

## IP Hotline

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### REGISTRATION OF A WELL-KNOWN MARK IN INDIA

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- India's trademark rules now include opportunity for applicants to apply to register well-known marks
- An online application must be supported by documents, such as a statement of case
- If approved, the mark will be included on the official website of the trademark registry

Enterprises often invest a great deal of money in brand strategy and marketing. A strong brand increases an enterprise's valuation and consumer base. Strong brands are in most cases easy to enforce due their reputation in the relevant markets.

As a signatory to the Paris Convention and the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs), India adopted the concept of well-known trademarks in its 1999 legislation. However, it has only recently introduced detailed rules for registration of such marks, including the evidence that the applicant must submit and the requirements that the registrar must consider.

This article answers the following questions:

- What are well-known marks and are all marks considered well known?
- What is the criteria for a mark to be considered well known?
- How does a trademark owner protect well-known marks and what are the benefits conferred by such a mark under Indian law?

### MEANING OF WELL-KNOWN TRADEMARKS

Under the Trademarks Act 1999, a 'well-known mark' means one used in relation to specific goods or services which has become well known to a substantial section of the public, in that the use of the mark in relation to any other goods or services would suggest a connection between them.

### OBTAINING A WELL-KNOWN TRADEMARK

Before March 2017, a trademark could be recognised as well known by the Indian court or by a trademark registrar. A list of such marks was also published on the trademark registry website. However, there was no process for registration of a well-known trademark.

The Trademark Rules 2017 provide a detailed process for registering a trademark as a well-known mark.

An online application must be supported by documents, such as a statement of case describing the applicant's rights in the mark and evidence in support of such a right and claim. To provide evidence for the rights of the applicant in the mark, the applicant must submit:

- evidence of use of the mark and annual sales turnover of the business using the mark;
- evidence of advertisements and publicity using the mark and related costs;
- evidence of actual or potential users of the mark;
- evidence of knowledge or recognition of the mark in India and overseas; and
- details of successful enforcement of rights with respect to the mark, if any, especially with respect to the mark being well known, including a copy of the judgment of any Indian court or registrar of trademarks determining the mark as being well known.

The registrar of trademarks then determines whether the trademark qualifies as well known. The registrar is required to consider:

- the knowledge and recognition of the mark in the relevant sections of the Indian public as a result of promotions of the mark in India;
- the duration and geographical area and extent of any use of the mark;
- the duration, extent and geographical area of any promotion of the mark (including advertising or publicity and

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- presentations at fairs or exhibitions);
- the record of successful enforcement of rights in the mark, especially recognition in India by any court or the trademark registry of the mark as a well-known mark;
- the number of actual and potential consumers;
- the number of persons involved in the channels of distribution of the goods and services; and
- the businesses dealing with the goods and services.

The following factors are not required as a condition to determine whether a trademark is well known:

- the use, registration or application for registration of the mark in India;
- whether the mark is well known to the Indian public; or
- whether the mark is well known, applied for, used or registered in any jurisdiction other than India.

Under the Trademark Rules, such an application, once filed, is examined and published in the *Trademark Journal*. On publication, any person may file an objection with the registrar to oppose the inclusion of the mark as a well-known mark. If there are no objections or any objections are overruled, the mark will be included on the list of well-known trademarks which is available on the official website of the trademark registry.

## LOOPHOLES

Under the Trademark Rules, it is not clear whether registration for a well-known mark is restricted to a specific class of goods or services, as the form does not provide for an option to restrict or identify such an application for registration. This runs contrary to the definition of 'trademark' under the Trademarks Act, which limits the protection of a mark to specific goods or services in relation to which it is used.

Further, there are no definitive guidelines or thresholds provided to enable the trademark registry to uniformly decide, among other things, what would amount to adequate use of the mark so as to ascertain whether a mark is well known.

## BENEFITS OF REGISTRATION AS A WELL-KNOWN MARK

Since a well-known mark can be registered, even if the mark is not actually used in India, this is beneficial to multinational companies for overall brand protection. If such companies do not use registered trademarks in India for a period of five years and three months, they are open to cancellation for non-use. However, well-known marks are not subject to such a provision. If a trademark is registered as a well-known mark then it will be automatically cited as the conflicting trademark in any subsequent applications and the registrar may refuse the application. This should reduce the opposition costs for the owners of well-known marks.

Further, such a registration will assist the owner of the mark in infringement and passing off actions, as the burden of proof to establish reputation among Indian consumers can be discharged easily.

## CONCLUSION

Registration of a mark as a well-known trademark is especially beneficial for multinational brands with an international reputation. Further, the introduction of a process to apply for registration of well-known trademarks is a step forward in India's efforts to provide enhanced IP protection in India. This is likely to boost confidence in India's IP regime within the global community.

– Pooja Kapadia, Aarushi Jain & Gowree Gokhale

You can direct your queries or comments to the authors

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