

Protection of “Well-Known Trademarks” In India before “The Trademarks Act, 1999”

Abstract

The present paper deals with the protection of “well-known trademarks” in India before enactment of Trademarks Act 1999. It depicts that Indian law had always protected well-known trademarks even though there was no specific provision in this regard in the statute except defensive registration. The courts had gone beyond the guidelines of enactment besides parameters of judging trademark on the scale of deception and confusion for users, and had rather laid down principle of dilution and tarnishment of trademark.

Keywords: Well-known Trademarks, Trademarks Act 1999, Intellectual Property Rights, Paris Convention, TRIPS Agreement.

Introduction

The present paper will travel the journey of India in protection of “well-known trademarks” from preindependence times till the enactment of the “Trademarks Act 1999”. It will take into account the statutory developments in India and also the growth of protection of “well-known trademarks” at international level.

Objective of the Study

The aim of this paper is to bring forward the evolution of trademark law in India before legislation The Trademarks Act 1999 was passed to show that this protection was always available to the well-known trademarks in India.

To show that Well-known Trademarks were protected in India, somewhat by statute but mainly through judicial precedents, even before India was compelled to implement protection standards of well-known trademarks of TRIPS Agreement, through enactment of The Trademarks Act 1999.

Research Question

1. Whether there existed any mechanism for Protection of Trademarks before enactment of Trademarks Act, 1999, in India?
2. What Forms the basis or foundation of Trademarks Act, 1999?

Review of Literature

After going through various important judgments of Hon'ble Supreme Court and other courts in India, the researcher is of the view that mostly all of them indicate towards an established Trademark protection mechanism even before the enactment of Trademarks Act 1999. It could be logically deduced and concluded from the available literature on the issue that such protection was effective although not as much as it is now, but well-known trademarks have always been protected in India. Therefore, based upon above observations after conducting a brief research over the issue prior to entire analysis, the following hypothesis could be drawn:-

Hypothesis

That there existed a mechanism of protection of Well-known Trademarks in India, backed by courts, before enactment of Trademarks Act, 1999.

That precedents laid in the above judgements of various court's formed the basis of Trademarks Act, 1999

The further research shall be conducted in order to prove the above hypothesis.

Research Methodology

The Research carried on by the author on the above issue can be attributed as 1) Descriptive or Qualitative and 2) Analytical in nature. Based upon the structure of paper, it could be seen that some portion of it shall be

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highly descriptive in nature i.e. dealing with the position of law prior to new legislations and presenting the secondary data derived from various sources including Judgements of High Court and Supreme Court of India, etc. Researcher has accessed this pre-collected data from various online sources like Online Legal databases Websites of various courts, Online journals and scholarly articles. As far as the latter part of paper is concerned, it is highly analytical in nature and presents the analysis of the researcher of the entire position of law prior to new legislation. This part presents data based upon the logical construction of the researcher after going through the collected secondary data available.

The Research is based upon the qualitative factors and looks into the historical aspect of law therefore it is not based upon the quantitative analysis as the subject matter could not be presented in numerical form, moreover graphical representation was not required. The research has therefore been carried on the basis of qualitative research tools. It is also important to mention that research did not require any empirical first hand data like questionnaires and opinions of general public to be collected in order to reach a conclusion to answer the undertaken research questions.

Research Design

The design or pattern of research is in consonance with the requirement of research. The initial data required has been collected by method of literature review and analysis, further the collected data has been analysed following the qualitative tools of research and results obtained shall be based on the evaluation of entire scenario or collected data.

Main Text of the Study

In a common parlance, trademark is "Well-Known trademark" if it is well reputed and known amongst its current and prospective consumers, but at international level there has been no such unanimity on the concept/definition of the term "Well-known Trademark", though, deliberations have been going for a long time. First time this term "Well-Known" originated in respect to trademarks in reference to reputation in old case *JG vs Stanford*¹. In International scenario, the expression "Well-Known Mark" finds place in "Article 6bis" of the "Paris Convention"², right from the year 1925 in which better protection and treatment to this concept is sought to be ensured. The use of the Article 6bis, is to block the usage and registration of a trademark, responsible for creating confusion alongwith another mark already well-known. "Well-known trademarks" are protected even without registration in member state due to "Article 6bis" of "Paris Convention". To get the benefit of above mentioned Convention, the prerequisites are that the mark should be well known and belong to a person, who is a national of one of the member countries. Protection to unregistered "Well-Known trademark" under "Article 6 bis" is applicable for identical or similar goods in member state. Under this Article, Member State agrees to refuse registration a trademark which is reproduction, imitation, or translation of a "Well-Known trademark", if due to it, confusion is caused, but this Convention, failed to

define "Well-Known trademark", rather had put the decision, whether mark is well known or not, upon the protecting country. Thus, Paris Convention puts an obligation on Member State to legislate in this regard.

