

WELL KNOWN TRADE-MARK PROTECTION IN INDIA: NEED FOR LEGISLATIVE ENACTMENT

Abhishek Chaudhari

PhD. Scholar Guru Gobind Singh Indraprastha University, Dwarka, New Delhi

Abstract: Well known marks have been given special protection under Indian law due to their existing brand value. One of the important characteristics of well known marks to be highlighted is the huge amount of the publicity done, no matter how old the mark has been. The paper highlights the problem of lack of legislative protection for well known trademarks with elaborate study of Intellectual Property Rights Regime for well known marks protection. Without proper legislative action in regard to inconsistencies the provisions dealing with prosecution and enforcement of well known marks is bound to fade and eventually will dilute the protection afforded to well known marks under Trade Marks Act 1999.

I. INTRODUCTION

Intellectual Property (IP) has been traditionally categorized into Industrial property and Copyright. The term Industrial Property includes patents, trademarks, industrial designs, and geographic indications of source. Copyright protection is granted to protect literary, artistic and musical works. Rights related to copyright include those of performing artists in their performances, producers of phonograms in their recordings, and those of broadcasters in their radio and television program. Intellectual property rights are generally said to be a bundle of exclusive rights granted to the lawful owner.

The term intellectual property denotes the specific legal rights, and not the intellectual work itself. It is important to be aware of what these IP rights are, how they can be protected and, in due course, how to benefit from them.

The origin of trademarks¹ can be traced from the beginning of the trade practice. The marks are as old as the histories of mankind and religion. Researcher has come across excavated artifacts from places such as ancient Egypt with various symbols carved thereon for religious and superstitious reasons. "Potters marks" appeared in relics left from the Greek and Roman periods and were used to identify the maker (potter) of a particular vessel). Among those who specialize in researching the cultural heritage of marks, the studies surrounding "potters marks" are famous².

The traditional role of trademarks and trade symbol is to indicate the commercial origin of goods and services it also guarantees consumers and other stakeholders a certain level of quality. In establishing a strong commercial identity, exclusive rights to trademarks and trade symbols has become increasingly important for any actor willing to compete on the global arena.

According to Nordberg³ it is important to understand the difference between trademark and brand but also the symbiotic relationship that exists between them. "Trademark" is the legal term and represents a distinctive mark or symbol to which an owner can obtain an

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

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

³ Interview with Karin Nordborg, available at https://gupea.ub.gu.se/bitstream/2077/22651/1/gupea_2077_22651_1.pdf (last visited January 20, 2018).

exclusive right whereas “well known mark” is a broader term also including associations produced by a trademark, such as goodwill, image and prestige.

Well known mark have the potential of attracting consumers, employees, financiers etc. and could be used to establish long lasting relationships on the market. According to Petrusson⁴ a well known mark can be considered an intellectual phenomenon representing the ability of a specific Firm to enhance value for consumers and other stakeholders. Today, well known marks are increasingly being recognized as valuable asset of firms. They function primarily as communication vehicles and carriers of firms’ collected value. It is important to realize that the value of a well known mark results from large investments and exercises that need solid legal protection. Understanding such importance of well known trademark in present era, there is great need for recognition of evolution or history of development of well known marks. The origin of the well known marks paves the way from Paris convention to TRIPS agreement and finally gets the WIPO recommendation. The above important phases of well known trademark’s development are discussed below:

- ***Paris Convention***

The Paris convention for protection of industrial property is the oldest and multilateral industrial property treaty. It was signed in Paris on 20 March 1883 entered into force from the 7 July 1884. In 1883 the doctrine of well known mark was very first established under the Article *6bis* of Paris convention, which provide for the regime for protection of well known marks as it enacts that the countries of the Union can refuse or cancel the registration and prohibit the use of mark which causes confusion as being reproduction, imitation or translation of well known mark of a particular country. The provision also applies in concern with the mark when essential portion of the mark is reproduction of well known mark. The Paris convention did not specify measures relating to the protection of the well known trademarks or their recognition procedures, thereby providing opportunity to the signatory countries to address these matters according to their wish and the result was that most of the countries do not process application in relation to the recognition of well known trade mark unless until owner of such marks expressly demonstrate the needs for the recognition with most of the countries having no separate independent application procedure for recognition of well known mark.

