

PROTECTION OF WELL KNOWN TRADEMARK AND RECOGNITION OF TRANSBORDER REPUTATION IN INDIA

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I. INTRODUCTION

The protection of well known trademarks in India has been provided from section 11(6) to section 11(10) of the Trademarks Act, 1999 and all such are read with section 2 (1) (zg) that defines a well known trademark. A well known trademark can be both registered and unregistered mark. Even if well known mark is not registered in India then also it gets protection in India. As per section 11² of trademark merchandise act 1999 it gives protection against any infringement and passing off action. Therefore, if any other mark which is similar to well known mark in any form then registered proprietor is entitled to bring a suit for passing off.

Marks are "distinctive signs and whose purpose is not to protect an invention but to make products distinguish for consumers and competitors" protected by industrial property law. Article 15.1 of TRIPS³ gives a definition of the trademark: "Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark". A trademark provides trademark proprietor an exclusive right to distinct their products and services, or to authorize another entity to use it, usually but not always in return for payment. The length of the protection varies approximately ten years, but a trademark can be renewed indefinitely by means of additional taxes. To be considered as a lawful trademark, a chosen sign must be, inter alia:

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² Section 11 of The Trademarks Act, 1999, reads as, "*Relative grounds for refusal of registration.*"

³ Article 15.1 of TRIPS agreement, reads as

"Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark".

Distinctive: the sign must distinguish goods and services from other goods and services in the same category; Non-deceptive: the sign must not be of a nature that can generate confusion among consumers, including confusion as to origin.⁴

II. Definition and Meaning of Well Known marks

Section (2) (zg) of TMA, 1999 give statutory recognition to well known trademarks and reads as: "A trademark which is to be registered for goods or services which are not similar to those for which the earlier trademark is registered for goods or services which are not similar to those for which the earlier trademark is registered in the name of a different proprietor shall not be registered if or to the extent the earlier trademark is a well known trademark in India and the use of the later mark without due cause takes unfair advantage of or detrimental to distinctive character or repute of the earlier trademark".⁵

A mark which is very known to a large number of public and which has a reputation and goodwill in the market and also known to a large part of those involved in the production or trade or use of the goods concerned and is clearly associated with such goods as coming from a particular source. To decide whether a mark is well known mark or not it is to take into consideration the fact that mark is known in domestic and international market or not.⁶

There is both domestic as well as international protection available to well known trademark. The Paris convention for the protection of industrial property, 1883 says that member's

⁴ Jacob and Robin, *Kerly's Law of Trademarks and Trade names* 88 (Sweet & Maxwell. London, 12th edn., 1986).

⁵ Section 2 (zg) of The Trademark Act, 1999, reads as,

" in relation to any goods or 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 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."

⁶ Carlos M. Correa, *Trade related aspects of Intellectual Property Rights* 108 (Oxford University Press, New York, 1st edn., 2007).

countries have to give special protection to well known marks.⁷ But there are many countries which are not member to these convention and they are not bind to it. As India was not a party to this convention but after signing of the TRIPS agreement India is also obliged to protect well known marks. As per Article 2 (1)⁸ of the TRIPS agreement provide that members shall comply with Article 1-12 and 19 of the Paris Convention. Article 16 (2) & (3)⁹ of the TRIPS require member countries to extend the protection of Article 6 *bis* to services and goods or services, which are not similar as well known mark. Thus, every member of the TRIPS have to protect the well known trademark even if they are not member of the Paris convention for the protection of industrial property, 1883. The clause 29 (4) of the lapsed bill also has the same principles like TRIPS agreement and Paris Convention for the protection of industrial property, 1883.

III. Factors to be considered for determining whether a mark is Well known

The following factors determined whether a mark is well known or not and such factors are as follows:¹⁰

1. The number of actual or potential consumers of the goods or services.
2. The number of persons involved with the channels of distribution of the goods and services.

⁷ Paris Convention for the protection of Industrial Property 1883, amended on September 28, 1979.

⁸ Article 2 (1) of TRIPS agreement 1995, reads as,

"In respect of Parts II, III and IV of this Agreement, Members shall comply with Articles 1 through 12, and Article 19, of the Paris Convention (1967).