Afterwards the "Trade Related Aspects of Intellectual Property" of the "General Agreement on Tariffs and Trade" ("GATT TRIPS") expressly referred to and extended the "Paris Convention". "GATT TRIPS" Article 16(1) extended the very idea to service marks and required that these marks be well-known only to a "relevant sector of the public." The protection envisaged in "Article 6bis" of "Paris Convention" does not have teeth and arises only if national statute allows it or on demand of concerned party. Moreover, it does not extend protection to service marks, but this position changed when "Article 6bis" of the "Paris Convention" has been enforced through "Trade Related Intellectual Property Rights" (herein after called as "TRIPS") which was adopted in 1995. "Article 16" of "TRIPS"³ had brought an additional special treatment in favour of such marks as it provides non-exhaustive guiding light to the concerned establishments of countries for assessment as to whether a mark is well-known or not. Further in order to determine well-known mark, member should consider familiarity of the mark with the related segment of the public, as well as in the member country, which has been attained as a consequence of advertisement of the mark. It is pertinent to mention that protection has been provided to well-known trade mark if it is registered and infringement is made in respect of similar or identical goods and services on ground of confusion but also in relation to dissimilar goods and services, on the conditions that firstly the infringing trademark must be used in respect of other goods or services which shows link between other goods or services and the proprietor of the well-known mark and secondly the interest of such proprietor must be likely to be effected by such use.

Now third instrument, for the safeguard of "Well-Known trademark", the WIPO's "Joint Recommendation Concerning Provisions of the Protection of the Well-Known Marks"⁴, has joined the above-mentioned treaties. These recommendations were made to clarify, consolidate and improve the prevailing safeguards for "Well-Known trademark" under the "Paris Convention" and the "TRIPS Agreement". It included comprehensive stipulations regarding consideration of mark as a "Well-Known trademark" by member states and solutions in cases of discords between "Well-Known trademark" and others. The provisions of WIPO supplement the "Paris Convention" and "TRIPS" standards by setting out a non-exhaustive list of aspects that "competent authority" could consider in determining a "Well-Known trademark" and this is considered as major innovation of the WIPO provisions as generally the question of how to consider whether a Mark as well-known is not enumerated by national statute but is entrusted to the competent authorities. In each country, the circumstances are different, so are the competent authorities or courts, which work for implementation or the defense of the trademark.

Parallel to International developments for protection to well-known marks, India had also taken steps to protect such trademarks as The Trade Marks Act 1940 was enforced in pre-independence era and vide Section 38⁵ it provided for protection to well-known trademarks. Section 38 provides for “defensive registration of well-known trademarks”. Afterword’s new statute, “The Trade and Merchandise Marks Act, 1958” was enforced which contained exactly similar provision under Section 47⁶ of “defensive registration of well-known trademarks”. Under this provision, “a trade mark consisting of any invented word has become so well-known in respect of 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, 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”. The eligibility for “defensive registration of a well-known mark” under “Section 47” can be tested on the scale as if the usage of the trademark for goods other than the registered goods is anticipated to be taken as signifying a correlation in the course of business between such goods and the “Well-Known trademark’s” proprietor. Thus, possibility of deceit was the pivotal aspect in establishing a mark being qualified as “Well-Known trademark” for registration under this section. Other essentials were that mark must be an invented one which is already registered and used quite extensively.

