What Should It Take To Be Well-Known? Fashioning An Evidence-For-Benefits Matrix For ‘Well-Known Marks’ Under Indian Trademark Law

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Despite having one of the world’s best statutes for protecting well-known marks (‘WKMs’), the Indian judiciary’s attitude towards this area has been disappointingly bereft of assuredness or proportionality. Instead, Indian judges’ approach to offering WKM protection has dragged focus everywhere from annual balance sheets to the influence of globalization. This paper discusses the relevant provisions of the Indian statute, highlighting the protection offered to WKM proprietors and comparing these with selected international standards. This is used as the basis for splitting a decade-plus of case law into various categories according to standards employed by Courts in according to WKM status. These categories, in turn, are used to inform the central argument of the paper: an evidence-for-benefits matrix for according to WKM protection. Two conclusions are advanced. First, various types of evidence led by claimants need to be subjected to tougher standards which can be assessed on a factual gradient. Second, WKM status itself should not be treated as monolithic and should instead be divided into a spectrum of rights to be apportioned based on the quality of evidence produced by claimants.

Keywords: Well-known marks, Trade Marks Act, 1999, Paris Convention, WIPO Joint Recommendation, trademarks

Daimler Benz and the Opening Salvo

“I think it will be a great perversion of the law relating to trademarks,” began Justice Narain in Daimler Benz,1 “if a mark of the order of [‘MERCEDES BENZ’]...is humbled by indiscriminate colourable imitation by anyone...Such a mark is not up for grabs – not available to any person to apply upon anything.”2

“There are marks which are different from other marks,” he continued, “there are...marks which have become household words. ‘BENZ’ as a name of a car would be known to every family that has ever been used as a quality car. The name ‘BENZ’, as applied to a car, has a unique place in the world. Nobody can plead in India...that he is unaware of the word ‘BENZ’ as used with reference to [cars].”3

Despite being issued nearly ten years before the Indian Trade Marks Act statutorily recognized “well-known marks” (“WKMs” hereafter),4 the Daimler Benz judgement remains undisturbed near the summit of legal authority in the country that captures the thinking behind the elevation of certain trademarks to the status of WKMs.

In retrospect, two things stand out about Justice Narain’s short parable above. First, it is broad enough to extend without attenuation in effect to trademarks of any type, relating to any kinds of products or services, originating anywhere in the world (indeed, the WIPO Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks seven years later noted as much while identifying passing off and rent-seeking by squatters as the biggest reasons for custom-made legal protection for WKMs).5 Second, and perhaps more remarkably from a legal standpoint, the test is unapologetically factual, placing at the centre of the inquiry the average consumer on the street.

Thus, when the Indian Supreme Court made the Daimler Benz test more accessible in 1996 by extending WKM protection to marks unregistered in India and loosening requirements for claimants to demonstrate use of the mark within the country,6 India’s WKM law was, for all intents and purposes, TRIPS-compliant well before TRIPS was established as a minimum standard.

True to form, India’s post-TRIPS Trade Marks Act, 1999 went comfortably beyond the baseline set in Article 6 bis of the Paris Convention and Article 16(3) of TRIPS, activating a raft of WKM standards and protections in Sections 11(6) to (11) of the new Act and displacing the defensive registration system under the old Section 47. These changes were important

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enough to gain prominent acreage in the Statement of Objects and Reasons of the new Act and an assessment characterizing Indian Act as among the most progressive WKM legislations in the world at the time would not have been far wrong.  

The decade-plus, since then, however, has seen an odd inversion of this progress, with the Indian judiciary frequently struggling to apply or justify the application of these thorough statutory standards. While the robustness of the Act means that any judicial damage done is far from terminal, India’s judicial engagement with WKM law is urgently in need of a re-think. How this re-think should occur and how best it can be implemented is the central focus of the rest of this paper.

**Why are Well-Known Marks Protected?**

The reasons for the introduction of WKM protection are, interestingly, mischief-driven. In upholding the standard that WKM status can be accessed by a claimant with proof of the mark being well-known in at least one relevant sector of the public, the WIPO Joint Recommendation notes that a more stringent test is undesirable since it would not further the purpose of WKM protection, which is to prohibit passing off or squatting on WKM by unauthorized parties. Indian law has sharpened this rationale to one of consumer-serving prevention of dishonest adoption, especially in cases where the use of the WKM is in relation to products or services that could likely mislead consumers into assuming a connection between the dishonest use and the WKM proprietor.

There is also stable – if slightly thinner – precedent which locates the reason for WKM protection in proprietor-centric ‘warranty of quality’ justifications more in tune with traditional trademark law. However, there has been little development of these rationales worth mentioning, with judicial focus having bizarrely been redirected to finding pre-1999 precedent for WKM protection rather than how or to what extent these rationales operate in increasingly informed and segmented modern markets.  