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

Trade Related Aspects of Intellectual Property Rights (TRIPS agreement) also enforce the protection of well known mark under Article *6bis* of Paris Convention. TRIPs agreement has incorporated Articles 16.2 and 16.3 of the TRIPS agreement. The Articles provide for application of Article *6 bis* in regard to services and application of to goods or services which are not similar to those for which trademark is registered respectively. The concept of well known marks evolved from Paris Convention to TRIPs Agreement. TRIPs Agreement enhanced the understanding of well known marks by providing with the factors to determine the mark as well known which included knowledge of trademark in the relevant sector of the public as well as the knowledge in the member concerned which has been obtained as a result of promotion of the trademark. Further the Paris Convention dealt with the goods alone and provide protection against identical or similar goods only but TRIPs agreement in its ambit includes protection against registered trademarks in relation to both goods and services; also covers dissimilar goods and services to the extent the third party use is found to indicate relation between use of such dissimilar goods and services with the owner of the registered mark, which can most probably harm owner’s interest. Though there has been important enhancement of the aspect of well known trade mark but both the conventions lacked in defining the term well known mark and thus left the definition to be provided by respective national laws of different countries.⁵

⁴Petrusson, Ulf, *Intellectual Property and Entrepreneurship*, 220(2ndedn., 2003).

⁵TRIPs Agreement, art. 16.2.

- ***World Intellectual Property Organization.***

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

The draft the WIPO Committee of Experts on Well-Known Marks has considered Provisions on the Protection of Well-Known Marks at its first session (November 13 to 16, 1995), second session (October 28 to 31, 1996) and third session (October 20 to 23, 1997). The Standing Committee on the Law of Trademarks, Industrial Designs and Geographical Indications (SCT) continued the work at its first session (July 13 to 17, 1998), second session, first part (March 15 to 17, 1999), and at its second session, second part (June 7 to 11, 1999).

The Recommendation is the first implementation of WIPO's policy to adapt to the pace of change in the field of industrial property by considering new options for accelerating the development of international harmonized common principles. The question of new approaches to the progressive development of international intellectual property law was outlined in the WIPO Program and Budget for the biennium 1998-99, which under Main Program 09 states:

“Given the practical imperative for accelerated development and implementation of certain international harmonized common principles and rules in industrial property law, the future strategy for this main program includes consideration of ways to complement the treaty-based approach. If Member States judge it to be in their interests so to proceed, a more flexible approach may be taken towards the harmonization of industrial property principles and rules, and coordination of administration, so that results can be achieved and applied more rapidly, ensuring earlier practical benefits for administrators and users of the industrial property system”.

According to the Indian perspective towards the trademark, achievement of status of well known mark is consider as meeting up with the concept of “Nirvana” that generally refers to a state of pleasure achieved by devoting oneself from external factors like desire, jealousy, hatred, ignorance etc. In the present era concept of well known marks are given broader interpretation and have reached beyond the understanding of traditional concept of Trademarks as traditionally objective of trademark protection is safeguarding of consumers from deceptively similar marks which causes confusion at large scale. Well known marks focuses on protection of distinctive character of a mark in regard to dilution, free- riding and tarnishment. As well known mark goes away from the traditional concept of deception proof of confusion in case of infringement and passing off action becomes secondary in nature.

A Joint Resolution Concerning Provisions on the Protection of Well-Known Marks was adopted by the General Assembly of the World Intellectual Property Organization (WIPO) and the Assembly of the Paris Union in September, 1999 (hereinafter the “WIPO Resolution”)⁷. Factors to determine Marks falling under the category of well known mark have been well listed in WIPO Resolution. Which includes the consideration in regard to level of reputation of the mark, the duration and geographical extent of use, extent of publicity related to the mark, extent of trademark registration at world at large as well as the instances concerning successful enforcement of the mark.

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

⁷ WIPO Document No. SCT/3/8 ‘, WIPO, available at: <http://www.wipo.org>. (last visited on January 22, 2018)

In the case of *JG v. Stanford*⁸ it was for the first time recognized that the term 'well known' in relation to trademark originates from the term 'reputation' and it was held that the law of passing off prevents commercial dishonesty on the part of trades.

When in particular nation statutory provisions are silent as regard to reputation or goodwill in relation to well known trademarks then determination of reputation depends upon usage of particular goods or services in connection with business.