Those who owned well-known marks sometimes do had utilized this provision for registering their trademarks in all or some classes. For example KODAK⁷ which is said to be synonymous with cameras and films, but if another person want to use the same mark for cycles, people may wonder about its origin and may link it to original KODAK, but this defensive registration was denied to the mark BATA⁸, despite being famous trademark as it is a surname and not invented word, whereas GEEP⁹ mark was granted defensive registration despite it being phonetically equivalent to dictionary word “Jeep” because GEEP was invented from initial letters of trade style Great Eastern Electro Platers Limited. It need to mention here that “Section 47” of the “Trade and Merchandise Marks Act 1958” do not refer to dilution of the distinctiveness of the marks, but rather it deals with the dis-similar goods to show connection between goods and persons involved to use the trade marks, thus it refers to the confusion and deception of the customers caused by defendant’s use. Moreover, the burden of proof lies was on the proprietor of the well-known mark to demonstrate a link during trade amongst the intended novel merchandises and the goods already registered, but if link could not be proven, then the defensive registration was likely to be removed. Due to the restrictions levied, the defensive registration could not attain the resolve, it had initially envisioned. “Defensive registrations”

available under “Section 47” turn out to be futile in comparison to the general registrations, and it was rarely availed by users, as still remedy of passing of was available even without the facility of defensive registration. Thus, the Indian Courts from time to time had given interpretation under “Trade and Merchandise Marks Act 1958” for protecting the “Well-Known trademark” and they had applied this for opposition proceedings and passing of actions, as it found that dilution of the marks is an act of unfair competition and it also creates confusion and deception in the minds of the ultimate users. Here are some of the court decisions under the Trade Merchandise and Marks Act, which turn out to be markers in the development of precedents on well-known trademarks

In case of “Sunder Parmanand Lalwani & Ors v. Caltex (India) Ltd.”¹⁰, where opposition by the well-known trademark was allowed. In this case Caltex had opposed registration application of the mark CALTEX for “Horological and other Chronometric instruments and parts thereof” in Class 14. The opposition application was dismissed by the Deputy Registrar. Deputy Registrar held

“that the competing marks were identical but the competing goods were entirely different in character. He further held that there was no connection in the course of the trade between the competing goods as they were never sold at the same shop. He further held that the trade channels through which the respective goods passed were entirely different, and that, as a matter of fact, the opponents’ goods were exclusively available only at their own service stations or agencies where even similar goods of another trader were not permitted to be sold, much less the goods of others of a different character as those of the applicant in respect of which the mark was applied for a registration. He held that the reputation of the opponents was only in respect of the goods for which their marks were being used. He held that, therefore, despite the reputation of the opponents’ mark, the use of the applicant’s mark would not be likely to deceive within the meaning of Section 11 of the Trade and Merchandise Marks Act, 1958 (hereinafter referred to as “the Act”). The opponents had urged that the application had been actuated by dishonest intention and motive in selecting the mark, and that, therefore, the Registrar should exercise his discretion against registering the mark. The Deputy Registrar negated that contention. He dismissed the opposition; the consequence whereof would be that the applicant’s mark would be registered”.

The Single Judge of the Hon’ble High Court held that

“the applicant’s mark was not an Importer’s mark, and that the applicant was not the owner thereof. The learned Judge confirmed the Deputy Registrar’s finding that there was no danger of confusion. The learned Judge, however, held that the applicant dishonestly selected the mark, and that in view of the existence of such dishonest intention the Deputy Registrar was wrong in exercising the

discretion in favour of the applicant, and that the Deputy Registrar ought to have refused registration on that ground also. The learned Judge does not appear to have dealt in his judgment with the point whether he could interfere with the exercise by the Deputy Registrar of his discretion, and if so, on what particular grounds it would be competent for him to so interfere. The learned Judge allowed the appeal and the petition, set aside the order of the Deputy Registrar and declared that the opposition had succeeded, the necessary consequences whereof would be that the applicant's application for registration would fail"

This second appeal was rejected but the Division Bench held in favour of the opponent that

"On the facts of this case, we have no hesitation in holding that a large number of persons, if they see or hear about the mark Caltex in connection with watches, would be led to think that the watches were in some way connected with the opponents, or they would at least wonder whether they were in any way connected with the opponents. Persons seeing the mark attached to watches, which is a new class of goods, would assume, or are most likely to assume, that they originated from the proprietor of the mark, namely, the opponents. We are, therefore, of the opinion that if the application for registration is granted and the mark is used in connection with the goods in respect of which the application is made, it is likely to cause deception and confusion." Thus, it was held that even though goods of both the parties have different sale routes but goods of the opponent is used by all sections of people in India and as both the marks are similar thus there are chances of confusion. Hence concluding that the Mark which is popular amongst the population will create deception even if used on dissimilar goods.

