, and how many people or buyers it reaches.

The validity and registration of a trademark are discussed in subsection (v) of section 11(6). It discusses the various legal options available for contesting the validity of a trademark. In this process, the registrar's decision is crucial. In order to achieve global court recognition for your trademark, you must determine whether other organizations or tribunals in other nations have regarded it as renowned. "Other Authorities" refers to any authority other than the Indian Registrar and Indian tribunals for the purposes of this article.

These are not the only criteria that influence the level of recognition a trademark receives. Determining whether a trademark has attained the requisite degree of notoriety to be deemed renowned is a matter of fact. Particular attention is paid to the particular facts and conditions of each case. Additional factors, including those that vary across industries, are duly considered.

In conjunction with Sections 2(1)(zg), 9(1) Proviso, 11(2) regarding opposition, Sections 9(2)(a), 11(1) and (3), Explanation (b) in Section 29(4), Sections 11(6) to 11(9), 11(11), Section 29(4), and all other provisions contained in Sections 29 and 33, the Trademark Act of 1999 establishes the legal framework for well-known trademarks. It is crucial to bear in mind that a renowned trademark is entitled to the same protections as an ordinary trademark, in addition to the common law protections provided by a passing-off action.

Trademarks that enjoy widespread recognition in India are safeguarded by legislation including sections 11(a), 27(2), and 32 of the Trade and Mercantile Mark Act of 1958 and sections 11(2), 11(3),

⁷ <https://www.google.com/amp/s/indiancaselaws.wordpress.com//a-guide-to-well-known-trademarks/amp/> to read Ankit Rastogi's extensive reference to Famous Trademarks. (visited on 22.2.24).

⁸ World Intellectual Property Organization, Joint Recommendation for Protecting the Rights of Registered Trademarks. (WIPO, Geneva 2000)

27, and 29(2) of the Trademark Act of 1999. It is noteworthy to mention that a mere conflict with a reputable brand in India does not suffice as a sole reason to revoke a trademark registration in accordance with this legislation.

Advantages of Well-known Trademark Status

Registrars will likely deny your application if the proposed trademark is excessively similar to an existing, widely recognized mark. The protection afforded to a trademarked company name is applicable in all markets where the product is sold. Infringement of a trademark may occur through the use of a trade name that is confusingly similar, irrespective of the defendant's products having no connection to the renowned brand. Therefore, firms gain numerous benefits from their notoriety, which also generates new promotional prospects.

regardless of its registration status or usage in India; this is advantageous for multinational corporations in safeguarding their entire brand portfolios. The general statute of limitations gives revocation authority to any trademark that has not been duly registered within a period of five years. The proprietor of a widely recognized trademark would gain an advantage from this regulation as it would reduce the cost of legal challenges.

Through passing off and infringement, the litigation will also assist the owner of the renowned trademark in constructing a prima facie case, thereby transferring the burden of proof to the party being pursued for registration.

The Influence of Established Trademarks on Pre-Registered Marks With the increasing recognition of the significance of trademark protection by companies in India, the Indian Trademark Registry is poised to expand its current database of renowned trademarks. There have been 137 trademark applications submitted to the Trademarks Registry.⁹

Gillette U.K. Ltd., based in England, holds the prestigious trademark "7 O' CLOCK" which is associated with their razors. In 1998 PTC 288 DB, the Bombay High Court granted recognition to

⁹ " Well-Known Trademark list Intellectual Property India//ipindiaonline.gov.in/tmrpublicsearch/well - known-trademarks-updated.pdf, (visited on February 23, 2024)

this trademark, thereby consolidating the brand's status as a widely recognized and recognizable name. In contrast to conventional trademarks, protection for the prestige and reputation of well-known marks extends across categories and the entire country.

The Trade Mark Registry will not grant approval or registration to a trademark that is excessively similar to an already registered mark. The primary objective of the Indian Trademarks Rules is to mitigate consumer confusion regarding trademarks through the evaluation of oppositions and trademark registration applications submitted in support of said applications.