⁹ Article 16 (3) of TRIPS agreement 1995, reads as,

"Article 6*bis* of the Paris Convention (1967) shall apply, *mutatis mutandis*, to services. In determining whether a trademark is well-known, Members shall take account of the knowledge of the trademark in the relevant sector of the public, including knowledge in the Member concerned which has been obtained as a result of the promotion of the trademark."

¹⁰ Section 11 (7) of The Trademarks Act, 1999, reads as,

"The registrar shall, while determine as to whether a trademark is known or recognized in a relevant section of the public for the purpose."

3. The business circles dealing with the goods or services to which that mark applies.

When a trademark has been determined to be well known trademark in at least one relevant section of the public in India by any court or registrar, the registrar of Trademarks is required to consider that trademark as a well known trademark with regard to the registration under the TMA, 1999.¹¹ The registrar has to require considering the bad faith or *malafide* intention of the other user in the adoption of the mark that is a well known mark.¹²

The well known mark has to be popular between the public and the registrar can only registered such marks when the condition of article a section 11 (7) will be fulfilled by the proprietors of the mark. There is no separate procedure for registration of well known trademarks under the TMA, 1999. Well known trademarks are registered as any other ordinary mark and the conditions for registration have to be followed. The registration of a well known trademark can be refused if it is in conflict with the public policy requirements as under Section 9 (2) or prohibitions as under section 9 (3), even though it fulfils the other requirements under Section 11 (6) to Section 11 (9).¹³

¹¹ Section 11 (8) of The Trademarks Act, 1999, reads as,

"Where a trademark has been determined to be well-known in at least one relevant section of the or registrar, the registrar shall consider section of the public in India by any court trademark as well-known trademark for registration under this act."

¹² Section 11 (10) of The Trademarks Act, 1999, reads as,

"While considering an application for registration of a trademark and opposition filed in respect thereof, the registrar shall protect a well-known trademark against the identical or similar trademarks."

¹³ Current development of protection trademarks which is well known among public in abroad ("well known foreign trademarks") in India, available at: http://www.pdfFiller.com/53959506-2011_policy05pdf-Indian-Intellectual-Property-Report-2011-Vol3-Current----JETRO-Various-Fillable-Forms (Visited on March 18, 2015).

IV. Concept of dilution and protection of well known mark against dilution

Dilution means "a use of mark in business and it is very similar to a famous mark that by it may reduce the consumer or public view about the famous mark which signifies something unique in particular."¹⁴

Trademark Dilution¹⁵ It is concept of trademark law and provides the owner of a reputed trademark standing to prohibit others from using that mark in a way that would lessen its uniqueness. In most cases, trademark dilution involves an unlawful use of another's trademark on products that do not compete with, and have little connection with, those of the trademark owner. It means weakening of a mark through use of similar mark. Such use may not create any confusion or deception in the minds of the consumer but it may diminish the power, which the mark enjoys in the forms of reputation.¹⁶ There are different types¹⁷ of dilution that has come in to light after judicial pronouncement. Such judicial Pronouncement are;

In *Champagne Moet & Chandon v. Union of India*¹⁸ In this case, the Delhi High court declined to grant an injunction in order to protect the French marks MOET & CHANDON from the Indian marks MOET'S. The court gave the outlook for such decision that French mark proprietors unsuccessful to provide any evidence of use, advertisements or significant presence in India and the average Indian consumer was unaware of the mark. The court held that though there mark is well known in various countries but not in India and Indian mark MOET'S is well known in India.

¹⁴ Dilution, available at: https://www.law.cornell.edu/wex/dilution_trademark (Visited on March 18, 2015).

¹⁵ Trademark Dilution, available at: http://en.wikipedia.org/wiki/Trademark_dilution (Visited on April 27, 2015).

¹⁶ D.P. Mittal, *Law of Trademarks, Passing off and Geographical Indications of Goods* (Taxman, New Delhi, 2000).

¹⁷ G.B Reddy, *Intellectual property rights and the Law* 272 (Georgia Law Agency, Hyderabad, 7th edn, 2008)

¹⁸ 2011 (46) PTC 484

In *Miss Universe Inc. v. Bohna*,¹⁹ it was affirmed in this case that the defendant was using the trademark "Miss Nude Universe" for some dancing business. Plaintiff was using the trademark "Miss Universe" for beauty pageant and use of such mark was to smudge the trademark of the plaintiff. Here Court reserved the defendant from using the trademark of the plaintiff.