In another case titled as *Bata India Ltd. Versus Pyarelal & Co., Meerut City & Ors*¹¹, where the Court below had disallowed an injunction application made by the plaintiff, against the Pyarelal & Co. The dispute was pertaining to use of "BATAFOAM" as trademark on rubber foam by defendant. It was held that applicant's trademark "BATA" is India's renowned label for superior footwear. Plaintiff have registrations for their trademark for many kinds of goods of rubber and leather and also got registration of their trademark in all key Indian languages along with English. Plaintiff argued that by use of the offending trademark "BATAFOAM", the other party had deceived the consumers and it is unjust enrichment through fraudulent and bad faith by passing off on the plaintiff's goodwill and reputation. It was refused by the defendants who contended that that respective businesses of both the parties are different, and as its good was marketed as "BATAFOAM", and it won't lead to confusion or deception. The plaintiff's claim was disallowed by District Court while holding that there is no registration for the mark BATA in favour of plaintiff, for goods of defendant and as the mark of defendant "BATAFOAM" is not alike in looks to the applicant's trademark "BATA", thus, there could not be any passing off. The single bench of Allahabad High

Court overturned the above decision and held that "With great respect, I regret my inability to subscribe to the view taken by the Calcutta High Court. Merely because the plaintiff in the present case is not producing foam is not enough to hold that there can be no passing off action in respect of the user of the name 'Bata' to the products marketed by the defendants. The user of the name or mark 'Bata' by the defendants is indicative of their intent. It appears that they desire to market their foam with a view to gain some advantage in a competitive market. As seen earlier, there is no plausible explanation as to why the name 'Bata' was being used by them. A passing off action would lie even if the defendants were not manufacturing or producing any goods similar to that of the plaintiff. A passing off action would lie where a misrepresentation is likely to be caused or a wrong impression created, as if the product was of someone else". "I am of the opinion that the user of the name 'Bata' to any product may give rise in the mind of unwary purchaser of average intelligence and imperfect recollection that it is a product by the plaintiff. It is this impression which may ultimately cause damage to the reputation of the plaintiff. It amounts to an invasion of his right vis a vis the name 'Bata'. The moot point to be considered in an action for passing off where goods marketed by the defendants are likely to cause an impression in the mind of the purchaser that he is buying the goods of 'Bata'. If it creates this impression, it would be a case for the grant of a temporary injunction for the duration of the suit. If this is not done, the plaintiff may suffer an irreparable injury". Thus, again the Hon'ble High Court had held use of trademark which is similar to reputed trademark, even on dissimilar goods can cause effect goodwill of the reputed trademark

Delhi High Court in the matter of *Daimler Benz Aktiengesellschaft & Anr. v. Hybo Hindustan*¹², had granted injunction in favour of Daimler Benz, the plaintiff for their BENZ logo against Indian underwear Company for passing off. The Hon'ble Court had held that logo of MERCEDES BENZ has been diluted by the defendant, who made undergarments. It is pertinent to mention here that the Court had first time had held the reputation of the plaintiff as well-known marks for granting relief of injunction holding that the Mercedes Benz is well-known in India along with its three star logo. It was further held that

"In my view, the Trade Mark law is not intended to protect a person who deliberately sets out to take the benefit of somebody else's reputation with reference to goods, especially so when the reputation extends worldwide. By no stretch of imagination can it be said that use for any length of time of the name "Benz" should be not objected to". Thus, the defendant was not allowed to dilute the name "BENZ" with regard to their product of underwear.

In a case of *Kirloskar Diesel Recon Private Ltd. & Anr. v. Kirloskar Proprietary Ltd. & Ors*¹³, dispute was regarding adopting the name of "Kirloskar" which is also a surname in India. The plaintiff was "Kirloskar Group of Companies" which have distinctive reputation and goodwill whereas