Methods for Filing a Prominent Trademark

The High Court of Delhi or the Supreme Court of India may determine whether a particular brand name is "well-known" in India. Since the publication of the Trademark Rules of 2017, significant progress has been made. Individuals may register for a trademark in accordance with Rule 124 of the Trademark Rules, 2017 by submitting a duly completed Form TM-M along with the mandatory supporting materials. In addition to the required application fees, the petition should include a rationale for the trademark's "well-known" status. In India, renowned trademarks can qualify for registration and protection despite their lack of active usage. This holds true in all geographic regions, product categories, and industries. This creates a significant motivation for multinational corporations (MNCs) to pursue comprehensive trademark protection in India.

Choice of a trademark

To establish consumer recognition for your trademark, you must devise an idea that is inherently distinctive. Furthermore, it is critical to ascertain an individual's social category. At the present time, 45 distinct "categories" of goods and services are eligible to employ a trademark. The numerical values from 1 to 34 correspond to merchandise categories, while the values from 35 to 45 represent service sectors.

Utilize Mark Search

It is essential, once a mark has been selected, to search a database to determine whether similar markings are already in use. To conduct independent investigation in this domain, please visit the website of the Controller General of Patents, Designs, and **Trademarks**.

It is possible to concurrently submit multiple applications for a trademark, including applications for a class, series, or collective mark. In order to complete this procedure, one must fill out a TM-A form. This application for registration encompasses a vast array of potential trademark classes. In Indian currency, the submission charge for this form varies between 9,000 and 10,000 INR.

This category comprises all entities besides individuals, microbusinesses, and sole proprietorships. The application fee is Rs. 9,000 if submitted electronically and Rs. 10,000 if submitted in person at the Office of Trademarks. Additionally, paper submission for Rs. 5,000 and internet submission for Rs. 4,500 are both viable options for payment.

Prior to submitting the form, it is critical to verify it for typos and grammatical errors; failure to do so may result in application processing delays or rejection. Submit the application along with a 9-by-5-centimeter image showcasing your brand. Doubling the original papers is mandatory; two duplicates of the complete document are also required.

Through a designated agent, electronically, or in person, the application may be submitted.

Upon electronic submission of your documents, you will promptly receive a confirmation of receipt. Consider that there could be a two-week delay if you choose to submit your application via electronic channels.

Doctrine of Territoriality and Universality

The purpose of the Indian Trademarks Act is to protect well-known trademarks within the nation. According to the Trade Marks Act of 1999, when a trademark is commonly linked with an unrelated assortment of goods or services, consumers may be tempted to associate its use with inconsequential labor and products. Nevertheless, judicial viewpoints regarding the transnational reputation of renowned trademarks have developed over time.

The territoriality hypothesis posits that enforcement of intellectual property rights is limited to the boundaries of the nation that initially granted such rights. This viewpoint holds that a product or service is only renowned in the region where the trademark gained widespread recognition first. The

precedent-setting Indian case **Jones Investment Co. vs. Vishnupriya Hosiery Mills** was the first to define this rule.¹⁰

Universality Doctrine

A trademark attains global legitimacy upon undergoing registration or recognition in a single country. By bolstering reputation on a global scale, this concept provides an exemption to the territoriality argument. The level of recognition that a trademark receives in the United States does not necessarily ensure that it will attain the same status in India or any other jurisdiction where the aforementioned goods and services are commercially available. After careful deliberation, the Supreme Court arrived at a unanimous verdict in the case of *Milmet Oftho Industries & Ors. v. Allergan Inc.* The value of the Respondents' initial utilization of the mark beyond the borders of India is deemed inconsequential by the tribunals of honor. The conventional wisdom holds that in order to effectively establish its brand among consumers in a particular industry, a company must first establish a strong reputation in that sector. The Supreme Court of the United Kingdom ruled in *Starbucks v. Such was English like. Broadcasting via Sky British Sky* could not be sued by Starbucks for misrepresenting its services, as the company had no customers or commercial connections in the United Kingdom.