Art 6 bis of the Paris Convention is frequently identified as a starting point for WKM law but it is, at best, a trifle self-involved – it did not address what WKM are but merely set a few reasonably porous boundaries around what WKM ought to be. Even in this embryonic form, however, it set two conditions that remain at the core of WKM even today – that there is no requirement for country-specific registration for WKM in order to access protection in that country and that any trademark, identical or similar to a WKM, will not be registered.

This was expanded by Article 16 of TRIPS in two important ways – first, it suggested that the knowledge of a relevant section of the public be the barometer to judge whether a mark had attained WKM status and second, it significantly elevated the degree of protection offered to WKM to include dissimilar goods and services.

**Well-Known Marks under the Indian Trade Marks Act**

The Indian Trade Marks Act incorporates all these conditions and usefully extends this basic framework in three further directions. First, Section 11(7) of the Indian Act follows Article 2(2)(a) of the WIPO Joint Recommendation in populating the inquiry into the “relevant section of the public” by covering within the scope of the expression actual and potential consumers, persons involved in the channels of distribution and the business circles dealing with the products/services in question. This appears to be an inexhaustive and flexible list of considerations, though the focus in the language is firmly on the number of persons so acquainted with the mark rather than qualitative association of any kind.

Second, Section 11(6) of the Indian Act replicates the WIPO Joint Recommendation’s list of relevant factors in a WKM inquiry (“positive factors”), namely, the knowledge or recognition of the mark in the relevant section of the public; the duration, extent and geographical area of any use or promotion of the mark and the record of successful enforcement of the mark. There are some differences between the WIPO Joint Recommendation factors and the Section 11(6) factors but their sum total merely points to the fact that the Indian position is slightly more sclerotic on proof of use in the form of trademarks applied for or granted.

Third, and perhaps equally important, Section 11(9) lists factors that are not to be considered pre-conditions for accessing WKM status (“negative factors”), which include use, filing of an application or registration in India and abroad and, as a corollary of the “relevant section of the public” inquiry in Section 11(7), establishment as a WKM to the public at large in India.

The prominent deficiencies in this language are as unhappy as they are consistent across the Indian Act and the WIPO Joint Recommendation. The positive
factors are open-ended with the condition that any, all, combination or none of these factors may be relevant to the determination, which lends flexibility to the judicial authority making the determination, but perhaps too much so. The Indian Act mitigates this slightly by couching these factors in mandatory terms but simultaneously leaves it open to the judicial authority to “take into account any fact [considered] relevant”20 in this inquiry.

The onus of supplying the material that informs these positive factors is on the applicant21 but critically, the judicial authority is not allowed to insist on the presentation of any particular criteria – the choice as to what material is produced to secure WKM status is left entirely to the party in question.22 Further, as Section 11(9) demonstrates, the negative factors under the Indian Act do little more than set fairly liberal outer limits on material that cannot be insisted on. However, even so, the evidentiary standard is, in theory, higher than the one used to gauge reputation,22 though the concepts remain fungible in practice.

On the substantive side of the equation, while Indian law does not benefit WKM proprietors over and above regular registered proprietors in terms of the similarity standards required to be met, it would appear that WKM proprietors can obtain injunctive relief by demonstrating any one of three factors – no due cause for adoption of the mark, taking unfair advantage of the mark or detriment to the mark.23 This constitutes a significant advantage and chimes with the position under the UK Act, for instance, which exempts WKM proprietors from having to demonstrate actual damage, leaving the door open for even the most rudimentary of quia timet actions.24

Further, under Section 11(10), WKM proprietors benefit from full prosecutorial protection in the twin sense that a burden is cast on the Registrar to not only ensure that a WKM proceeds to registration when applied for but also to ensure that action is taken to block identical or similar trademarks during prosecution or opposition. In sum, therefore, proof of WKM status is essentially a bypass for the tests of objective and relative grounds of refusal of a trademark under Sections 9 and 11 of the Act – advantages which are unique to WKM proprietors over other registered proprietors.

In essence, the scheme of the Indian Trade Marks Act in relation to WKMs is fairly straightforward. Section 2(1)(zg) captures the core of Article 6 bis and the WIPO Joint Recommendation while simultaneously ensuring that it keeps a safe conceptual distance from potentially confusing categories such as marks having “a reputation in India”,25 the latter being a part of the substructure of an infringement inquiry under Section 29(4).

This is buttressed by a series of notes for interpretation carried in the Draft Manual for Trademark Practice and Procedure which provide some extremely functional thumb rules in respect of facts to be considered and evidentiary standards to be applied for WKMs. To distinguish between WKMs and marks with reputation in India, for instance, the Draft Manual suggests that while proof and details of the market share of the claimant may not be a necessary condition to establish the latter, it will be an appropriate inquiry in case of the former, with separate, industry-specific factors – such as those in the case of financial services – to be considered on a case-to-case basis.26

Simultaneously, the Trade Marks Registry maintains a public record of marks recognized as WKMs – a list that currently dates back to 1990 and Vicks27 but one whose genealogy can, without much difficulty, be traced back to what may safely be called “élite trademarks” going at least as far back as Phillips28 in 1983. [As a logical extension of this, proof of the claimant’s mark being a part of this record automatically entitles the mark to WKM status,29 though recently, an interesting, if pedantic, debate has emerged on whether recognition by a legal authority outside this public record would similarly function as open-and-shut proof of WKM status.30]

Categorizing Indian Case Law on Well-Known Marks

Since then, Indian judicial engagement with the standards to be applied and upheld in according WKM status to trademarks has helpfully, though surely unintentionally, resolved itself into four neat categories.