defendant was using mark "KIRLOSKAR" as their corporate name amounting as passing off. There is also allegation that this mark has been adopted in bad faith as one of the appellant/defendant was previously associated with the plaintiff and helped in creating reputation of the Company. It need to mention here that business of the respective parties was different and as per defendant, hence no chances of confusion or deception and it is also surname, thus they are eligible to use it, but plaintiff had prayed for protection of their exclusive reputation from tarnishment and the Hon'ble High Court of Bombay while relying upon the above mentioned case of Mercedes Benz, had held that "18. In passing off action, the plaintiff is not required to establish fraudulent intention on the part of the defendant and as such, it was not necessary for the respondents to establish fraudulent intention on the part of the appellants in incorporating the word 'Kirloskar' as part of corporate names of 1st appellant in each of the appeals. It was even not necessary for the respondents to prove causing of actual confusion amongst the customers or public at large by the appellants adopting the word 'Kirloskar' as part of corporate names of 1st appellant in each of the appeals. What the respondents were required to establish, which the respondents have established, is a likelihood of deception or confusion." Thus, held that such erosion of the trademark need to be protected by law of passing off, as no one can be allowed to take the advantage of somebody else's commercial reputation.

In another case, the Court got an opportunity to decide regarding the trademark registration application, where the trademark was deceptively similar to that of well-known registered Trademark. In **British India Corpn. V. Kharaiti Ram**¹⁴, the petitioners were well-established producers of shawls, blankets and have been marketing their goods from 1920 under the trade name 'DHARIWAL' with the device of lamb written in a distinctive style. The petitioner got registration of the trademark in its favour in the year 1955. The respondent's registration application pronounces their mark as DWM-DHARIWAL, for the identical goods in the same class. Actually, the opposite party was been using a portion of the proposed trade mark namely DHARIWAL, which was equivalent to registered mark of the petitioner and by removing the prefix "DWM" from the mark during actual business, an endeavour was being made to cheat the general public. This is not an honest practice as there were chances of confusion between the articles of the two producers due to use of similarity. Even the respondent no. 1 was an employee of the petitioner for 39 years till Nov. 1985, therefore, registration was justifiably refused.

In the case of Caterpillar Inc. v. Mehtab Ahmed¹⁵, the matter was pertaining to adoption of logo mark "CATERPILLAR and CAT". In this case, defendant was proceeded against ex-parte. The Court had held that there is necessity to protect the dilution of "Well-Known trademark" in order to avoid its weakening. It was held that if subsequent user adopts similar mark, it will diminish the value of trademark of the prior user, which will result in dilution

of the mark itself and such is considered as commercial invasion by subsequent user. Also it was held that there is no necessity for establishing the element of confusion and it will not be a fair practice expected in trade and commerce, thus amount to dilution by tarnishment and this act is committed generally in regard with well recognized, strong and famous marks.

The High Court of Delhi, in the matter of "Honda Motors Co. Ltd. v. Charanjit Singh & Ors"¹⁶, also held similarly as dispute was regarding the use of mark "HONDA" by defendant in connection with pressure cookers. Initially opposition was filed by the plaintiffs, which was granted in their favour in connection with nonelectric pressure cookers, but defendant applied for registration of "HONDA" as their trademark with Class 21 for "Pressure cooker". Thus, they preferred suit for passing off but the defendant taken the defence of prior use, but the Hon'ble Court had held in favour of the plaintiffs that "HONDA" had reputation for superior quality Automobiles and power equipments and using of this mark by defendant would mislead the public, letting it to believe that it had originated from the plaintiffs and will dilute the goodwill and reputation of the plaintiffs and it may cause injury to the plaintiff's Company.

In above mentioned cases and many more cases, the Indian courts had protected the rights of well-known trademarks based on deception of public and dilution of goodwill of the well-known mark.

Another parallel development in protection of well-known trademarks took place regarding its use as the traditional concept was that an un-registered Trade Mark can be protected in a country only if it has been actually used in that country. This concept is recognized as "Crazy Horse" doctrine. In a well-known case titled as **Alain Benardin V. Pavilion Properties**¹⁷, commonly known as the Crazy Horse case in England where the claimants were proprietors of an establishment in Paris called "Crazy Horse Saloon". The defendants set up an establishment in some respect similar in London advertising it under the caption as "Crazy Horse Saloon comes to London". There was evidence of deception and confusion amongst the public in England. The claimants had circulated publicity material in English through travel agencies in that country but they had no office there and took no order there. It was held that the claimants had failed to show a reputation acquired by user in England on which an action of passing off could be based. Eleven years afterward, the decision in "Crazy Horse" case was not approved in the case of Belfast¹⁸. In this case the claimant had a shop in Belfast, they advertised throughout Ireland and had customers there. It was held by Irish Court that they had a protectable goodwill in Ireland. In other words, the theory that in cases of passing off action, goodwill can't be acquired without some sort of actual manufacturing activities there, was not approved.