It is of the utmost importance to disclose a company's global prominence. A scenario akin to the one encountered by the Supreme Court of India was illustrated in the *Toyota Jidosha Kabushiki Kaisha v. M/s Prius Auto Industries Limited* case. A recent pivotal ruling emphasized the significance of ascertaining whether the party initiating the passing-off lawsuit has established a nationwide goodwill associated with the mark in question. Following an examination of cases involving cross-border renown in Australia and the United Kingdom, the Indian Supreme Court determined that it adheres to the territoriality principle rather than the universality method. Despite the recognition of international reputations under Indian law, the burden of proof regarding the existence of said reputation rests with the individual asserting it. Reputation management for a business includes activities such as endorsing the brand and its products in a particular market. The measure of public recognition and the elements that contribute to the ascent to prominence of a trademark constitute its reputation. Products are now available in every region of the world as a result of the expanding globalization of commerce.

¹⁰ WP No. 3851 of 2015.

Following an examination of international reputation cases involving the United Kingdom and Australia, the highest court of India has decided to adhere to the territoriality principle as opposed to the universality principle. In Indian law, while the concept of cross-border reputation is acknowledged, the party asserting the reputation bears the burden of proof, not the reverse. The reputation of a company can propagate across an entire nation through various means, including advertisements, the internet, and other extensive dissemination of information regarding the brand and its products to the general public. The measure of public recognition and the elements that contribute to the ascent to prominence of a trademark constitute its reputation. In light of the expanding phenomenon of global trade. A pivotal legal case in the development of intellectual property legislation in India is the M/s Prius Auto Industries Limited vs. Jidosha Kabushiki Kaisha case.

The antecedent argues that the Territoriality theory is more significant than the concept of universality.

A Review of Trademark Protection Rules in India

In the realm of trademark legislation in India, the Trade and Merchandise Marks Act of 1958 was superseded by the Trademarks Act of 1999. Procedures for formally registering and defending well-known trademarks, as well as initiating legal actions against the unauthorized use of said names, are outlined in Section 47 of the Trade and Merchandise Act. These restrictions persisted until the enactment of the Trademarks Act in 2003. A trademark may qualify for registration and protection under the Trade and Merchandise Regulation. The Marks Act applies when the designation contained in the trademark has become so widely recognized in connection with the products for which it is registered and used, that using it with other products would logically imply a business relationship with the products for which it is registered and used. Notwithstanding any assertions made in Section 46 to the contrary, the trademark may be formally registered in the original owner's name for the substitute products through the prescribed application procedure, notwithstanding the original owner's lack of intention to utilize the brand with the substitute goods. In accordance with the provisions of that section, it will be exempt from disqualification in the registration for those specific items so long as it remains registered. Regarding Section 47(1), Defensive registration of a well-known trademark is contingent on whether or not consumers would infer liability for those items from the owner's use of the trademark in connection with products other than those for which it is registered or in use. In other words, under this regulation, the likelihood of fraud was the determining factor in a determination regarding the registration of a widely recognized mark. Numerous trademark

owners exploit this vulnerability by submitting applications for brand registration in specialized niches.

In passing-off cases, Indian courts have upheld the rights of trademark owners of well-known marks even in the absence of formal protective registration. These precedents, which represent pivotal moments in the evolution of Indian legislation concerning renowned trademarks, have their origins in the Trade and Merchandise Marks Act. They laid the groundwork for regulations that were subsequently incorporated into the Trademarks Act. Primarily, the possibility of consumer confusion governed the determination of whether a well-known mark could be registered in accordance with this provision. In certain instances, Indian courts have acknowledged the legitimacy of unregistered trademarks as a safeguard for renowned corporations.