Protection of Well known marks in India is at higher priority level then compared to ordinary trademarks. Initially this protection was given by the action of passing off under the Common Law, like in the case of *Daimler Benz Aktietgesellschaft v. Hybo Hindustan*⁹ the manufacturer of Mercedes Benz sought an injunction against the defendant on the ground of use their famous symbol 'three pointed star in the circle' and the word Benz. The court for using these famous marks for selling apparel granted injunction. Similarly in *Whirlpool Co &Anr v N R Dongre*¹⁰ plaintiffs Whirlpool mark had worldwide reputation and sale of their machines in U.S. embassy in India with large scale advertisement of mark on international magazine that had circulation in India. Defendants started using such mark of plaintiff on their washing machines due to which action was bought against them; the court held that the plaintiff had established a 'transborder reputation' in India and thus defendant were enjoined from using the same trademark for their products.

In relation to the analysis of Transborder Reputation Courts of India in with time has started taking a broader perspective. Like in case of Indian *Shaving Products Ltd v. Gift Pack*¹¹(regarding use of the words 'Duracell-ultra by plaintiffs and 'Ultra' by defendants) and *Allergan Inc v Milmet* of the industries¹²(regarding use of word 'ocuflex' for medicinal preparations) thought the plaintiff did not had any business in India but the trade circles in India were well aware of transborder reputation of the mark. Court undertook this transborder reputation of mark and passed injunction orders against the defendants.

Though there has been important enhancement of the aspect of well known trade mark but both the conventions lacked in defining the term well known mark and thus left the definition to be provided by respective national laws of different countries.

India being a member of World Trade Organization (WTO) since 1995 and thus a signatory to the Trade Related Aspects of Intellectual Property Rights (TRIPS agreement), adopted new Trade Marks Act 1999 which came into force in 2003 further providing for provision relating to well known marks and introducing many statutory changes like protection of well known trademarks even without registration and use in India as well as providing special right to the proprietor of well known trademarks to institute opposition proceeding at the stage of registration on the ground of mark being a well known trademark.

II. PROBLEMS RELATED TO WELL KNOWN PROTECTION IN INDIA

In India, section 2(1)(zg) of Trademark Act 1999 provides the definition of well known mark. Section 11(2), (6), (7) & (9) Of the Trademark Act 1999 very specifically deal with the understanding of well known marks and form relative ground of refusal of trade mark registration. On the other hand Section 29 of the Act which deals with the infringement of the registered trade mark does not mention in its any clause the specific expression 'well known mark' and has only used under its clause 4 the expression as 'registered trade mark, that has a reputation'. This makes it very confusing to find out the real intention of the legislature in regard to protection of well known mark after registration. Which certainly represents that the legislature had intention to protect the well known mark at the stage of registration only if not so why discrepancy in respective language used in Section 11 (2) and 29 (4) of the Act has been made.

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

⁹*Daimler Benz Aktietgesellschaft v. HyboHindustan* AIR 1994(Del)239

¹⁰*Whirlpool Co &Anrv.N R Dongre* PTC1998(Del) 698.

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

¹²*Allergan Inc v.Milmet oftho industries* 1998 CAL 26.

Other than the lacuna in Section 29 (4) other matters that need consideration and clarification by the legislature are as follows:

1. The definition of well known mark provided in the Act gives no parameter to determine whether a mark is well known mark or not rather it uses ambiguous language by reading as “a mark which has become so to the substantial segment of the public which uses such goods or receives such services” are left open for the interpretation by the courts.
2. In the absence of such clear definition of well known mark, the section dealing with enforcement of such well known mark also lack clarity in determining whether a mark is well known mark. Thus in absence of such proper guidelines regarding well known marks for enforcement proceedings, the scope of protection afforded to well known marks are adversely affected.
3. Section 29 (4) does not make any reference to bad faith adoption in deciding rights of the parties.

Now in India new rules regarding registration of well known mark has been introduced in 2017 Rule 124 of Trademark Rules 2017. Provides determination of well known mark by Registrar, until now the well known mark can be recognised through a trademark infringement dispute in court, But now trademark owner can make an application to the registrar for the determining the trademark as for well known mark. The introduction of the present rule is considered to be the significant development in regard to the recognition of well known trade marks and their protection but the major challenge which remains open for consideration is the Constitutional Validity of the Rule 124 of Trademark Rules, 2017. Rules, which are delegated legislation, draw their legitimacy from the parent statute. In this case the Trade Mark Rules, 2017 draw their legitimacy from the Trade Marks Act, 1999. This legislation however does not delegate to the Central Government the power to create an entirely new procedure to recognize well-known trademarks. Section 157 of the Act, which lays out the rule making power of the Central Government under the Trade Marks Act, 1999, is silent on the issue of well known trademarks. There is a residuary provision in Section 157(xli) that gives the Central Government the power to make rules for “any other matter, which is required to be or may be prescribed”. Like all provisions conferring residuary powers, this provision is widely drafted however a residuary provision is still bound by the two most important principles of delegating legislative power: The first principle is that delegated legislation cannot be in conflict with the provisions of the parent legislation. Secondly, an essential legislative function cannot be delegated by Parliament to the Executive.