The Federal Supreme Court of Germany held that a defendant who was affixing the widely known marks of a candy manufacturer in a manner of a trade to gag package it distribute which contained a condom and carried the parodied advertising slogan of the candy .manufacturer mark and was engaging in unfair competition. In such a case there is dilution of the trademark of candy manufacture by defamation..

In *Deere & Co. v. MTD Products Inc.*²⁰ a suit was filed by the plaintiff against the defendant for using its "Deer" design as a trademark. The plaintiff is the world's largest manufacturer of agricultural gear. The logo consists of two dimensional silhouette of a leaping male deer in profile. The defendant was producing a television commercial to endorse its tractors. The commercial consisted as a deer looking over its shoulder, jumping through logo frame and braking it hoping into noise and running in fear as it is followed by one o the plaintiff's tractors and barking dog. Here court directed an injunction on the ground that the commercial would blur the difference between Deere logo of the plaintiff and other logo in the markets.

In *De Nemous & Co of USA v. Zip Industries Pvt. Ltd.*²¹ the Court held that " a mark is well known lies on the proprietor of the mark and the proprietor is required to file substantial evidence in support of their contention that the mark is well known in India".

¹⁹ 27 IIC 115 (1992).

²⁰ 41 F.3d 39.

²¹ 2004(28) PTC 174.

V. Factors required to be considered by registrar

The Registrar need to consider the following factors to know whether mark is well known or not and such factors are as follows:²²

- a) Acquaintance or detection of that mark in the relevant section of public, including knowledge in India obtained as a result of promotion of the trademark;
- b) Duration, degree and geographical areas of use of that mark;
- c) Duration, extent and geographical areas of any endorsement of the mark, including advertising or publicity and presentation, at fairs or exhibitions'
- d) Duration and geographical area of any promotion of that mark, to the extent they imitate the use of registration of the mark;
- e) Record of successful enforcement and the extent to which the mark has been familiar as a well known mark by any court or registrar.

Problems faced in as long as protection to the well-known trademarks in India and the ways for enhancement and biggest problem in protecting foreign marks in India is that courts are hesitant in protecting foreign trademarks which are not registered in India. The Delhi High Court at a variety of times has said that if the foreign plaintiff marks is not registered in India then they has to prove by evidence.²³ The Indian courts are applying the provisions of the trademark to provide protection to the foreign marks. "However as a prerequisite to availing of such protection, proprietors are required to set up the well-known nature/repute of their mark, by adducing requisite evidence to that effect. In the absence of a straight jacketed formula for what amounts to "requisite evidence", future litigants can rely on judicial precedents as a guide for the same."²⁴ Another problem is that India do not have different or separate specific law for foreign marks. All marks are treated alike, whether Indian or

²² The Trademark Act, 1999.

²³ *Supra* note 75.

²⁴ 14 fn of 2011

foreign. As such, foreign marks are also requisite to fulfill the conditions in the Act such as registration, use and advertisements to avail of the well-known status.

VI. Protection of well known trademarks by passing off action

If well known trademark is not registered in India then it is not protected by infringement actions. But Indian courts has played very significant role in protection of such marks by action of passing off. The judgments in which court provided the relief to plaintiff by passing off action are as follows:

In *Banga watch v. Philips*²⁵ the respondents used the well known name 'Philips' on a broad range of electrical and non electrical goods plus lighting equipments, radio, radio clocks and multiple electric clocks and timers for a number of years. 'Philips' is well known trademark not only in domestic market as well as in international market. On other side appellants used the mark 'Philips' for watches, clocks and accessories. They were not able to provide any evidence in relation to the adoption of mark. The Court said that same mark can cause deception and confusion. Thus, court passed the permanent injunction in favour of the plaintiff. As per the Paris Convention every legal system has to protect the well known trademark. Such protection to this kind of well known mark is very important. It helps Consumer to choose the genuine product and it protects consumers from deception and confusion. In *Bata India Ltd. v. M/S Pyare Lal and Co*²⁶ the plaintiff instituted passing off action against the defendants. This company is internationally known and mostly famous for its leather products. The Bata Company has been using the mark BATA before 1940. It was registered under the act of 1940 and start manufacturing goods like canvas, plates, leather shoes, rubber, hosiery and other related things. This company bills registered under the act of 1940.