Quite obviously the later view is correct, in view of the increasing modernization and globalization of trade and communication technology. Therefore, the place of manufacture has no nexus with acquiring

of goodwill for the product or service outside the place of manufacture. Proof of existence of goodwill of the foreign plaintiff is sufficient to entitle him to a relief of passing off. If a consumer is habituated to using a particular brand of goods for considerably long period during which no one used that or similar marks and thereafter someone starts using the same marks a fraudulent indent may be assumed and the fraud may be redressed in the country in which it is committed irrespective of the country to which the defrauded person belongs. The traditional view adopted in the "Crazy Horse" case was not approved in England. Even it was not adopted in India. The Bombay High Court in the case of "**Kamal Trading Co. v. Gillette U.K. Ltd.**",¹⁹ held that "the goodwill is not limited to a particular country because in the present days, the trade is spread all over the world and the goods are transported from one country to another very rapidly and on extensive scale. The goodwill acquired by the manufacturer is not necessarily limited to the country where the goods are freely available because the goods though not available are widely advertised in newspapers, periodicals, magazines and in other medias. The result is that though the goods are not available in the country, the goods and the mark under which they are sold acquires wide reputation."

In the landmark judgement of "**N. R. Dongre v. Whirlpool Corporation**",²⁰ the Apex Court held that "even though there was no sale in India, the reputation of the Whirlpool company was travelling transborder to India through commercial publicity made in magazines which are available in or about in India". Dr. Justice A. S. Anand²¹, the Honourable Judge of the Supreme Court had also observed that "Indian Courts have gone beyond the cold print of the statute and granted relief to protect worldwide reputation which a trade mark has acquired, even where the trade mark as such has not been registered in India. The rapidly growing international trade makes it imperative that intellectual property rights are properly recognised and managed in different countries of the globe. National protection is no longer adequate to safeguard intellectual property rights which can easily be pirated or copied by nationals of other countries and exploited in their own market or even in international markets."

Even the Division Bench of Madras High Court in its decision in "**Haw Par Bros. International Ltd. v. Tiger Balm Co. (P) Ltd**"²², has held that the appellants/plaintiffs are entitled to get the relief of interim injunction even without actually doing any business in India. The Delhi High Court in "**Apple Computer Inc. v. Apple Leasing and Industries**"²³, had laid down that for passing off action, it was not essential for a plaintiff to do business in India to prove *prima facie* case and balance of convenience to get an order of temporary restraint and it was sufficient if plaintiff had a reputation in India.

In the case of "**Caesar Park Hotels and Resorts Inc. V. Westinn Hospitality Services Ltd**"²⁴ the Madras High Court had clearly laid down principle that "it is manifestly clear that the plaintiff in order to get the relief of interim injunction restraining the defendant from using its service mark need not

establish that they actually carry on business in this country. It is enough if they have got customers here. If they have got customers in India, it necessarily means that the plaintiff has got reputation in the general sense of the word in this country. The said reputation could be brought out by advertisement. Therefore, if the plaintiff had acquired ownership of the service mark in India, as a result of some business done in India and as a result of large scale advertisement made in foreign periodicals circulated in India and the periodicals issued in India, he would certainly be entitled to take passing off action in India."

In the case of "**Playboy Enterprises Inc. Vs. Bharat Malik and another**"²⁵, the Delhi High Court got an occasion to decide the matter pertaining to international well-known Trade Mark. Magazine "Playboy" is internationally well known. The plaintiff "Playboy" Enterprise Inc. is the registered proprietor of the mark "Playboy" in India as well as in several other countries all over the world. The registrations were more than seven years old and therefore had become conclusively valid under section 32 of the 1958 Act. The defendant published an Indian Magazine named "playway". The magazine "playway" was similar as to its ideas, contents, themes, concepts and photographs. Delhi High Court issued injunction against the defendant holding that there was deceptive similarity with intention to thrive upon the strength of reputation and goodwill of magazine "Playboy" and held that the plea that since plaintiff's magazine has no circulation in India because of legal ban and import restrictions nor is India its country of origin thus, the question of infringement of trade mark does not arise. Court decided that this argument have no substance as now-a-days the reputation or the goodwill of the brand or trade name is not confined to national borders. Trade name or brand that acquires international reputation and does not confine in the four-walls of its house. It is immaterial if there is a legal ban or import restrictions of its sale or circulation in other countries.