The new Rule 124, goes against both principles. The rule reflects an entirely new policy to recognize “well-known” trademarks through a procedure that is not an adversarial proceeding.

III. RESEARCH METHODOLOGY

The methodology that is adopted in this study is essentially doctrinal, based on the critical analysis of primary as well as secondary sources. The primary material includes the relevant national legislation and their official and judicial interpretation as contained in the case-laws and administrative decisions. The secondary material includes books research and commentaries published in various journals special attention is made to rely on recent legal developments as far as possible.

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

Before the existence of Trade Marks Act 1999, the statute, which governed trademark in India was Trademark and Merchandise Act 1958. Prior to enforcement of Trade Marks Act in 2003, section 47 of the Trademark and Merchandise Act provided for defensive registration of well known marks as well as passing off actions against unauthorized use of well know trademarks.

Section 47(1) of the act read as:

Where a trade mark consisting of any invented word has become so well-known as respects any goods in relation to which it is registered and has been used, that the use thereof in relation to other goods would be likely to be taken as indicating a connection in the course of trade between those goods and a person entitled to use the trade mark in relation to the first mentioned goods, then, notwithstanding that the proprietor registered in respect of the first-mentioned goods does not use or propose to use the trade mark in relation to those other goods and notwithstanding anything in Section 46, the mark may, on application in the prescribed manner by such proprietor, be registered in his name in respect of those other goods as a defensive trade mark and while so registered, shall not be liable to be taken off the register in respect of those goods under the said section.

Through the reading of the above section it can be easily traced out that likelihood of deception was the deciding factor in determining whether well known mark can get registered under this particular section?

Indian Courts have upheld right in well known trademarks even without any defensive registration through remedy against passing off. Examples of such decisions are the following important cases:

In *Honda Motors co. v. Charanjit Singh*¹³ the Delhi High court had issued permanent injunction in a passing off action against use of the trademark HONDA for pressure cooker which the plaintiff was using in the respect of automobile and power equipments, on the ground that the word HONDA was used since last five decade by the plaintiff and not only had acquired international goodwill and reputation but had also become a household name in India.

Bombay High Court in *Sunder PermananadLalwani v. Caltex India ltd*¹⁴, held valid opposition by Caltex India of the registration of trademark CALTEX for watches. In this case Caltex Ind. Ltd was the proprietor of the trademark Caltex for petrol, Kerosene etc. and the mark was highly popular and enjoyed monopolistic reputation in the market. Lalwani started using CALTEX on watches in the market though the court held Lalwani to be the proprietor of the mark for watches in India it refuse registration because there was likelihood of deception or confusion in the mind of the customer, further Lalwani failed to establish honest selection of trademark for watches.

In *Bata India ltd. V. Deputy Registrar of Trade mark*¹⁵, registration of a trademark containing an “Artistic device with letters BSC” in respect of sewing machine parts was allowed when the appellat- opponent had been using “BATA” as well as “BSC” as combined trademark in respect of footwear. The respondent had adopted BSC in 1975 and built up goodwill and reputation of the mark confine to the state of Punjab. Appeal board said that BSC mark was not been used by the appellant independently the nature of goods were also completely different and therefore there was no question of confusion or deception.

In *CaterpillarInc.v. Jorange*¹⁶, plaintiff was the proprietor of the trademark ‘CATERPILLER’ and ‘CAT’ for heavy machinery, construction and agriculture industry equipment. From year 1996 they sold wide range of garments, sweaters, jackets, sunglasses, sporting goods. The plaintiff had not introduced the trademark in India on garment till then but relied on the transborder reputation emerging from its use of the trademark in other countries. They also claimed that in case of reputed brand names, the confusion could arise when grant was used on different goods. The court restrained the defendant from using ‘CAT’ and ‘CATERPILLER’ trademark. Above sited cases was some of the important judicial precedent which paved the way for well known mark to get codified through Trade Mark Act 1999 which finally came into force from September 2003.

