

JUNE 2017

NEW GUIDELINES FOR DETERMINING WELL-KNOWN TRADEMARKS IN INDIA

1. INTRODUCTION

The Office of the Controller General of Patents, Designs and Trademarks (the “CG Office”) recently notified and issued guidelines for setting out a procedure for determination of well-known trademarks in India (the “New Guidelines”).¹ The New Guidelines have been issued pursuant to Rule 124 of the Trade Marks Rules, 2017 (the “Rules of 2017”) that provides for determination of well-known trademarks by the Registrar of Trademarks (the “Registrar”).

2. PROTECTION TO WELL-KNOWN TRADEMARKS

A well-known trademark² under the Trade Marks Act, 1999 (the “Act”) is essentially a mark, which is so popular among a large section of public, that use of the same or a similar mark in relation to any other goods or services would be likely to be taken as indicating a connection between the two owners.

The Act does not provide for registration of well-known trademarks. However, the Act explicitly extends special protection to all trademarks that are recognised as well-known marks (for example, BAJAJ and Infosys) by judicial pronouncements.³

Under the Act, the protection afforded to a well-known mark against any kind of misuse is not limited to one category in which it operates commercially, but extends to all classes of goods and services. Registration and use of marks that are identical or confusingly similar to well-known trademarks are prohibited under the Act.

3. THE GUIDELINES

The Rules of 2017 brought in substantial changes to the trademarks registration process in India. Rule 124 for the first time introduced a system for determining a well-known trademark by the Trade Marks Registry. Any party interested in having their brand name or trademark included in the pool of well-known marks can now file an application for determination of a well-known trademark by the Registrar under Rule 124 (“Application under Rule 124”).

Pursuant to the Rules, the CG Office has issued the New Guidelines for filing and prosecuting Applications under Rule 124. The New Guidelines are summarized as follows:

¹ Link of the circular from the CG Office – http://www.ipindia.nic.in/writereaddata/Portal/News/333_1_Well-known_public-Notice.pdf

² Section 2 (zg) provides that a “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.

³ List of well-known trademarks in India - <https://ipindiaonline.gov.in/tmrpublicsearch/wellknownmarks.aspx>

3.1. Online-only filing

Applications under Rule 124 can be filed online only⁴.

3.2. Supporting documents

The following documents of proof are required to be submitted along with Applications under Rule 124:

- (a) A statement of case describing the applicant's rights on the mark and claims that the trademark is a well-known trademark;
- (b) Evidence in support of the applicant's rights and claim, such as:
 - Evidence showing use of the mark;
 - Documents pertaining to previous registrations;
 - Duly corroborated annual sales turnover under the subject trademark;
 - Evidence showing actual or potential customers of goods or services under the said trademark and evidence of recognition of the mark (in India and abroad);
 - Evidence showing expenses incurred in publicity and advertisement;
 - Evidence as to knowledge or recognition of the trademark;
- (c) Proof of successful enforcement of one's well-known trademark rights, if any; and
- (d) Copies of the judgments of courts in India or by Registrar of Trademarks, if any, wherein the trademark is determined as well-known.

Applications under Rule 124 are required to be considered by the Registrar based on the claims and the supporting documents. The details of the marks proposed to be included in the list of well-known marks are to be published.

3.3. Objections to Applications under Rule 124

Procedure has been prescribed for inviting objections to Applications under Rule 124 from third parties. Anyone can object to the inclusion of a trademark in the list of well-known trademarks by filing his objection with the Registrar. The objection should be filed along with supporting documents, if any.

3.4. Final decision

After deliberation by the Registrar on parties' arguments and documents submitted, an Application under Rule 124 can be allowed. A mark determined as well-known trademark is required to be notified in the Trade Marks Journal and then included in the list of well-known trademarks uploaded online.

⁴ Through the *compressive e-filing services* of trademarks made available at the official website - www.ipindia.nic.in

IndusLaw View:

With the New Guidelines in place, the process of determining well-known trademarks is expected to become more streamlined. Though the New Guidelines are an extension of Rule 124 of the Rules of 2017, they are indeed another leap in affording protection to marks which are actually well-known in India, but have not been granted such recognition by Indian courts.

Greater clarity in the procedure may have been useful. For example, it is unclear whether those marks held to be well-known by judicial pronouncements, which earlier would straight away go into the list of well-known marks maintained by the Registry, would now also be published seeking invitations for any objections.

The use of expressions such as "*the office may publish the details of trademark proposed to be included in the list of well-known trademarks*" and "*copy of the objection may be communicated to the applicant for comments within stipulated time*" in the New Guidelines do not help.

At the moment, the best possible interpretation that can be taken is that if the Registrar, while considering an application for determination of a mark to be well-known, finds that the mark has been held to be well-known by any judgment submitted along with the application, he will simply include the mark in the list of well-known marks without any publication or invitation for objections. However, if there is no such judgement, but if the documents in support are *prima facie* sufficient evidence that the mark is well-known, he will likely invite objections.

It is also pertinent to note that Rule 124 of the Trade Marks Rules, 2017 flows from Section 11(6)⁵ of the Trade Marks Act, 1999, which sets out the considerations the Registrar should have while determining a mark to be a well-known mark. Interestingly, Section 11(6) does not contemplate that the Registrar can record a database of well-known marks by inviting applications from users of well-known marks, and this section seems to be used mostly for determining well-known marks on a case to case basis.

Therefore, the new process for determination of marks to be well-known by the Registrar under Rule 124 may appear a bit overboard. However, since Section 11(6) is a fairly stand-alone principle by which the Registrar can determine marks to be well-known, Rule 124 and the New Guidelines should be of great help for recording well-known marks by the Trade Marks Registry and in fact, beneficial for the public at large.

Authors: Suneeth Katarki, Aditi Verma Thakur and Harshitha Vasanth

June 20, 2017

DISCLAIMER

This alert is for information purposes only. Nothing contained herein is, purports to be, or is intended as legal advice and you should seek legal advice before you act on any information or view expressed herein.

Although we have endeavored to accurately reflect the subject matter of this alert, we make no representation or warranty, express or implied, in any manner whatsoever in connection with the contents of this alert.

No recipient of this alert should construe this alert as an attempt to solicit business in any manner whatsoever.

⁵ 11(6) of the Trade Marks Act, 1999: The Registrar shall, while determining whether a trade mark is a well-known trade mark, take into account any fact which he considers relevant for determining a trade mark as a well-known trade mark including—

- (i) the knowledge or recognition of that trade mark in the relevant section of the public including knowledge in India obtained as a result of promotion of the trade mark;
- (ii) the duration, extent and geographical area of any use of that trade mark;
- (iii) the duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trade mark applies;
- (iv) the duration and geographical area of any registration of or any application for registration of that trade mark under this Act to the extent they reflect the use or recognition of the trade mark;
- (v) the record of successful enforcement of the rights in that trade mark; in particular, the extent to which the trade mark has been recognised as a well-known trade mark by any court or Registrar under that record.