The first of these covers cases where the judiciary is satisfied with the reasons and/or evidence offered by the claimant in favour of its WKM claim but does not discuss it, aside from merely noting the factum of its production by the claimant. This is despite the fact that there is broad consensus that even though the Trade Marks Act in Section 2(1)(zg) and Section 11 in particular offers a useful structure to evaluate WKM claims, the qualification of a mark as a WKM is decidedly a question of evidence.31
Indeed, the sum total of WKM qualification analysis in several important decisions has been limited to a perfunctory acknowledgement that the claimant is entitled to WKM status merely on account of “material placed on record”. While these instances are understandable from the perspective of judicial brevity, their frequency remains frustrating. This is not because the evidence supporting the endorsement of a particular trademark in such cases as a WKM based on material placed on record is lacking but because the lack of disclosure in these judgements of the nature, character and quality of this material makes it impossible to understand what the reasons for the endorsement were in the first place.

The second line of cases is one where the reasons and/or evidence offered by the claimant in favour of its WKM claim are themselves identified and classified into sub-categories but their judicial recognition is limited to an ambivalent nod of approval. These sub-categories variously include proof of the claimant’s trademark registrations, applications and domain names in India and abroad, the claimant’s income, sales and profits, recognition of the claimant’s mark by third parties, including other traders, customers and the media, the claimant’s advertisements and publicity reports and the amounts spent on them and the duration of the claimant’s use of the mark. This de facto “overall checklist” approach goes at least as far back as 1997 but has, particularly post-2011, emerged as the most popular judicial method of treating WKM claims.

While this method has largely been accompanied by a fairly thorough and diligent treatment of the facts of individual cases, it can be a dangerous line to run because of how susceptible it is to being used in an insidiously reductive manner. Indeed, there is an alarmingly large number of cases (volumes in terms of numbers of decided cases remain extremely relevant, of course, to gauging the relative evidentiary weight assigned by judicial precedent to individual factors in a checklist-style inquiry) where a mere iteration of the legal standard(s) for what constitutes a WKM without anything further has sufficed for a WKM finding.

While this may have been understandable in older cases where a lack of engagement with facts could be forgiven on account of a lack of clarity in the Indian statute pre-2003 or where ex parte proceedings make it structurally onerous to subject the claimant’s evidence to the same standards of proof, few decisions stand to be mitigated for such reasons. As such, these decisions are best sidestepped but cannot, by law, be ignored.

A third category of cases in this area embellishes the overall checklist method by focusing on one standout factor, vetted by proof adduced by the claimant, which entitles the claimant to an unqualified WKM finding. The emphasis on individual factors naturally shifts depending on the category of products or services relevant to the claimant’s mark but, over a period of time, the range of even these individual, standout factors is an impressive one.

It is an eclectic set of factors, too, including everything from recognition in international brand rankings, global and regional valuation of the mark, detailed data of year-on-year turnover and promotional spending prior to the rival business’ existence and even a successful history of enforcement of its trademark rights to more conservative and perhaps expected factors such as striking proof of sales/marketing expenditure, print media presence and long and uninterrupted use.

The final set of precedents is underpinned by and explicitly recognizes the need for WKM status to be accorded more liberally on account of the sudden spike in exposure for trade names owing to the complex and ubiquitous nature of corporate ownership and new media today. This was a justification first articulated by the Delhi High Court in Hyundai, where it linked the reputation acquired by a trademark to the growth and specialization of corporate structures and functions and underlined the need for WKM protection in such cases to the umbrella organization, even if the actual use of the mark was dissipated across several individual member corporations.

Tata Sons v Manoj Dodia and Beyond

The Hyundai justification was taken a step further with a powerful passage in Tata Sons Ltd v Manoj Dodia, one which is worth reproducing in full:

“A well-known trademark is…widely known to the relevant general public and enjoys a comparatively high reputation amongst them. On account of advancement of technology, fast access to information, manifold increase in international business, international travel and advertising/publicity on internet, television, magazines and periodicals, which now are widely available throughout the world, of goods and services during fairs/exhibitions, more
and more persons are coming to know of trademarks which are well known in other countries and which, on account of the quality of the products being sold under those names and extensive promotional and marketing efforts, have come to enjoy trans-border reputation. It is, therefore, being increasingly felt that such trademarks need to be protected not only in the countries in which they are registered but also in the countries where they are otherwise widely known in the relevant circles so that the owners of well-known trademarks are encouraged to expand their business activities under those marks to other jurisdictions as well...