²⁵ AIR 1983 PH 418.

²⁶ AIR 1985 ALL 242.

In June 1983, the Company comes to know about another company in Meerut which was selling goods by the name of Bata. The company instituted passing of action against the Meerut based company. But in district court well known Bata Company lost their case but they went to high court and there High court of Allahabad granted injunction.

*Singer manufacture co. v. loog*²⁷ In this case, Benerji J. held that the use of the mark BATAFOAM by the defendants was to create uncertainty between BATA and BATAFOAM mark. This was to cause the public to believe that the Bata has entered into the business of foam products and this was to use the well known Bata mark and this was to create deception and confusion.

In *Rustam Ali v. Bata Shoe Co.*²⁸ there was nonconforming order by the division bench of Calcutta high court. Here court was refused to restrain defendants by passing interlocutory injunction from using the mark BATA on the products like lungis and handkerchiefs.

Banerji J held, "A passing off action would lie even if the defendant were not developed or producing any goods similar to that of the plaintiff. a passing off actions would lie where a misrepresentation is likely to be caused or a wrong impression created as if the product was of someone else".

The court was of the view that every mark achieved some good will and reputation in the market and if there are some products brought into the market by the name of same brand or mark then consumer may assume that it is manufactured by the same manufacturer. Thus, such mark should be stop from circulating in the market. Otherwise it will lead to deception and confusion in the eyes of the public.

²⁷ AIR 1940 PC 86.

²⁸ AIR 1957 CAL 120.

However, In Bombay High Court in *Soni Kabushiki Kaiska v. Shamrao Masker*²⁹ Court did not agree with decision of Allahabad High Court in the Bata case and did not agree that detain of confusion and deception. In this case mark SONY was used by another manufacture on the product of lipstick in Greater Bombay and here court refused to grant injunction to the real proprietor of SONY.

We can say even if there is likelihood of confusion or deceptions and only on the basis of that mark is well known relief cannot be established. It's always depending on the facts and circumstances of the case.

In *Surjit v. Alembic Glass Industries Ltd.*³⁰ In this case, the alembic Company was registered manufacturer of the well known mark YEAR. This industry was making various goods and products in the name of same mark. The plaintiff applied for the registration of the trademark by the name of YEAR and he wanted to manufacture different goods of perfumery, cosmetics and toilet preparation. Defendant here didn't take the cynical registration for trademark YEAR.

Prof. Ponnuswami criticizes the inferences by the court that the Alembic has all the resources to manufacture the same products like the Surjit Singh products. If the plaintiff makes the goods in the name of YEAR then the common people may get confused by perfumery sold by the Plaintiff in the name of YEAR.

In *Ceat Tyres of India v. Jai Industrial Services*³¹ the plaintiff was registered proprietor of the CEAT and it's registered as a trademark. The company has acquired the repudiation and goodwill in the market. They are the one of the main manufacture of tyres and other goods in

²⁹ AIR 1985 BOM 327.

³⁰ AIR 1987 DEL 319.

³¹ 1991 (1) ARBLR 33 Del.

the domestic as well as international market. In the year 1987 they come to know that defendants was using their trademark and making belts made up of rubber or synthetic rubber. Then plaintiff brought passing off action against the defendants and asked court to pass an injunction and control them from their trademark.

P.K. Bahari. J. held that there was passing off action and defendants were preventive from using the trademark CEAT and passed temporary injunction. The court observed that defendant was taking unfair advantage of the plaintiff reputed trademark and it is necessary to prevent commercial immortality and dishonesty.

In, *Rolls Royce Plc v. R.R. Motors Pvt Ltd.*³² defendant was using the well known trademark of reputed car manufacture brand. Plaintiff is into the business of making car and internal burning engines. Rolls Royce is one of the reputed car manufacturers in the world and the defendant was using R.R mark for his goods and products. Here court passed an injunction and restrain defendants from using such mark in the future.