Under the Trademarks act, 1999

In September 2003, with the passage of the Trade Brands Act, trademark protection in India assumed a new complexion. The criteria outlined in the Trade Marks Act of 1999 are utilized to ascertain whether a particular mark qualifies as a renowned trademark.

1. A trademark application may be denied registration in accordance with Section 9 if it lacks adequate uniqueness or primarily comprises symbols that are already utilized in commerce to denote attributes such as quality, origin, and so forth. However, registration of a trademark cannot be denied if evidence of its notoriety is presented during the application process, as specified in this subsection.
2. In determining whether a trademark has acquired distinctiveness pursuant to Section 11(6), the registrar may, among other factors, consider the extent of usage of the trademark.
3. As stipulated in Section 11(7), the Registrar is obligated to take into account the magnitude of the potential customer or participant base within the distribution network in order to determine whether a trademark possesses the significance to a substantial proportion of the general population, as mandated by Section 11(6).
4. A trademark may be registered in India pursuant to Section 11(8) if a court or the Registrar determines that a significant portion of the Indian population is familiar with the mark.
5. To determine whether a mark is notable, Section 11(9) does not require that it be widely used in India, renowned in India, or recognized by a significant portion of the Indian

population.

6. Section 11(10) requires the Registrar to maintain the integrity of a well-known trademark in this manner. It is the responsibility of the Registrar to examine applications for trademark registration and objections thereto in order to prevent the registration of marks that may cause confusion among consumers.
7. In accordance with Section 11 of the Trademarks Act of 1999, trademark examiners are obligated to consider the level of awareness that a purportedly widely recognized mark possesses among the pertinent demographic as substantiation for the awareness acquired through trademark promotion.

The case under consideration is Warner Bros. Entertainment, Inc. and Others v. Harvinder Kohli and Others. ¹¹

In accordance with the court's reasoning in the preceding case, the Harry Potter films were produced to satisfy the particular desires of a limited audience. Consequently, it was determined that the likelihood of confusion between the two titles was minimal. With the capacity of such a sizable audience, one can discern between a film predicated on the Harry Potter novels and one centered on Punjabi humor. They were unable to progress to the legitimate Harry Potter novels and films, despite having viewed "Harry Puttar." In court, the verdicts of **Alex Jewellery Pvt. Ltd. and Rolex SA. were remarkably similar.** ¹² A complaint has been filed against the proprietor of the globally renowned ROLEX watch brand, who is the complainant. It was a component of the defendants' enterprise to distribute counterfeit 'ROLEX' timepieces. A well-established trademark, according to the Delhi High Court, is one that has attained such widespread recognition among a significant portion of the target market that it reasonably encourages the public to associate commercial connections with the entity employing the trademark and the products in question. Therefore, individuals who purchase timepieces bearing the 'ROLEX' brand at a specific price range are also apt to associate the plaintiff with such jewelry.

¹¹ Mondaq, "Comprehensive Insights into 'Famous Trademarks'," <https://www.mondaq.com/india/trademark/808148/in-depth-examination-of-famous-trademarks> (visited on February 23, 2024).

¹² 1998 PTC 698 (Del)

Under the Trademarks Rules, 2017.

Prior to the Trade Marks Rules of 2017, the sole method for determining whether a mark was well-known during opposition, rectification, or infringement actions was to examine whether the registrar or the courts declared it so. For Indian enterprises striving to establish recognition for their renowned trademarks, this presented a significant barrier. In response to this issue, Rule 124 of the Trade Marks Rules of 2017 was implemented in India as a significant new regulation. It established novel standards for identifying renowned insignia.

These recommendations offer proprietors of trademarks an avenue to obtain widespread recognition for their marks without resorting to litigation. The regulation stipulates that in accordance with entry 18 of Schedule 1, trademarks may be registered with the Registrar as well-known marks, accompanied by the required supporting documentation and a payment of INR 1 lakh. In order to be featured in a book or magazine, a trademark must possess the "well-known mark" designation.