Another reason for [this] growing acceptance...is that [when] a person using a well-known trademark...tries to take unfair advantage of the [reputation] which that brand enjoys in the market and thereby tries to exploit and capitalize on the attraction and reputation which it enjoys amongst the consumers... [he] tries to take advantage of the goodwill that [the] well-known trademark enjoys and such an act constitutes unfair competition.”

This rationale, the Court felt, was tailor-made to sustain a WKM finding in favour of the Tata Group, which had used the trademark “TATA” across various classes of products and services for over a century, generated a turnover (at the time) of over Rs. 96,000 crores and had led evidence to render irresistible the conclusion that millions of consumers associated the mark with the group of companies to the exclusion of anyone else.50

The expansion of WKM protection post-Manoj Dodia and based on this “new media” reasoning has been steady, though not entirely without questions on the eligibility of certain trademarks for WKM status even under this looser standard.51 Curiously, Manoj Dodia was instrumental in securing a raft of WKM declarations in short order in other infringement actions for the same claimant52 – a startling recent example of the judicial domino effect with one decision breaking the glass ceiling for several others and, for the Tata Group at least, a genuine instance of a gift that keeps on giving.

Another consequence of the judicial institutionalization of “new media” as a ground for relaxing WKM requirements has been that it has gradually shoved to the side the question of whether physical presence of the claimant’s mark in India is necessary for accessing WKM status. In 2007, Carrefour53 had suggested that some form of presence in India such as a physical place of business or subsisting commercial agreements with Indian parties was the bare minimum for a WKM claim to be sustained. However, since, Manoj Dodia, this requirement has been de-emphasized in contested cases,54 though a WKM claim in the extreme case where there is a complete absence of any physical connection with India has recently been rejected.55

A third, somewhat underappreciated outcome of Manoj Dodia has been its value in consolidating the Indian trademark law on dilution56 and, specifically in the WKM context, supporting the extension of WKM protection to cases where second-party use has been in relation to dissimilar products and services.57

The extension to dissimilar products and services, while integral to a wholesome understanding of WKMs, had been oddly restricted in terms of judicial authority until recently. The search for a succinct judicial manifestation of this extension begins and ends with Bloomberg,58 which emphasizes not just the maintainability of actions against such rival users that was never in doubt but also, in effect, limits the WKM claimant to merely having to establish that such rival use would “likely to be taken as indicating a connection in the course of trade”59 between the claimant and the rival user, in consonance with Section 2(1)(zg).

These propositions have understandably been followed without complaint since then,60 though the zealousness to reproduce the Bloomberg ratio in full has resulted in the odd judicial embarrassment where facts from previously decided cases have found their way into others.61

The final post-Manoj Dodia conclusion, though one it touches on only incidentally, revolves around the nature of WKMs themselves and whether constituting part or whole of a composite mark would disentitle a mark from qualifying as a WKM. On this issue, Manoj Dodia established clearly (though, to be fair, it was a straightforward conclusion given the facts of the case) that WKM protection would usually extend to the mark so identified, whether used alone or in conjunction with another mark or device.62

As such, it is consistent with the substantive equivalent of this issue – i.e. whether falling on a particular side of the distinctiveness/genericness spectrum would restrict the accessibility of WKM status ex ante – in respect of which Marico63 has held that the law leans in favour of invented/arbitrary marks64 but descriptive marks may also qualify as
WKMs if duration of use and customer identification with a single source can be established.

Towards an Evidence-for-Benefits Matrix for Well-Known Marks

It is evident that any efforts to recast the Indian law on WKMs must tackle both issues discussed so far – firstly, the suitability of the legislative standards offered by Section 2(1)(zg) and Section 11 of the Trade Marks Act and secondly, the manner in which these standards are judicially applied.

Apropos of these issues, two fairly uncontroversial claims emerge from the Indian judicial treatment of WKM claims analyzed above. The first of these speaks to a scattergun approach in terms of identifying facts that should populate the ideal evaluation of a WKM claim. This poses a fundamental question that needs to be answered en route to assimilating the extent to which the judicial net should be cast in a WKM inquiry – what factors and evidence ought to be considered by judges in identifying WKMs and is there an order of priority to these factors inter se?

The second observation that falls to be concluded is that the judicial consideration of evidentiary standards required to be met by WKM claimants has been wildly uneven. This inconsistency is exacerbated by the fact that the entitlement to WKM status has here to fore been considered (conceptually, at least) an uncomplicated binary. This begs a second key question – should the inability to establish certain evidentiary factors limit the WKM rights accessible to claimants and, if so, to what extent?