In regard to the recognition of a trademark as a well known trademark section 2(1)(zg) of the TM Act provides for definition of well known mark, it states that ‘well known mark in relation to any goods and services, 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

¹³Honda Motors co. v. Charanjit Singh [2003] 26PTC 1 (Del)

¹⁴ Sunder PermananadLalwani v. Caltex India ltd [1969] 24,36AIR (Bom.)

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

¹⁶In Caterpillar Inc. 100 NE v. Jorange [1999] 570 PTC (Mad).

or services would be likely to be taken as indicating a connection in the course of trade or rendering of the services between those goods or services and a person using the mark in relation to the first mentioned goods or services’.

Section 11 of the TM Act provides with the certain particular that need to be put into consideration before taking cognizance of trademark as a well known trademark:

- I. Knowledge of recognition of the alleged well known mark in the relevant section of the public that indicates knowledge obtained through promotion of the trade mark. Case concerned on this point is of HariPuttar¹⁷ in which trademark dispute arose in regard to the name of Indian movie as HariPuttar which related to the well known novel series Harry Potter, the court held that such similar names will not lead to the confusion as Harry Potter films are targeted to meet the entertainment needs of exclusive and elite audience who can very easily can be difference between film based on harry potter book and a film relying on Punjabi comedy even by seeing the film Harry Puttar they would never relate it to the original Harry Potter book or film.

Similarly, in the case of *Rolex S A v. Alex Jewellery Pvt. Ltd.*¹⁸ The plaintiff was owner of well known trade mark Rolex for Watches which has popularity over the world. Defendants were involved in the business of selling artificial jewellery in the name of Rolex. Analyzing the definition of well known trade mark under section 2(1)(zg) Delhi High Court held that according to the section 2(1)(zg) well known trade mark is the mark which in relation to goods, means a mark which has become so known to the substantial segment of the public which uses such goods that the use of such mark in relation to any other goods that the use of such mark in relation to other goods would be likely to be taken as indicating a connection in the course of trade between those goods and a person using the mark in relation to the first mentioned goods. So the segment of public which uses Rolex watches belonging to particular category in concern to price are very much likely to believe that Jewellery bearing the trademark Rolex has connection to the plaintiff.

- II. The duration extent and geographical area of any use of that trade mark. Duration of use of trade mark can be short or long but of that use matters a lot courts have been flexible in regard to the establishment of proof of degree of use whether high or low on the part of the plaintiff. In *Indian Shaving Product Ltd. V. Gift Pack*¹⁹ popularly known as Duracell Ultra case, court has observe that even though duration of sale of goods was less than 1 year but the plaintiff had achieved high sales and have advertise heavily so, requirement to establish long duration of sale does not comes into picture.
- III. The duration extent and geographical area of any promotion of the trademark including advertising or publicity and presentation at fairs and exhibition of the goods or services in which trademark appears. Advertising forms to be essential material to be given due regard by the courts in passing off cases relating to well known marks. In the *Whirlpool case*²⁰ on the ground of extent of advertisement made by the plaintiff court held the mark as well known mark as such advertisement of the product was sufficient enough to reach the public of the relevant section even though the product of the company was totally absent from the Indian market.
- IV. The duration and geographical area of any registration of or any publication for registration of that trademark under this act to the extent they reflect the use of the recognition of trade mark.

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

¹⁸Rolex S A v. Alex Jewellery Pvt. Ltd[2009] 41 284PTC (Del)

¹⁹ 1998 PTC 698 (Del)

²⁰N R Dongre v. Whirlpool corp. (1996) PTC (16) 583 SC.

- V. The record of successful enforcement of the rights in that trade mark, in particular the extent to which trade mark has been recognized as a well known trade mark by any court or registrar under that record. For example in the cases of Shaw Wallace and co. v. Superior Industries Ltd.²¹ & Shaw Wallace and Co. v. Mohan Rocky Spring Water Breweries Ltd. , Shaw Wallace a well known alcohol manufacturing company successfully enforce their trademark rights over the numerical part of the brand name '5000'.
- VI. The number of actual or potential customer of the goods and services in the recent case of Aveda Corp. v. Dabur India Ltd.²² Plaintiff used 'Aveda' as a trade name for the business of selling of beauty product. On the other hand defendant started using 'Uveda' as their trade name for selling their personal beauty product. The Delhi High Court took into consideration that plaintiff beauty product has miniscule presence in India (as there supply were limited to single spa in India, Rishikesh). So the chances of confusion in mind of people are very less as plaintiff could not be said to have huge consumer base as compare to the defendant thus, court gave only minor suggestion to the defendant to increase the font size of their name ' Dabur' to make it more prominent in order to avoid likelihood of confusion.
- VII. The number of persons involved in the channels of distribution of the goods or services.
- VIII. The business circle dealing with the goods or services, to which the trade mark, applies.
- IX. Where a trade mark has been determine to be well known in at least one relevant section of the public in India by any court or registrar, the registrar shall consider that trade mark as a well known trade mark for registration under this Act.