Thus, we can conclude from the above decisions that judiciary has played a very important role in protecting the well known trademark. The main aim and rationale of passing such decision is to protect the consumers from any confusion and they also help the manufacture from losing their goodwill and reputation in the market. All such action of courts is very significant for the function of trade and commerce industry in any country of the world.

VII. Current developments in India for protection of well known Trade marks and Transborder Reputation

Earlier in India there was no effectual protection was provided to the trademark proprietor and there was a need to change the trademark law. Such changes were very required to enhance the economic development of the country. There are many significant changes has

³² 64 (1996) DLT 696.

been made by the Indian Trademark law and such changes has been seen with the ratification of the Trademarks Act, 1999. These changes were of several kinds and can be summarized as follows:³³

- a) The concept of transborder reputation which prolonged the number of ways in which trademark rights can be created.
- b) Providing the better protection of well known trademarks as a result of transborder reputation, predominantly the development of the concept to goods different from those dealt in by the proprietor.
- c) The coverage of newer torts without a prescribed legislation.
- d) The expansion of remedies from purely statutory to more socially satisfactory ones.
- e) The intensification of remedies from the simple *ex parte* injunction to more complexes like grant of Anton Piller orders.

Such changes can be practical by explaining such in the following cases:

In *Taj Television v. Rajan Mandal*³⁴ the interesting John Doe type order was and it's required for instant protection to the plaintiff. The issue in this case was the broadcasting rights of the Soccer world cup 2002 and he has such right only for one month and therefore immediate protection as required. The plaintiff brought an action and the Delhi High Court granted an order for searching and seized equipment at various cable operators and as a result some 3500 licenses were signed up. The was very successful in restriction otherwise it might have been a complete loss or destruction of the plaintiff's intellectual property.

³³ Current development of protection trademarks which is well known among public in abroad ("well known foreign trademarks") in India, available at: http://www.pdfFiller.com/53959506-2011_policy05pdf-Indian-Intellectual-Property-Report-2011-Vol3-Current---JETRO-Variou-Fillable-Forms (Visited on March 18, 2015).

³⁴ Juhi Gupta, "John Doe Copyright Injunctions in India" 18 *JILI* 352 (2013).

The Indian Judiciary, also passed the Mareva injunctions in the cases like *Philips and tata*, the Norwich pharmaceutical order was granted in *Souza Cruz* for Hollywood cigarette and directing excise and customs commissioners to unveil the defendants export records and damages awards granted for the first time in the this was the first time the Indian Courts start granting punitive and exemplary damages instead of compensatory damages in order to shift the overburdened from criminal justice system to a civil system and it was held in the *Times Magazine* case.³⁵ There are the cases where Courts have expressly recognized the concept. In India the courts have granted protection to famous marks through passing off action, but law dilution is still in its developing stake. In India relief is granted on the ground of possibility of confusion as to source and not on the ground of dilution.

In, *Daimler Benz Aktiengesellschaft v. Hybo Hindustan*.³⁶ defendants use the well known and reputed mark BENZ along with three pointed star. This famous mark was used by the defendants on under garments. The High Court held that dependents have no right to use the plaintiff mark and granted relief to the plaintiff.

The Court also said that "...No one should be allowed to use a world famous name to goods, which have no connection with the types of goods, which have granted the worldwide reputation. In the instant case "BENZ" is a name given to a very high priced and extremely well engineered product. In my view, the defendant cannot dilute that by user of the Benz with respect to product like under user."

In the case *Willam Grant & Sons v. Mcdowell & Co. Ltd.case*³⁷ Court was of the view that "...I find the defendant has taken all the necessary elements of the plaintiff's GLENIDDICH whisky bottle label...The exclusive reputation (which the plaintiff's whisky

³⁵ *Supra* note 29.

³⁶ AIR 1994 DEL 239.

³⁷ 1994 (30) DRJ 105.

and associated bottle label enjoys) would be impaired if a similar label is used in connection with a product which is not the same, as the product of the plaintiff's whisky, the destruction being gradual debasement, dilution or erosion of what is distinctive".