Thus, from above discussion, it is clear that "well-known trademarks" were always protected in India even though the Paris Convention became binding on India only on December 7, 1998. Further India was member of "General Agreement on Tariffs and Trade" commonly known as "GATT" since 1948 but when it got converted to "World Trade Organisation" i.e. "WTO" then India becomes its founding member on 1st January, 1995. It is mandatory for a member of WTO to ratify TRIPS agreement due to which India was under compulsion to enact law to protect intellectual properties by providing minimum standards as established under TRIPS Agreement due to which India had enacted the Trademarks Act 1999.

The above research points out that status of "well-known trademarks" was always secure in India. Though India was under British rule and had not ratified international treaties but through provision of "defensive registration" of "well-known trademarks" an endeavour was made to protect the "well-known trademarks" through The Trademark Act 1940. This

provision was retained in post-independence era also under "The Trade and Merchandise Marks Act 1958". Even though this provision was very rarely resorted to but through judicial interpretations the "well-known trademarks" were for always protected not only against trademarks on similar goods but also against dissimilar goods. The Indian courts had gone beyond the statutory provisions in order to protect "well-known trademarks". Already we had seen the judgement passed in the case of "Caltex"²⁶ where relief has been given to the trademark which was reputed in the large segment of people, despite the fact that the disputed trademark as well as the trade channels of both the marks were completely different. It need mention here that this judgement had come way back in 1969 when India had even not adopted the "Paris Convention". Further in year 1985, the case of "Bata"²⁷, as mentioned above was decided, where the court had pointed out the use of famous trademark "Bata" by the defendants as mala fide and had granted the relief of temporary injunction on the ground that use of "Bataform" by the defendant as their Mark is likely to cause wrong impression on the consumers. It is pertinent to mention that here again the relief has been granted for dissimilar goods. The Indian courts had even used the term "well-known trademarks" to protect the reputation of famous trademark of "Mercedes-Benz"²⁸ much before India had consented to "TRIPS Agreement" and in the judgement of "Mercedes-Benz", the court had laid down the principle of dilution of the trademark which clearly shows the evolution of law on the subject as interpretation of law had shifted from concept of deception and confusion to dilution and tarnishment of "well-known trademarks". The Indian courts had also recognized trans-border reputation of the goods which were even not manufactured or used in India. This clearly shows that Indian courts had always remained a step forward in protecting the well-known trademarks. The accession to "TRIPS Agreement" had brought the whiff of freshness to the trademark law of India as due to it India had enacted the "Trademarks Act 1999" and recognized not only the service marks but also many other kinds of marks including collective marks, smell, shape etc. The India had also incorporated into its trademark law the requisites for recognizing well-known trademarks, thus the above discussion gives us the insight into working of Indian courts which were geared up for protection of well-known trademarks much before the adoption of "TRIPS Agreement" by India. The above discussed judgements put before us the perspective of Indian courts that judicial interpretations cannot be confined within the statutory limits, but it has the courage to go beyond the shackles of legislature wherever equity demands. So, it can easily be concluded that Indian Courts had always protected the well-known trademarks and had interpreted in a way so that no one is allowed to take benefit of others reputation and this had led to easy transition from "The Trade and Merchandise Marks Act 1958" to "The Trademarks Act 1999".

Conclusion

From the discussion in the paper, it can easily be concluded that Indian Courts had always protected the well-known trademarks and had interpreted in a way so that no one is allowed to take benefit of others reputation. This had led to evolution of law on this point and finally passing of statute of The Trademarks Act 1999..

References

1. (1617) Cr Jac 468, 79 ER 400 (Vivek Kumar Choudhary, *Journal of Intellectual Property Rights* vol. 15, July 2010, pp 293-301)
2. Article 6 bis of the Paris Convention:-
 - a. "The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trade mark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.
 - b. A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested.
 - c. No time limits shall be fixed for requesting the cancellation of the prohibition of the use of marks registered or used in bad faith."
3. "Article 16 RIGHTS CONFERRED":-
 "The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use".
 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.
 Article 6 bis of the Paris Convention (1967) shall apply, mutatis mutandis, to goods or services which are not similar to those in respect of which a trademark is registered, provided that use of that trademark in relation to those or services

would indicate a connection between those goods or service and the owner of the registered trademark and provided that the interests of the owner of the registered trademark are likely to be damaged by such use.