Section 11(2) of the trade mark act deals with the relative grounds of the refusal of trade mark registration and specifically provides that a trademark that is similar or identical to 'well known mark' cannot be registered to dissimilar goods or services but on the other hand section 29(4) dealing with the trademark infringement , does not provide with specific mention of well known marks but merely refers to a mark having 'reputation in India' which represents intention of legislature to protect well known mark at the stage of registration only.

V. DEFENSE OF HONEST CONCURRENT USER IN TRADEMARK ACT 1999

Concurrent use by two or more individual of the same trademark for the same products is totally as opposed to the entire character of trademark law , for a trademark is intended to signify that the goods originate from one source and one and only source.¹ however section 12 of the trademark Act 1999 holds provision to manage exceptional cases emerging from honest concurrent utilization of the same or similar mark by distinctive persons.

SECTION 12:-Registration in the case of honest concurrent use, etc.—In the case of honest concurrent use or of other special circumstances which in the opinion of the Registrar, make it proper so to do, he may permit the registration by more than one proprietor of the trade marks which are identical or similar (whether any such trade mark is already registered or not) in respect of the same or similar goods or services, subject to such conditions and limitations, if any, as the Registrar may think fit to impose.

This section is similar to section 12 (3) of the previous act that is trade and merchandise marks act 1958 with the exception of that services are included and rather than the words "nearly resemble each other " the words "similar" is utilized and for 'depiction of merchandise's the words 'similar products' is utilized.

²¹Shaw Wallace and co. v. Superior Industries Ltd [2003] 27 PTC (Del)

²²Aveda Corp. v. Dabur India Ltd[2010] 14808 CS (OS) (Del)

Scope of section 12

The section 12 allows the registration by more than one proprietor of indistinguishable or similar trade marks in admiration of same or similar goods.¹ It is an exception to the preclusion of registration of similar marks held in section 11, and it overrides the simplification of denial held in this. The clause, “whether any such trademark is now enrolled or not” in enclosure makes it clear that the exception applies to unregistered mark likewise. The force of giving concurrent registration is optional this is clear from the utilization of the saying “he may allow registration”. In permitting registration the registrar has force to force any condition and limit. The onus of creating an instance of registration under the section is on the aspirants. before registration could be allowed on the premise of honest concurrent utilize, the other procurement of the act must obviously be fulfilled, with respect to sample the necessity of different character or limit to recognize under section 9.2

User pertinent :- For the application of section 12 user preceding the date of use is separated from everyone else applicable. The gathering can't exploit consequent user simply on account of the long pendency of the application³.

The section requires honest concurrent utilization which implies that the use asserted must be honest and in addition concurrent. The expression 'concurrent utilization ' implies that the petitioners use must be concurrent with the adversaries utilization of the enrolled mark not that the petitioner use has been concurrent with the rivals registration. The expression concurrent has not the same importance as contemporaneous. Section 12 is intended to perceive and make note of the fact that the significant open can, by commonality achieved by concurrent user, realize there are two similar marks being used thus be instructed to the requirement for inspecting them with more than conventional forethought, and accordingly to recognize them .this oblige that the same open have got both marks in the market place and the chance of evaluating the level of disarray liable to guarantee from the likeness of the marks which is to a huge degree characteristic of the measure of open hinder 4. in the event that the adversaries and seekers merchandise were sold through diverse trade channels, such utilize would not constitute concurrent utilization. where there has been no utilization of the adversaries mark or where the gatherings products have not been sold side by side in the same market, there has not been any chance of testing what level of perplexity is mediocre in people in general premium. In such circumstance the registrar could consider enrolling the mark under the proviso "or other unique circumstances".

The defense of honest concurrent use came into existence through two important cases firstly the case of Dent v. Turpin²³ determine that two user of the mark being derived from a common predecessor had a separate right to obtain injunction against the third party using the mark unauthorisely. Secondly in Southorn v. Reynolds²⁴ the Dent case was relied on to come to the conclusion on many similar fact but both these cases did not related to dispute between the concurrent users.