In the instant case plaintiff assumed that the label used by the defendant on its Whisky Bottle along with the outer carton of the said bottle were a significant imitation of the plaintiff's Single Malt Whisky Bottle, label and carton. It was further alleged that the use by the defendant of the said carton and label would lead to serve dilution of the marks. Thus, trademarks carries the goodwill and reputation where ever they go and transcends the physical boundaries of a geographical region and acquires a trans border reputation not only through imports of goods but also by its advertisement shall be a well known trademark within the meaning of a trademark law and shall be protected under the Trademarks Act, 1999.

In India and in many other countries where the concept of transborder reputation has been recognized and this is a positive sign for the proprietors of the trademark and for the governments that seek to harmonize the Intellectual property regime all over the world.

The United States Embassy also predictable that the digitization of the Trademark Registry be completed soon and also asked the Indian government to digitalized the customs department³⁸ to further the filing of notices from rights holder electronically.³⁹

In *Champagne Moet & Chandon v. Union of India*⁴⁰ In this case, the Delhi High court declined to grant an injunction in order to protect the French marks MOET & CHANDON from the Indian marks MOET'S. the court gave the opinion for such decision that French

³⁸ Doctrine of Transborder reputation, available at: <http://newdelhi.usembassy.gov/iprtrademark.html> (Visited on April 24, 2015).

³⁹ *Ibid.*

⁴⁰ 2011 (46) PTC 484

mark proprietors failed to provide any evidence of use, advertisements or significant presence in India and the average Indian consumer was unaware of the mark. the court held that though there mark is well known in various countries but not in India and Indian mark MOET'S is well known in India.

In *Timberland & Co. v. Vijay & Ors*⁴¹ the Delhi High Court granted injunction in favour of the plaintiff against the defendant's mark TIMBERLAND. The plaintiff mark TIMBERLAND and it is well known across the various countries including India. the plaintiff was able to prove by showing evidence of expenses for the years and for advertisement and promotion of the mark in India.

In *Roca Sanitario S.A. v. Naresh Kumar Gupta & Anr.*⁴² the ROCA mark was failed to establish any use, advertisement or any significant presence in India and the Delhi High Court said, though the plaintiff mark is well known in international markets but not in India as the average Indian consumer was unaware of the mark ROCA. The plaintiff as evidence to proof placed on the record copies of some magazines, but all such magazines were in different languages and therefore not known in India.

Thus, the Delhi High Court restrained and not passed an Injunction in favor of ROCA against the mark ROMA and the court held that "*while claiming injunction for deceptive similar trademark, there should proof that trademark of goods to be well known in the country.*"

In *Aveda Corporation v. Dabur India Ltd.*⁴³ the plaintiff was in the business of trading the beauty products in the name of AVEDA and the defendants started selling such products in the name of UVEDA. The Delhi High Court restrained the plaintiff from selling such

⁴¹ 2011 (46) PTC 530 (Del).

⁴² MANU/DE/2040/2010

⁴³ 2010 (42) PTC 315 (Del).

products by the name AVEDA and said that plaintiff mark was not that known as defendant mark UVEDA is known. Thus, the court held that its not enough to establish that mark is well known in India.

In *Rolex S.A. v. Alex Jewellery Pvt. Ltd.*⁴⁴ the Delhi High court held that the plaintiff was entitle to an injunction as his mark ROLEX is well known in India and its also promoting its mark through online stores also in India. in this case the defendant was in the business of selling artificial jewellery in the name of ROLEX. Thus, court restrained the defendant from using such mark in selling the artificial jewellery.

In the case of *Societe Des Produits Nestle, S.A. v. Swaraj Indus Trial and Domestic Appliances*,⁴⁵ the application for trademark "Maggi" for electric fans was rejected. The trademark "Maggi" was aready registerd in the international market in favour of appellant being the surname of its founder Julius Maggi. The appellate board found it to be well-known trademark and held that public was likely to associate the electrical goods as diversification of business.⁴⁶

In *Austin Nichols & Co and Seagram India Pvt. Ltd. v. Arvind Behl Director, Jagjit Industries Ltd.*⁴⁷ the doctrine of transborder reputation was settled in this particular case relating to the importance to be given to the doctrine. In these case the BLENDERS PRIDE mark was used by the plaintiff for manufacturing the whisky from lat 50 years and almost in 105 countries and very reputed in India and the defendants are the local manufactures of alcoholic drinks and selling their whisky under the mark BLENDER'S PRIDE.