Both these questions may be fruitfully addressed by combining and reconstructing the legislative and judicial treatment of WKMs in the form of a cumulative evidence-for-benefits spectrum, as mentioned in Table 1:

<table>
<thead>
<tr>
<th>Category</th>
<th>Evidence led</th>
<th>Extent of WKM recognition</th>
<th>Category</th>
</tr>
</thead>
<tbody>
<tr>
<td>(1)</td>
<td>Judicial acknowledgement of WKM status [Section 11(8)]</td>
<td>Full prosecution priority against future applicants [Section 11(10)] + Entitlement to WKM declaration, including ex parte declaration, against rival mark applied to similar products or services</td>
<td>(A)</td>
</tr>
<tr>
<td>(2)</td>
<td>Factors relevant for WKM determination [Section 11(6)]</td>
<td>(A) above + Mere demonstration of a prima facie link between the marks i.e., exemption from establishing likelihood of association [Section 2(1)(zg)]</td>
<td>(B)</td>
</tr>
<tr>
<td>(3)</td>
<td>On ground, tangible proof of recognition by the relevant section(s) of the public [Section 11(7)]</td>
<td>(B) above + Entitlement to full WKM declaration against rival mark applied to dissimilar products or services [Bloomberg + Section 2(1)(zg)]</td>
<td>(C)</td>
</tr>
<tr>
<td>(4)</td>
<td>Evidence of distinctiveness qua the general public over and above Section 11(6)(i) [Article 8(2)(c) of the CTMR]</td>
<td>(C) above + Entitlement to relief, including ex parte relief, in quia timet actions without proof of actual damage</td>
<td>(D)</td>
</tr>
<tr>
<td>All of the above [(1)+(2)+(3)+(4)]</td>
<td>Full WKM status [(A) + (B) + (C) + (D)]</td>
<td></td>
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</tr>
</tbody>
</table>

actively prejudice the WKM so granted because of the inevitable sedimentation of evidence supporting the WKM claim, which may be undesirable in view of “new media” evidence led by similar but distinct rival marks.

As such, splitting the benefits of WKM status to permit Category (1) evidence to access Category (A) WKM status [Section 11(10) benefits allied to a WKM declaration in respect of similar products or services] is as proportional as it is intuitive.

Category (2), which covers cases where the claimant has fulfilled the more traditional factors to access WKM status, accordingly merits not only Category (A) status but also a liberation from the requirement of having to establish a likelihood of association between the contesting marks. The latter
is specifically justified because the presumption raised by an establishment of the Section 11(6) factors and, in particular, the duration, extent and geographical area of promotion and use [Sections 11(6)(ii) and (iii), which appear, by judicial consensus, to be the most relevant factors] stands to be rewarded with a concomitant lowering of burden on the claimant.66

However, given that these factors can still theoretically be met by fairly rudimentary evidence such as use in neighbouring territories, in territories where the same language is spoken and territories with trade channel and media coverage overlaps67 – evidence which seems fairly dated today – it does not quite justify the extension of the benefit of sustaining actions against rivals trading in entirely dissimilar products or services.

This benefit should, therefore, be accorded in the event the claimant is able to enter evidence to specifically meet the conditions captured in Section 11(7) i.e., evidence which demonstrates recall value among the relevant section of the public [Category (3) corresponding to Category (C) above]. Given the speculative way in which Section 11(7) has been assumed in favour of claimants in India, though, two important safeguards stand to be incorporated.

The first of these emerges from a frowning reconciliation of the fact that, despite their elaborative nature, Section 11(7) factors for evaluating recognition in the relevant section of the public is distinctly biased in favour of the impression carried by the end-consumer. The suggestion that the impression carried by other actors in the production or supply chain should be included in the “relevant section of the public”, especially where the function of the trademark is primarily as an indication of origin, has received only feeble acknowledgement.68

This should certainly be a more prominent part of the judicial investigation into the “relevant section of the public” and, perhaps, even the inquiry into the role of the end-consumer can be sharpened to cases where the economic behaviour of the consumer has demonstrably been altered as a consequence of the use of the conflicting mark.69

Secondly, and entirely independent of the evidentiary rigour demanded by Section 11(7), the inquiry into who the “relevant section of the public” needs to be far more detailed than under status quo. The WIPO Joint Recommendation recognizes that consumer surveys and opinion polls are valuable tools in this determination but unfortunately does not prescribe standards or quantitative baselines for such evidence.67 The employment of such economic tools in WKM cases in India has also been disappointingly thin,70 making it difficult to fix benchmarks for evidence of this nature.

Finally, Article 8(2)(c) of the CTMR is an instructive legal standard which require WKMs in the European Union to be “widely diffused without losing its distinctive character” in relation to the general public – a standard that could meaningfully be used to cap the evidentiary set required to be rolled out by a WKM claimant [Category (4) above]. This standard goes over and above the “substantial segment of the relevant section of the public” which the Indian Act holds so dear and is a strong basis for granting full, context-independent WKM rights. While this condition does, admittedly, conflict with Section 11(9)(v) which says that it should not be a sine qua non for accessing WKM status, the latter is clearly intended to be a gatekeeper provision on which basis further WKM rights could be accessed rather than a factor on which basis WKM status cannot be accorded.

In a circumstance where recognition by the general public is established by a claimant, the WKM in question would evidently be a transcendent one and would merit protection not just in prosecution and in consequential litigation but also preemptively,71 including in qui timet cases [Category (D) above], as is the case under the UK Act, for instance.

