



# ENHANCED PROTECTION

Pranit K. Nanavati outlines developments in the level of protection afforded to reputed registered trademarks in India under the new trademark law.

**B**efore the Trademarks Act, 1999 came into force in India on September 15, 2003, only passing-off action under the common law was maintainable in order to prevent violation of reputed trademarks that were not registered for the goods passed off. The new trademark law provides for statutory protection to reputed registered trademarks that may yet not have acquired the status of a well-known trademark.

Section 29(4) of the Trademarks Act, 1999 provides for statutory protection to registered trademarks having reputation in India against unauthorised use without due cause, in respect of goods not covered by registration, where such unauthorised use takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trademark. Under the old trademark law, the proprietor of a popular trademark registered in respect of some goods had a legal remedy only under the common law to prevent unauthorised use in respect of goods not covered by registration.

Well-known trademark, in relation to any goods or services, means a mark that has become well-known to the substantial segment of the public that 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.

The Registrar shall, while determining whether a trademark is a well-known trademark, take into account any fact that he considers relevant for determining a trademark as a well-known trademark, including:

- (i) 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
- (ii) the duration, extent and geographical area of any use of that trademark
- (iii) 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
- (iv) the duration and geographical area of any registration of or any application for registration of that trademark under the Trademarks Act, 1999 to the extent that they reflect the use or recognition of the trademark
- (v) 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

The Registrar shall not require as a condition for determining whether a trademark is a well-known trademark, any of the following, namely:

- (i) that the trademark has been used in India
- (ii) that the trademark has been registered
- (iii) that the application for registration of the trademark has been filed in India
- (iv) that the trademark (a) is well-known in, (b) has been registered in, or (c) in respect of which an application for registration has been filed in any jurisdiction other than India, or
- (v) that the trademark is well-known to the public at large in India.

Article 16(3) of TRIPS expands the scope of Article 6bis of the Paris Convention for the

WHILE INDIA IS INCREASINGLY GETTING INTEGRATED WITH THE DEVELOPED WORLD, THE NEW TRADEMARK LAW IN INDIA IS PUT IN PLACE AT THE APPROPRIATE TIME FOR STATUTORY PROTECTION OF REPUTED BRANDS IN INDIA THAT MAY FALL SHORT OF MEETING THE REQUIREMENTS OF A WELL-KNOWN TRADEMARK.

Protection of Industrial Property that applies to well-known marks. The new trademark law in India does not limit such enhanced protection to trademarks determined to be well-known; it has extended the enhanced protection to reputed registered trademarks that may not meet the requirements of a well-known trademark. Thus, under the new trademark law in India, in order to maintain infringement action in such a situation, wherein a reputed registered trademark is taken unfair advantage of under the pretence that the registration does not include goods that the defendant uses such or similar trademark for, the registered proprietor of such reputed trademark need only prove to maintain infringement action that the trademark is registered for some goods, that the goods in question are dissimilar, that the registered trademark has reputation in India, that the defendant uses such or similar trademark without permission, that the use by the defendant is without due cause and that the unauthorised use takes unfair advantage of or is detrimental to the distinctive character or repute of the trademark.

Indian Courts have started providing relief under Section 29(4) and at least a couple of High Court judgments are available as briefly described below:

1. Gujarat High Court, in August 2007, upheld temporary injunction allowing infringement action to be maintained against the unauthorised use in respect of spectacles where the trademark having reputation in India was registered in respect of milk and milk products.
2. Madras High Court, in June 2007, upheld temporary injunction allowing infringement action to be maintained against the unauthorised use in respect of providing hair care services where the trademark having reputation in India was registered in respect of cosmetics, hair care and beauty care products.

While India is increasingly getting integrated with the developed world, the new trademark law in India is put in place at the appropriate time for statutory protection of reputed brands in India that may fall short of meeting the requirements of a well-known trademark. Such enhanced protection obviates the need for having registration in all the classes that otherwise would be required to obtain statutory relief when goods in question are not covered by registration.

People who think that popular brands registered for some goods are up for grabs for use in respect of other goods would have a tough time escaping the expanded scope of statutory protection available in India under the new trademark law.

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His engineering experience while working with Transmission Engineering of General Motors Powertrain Engineering, Michigan, USA, includes project management of automatic transmission subsystems and powertrain-vehicle integration. Pranit has managed engineering communications with Bentley Motors, Fuji Heavy Industries, Isuzu Motors, AM General and Workhorse Custom Chassis. Pranit has provided trained engineers on automatic transmissions at GM Technical Center, India, and Tata Consultancy Services.

Pranit's legal experience includes filing and prosecuting patent, trademark, design, and copyright applications in India, and litigation involving infringement of patents, trademarks and copyrights. Pranit has drafted automotive powertrain-related US patents.

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