The trademarks regulations of 2017 ought to be consistent with the more comprehensive trademarks act of 1999, given their subordinate status. However, controversy erupted when these modifications were ultimately put into effect.

The Trademarks Act of 1999 prohibits the federal government from establishing a novel registration process for well-known trademarks. In addition, with regard to widely recognized trademarks, the Trade Marks Act of 1999 (the Act) merely provides for the possibility of federal legislation concerning "any other matter necessitating attention or as directed by the government," with no explicit mention of the aforementioned.

Nevertheless, the novel Rule-124 introduces a novel and consensus-building approach to the registration of widely recognized trademarks. In contrast to Section 11 of the 1999 trademark legislation, which prescribes an adversarial process for registering well-known trademarks, this innovative approach is cooperative. In contrast to Section-11, which mandates an objection, infringement, or correction process prior to determining the validity of a well-known trademark, Rule-124 simplifies the registration process for such marks by merely submitting them to the registrar.

This new legislation confers additional authority upon the Trademarks Registry, notwithstanding the recent exposure of its corrupt practices through the apprehension of ND Kasturi, an enlistment center. The possibility of recorder error in the registration of significant imprints is increased by the new regulation, which allows registrants to remove marks that were inadvertently included in the register. The introduction of the 2017 Brand Names Rule represents a significant achievement in the ongoing process of revising the Brand Names Enrollment framework. Furthermore, it encompasses the Indian government's commitment to intellectual property (IP) protection and the strengthening of IP regulations in India to ensure greater stringency and comprehensiveness. The purpose of the Brand Names Rules, 2017 is to facilitate the modernization and development of the brand name registration process in India.

Judicial interpretation of well-known trademarks.

A new Trademarks Act was enacted in India in 1999 and commenced enforcement on September 15, 2003. Proposed modifications were introduced to the legislation to incorporate the legitimate safeguarding of renowned trademarks, which had hitherto been protected under common law. The specific criteria that the registrar is obligated to employ in order to ascertain the notoriety of a mark are exhaustively delineated in sections 11(6) and 11(7) of the Trademarks Act of 1999.

McDonalds Enterprise v. Joburger's Drive Motel establishment and others as a result of ¹³

The criterion for determining whether a mark is "well known" as determined by the South African courts is whether or not a substantial proportion of the intended consumers identify with it. *Rolex Sa. v. Alex Jewellery Pvt. Ltd. & Ors.* The contested provision of the Trademarks Act has been reinstated. The plaintiff, seeking to halt the illicit trade of counterfeit Rolex watches and other products bearing the Rolex trademark, has initiated legal proceedings against the defendant. The court reasoned that the plaintiff's watches might be misidentified as low-quality imitations due to the tendency of people in particular socioeconomic classes to wear timepieces within a particular price range.

The court rendered a partial decision regarding the offended party's brand name, finding it to be a "generally perceived mark" as defined in Section 11(6) of the Brand Names Act on account of its

¹³ (547/1995) [1996] ZASCA 82 (27 August 1996)

extensive usage, lengthy history, and geographical scope. The aggrieved party and degree of topography in *Gillette UK Restricted v. Kamal Exchanging Co.* The plaintiff in *Kamal Exchanging Co. v. Gillette UK Restricted*. The aggrieved party requested an injunction prohibiting the litigants from affixing the 7'O Clock emblem to their toothbrushes. The defendant asserted that their razors and grooming cream, which featured a seven o'clock seal, had earned them an international reputation, and the court agreed. Misrepresentation and confusion of consumers would result from the defendant's use of the plaintiff's trademark. This is illustrated through the *Whirlpool Co. & Others v. NR Dongre* case. The plaintiff was the rightful owner of the trademark Whirlpool, which was initially filed for registration in India in 1977. Regardless, they refrained from recharging the brand moniker. The respondent used this renowned brand of washing machines worldwide. The aggrieved party presented the United States Consulate in India with hardware. Multiple international periodicals that were published in India featured advertisements appearing on behalf of the plaintiffs. According to the court's ruling, significant strengths support the Whirlpool brand's internationally recognized standing.