In view of the evidentiary gradient and proposed WKM benefits highlighted above, the cumulative effect of Categories (1) through (4) should, therefore, entitle the claimant to full WKM status. However, Indian law would do well to require claimants to link this distinctiveness qua the general public to proof of use and advertising in each case instead of permitting claimants to shoehorn Sections 11(6)(iv) and (v) compliances in the stead of a more thorough WKM inquiry. This is critical, not least to keep a tight rein on the objectivity of WKM standards and enforce judicial discipline, since soft, ex parte declarations by Courts are frequently and too easily becoming the basis for claimants to assert full-blown WKM rights for the same marks further down the road, without so much as a perfunctory inquiry into the tougher, more factual requirements under Sections 11(6)(i)-(iii).

Further, as a general rule, this evidence/benefits matrix should apply with equal vigour to ex parte
cases, except as specified. Indeed, there is no reason why the absence of contesting defendants should absolve claimants from having to meet evidentiary standards to access a status that is robustly defined by statute.

Conclusion

Making sense of the Indian law on WKMs at a distance, what is perhaps most striking is the endeavour and zeal of the judiciary in accounting for as many factors as possible in determining whether a trademark is worthy of WKM protection. This much is evident from the glut of more recent judicial decisions, especially those post-Manoj Dodia, which have profitably exploited the “new media” line of reasoning in order to cover and emphasize several contemporary factors that would perhaps have otherwise been left out of a WKM inquiry.

The compromise to be made in this context, inevitably, is with the text of the Trade Marks Act itself which, as its history and comparison with international equivalents indicates, offers an extremely thorough set of conditions that must be met before granting WKM protection. In many ways, it is an impossible trade-off – one which requires the quality of evidence led by claimants to be judged in light of the sheer breadth of the statutory factors Indian judges are bound to consider. This paper has put forward one possible way to strike this balance, though it must be acknowledged that the matrix suggested is responsive to case law that has come before it, rather than attempting to account for any determinants that may engage the Indian judiciary in the future.

While there can (and, indeed, should) be healthy disagreements over which model is best suited to answer the dynamic demands of proprietors seeking WKM protection, it is clear that whatever path is followed must be consistent with the reasons for which WKMs were given separate legal recognition in the first place. As Indian case law on this subject testifies, gleaning these reasons from a veritable ocean of jurisprudence has not always been an easy task.

However, there can be little disagreement that, at its foundation, WKM protection should be employed to entitle a special segment of proprietors to protect their reputations and businesses from harm, even where there is no real risk of confusion. The heightening of this standard of protection for a subclass of claimants above the protection offered to other registered proprietors is definitely controversial. However, it should be seen as a just reward for meeting what are undoubtedly the toughest evidentiary standards trademark law has to offer.

References

1 Daimler Benz v Hybo Hindustan 1994 (14) PTC 287 (Del).
2 Daimler Benz v Hybo Hindustan 1994 (14) PTC 288 (Del).
3 Daimler Benz v Hybo Hindustan 1994 (14) PTC 290 (Del).
4 By curious accident, Indian judicial treatment of WKMs goes at least as far back as 1992 and Weston Electronics v Weston Industries AIR 1992 Del 340. However, the use of the expression ‘well known mark’ connoted no specific legal significance in the context of the case and the adoption of the phrase was likely on account of the lack of easy English language alternatives to express the category of trademarks being referred to.
6 NR Dongre v Whirlpool 1996 (16) PTC 583 (SC).
7 Problems of attribution in this area of trademark law are not inconceivable since legal and evidentiary standards have and continue to be frequently and confusingly conflated in reference to related but disparate concepts such as “well-known marks”, “famous marks”, “trans-border reputation”, “acquired distinctiveness” and “secondary meaning”, among others.
8 However, Section 2(1)(zg) of the Trade Marks Act identifies WKMs as a standalone legal category, consistent with the Paris Convention, TRIPS and the WIPO Joint Recommendation and it is in this sense that the expression is used hereafter; Kailasam K C & Vedaraman R, Law of Trade Marks & Geographical Indications (2nd edn, Wadhwa Nagpur, New Delhi), 2005, 235-236.
9 Cadbury India v Neeraj Food Products 2007 (35) PTC 95 (Del) and Nestle v Jai Ram 2009 (39) PTC 514 (IPAB).
10 Beiersdorf AG v Ajay Sukhwani 2009 (39) PTC 38 (Del).
11 Jupiter Infosys v Infosys Technologies 2012 (49) PTC 383 (IPAB).
12 Rolex SA v Alex Jewellery 2009 (41) PTC 284 (Del).
13 In so doing, TRIPS also expands the similarity inquiry to an evaluation of whether the competing mark offends the “essential part(s)” of the WKM (an inquiry presumably beyond mere identity or similarity of the competing mark to the WKM as a whole) – a textual difference that serves as an important concession to WKM claimants but one which has not, thus far, picked up much attention in India. Another contribution of Article 16 was the extension of WKM protection to services.
14 To be sure, Section 2(1)(zg) of the Indian Act fixes this requirement at a “substantial segment” of the relevant section of the public. In fact, there is even some genuine – albeit slightly misdirected – judicial authority to state that a WKM status cannot be accorded to a claimant without evidence of the availability of journals carrying promotional material and proof of the volumes of their circulation. Venkateswaran S, Venkateswaran on Trade Marks & Passing Off: Volume 1 (5th edn, LexisNexis Butterworths Wadhwa Nagpur, New Delhi), 2010, p. 1111.
“The duration, extent and geographical area of any promotion of the trademark” under Section 11(6)(ii) is a concession to Article 16 of TRIPS, though the Indian Act does not insist – as TRIPS does – that this promotion be specific to India. Kitchin D et al., Kerly’s Law of Trade Marks and Trade Names (14th edn, Sweet & Maxwell, London), 2007, p. 418.