The rationale behind the honest concurrent user was put forward in Dewhurst & Son`s Ltd²⁵, the court held the opinion in following words ‘let us, than consider what the position of register will be, and how far the interests of the public will be protected if this mark is registered. As to the consents, I do not say that they are immaterial. They are valuable as affording some evidence that there will not be deception. . .’

In John Fitton and co.²⁶ five factors relating to the successful honest concurrent user defense were laid down:

1. The extent of use in time & quantity & the area of trade.

²³ Dent v. Turpin [1861] 2 139 ER (J&H)

²⁴Southorn v. Reynolds [1865]12 75LT.

²⁵Dewhurst & Son`s Ltd [1896]2137CH.

²⁶John Fitton& co.[1949]66 110 RPC .

2. The degree of confusion likely to ensue from the resemblance of the mark which is to a large extent indicative of the measure of public inconvenience.
3. The honesty of concurrent use.
4. Whether any instances of confusion have in fact been proved &.
5. The relative inconvenience which would be caused if the mark were registered.

On the above mentioned rationale section 12 of the Indian Trade Mark Act 1999 provides for registration of trade mark in case of honest concurrent use by providing that 'in the case of honest concurrent use or of other special circumstances which in the opinion of the Registrar, make it proper so to do, he may permit the registration by more than one proprietor of the trade marks which are identical or similar (whether any such trade mark is already registered or not) in respect of the same or similar goods or services, subject to such conditions and limitations, if any, as the Registrar may think fit to impose'. Mere reading of the section clears that registrar does not have any obligatory requirement to register honest concurrent user, it totally depend upon his subjective description. The case of *Kores (India) Ltd. V. M/s KhodeEshwarsa& Son*²⁷ laid down, law concerning honest concurrent use with regard to section 12(3) of Trade & Merchandise marks Act 1958 being ejusdem generis to section 12 of the present Act. It was held by the court under mention facts are required to be consideration for establishing registrability of a trade mark as Honest Concurrent use mark.

1. The honesty of the concurrent use
2. The quantum of concurrent use of trade mark shown by the petitioner having regard to the duration, area & volume of trade and to the goods concerned.
3. The chances of confusion resulting from the similarity of the applicant's and opponent's of trade mark, as a measure of the public interest or public inconvenience.
4. Whether any instances of confusion have in fact been proved.
5. The relative inconvenience that may be caused to the parties concerned.

With the 1994 amendment in the trade mark act effect of honest concurrent user defense has been diluted to the larger extent, since the act requires that the proprietor of an prior mark would have to oppose an application for registration in opposition proceeding. It was held in the case of *Road Tech v. UNISON*²⁸ that if the proprietor of the earlier trade marks files objection in regard to the registration of identical mark by concurrent user the registrar is required to reject the application of the concurrent user. Further in the case of *Re Majestic Distilling Co.*²⁹ it was pleaded by majestic that they have been using the trade mark even prior to the other companies such as mark onus Red Bull and thus they should be allowed to manufacture Tequila but court rejected such use as on the ground that it can result into confusion in the mind of public.

Though the court has been lenient when it comes to the adoption of trade mark regarding educational institution for example in the case of *Goenka Institute of Education & Research*³⁰, the high court upheld the defense of honest concurrent user but it went to give direction to the parties to give additional information or disclaimer so that student or the general public are not confuse into thinking that they both originate from same source. Similarly in *Satileela Charitable Society v. Skyline Educational Institute*³¹ in the name of engineering institution in the name of skyline was allowed to be continued despite of existence of skyline business school of other party. The courts allow such leniency regarding similar names of educational institutions, mostly upon the public interest ground and the need to preserve interest of student.

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

²⁸*Road Tech v. UNISON*[1996] 805(FSR).

²⁹*Re Majestic Distilling Co.* [2003] 315 1311 (F. 3d)

³⁰*Goenka Institute of Education & Research* [2009]40 393 PTC (Del)

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

VI. CONCLUSION

Well known marks have been given special protection under Indian law due to their existing brand value. One of the important characteristics of well known marks to be highlighted is the huge amount of the publicity done, no matter how old the mark has been. Trade mark proprietors are been using such fancy names, numerals or anything attractive that can make the mark unique and hence provide them with greater protection.

In India though section 2(1)(zg) provides for the definition of well known mark and section 11(2), (6), (7) & (9) Of the trade mark act 1999 very specifically deals with the understanding of well known marks and firms relative ground of refusal of trade mark registration but section 29 which deals with the infringement of the registered trade mark does not mention in its any clause the specific expression 'well known mark' and has only used under its clause 4 the expression as 'registered trade mark, that has a reputation. Which makes it very confusing to find out the real intention of the legislature in regard to protection of well known mark after registration does it means that legislature had intention to protect the well known mark at the stage of registration only if not so why discrepancy in respective language used in section 11 (2) and 29 (4) has been made.