Problems related to well-known trademarks.

Section 2(1) (zg) of the Trademark Act of 1999 defines the term "well-known mark" with respect to trademark law in India. Particularly applicable and constituting a ground for rejection against the registrability of the trademark are Sections 11(2), (6), (7), and (9) of the Trademark Act 1999; these sections were intended for the well-known mark. Furthermore, this matter is addressed in Section 29 of the Act, which pertains to the violation of trademarks.

The phrase "registered trade mark with a reputation" is employed in Section 29(4), while the term "well-known mark" is absent in Section 11(2). render the legislative objective pertaining to trademark protection subsequent to registration ambiguous. The disparity in wording between the two sections implies that the primary objective of the assembly at the time of registration was to provide protection for established brand names.

There are additional instances in which the rationale for the assembly should be elaborated upon, apart from the omission in Segment 29(4).

The definition of a "notable imprint" in *The Demonstration* is ambiguous; it refers to an imprint that

has gained prominence among a significant portion of the public who purchase such products or receive such services. The courts may grant some discretion in interpreting this. Furthermore, the lack of definition of well-known insignia in the section pertaining to their enforcement obscures the nature of a significant imprint. The lack of regulations in this regard impacts the degree of protection afforded to well-known brands in cases involving trademark infringement.

In Section 29(4), the rights of the parties involved in an adoption in poor faith are not addressed.

In India, registration procedures for renowned marks were implemented in 2017 in compliance with Rule 124 of the Trademark Rules. Trademark infringement cases were formerly the sole source of legal controversy surrounding this regulation. However, that has since changed as the Registrar now possesses the authority to either confirm or refute the claim that a mark is widely recognized. This development shows promise for the protection and recognition of mighty brands and trademarks, but the constitutionality of Rule 124 remains a contentious issue.

The format of segment 157 of the 1999 Exchange Imprints Demonstration of Focal Government's standard-setting capability does not include any mention of well-known brands. The authority to regulate "anything else that is anticipated to be or might be recommended" is delegated to the Focal Government under the catch-all provision referred to as Section 157(xli). However, it is imperative that the provision adheres to the two fundamental principles of regulatory designation: According to Section 157(xli), the Focal Government is empowered to establish regulations on "anything else that is anticipated to be suggested or could be suggested." This provision is a catch-all clause. Nevertheless, the condition must adhere to the two fundamental principles of authoritative delegation: It is not permissible for the provisions of a subordinate law's title to directly intersect with those of the dominant law.

The second point is that Parliament would not tolerate the Executive exercising an additional legislative authority over members of Parliament. Rule 124, which serves as the novel mechanism for distinguishing renowned trademarks under non-contradictory conditions, runs counter to both of these tenets and represents a change in policy.

In situations where multiple entities offer identical products or services using the same trademark,

the "Honest concurrent use" claim will govern those uses. This notion operates in direct opposition to the fundamental principle underlying brand name regulation, which is to ascertain the provenance of products.

Multiple proprietors may register an identical or similar mark under Section 12 for the same or similar goods or services if the Registrar determines that there is bona fide concurrent use or extraordinary circumstances exist. The Registrar possesses the jurisdiction to establish such prerequisites and restrictions. This clause adopts a more flexible approach in lieu of Section 11's broad prohibition on registering comparable marks in order to accommodate such circumstances.

Position in US

Notwithstanding the United States' membership in both the Paris Convention and TRIPs Agreement, Congress has enacted legal measures to enforce these commitments, and the judiciary is divided as to whether or not the provisions of the treaties are automatically applicable. Others will suffer severe harm as a consequence of the application of the Paris Convention's norms to the territoriality principle.