Section 11(6) includes the duration and geographical area of trademark applications/registrations to demonstrate use or recognition while the WIPO Joint Recommendation does not and the latter includes a reference to the value of the mark which the former does not.

Sections 11(6) (iv) and 11(8) of the Trade Marks Act, 1999; This bias in favour of proof of engaging with country-claimants from WKM status where there has been continuous (accessed on 3 October 2015).

It does still remain a debate that can be reopened in the future. Presumptions functional acquiescence and disentitles claimants from WKM status where there has been continuous use of a rival registered trademark for five years or more. Kitchin D et al., Kerly’s Law of Trade Marks and Trade Names (14th edn, Sweet & Maxwell, London), 2007, p. 419.

Sections 11(9)(i), (ii) and (iii) of the Trade Marks Act, 1999.


Section 11(9)(iv) of the Trade Marks Act, 1999.

Section 11(9)(v) of the Trade Marks Act, 1999.

Section 11(6) of the Trade Marks Act, 1999.


Ashok Leyland v Blue Hill Logistics 2011 (46) PTC 535 (Mad); Interestingly, the Supreme Court has ruled that, despite the definitional qualifications placed on WKM’s, a key difference between WKM’s and marks with reputation is that the latter are typically restricted to a particular territory, category of products or services, category of population, linguistic section of the public and so on. As such, even though WKM status is treated for all intents and purposes as a level above marks having reputation in India, theoretically, it does still remain a debate that can be reopened in the future. TV Venugopal v Ushodaya Enterprises (2011) 4 SCC 85.


Richardson Vicks v Vikas Pharmaceuticals 1990 PTC 16.


Tata Sons v Shamim [Delhi High Court judgement dated 17 August 2012 in CS(OS) 1428/2009] and Mahindra & Mahindra v MN Marketing 2014 (60) PTC 227 (Bom); The same conclusion follows in the event that the rival user admits to the well-known nature of the claimant’s mark. Living Media v Adarsh Gupta MIPR 2010 (1) 78.

Societe Des Produits Nestle v Swaraj Industrial and Domestic Appliances 2013 (56) PTC 94 (IPAB) and, per contra, Kamat Hotels v Royal Orchid Hotels 2015 (61) PTC 60 (Mad).

Paragon Steels v Paragon Rubber 2009 (6) KarL J 566.

Agro Tech Foods v Sadhu Churilal 2009 (40) PTC 33 (Del), Red Hat v Hemant Gupta 2012 (51) PTC 422 (Del), The Timken Co v Timken Services 2013 (55) PTC 568 (Del), Microsoft Corporation v Kurupat Venkata 2014 (57) PTC 601 (Del) and The Coca Cola Co v KM Salim 2014 (59) PTC 641 (Del).

Initial attempts at grappling with the idea of using a carousel of evidentiary factors of this nature include Horlicks v Kartick Sadhukan 2002 (25) PTC 126 (Del), Aktebolaget Volvo v AK Bhuta 2006 (32) PTC 682 (Del), Intel Corporation v A Sailesh 2007 (34) PTC 492 (Del), Tata Sons v AK Chaudhury 2009 (40) PTC 54 (Del) and Tata Sons v Tata Sumo Industrial [Delhi High Court Judgement dated 19 November 2009 in CS(OS) 1837/2006].

Omega SA v Avanti Kopp Electricals 2003 (27) PTC 327 (Mad).

General Electric v J Singh (2011) II AD (Del) 18, ICICI Bank v Chauandong Xu 2012 (49) PTC 291 (Del), Lavasa Corporation v Lavasa Visuals 2013 (56) PTC 231 (Bom), S Oliver Bernd Freier v Rasul Exports 2014 (58) PTC 630 (Del), Yahoo! Inc v Firoz Nadiawala 2014 (58) PTC 352 (Del), Ford Motor Co v CR Borman 2014 (59) PTC 132 (Del); Jockey International v R Chandra Mohan 2014 (59) PTC 437 (Del), Triumphant Institute of Management Education v Time Coaching/Education 2014 (59) PTC 529 (Del), Cargill India v Quality Agro Mills [Delhi High Court judgement dated 20 March 2014 in CS(OS) 3305/2012], Havells India v TT Plyboards 2015 (61) PTC 513 (Del) and Virgin Enterprises v Virgin Paradise 2015 (61) PTC 145 (Del).

