

**LANDMARK SUPREME COURT OF  
INDIA DECISION ON USE OF  
TRADE MARK**

The new Trade Marks Act, 1999, came into affect in India on September 15, 2003, giving recognition to well-known trade mark (see article in BULLETIN dated October 15, 2003 – Vol 58 No. 19) Just preceding the introduction of the Act comes a landmark decision of the Supreme Court of India. In the case of *Hardie Trading Ltd. v Addison Paint and Chemicals Ltd.* reported in 2003(27) PTC 241 (decided on September 12, 2003) the Supreme Court of India, while deciding a cancellation action has categorically stated that ‘use” of a trade mark as understood under Indian law may not necessarily be use upon or in physical relation to goods. The court has held that to constitute use there is no requirement for the goods bearing the mark to be physically present and made available in India. The court has held that the presence of the mark in advertisements, in invoices and in orders also constitutes use of the trade mark. While citing with approval the English decision in *Bon Matin Trade Mark* (1989 RPC 536), the court held that even the presence of the mark on price lists and promotional literature constitutes use.

On the question of cancellation of a trade mark, the court held that mere continuous non-use of the trade mark for 5 years is not sufficient. To succeed in such a cancellation action “an intent not to resume use of the mark is to be proved.” An actual intention to abandon is an essential component.

While commenting upon special circumstances excusing non-use, the court held that the fact that registered proprietor could not import its products into India owing to import restrictions, did constitute a special circumstance. Accordingly, the registered proprietor could only manufacture its goods in India, which would require an enormous investment of setting up a factory, making the entire project economically unviable. This constituted a special circumstances.

This Judgment will go a long in assisting registered proprietors of well-known marks India in maintaining their registrations.

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**LANDMARK SUPREME  
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DECISION ON USE OF  
TRADE MARK**

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