⁴⁴ 2009(41) PTC 284 (Del).

⁴⁵ 2013 (56) PTC 94 (IPAB).

⁴⁶ Alka Chawla, "Intellectual Property Law" XLIX *ASIL* 731 (2013).

⁴⁷ 2006 (32) PTC 133 (DEL).

The court held: "*The plaintiffs having come out with 'Blenders Pride' whisky first in the international market were first past the post; even though the defendants were the first to do so in India. The fact that the product of the plaintiff was not manufactured or sold in India from 1973 (when it first entered the market) till 1995 when it became freely available in India, is of no consequences.*" Thus, court granted an injunction in favour of the plaintiff considering that the plaintiff mark was well known and also had several promotional events in India both before and before 1991.

In *Sony Corporation v. Jasbir Singh Kohli*⁴⁸ The intellectual Property Appellate Board granted an injunction in favour of the plaintiff and restrained the defendant from using the mark SONICO as it was identical and deceptively similar to the plaintiff mark SONY. The court was of the view that SONICO is not that well known as the plaintiff mark SONY is known.

In *Bloomberg Finance LP v. Prafull Saklecha*,⁴⁹ the plaintiffs were a multinational news service and registered under the trademark BLOOMBERG in USA. The Trademark world magazine of April 2005 identified the trademark BLOOMBERG to be a well known trademark in the world. It was held that the plaintiff has been able to show that BLOOMBERG is a well known trademark with transborder reputation as well as representation in India. Marks are identical; therefore, there is every possibility of deception and confusion.

In *Kabushiki Kaisha Toshiba v. Toshiba Appliances Co.*⁵⁰ The defendant mark TOSIBA which was similar to well known mark TOSHIBA of the plaintiff and court grant an injunction in favour of the plaintiff as the mark TOSHIBA was used by the defendant with *malafide*

⁴⁸ 2005 (31) PTC 486 (IPAB)

⁴⁹ 2013 (56) PTC 243 (Del).

⁵⁰ 2005 (30) PTC 188

intention. The plaintiff mark was well known mark of Japanese company and plaintiff was into extensive advertisements in India and it's has an registration since 1953.

In *Milmet Oftho Industries & Ors. v. Allegen Inc.*⁵¹ The Indian pharmaceutical company manufacturing OCUFLOX and the defendant company was also manufacturing OCUFLOX. As par the respondent the mark was first used by him in September 1992 and marketed in several other countries except India and the registration to plaintiff was granted by the Food and Drug Control Administration in August 1993. The court held that "*the mere fact that the respondents have not been using the mark in India would be irrelevant if they were first in the world market.*"

In *HPL Electric and Power Pvt. Ltd. v. Sanjeev Sharma*,⁵² the plaintiff was a proprietor of trademark HPL. The defendants started manufacturing solar torches and lights under the identical trademark HPL. Decree of permanent injunction was passed in favour of the plaintiff.

In *Honda Motors Ltd v. Charanjit Singh*⁵³ The Japanese mark HONDA was registered in India and acquired reputation and goodwill for many decades. Every middle class person's is aware about such brand in India and it due to the extensive advertising and various collaborations with Indian companies. The court held that the defendant has restrained from using the mark and granted the injunction in favour of the plaintiff and restrained the defendant from using the mark HONDA for pressure cookers, with the view that the use of the mark by the defendant would amount to infringement of the plaintiff's mark and would cause grave injury to both the plaintiff and the consumers.

⁵¹ (2004) 12 SCC 624

⁵² 2013 (56) PTC 464 (Del).

⁵³ 2003 (26) PTC 1

In *Caterpillar INC. v. Jorang & Anr.*⁵⁴ the plaintiff mark CAT is well known in all over the world and the defendant was using the marks CAT and CATERPILLAR on garments and it was held by the court that the defendant was infringing trademarks CAT, which has been known for its leather products and enjoyed prior registration in almost 175 countries including in India.