KK Aggarwal v NIIT 2013 (54) PTC 178 (Del), NRB Bearings v Windsor Export 2014 (60) PTC 75 (Del), Pfizer Products v MN Patel [Delhi High Court judgement dated 6 August 2014 in CS(OS) 3271/2012] and Jaguar Land Rover v Saurabh Khaneja 2014 (58) PTC 357 (Del).


Tata Sons v Ghassan Yacoub 2004 (29) PTC 522 (Del).

See note 12.

AP Moller-Maersk AS v Maersk Mining [Delhi High Court judgement dated 1 June 2012 in CS(OS) 1787/2012].


Castrol v Mahendra Automobiles 2011 (48) PTC 336 (Del).

See Bharti Airtel v Airtelasia [Delhi High Court judgement dated 8 September 2014 in CS(OS) 2476/2013] and Cadila Healthcare v Medipol Pharmaceutical 2014 (58) PTC 650 (Del).

Kalpataru Properties v Kalpataru Hospitality 2011 (48) PTC 135 (Bom).
46 Infosys Technologies v Marwadi Inforsys 2009 (41) PTC 622 (Del), Castrol v Thakur Dassochh 2012 (52) PTC 580 (Del), Peretti Van Melle v Ramkrishna Food Products 2014 (58) PTC 203 (Del) and VIT University v Bagaria Education MIPR 2015 (2) 0095.

47 Hyundai Corporation v Rajmal Ganna 2007 (35) PTC 652 (Del).

48 An excellent counterfactual to this scenario i.e., where the corporation is well-known but the mark in question may not be, was addressed in UTO Nederland v Tilaknagar Industries 2012 (49) PTC 249 (Bom).

49 2011 (46) PTC 244 (Del).

50 2011 (46) PTC 246-247 (Del).

51 2011 (46) PTC 252 (Del).

52 Consider, for instance, Pioneer Hi-Bred v Pioneer Agrovision [Delhi High Court judgement dated 23 December 2014 in CS(OS) 1626/2013] and its distinctly shaky appraisal of WKM evidence, bailed out eventually by its reliance on Manoj Dodia.

53 Indeed, Manoj Dodia has been subsequently used to recognize the WKM status of the ‘TATA’ trademark with very little appreciation of evidence as filed. This was certainly the case in Tata Sons v Hoop Anin 2012 (49) PTC 373 (Del), Tata Sons v Ashok Kumar [Delhi High Court judgement dated 15 October 2014 in CS(OS) 1993/2013] and Tata Sons v SP Singh 2015 (62) PTC 558 (Del).

54 Carrefour v V Subburaman 2007 (35) PTC 227 (Mad).

55 Ex parte cases tend to be far easier on WKM evidentiary thresholds even in cases where little or no physical presence in India is demonstrated. See Clinic Laboratories v Gufic 2009 (41) PTC 41 (Del).

56 Hypnos v Hosur Corr 2015 (62) PTC 374 (IPAB).

57 ITC v Philip Morris 2010 (42) PTC 572 (Del).

58 2011 (46) PTC 246-247 (Del).

59 Bloomberg Finance v Prashul Sahlecha 2013 (56) PTC 243 (Del).

60 Bloomberg Finance v Prashul Sahlecha 2013 (56) PTC 257 (Del).

61 Brahmos Aerospace v Brahmos Garments 2014 (60) PTC 381 (Del), Brahmos Aerospace v FIITJEE 2014 (58) PTC 90 (Del), Citigroup v Citicorp Business 2015 (61) PTC 612 (Del) and Choice Hotels v MS Kumar 2015 (62) PTC 269 (Del).

62 RBS Group v Sharekhan 2015 (61) PTC 573 (Del).

63 2011 (46) PTC 252 (Del).

64 Marico v Agrotech Foods 2010 (44) PTC 736 (Del).

65 Polo/Lauren v Royal Classic Mills [IPAB judgement dated 19 March 2008 in OA/44/2006/TM/CH], which held the field pre-Marico, had, in fact, borrowed from Nutrine v Ayyan Fireworks [TA/16-17/2003/TM/CH (TMA Nos. 6-7/1998)] and cast this as a strict condition, shutting out descriptive marks of all types.

66 There is perhaps also an argument to suggest that this lowering of burden should be accompanied by a relaxation of evidentiary burden while considering the reasonable accessibility of certain types of evidence to the claimant, especially proof of vintage use.


69 Intel Corp v CPM UK (Case C-252/07, decided 27 November 2008).

70 Jolen v Shobhanal Jain 2005 (30) PTC 385 (Mad).

71 Binno v OHIM (Case T-357/11, decided 14 December 2012).

72 Helena Rubinstein v OHIM (Case C-100/11P, decided 10 May 2012).