

WELL-KNOWN TRADEMARKS – INDIA PERSPECTIVE

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Till the present day, there are 81 declared well-known trademarks in the list maintained by the Trademark Registry in India. By the introduction of one step procedure for determining a trademark as well-known, the list is expected to increase very soon. This is the right opportunity for trademark owners in India or overseas to have their trademarks accepted and declared as well-known in India so that their trademarks are protected from being infringed or passed off by any unauthorized person.

INTRODUCTION

With the emergence of several social media platforms and innovative advertising ideas the reach of brands to the consumers have increased tremendously. Consumers are growing aware of trademarks associated with such famous brands. A huge amount of time, money, and resources are being spent by the owners of the trademarks to maintain their popularity in this globalized world. The tag of ‘well-known trademark’ in such a competitive market would be like attaining ‘MOKSHA’ for trademark owner as with the tag of the well-known trademark the basic aim for the protection of trademark shifts from the ‘consumer deception’ to preserving the distinctiveness of a trademark by protecting it against dilution and tarnishing. Hence, proof of confusion and deception, which is one of the traditional requirements of trademark infringement actions and passing-off actions, becomes a secondary consideration in the protection of well-known trademarks.

Indian Trademark Law recognizes well-known trademarks and has adopted the criteria that has been laid down under Article 6 of the TRIPS Agreement.

The statutory definition of a well-known trademark is given in the Trade Marks Act, 1999, (“Act”) is -

“well-known trade mark”, 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.

Further, there are provisions in the Act which lays down the factors which deals with the various matters concerning protection of well-known trademark. They are in the nature of explanations, which may arise in the context.

Under the Act, the Registrar of Trademarks (Registrar), while determining whether a trademark is a well-known trademark, will have to take into account any fact which he considers relevant for determining a trade mark as a well-known trademark including-

- a) the knowledge or recognition of that trademark in the relevant section of the public including knowledge in India obtained as a result of promotion of the trademark;
- b) the duration, extent and geographical area of any use of that trademark;
- c) the duration, extent and geographical area of any promotion of the trademark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trademark applies;

- d) the duration and geographical area of any registration of or any application for registration of that trademark under this Act to the extent they reflect the use or recognition of the trade mark;
- e) the record of successful enforcement of the rights in that trademark, in particular the extent to which the trademark has been recognised as a well-known trademark by any Court or Registrar under that record.

Also, while determining the knowledge and recognition of the trademark in the relevant section of public as mentioned above the Registrar will have to take account of-

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

The law is very clear regarding the fact that if a trademark has been determined 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 trademark as a well-known trademark for registration under the Act.

The Act states that while determining a trademark to be well-known, the Registrar shall not require as a condition that the trademark has been used or registered or has been applied for registration in India. It also states it is not essential that the trademark should also be well known to the public at large in India. Further, it is also not a condition that the trademark is well-known or a registered trademark or the pending registration or pending in any jurisdiction other than India.

Once a trademark is declared as well-known by the Registrar or by any courts, the trademark registry while dealing with any new trademark shall not register any similar or deceptively similar trademark that is identical or similar to the ‘well-known’ trademark across all classes of goods and services. For e.g. “SONY” has been declared as a well-known trademark under the Indian law which means that in India only Sony Corporation can use or register the mark “SONY” in any class of goods and services. Similarly, if there is an infringement proceeding, a ‘well-known’ trademark can be asserted against defendants dealing in entirely different goods or services. Therefore, a well-known trademark is of great importance to the trademark owners and has huge commercial implications.

A recent amendment in the Indian Trademark Rules, which have been notified as ‘The Trademark Rules, 2017’ (“Rules”), has created a lot of buzz amongst the trademark owners. A new procedure for filing of an application for the determination of trademark as well-known by the Registrar has been introduced. Prior to enactment of any such Rule, the process of declaring a trademark as well-known was solely decided by the Courts or Tribunals, resulting out of a full-fledged contested litigation or legal proceeding. A mere claim that the trademark is well-known by the owner of the trademark is not sufficient.

Under the notified Rules, the trademark owner can now file an application for declaration of their trademark as a well-known trademark before the Registrar by making a payment of prescribed fee of INR 1 lakh (USD 1550 approx.). While reviewing such an application, the Registrar would determine whether the said trademark is to be considered as a well-known trademark or not based on the provisions laid down in the Act as mentioned above. Under the Rules the trademark owner can now directly proceed to protect his trademark as well-known, without initiating any infringement or opposition proceedings. Though the Rule does inflict certain duties on the general public as they are free to object and such objections are to be filed within 30 days from the date of invitation of such objection.

In order to further streamline the procedure for filing of an application for well-known trademark, a notice has been issued by the concerned authority. The notice includes certain requirements to be fulfilled by the applicant while filing the application for inclusion of a trademark in the list of well-known trademark.

The general guidelines include:

1. The application should be accompanied with following set of documents:

Statement of case:

This should describe the applicant's rights in the trademark and also the applicant's claim that the trademark is a well-known trademark, clearly and in a proper manner.

Evidence in support:

Evidence in support of the applicant's rights and claim is to be filed along with the application. In other words the application should be accompanied with:

- Evidence as to use of trademark.
- Any applications for registration made or registration obtained.
- Annual sales turnover of the applicant's business based on the subject trademark duly corroborated.
- Evidence as to the number of actual or potential customers of goods or services under the said trademark.
- Evidence regarding publicity and advertisement of the said trademark and the expenses incurred.
- Evidence as to knowledge or recognition of the trademark in the relevant section of the public in India and abroad.

Details of successful enforcement of rights:

If there are any enforcement rights relating to the said trademark in particular extent to which trademark is recognized as well-known trademark by any Court in India or Registrar, those details have to be clearly stated.

Copy of the Judgment:

If there is a judgment by any Court in India or Registrar, where the trademark is determined as well-known trademark, such judgment should be given with the application under rule 124.

The size of the document:

The documents submitted along with statement of case as evidence / supporting document should be in PDF format with resolution of 200 X 100 dpi on A4 size papers and total file size shall not exceed the limit of 10 MB.

2. After the receipt of the application, the controller will consider the claim of the applicant on the basis of documents submitted.
3. The office may publish the details of trademark proposed to be included in the list of well-known trademarks.
4. Any person, who wants to object the inclusion of the said trademark in the list of well-known trademarks, may file his objection in writing to the Registrar stating out the reasons clearly for his objection and also the supporting documents, if any exist.
5. Copy of the objection will be communicated to the applicant for comments within stipulated time.

6. Office will communicate the decision in respect of the objections to the parties concerned.
7. Final decision of the office regarding inclusion of the trademark in list of well-known trademarks will be communicated to the applicant.
8. In case the mark is determined as well-known, the same will be notified in the Trade Marks Journal and included in the list of well-known trademarks made available on the official website.

Till the present day, there are 81 declared well-known trademarks in the list maintained by the Trademark Registry. By the introduction of one step procedure for determining a trademark as well-known, the list is expected to increase very soon. This is the right opportunity for trademark owners in India or overseas to have their trademarks accepted and declared as well-known in India so that their trademarks are protected from being infringed or passed off by any unauthorized person. At the same time, the Registrar ought to follow a cautious approach while considering applications for determination of trademarks as well-known, since once a trademark is declared as well-known, it will preclude any other party from using such trademark (or even similar to it) in respect of other goods and services.



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