Other than the inconsistency in section 29 (4) other matters that need consideration and clarification by the legislature are as following:

1. The definition of well known mark provided in the Act gives no parameter to determine whether a mark is well known mark or not rather it uses ambiguous language by reading as "a mark which has become so to the substantial segment of the public which uses such goods or receives such services" are left open for the interpretation by the courts.
2. In the absence of such clear definition of well known mark, the section dealing with enforcement of such well known mark also lack in determining whether a mark is well known mark. Thus in absence of such proper guideline regarding well known marks for enforcement proceedings, the scope of protection afforded to well known marks are adversely affected.
3. Section 29 (4) does not make any reference to bad faith adoption in deciding rights of the parties.

Without proper legislative action in regard to above mentioned inconsistencies the provisions dealing with prosecution and enforcement of well known marks is bound to fade and eventually will dilute the protection afforded to well known marks under Trade Marks Act 1999.

VII. ACKNOWLEDGEMENT

This research was supported by USLLS, GGSIPU. I thank my colleagues from USLLS who provided insight and expertise that greatly assisted the research. I would like to extend my thanks to my supervisor Dr. Lisa Lukose for the guidance. Last but not the least i am thankful to my family and friends for immense support.

VIII. REFERENCES

- [1] Dr. B.L. Wadehra, *Law Relating to Intellectual Property* (Universal Law Publishing Co. New Delhi ;fifth edn. 2013)568.
- [2] D.M.Kerly, *Kerly's Law of Trade Marks and Trade Names* (Sweet & Maxwell; fifteenth edn.reprint2016).
- [3] Morcom, Roughton & St Quintin, *The Modern Law of TRADEMARKS* (Lexis Nexis, Delhi;fifth edn.2016).
- [4] KC Kailasam, *Law of Trademarks*(3rd, LexisNexis, Gurgaon; third edn., 2013)1927.

- [5] Mary M.Squyres and Nanette Norton, *Trademark Practice Throughout the World*(South Asian; second Edition 2012)2216.
- [6] N.S. Gopalakrishnan & T.G. Agitha, *Principles of Intellectual Property Rights* (EBC, Lucknow; first edn. 2009) 589.
- [7] P Narayanan, *Trade Marks and Passing off* (Eastern Law House, Delhi sixth edn. 2004)1536.
- [8] Brandon Barker, “The Power of the Well-Known Trademark: Courts Should Consider Article 6bis Of The Paris Convention An Integrated Part Of Section 44 Of The Lanham Act” 81 *Washington Law Review Association* 363 (2006).
- [9] Brajendu Bhaskar, “Trademark Dilution Doctrine: The Scenario Post TDRA, 2005” 1(4) *NUJS L. Rev.* 637 (2009).
- [10] Frederick W. Mostert, “Well-Known And Famous Marks: Is Harmony Possible In The Global Village?” 86 *The Trademark Rep* 103 (1993).
- [11]Jing Brad Luo & Shubha Ghosh, “Protection and Enforcement of Well-Known Mark Rights in China: History, Theory and Future” *Northwestern Journal of Technology and Intellectual Property*1(2009).
- [12]Latha R. Nair, “Tracking The Protection Of Well-Known Marks In India: A Befuddled Path To Nirvana?” 101 *Trademark Rep.* 1419 (2011).
- [13]Leah Chan Grinvald, “A Tale of Two Theories of Well-Known Marks”, 13*Vanderbilt Journal Of Entertainment And Technology Law* 1 (2010).
- [14]Gaurav Mukherjee and Srishti Kalro, “What Is The Confusion Over Dilution?: Towards A Meaningful Understanding Of Section 29(4) Of The Trademarks Act, 1999” 4 *IJIPL* 139 (2011).
- [15] Dev Saif Gangjee, “Lots In A Name: Would "Diluted" Marks Still Sell As Sweetly?” 25(2) *NLSI. Rev.* 27 (2013).
- [16]Vivek Kumar Choudhary, “Protection of well known Trademark and Weakening of Honest Concurrent Use”15 *Journal of intellectual Property Rights* 293-301(2010).
- [17]Aditya Singh, “Concept of Well-Known Trade Mark” *PL August S* 23(2011).