

Well-Known Trade Marks

The Trade Marks Act 1999 has finally been made effective from September 15, 2003. One of the most significant features of this legislation is the recognition of well-known trade marks. The present note shall discuss in detail.

1. Criteria for establishing a trade mark as a well-known trade mark.
2. The type of evidence required.
3. The benefits to the owner of a well-known trade mark.

I. CRITERIA FOR ESTABLISHING A TRADE MARK AS A WELL-KNOWN TRADE MARK

- i) The Registrar now has the powers to make a determination that a trade mark is a well-known trade mark in a pending proceeding.
- ii) There is no requirement that the trade mark should be well-known to the public at large in India [S. 11(9) (v)]. To be well-known the trade mark is only required to be known or recognized in a relevant section of the public. [S. 11(7)]
- iii) For ascertaining the relevant section of public, the following criteria apply :
 - a) the number of actual or potential consumers of the goods or services ; [S.11(7)(i)]
 - b) the number of persons involved in the channels of distribution of the goods or services ; [S.11(7)(ii)]
 - c) the business circles dealing with the goods or services [S.11(7)(iii)]

The trade mark is required to be well-known in only one of the relevant sections of the public in India.

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**TRADE MARKS ACT,
1999
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- iv) To be declared as a well-known trade mark there is no requirement for the trade mark to be used in India [S.11(9)(i)] or to be registered in India [S.11(9)(ii)] or for an application for registration of the trade mark to be filed in India [S.11(9)(iii)]
- v) There is no requirement for the trade mark to be well-known in any other jurisdictions other than India [S.11 (9)(iv)(a)]
- vi) There is no requirement for the trade mark to have been registered anywhere in the world [S.11 (9)(iv)(b)] or for an application to have been filed for the trade mark anywhere in the world [S.11 (9)(iv)(c)]
- vii) While determining whether a trade mark is a well-known trade mark, the Registrar is duty bound to take into account any fact which he considers relevant for determining a trade mark is well-known, including;
 - a) the knowledge or recognition of the trade mark in the relevant section of the public including knowledge in India obtained as result of promotion of the trade mark ; [S.11(6)(i)]
 - b) the duration, extent and geographical area of any use of the trade mark; [S.11(6)(ii)]
 - c) 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; [S.11(6)(iii)]
 - d) the record of successful enforcement of the rights in the trade mark; in particular, the extent to which the trade mark has been recognized as a well-known trade mark by any court or Registrar under that record.

II. TYPE OF EVIDENCE REQUIRED

- i) Details of promotion of the trade mark in India which could include;

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- a) sales promotion figures in India for as far back as possible.
 - b) sales promotion figures concerning use of the mark in major countries of the world, in particular the commonwealth countries such as U.K., Australia, Canada and Singapore and also other major countries such as U.S.A., the Gulf Countries, South Asian Countries and other countries in the European Union including Germany, Netherlands etc. where there are large sections of the Indian population.
 - c) details of advertisements in major International magazines also circulated in India.
 - d) details of publicity through satellite television channels also beamed into India.
 - e) advertisement, publicity and presentation of the mark at fairs and exhibitions.
 - f) any other form of promotion accessible to the Indian public.
- ii) Extent of use of the trade mark in India and other parts of the world, which could include;
- a) sales figures concerning use of the trade mark in India.
 - b) sales figures concerning use of the mark in major countries of the world, in particular the commonwealth countries such as U.K., Australia, Canada and Singapore and also other major countries such as U.S.A., the Gulf Countries, South Asian Countries and other countries in the European Union including Germany, Netherlands etc. where there are large sections of the Indian population.
- iii) Records of successful enforcement of rights in the trade mark world-wide including in particular, details of proceedings anywhere in the world wherein the trade mark may have been held to be well-known or famous.

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III. THE BENEFITS TO THE OWNER OF A WELL-KNOWN TRADE MARK

Once the trade mark has been held to be a well-known trade mark there are numerous benefits including :

- i) A well-known trade mark owner may be entitled to successfully oppose third party applications in respect of completely dissimilar goods.
- ii) A well-known trade mark owner can also successfully oppose third party applications for similar trade marks (as opposed to deceptively or confusingly similar trade marks) in respect of similar goods or services so long as there exists a likelihood of confusion which also includes likelihood of association with the well-known trade mark.
- iii) The Act makes the Registrar duty bound to protect well-known trade marks against identical or similar trade marks.

It is therefore apparent that obtaining a determination of a trade mark to be a well-known trade mark is highly beneficial to a brand owner.

Furthermore, it is important that all efforts be made to solicit a determination that a trade mark is well-known in any pending opposition proceeding or a proceeding that is likely to be initiated in the near future. Accordingly, we urge clients to provide us with evidence, not just sufficient to win the proceeding, but to also obtain a determination that the trade mark is a well-known trade mark under the Act. Failure to obtain such a determination may lead to complications in the future.

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