Conversely, some have argued that well-known trademarks of foreign companies in the United States ought to be safeguarded, notwithstanding their lack of registration or usage in the country of origin. The Lanham Act defines the regulation of brand names in the United States. As the term "brand name" encompasses a broad scope, its definition of what could be termed an imprint is remarkably inclusive. As per Segment 1127, any word name image variety constitutes a brand name illustration. The United States permits this arrangement through the Lanham Act of 1946, which prohibits the registration or use of brand names, whether foreign or domestic, that are confusingly similar to well-known brand names associated with the unapproved individuals or their predecessors. [(2a) through (2d), (43(a) through (43(c)), (44(b) through (44(h))]. Trademarks are safeguarded against infringement and registration by a third party in the United States who possesses a comparable mark for the identical or related products and services as the initial one. However, this safeguard does not extend to unregistered prior marks; instead, it is applicable solely in cases where a reasonable likelihood exists that consumers could become confounded.

Section 43(a) of the Lanham Act of 1946 authorizes the owner of a prominent imprint to initiate a claim for brand name encroachment in a court of the United States government. Whether or not this will likely result in disarray ultimately depends on the court's decision. Ensuring defence does not require the registration of a trademark. In contrast, the law provides numerous exhaustive and non-restrictive guidelines for conducting the investigation. The aforementioned elements are among these, along with the following: comparability of by-marks, social distance or association between the specific labour and products, strength of the offended party's imprint (including the degree of business recognition the imprint possesses), advertising channels employed, customers' level of concern when purchasing the products and additional benefits, and so forth.

Prominent trademarks are granted Weakening protection under the Government Brand Name Weakening Demonstration (FTDA), which was amended by the Trademark Weakening Modification Act (TDRA). This provision prevents a similar trademark from tampering with the distinctiveness of the renowned trademark. Dilution can be observed in the form of corrosion, a specific quality that is frequently associated with negative or substandard qualities, or blurring, which refers to the reduction of distinctiveness. While the Anti-cybersquatting Consumer Protection Act (ACPA) provides legal protection for trademark owners against registrants of domain names that unjustly and misleadingly register domain names or exact replicas of their trademarks, it does not provide a remedy for those who violate cyber names.

Common Law safeguards: In the perceptions of consumers, distinctive trademarks may acquire secondary meanings and become associated with specific products or services. Thus, common law may afford protection to such trademarks even in the absence of federal registration. For enhanced safeguards against legal challenges to the validity of the trademark, the license has the potential to transform into an incontestable right following five years of consistent use and compliance with all other stipulations.

Conclusion

The concept of famous trademarks has undergone significant development over the course of its history, starting from its inception in the Paris Convention for the Insurance of Modern Property and continuing through its incorporation into the Exchange-Related Protected Technology Privileges

(Outcomes) arrangement and, most recently, its establishment under the World Patent Organization (WIPO). These developments demonstrate that brands gain greater public support and become more scrutinized.

Predominantly, brand registration and protection are the focal points of brand owners' rights, followed by the prominence of well-known brands. Diverse forward-thinking tranquil accords, such as Excursions and WIPO, have facilitated the necessities for the worldwide security of well-known brands.

The purpose of this analysis is to examine and assess the extent to which India's Indian Exchange Imprint Resolution (which comprises the Exchange and Product Imprints Demonstration of 1958, Exchange Imprints Demonstration of 1999, and Exchange Imprints Rules of 2017) ensures that well-known brands are able to engage in double-dealing activities within the nation.

This segment provides an in-depth analysis of the Indian legal system and legislation pertaining to well-known marks, with an effort to illuminate the strategies employed by the proprietors of such marks to assert their legal rights in India. It demonstrates to established businesses the significance of brand protection and equitable competition, in addition to the advantages for customers. This section serves as an exceptionally enlightening treatise on trademark law and its practical implementation in the registration process of renowned marks in India. It accomplishes this through the use of prominent legal frameworks, challenges, and resolutions.

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