4. www.wipo.int 26.09.2020 at 15:49

5. Section 38(1) "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 37, trade 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".

(2) "The registered proprietor of a trade mark may apply for the registration thereof in respect of any goods as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods, otherwise than as a defensive trade mark, or may apply for the registration thereof in respect of any goods otherwise than as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods as a defensive trade mark, in lieu in each case of the existing registration".

(3) "A trade mark registered as a defensive trade mark and that trade mark as otherwise registered in the name of the same proprietor shall, notwithstanding that the respective registrations are in respect of different goods, be deemed to be, and shall be registered as, associated trademarks".

(4) "On application in the prescribed manner by any person aggrieved to a High Court or to the Registrar, the registration of a trade mark as a defensive trade mark may be cancelled on the ground that the requirements of sub-section (1) are no longer satisfied in respect of any goods in relation to which the trade mark is registered in the name of the same proprietor otherwise than as a defensive trade mark, or may be cancelled as respects any goods in relation to which it is registered as a defensive trade mark on the ground that there is no longer any likelihood that the use of the trade mark in relation to those goods would be taken as giving the indication mentioned in sub-section (1)".

(5) The Registrar may at any time cancel the registration as a defensive trademark of a trademark of which there is no longer any registration in the name of the same proprietor otherwise than as a defensive trademark".

(6) "Except as otherwise expressly provided in this section, the provisions of this Act shall apply in respect of the registration of trademarks as defensive trademarks and of trademarks so registered as they apply in other cases".

6. 1) "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 trade 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".

2) "The registered proprietor of a trade mark may apply for the registration thereof in respect of any goods as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods otherwise than as a defensive trade mark, or may apply for the registration thereof in respect of any goods otherwise than as a defensive trade mark notwithstanding that it is already registered in his name in respect of those goods as a defensive trade mark, in lieu in each case of the existing registration".

3) "A trademark registered as a defensive trademark and that trademark as otherwise registered in the name of the same proprietor shall, notwithstanding that the respective registrations are in respect of different goods, be deemed to be and shall be registered as associated trademarks".

4) "On application made in the prescribed manner to a High Court or to the Registrar, by any person aggrieved, the registration of a trade mark as a defensive trade mark may be cancelled on the ground that the requirements of sub-section (1) are no longer satisfied in respect of any goods in relation to which the trade mark is registered in the name of same proprietor otherwise than as a defensive trade mark, or may be cancelled as respects any goods in relation to which it is registered as a defensive trade mark on the ground that there is no longer any likelihood that the use of the trade mark in relation to those goods would be taken as giving the indication mentioned in sub-section(1)".

5) "The Registrar may at any time cancel the registration as a defensive trade mark or a trade mark of which there is no longer any registration in the name of the same proprietor otherwise than as a defensive trade mark".

- 6) "Except as otherwise expressly provided in this section the provisions of this Act shall apply in respect of the registration of trademarks as defensive trademarks and of trademarks so registered as they apply in other cases".
7. *Eastman Photographic Co. Ltd vs John Griffiths Corpn* 15 RPC 105
 8. *Rustom Ali Molla vs. Bata Shoe Co.* AIR 1957 Cal 120
 9. Application ID 149476
 10. AIR 1969 Bom. 24
 11. AIR 1985 All. 242
 12. AIR 1994 Del. 239
 13. AIR 1996 Bom. 149
 14. 2000 PTC 171
 15. 2002 (25) PTC 438 (Del.)
 16. 2003 (26) PTC 1, 20 (Del.)
 17. 1967 RPC 581:1967 FSR 341
 18. C & A 1978 FSR 126
 19. 1988 (1) IPLR 135
 20. (1996) 5 SCC 714
 21. *Journal Section of* (1997) 6 SCC 16
 22. 1996 PTC 311
 23. 1993 (1) IPLR 63
 24. (1999) PTC 430 (SC)
 25. 2001 PTC 328.
 26. *supra*
 27. *supra*
 28. *supra*