In *Tata Sons Ltd. v. Manoj Dodia*,⁵⁵ the court observed that brands are not build in a day, it take years to establish a brand in the market. The companies which invest heacily in brand building and back them up quality products are bound to suffer not only in reputation but also in financial terms, on account of dimunition in the value of the brand as well as sale of their products/ services, if the brands are not given adequate protection by the courts, by awarding punitive damages against the infringers.⁵⁶In *Indian Shaving Products Ltd. v. Gift pack & Anr*⁵⁷ the plaintiff's mark DURACELL was held by the court to be well known marks and has been very substantial use in India and has very effective investments, promotions and advertisements. The court was of the view that the reputation got by the mark in India and other countries was substantial and it was also registered in India. the court also considered that the plaintiff has to bear a losses and it was a malafide use of the mark DURACELL by the defendant.

In *Aktiebolaget Volvo v. Volvo Steels Ltd.*⁵⁸ the Bombay High Court held that plaintiff was entitled to protection of the mark VOLVO and established goodwill and reputation in India by advertisements in various international magazines having circulation in India and the plaintiff also registered its mark in India.

⁵⁴ 1999 (19) PTC 570 (DB)

⁵⁵ 2011 (46) PTC 244 (Del).

⁵⁶ Alka Chawla, "Intellectual Property Law" XLVII *ASIL* 574 (2011).

⁵⁷ 1998 PTC 18 (Del).

⁵⁸ 1998 PTC 47 (Bom).

All the above decisions of the Indian courts were very effective in protecting the trademarks which were very reputed and well known in the world. Indian courts have protected foreign marks also and adopted liberal approach and provided the effective protection to all such marks. If a plaintiff seeks to protect his foreign well known mark in India, his best chances of getting an injunction in his favour would be to have Indian registrations for that mark or they have to provide evidence to show considerable use of the mark in India, even if the mark is unregistered.⁵⁹

But there are cases when even Supreme Court and other courts of India held that non-use of the mark in India will not protect their mark in India even if that mark is well known in other countries. Such cases are as follows:

In *Milmey Oftho Industries & Ors. v. Allergan Inc.*⁶⁰ The Supreme Court held that the non-use in India would be irrelevant if the plaintiff was the first in the world market. However, the decision carried a word of caution that foreign brand owners who have no intention of coming to or introducing their product in India will not be allowed to restrain an Indian company from selling a product in India, if the Indian company has genuinely adopted the mark.

In *Jolen Inc. v. Doctor & Co.*⁶¹ the Delhi High Court held that if company has no business in India that doesn't mean it will not get effective protection. The court decided the suit in favour of the plaintiff and upheld their rights in India in respect of the trademark JOLEN and said that they have right to protect their goodwill and reputation of its name or trademark.

⁵⁹ V. A. Mohta, *Trademark, Passing Off and Franchising* 122 (All India Reporter, Nagpur 1st edn., 2004).

⁶⁰ 2004 (28) PTC 585 (SC).

⁶¹ 2002 (25) PTC 29 (Del).

Thus, Indian courts has revealed that in all the recent decisions that well known marks are protected in India and foreign marks are equally protected even they are not registered in India. We even say that court asked for the evidence to verification that such mark has been well known in India. Indian courts have provided protection to the foreign marks and upheld the Doctrine of Trans-border reputation, but Indian courts were inconsistent in protecting trans border reputation doctrine. It was advised by courts that companies who want to invest in the Indian market should apply for registration of their trademarks in India.⁶²

Since India follows common law principles, an unregistered mark can also get protection, but as by various judgments of the courts was of the view that a registered mark gets more protection. In the event that a mark is unregistered, the owner would have to produce evidence of presence of the mark in India. While courts do identify trans-border reputation, it would be advisable to establish that there has been some use of the mark in India or some expenditure has been incurred in advertising the mark in India.⁶³

The rights holder of the trademark not only enter their trademark in India they also get registered such trademarks. Such proprietors also registered their marks in the Indian sub-continent i.e. in the territory of Pakistan, Sri Lanka, Bangladesh, Nepal, Bhutan, Maldives, Afghanistan and Burma because their borders are very close to each other and as India is the biggest market amongst all of them, any trademark, which has goodwill and reputation in India, is likely to be infringed in these markets.¹³ This leads not only make counterfeit products but also result in counterfeit goods being imported to India and various other countries

⁶² Doctrine of Transborder reputation, *available at*: <http://newdelhi.usembassy.gov/iprtrademark.html> (Visited on April 24, 2015).

⁶³ *Ibid*

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