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IP Focus



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Since: 1991

INTTL ADVOCARE is a law firm based at New Delhi, India, specializing in the field of intellectual property rights and information technology. It offers broad spectrum of professional services pertaining to advisory, prosecution and enforcement issues in the field of trade marks, copyrights, industrial designs, patents, cyber squatting, border measures, computer software piracy, geographical indications, traditional knowledge, unfair competition, unfair trade practices, consumer protection laws, corporate laws, commercial documentation, licensing, foreign collaborations, transfer of technology agreements and franchising, IP audit, due diligence etc.

The firm has grown in the Indian sub-continent as also having a network of Associates in Asia and other continents. INTTL ADVOCARE has multi-jurisdictional practice, handling IP litigation and prosecution on an all India basis through its associate offices at Mumbai, Chennai, Kolkata, Bangalore and Ahmedabad.

INTTL ADVOCARE has had the privilege of representing some of the biggest and leading brands in the industry including but not limited to Foods and Beverages, Liquor, Garments, Cosmetics, FMCG, Fashion Accessories, Computer Software, Telecommunication, Aviation, Information Technology, Media, Electronics, Telemarketing Industry, Pharmaceuticals, Automobiles, Biotechnology and Process Engineering.

INTTL ADVOCARE was established in 1991 by **Hemant Singh**, the founder partner of the firm, and a leading IPR litigation lawyer at New Delhi, India, who joined the bar in 1984 and has been exclusively practicing in the field of Intellectual Property Rights for more than two and a half decades.



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Well-known trade marks explained

Prietika Singh and Dheeraj Seth of Intl Advocare discuss the registrability of well-known trade marks

The concept of having well known status in the area of trade marks now has new horizons affording wider protection to good faith proprietors of well known trade marks against infringers.

The concept of well known trade marks is expansive in nature. Pursuant to Article 6 *bis* of the Paris Convention, countries are empowered to grant a trade mark well-known status if the relevant authorities deem it so after taking into consideration all relevant and necessary factors.

Marks enjoying well-known status get wider protection, in addition to the standard grounds for trade mark infringement, irrespective of class of goods and/or services being of different nature and description. Commonality of field of activity is not any more a pre-requisite for an infringement or passing off action.

In cases involving well-known marks, the courts not only consider the issue of likelihood of confusion or deception in the marketplace but even consider the fact that any misuse of a well-known mark will take unfair advantage and may cause detriment to the distinctive character inherent in the well-known mark.

The situation before the Indian Trade Marks Act, 1999

Even before the introduction of Trade Marks Act, 1999, well-known marks enjoyed protection under common law of passing off. There were several cases decided in India before the Act of 1999, where a well-known mark was afforded protection regardless of the field of activity under the common law of passing off.

Principles governing well-known status

Over the years, the following principles for protection of well-known trade marks have emerged from the interpretation of treaties such as the TRIPs agreement and the Paris Convention as well as judicial pronouncements:

- The opponent is not required to carry on any business within India and is not required to possess any registrations, to be entitled to claim protection of its trade mark;
- Cross-border and spill over reputation of a foreign trade mark is valuable intellectual property which ought to be protected;
- Misappropriation of internationally famous trade marks is not permissible;
- Bad faith adoption, use and registration of another's trade mark is not permissible; and
- Commonality of goods or services is not a condition precedent to constitute a test of passing off.

Marks enjoying well-known status get wider protection, in addition to the standard grounds for trade mark infringement

To comply with its international obligations, India has introduced the concept of well-known trade marks in the Act. The term "well-known trade mark" has been defined in Section 2 (1) (zg) of the Act as follows:

"S 2 (1) (zg) "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 use of such mark in relation to other goods or services would be likely to be taken as indicating connection in course of trade or rendering of services between those goods or services and person using the mark in relation to first mentioned goods/ services."

Section 11(6), 11(7) and 11(9) of the Act specifically deal with following factors that the Registrar shall take into consideration while determining that the trade mark is a well-known mark:

- (i) Knowledge or recognition of that trade mark in rele-

- vant section of the public including knowledge in India obtained as a result of promotion of the trade mark;
- (ii) Duration, extent and geographical area of any use of that trade mark;
- (iii) Duration, extent and geographical area of any promotion of trade mark, including advertising or publicity and presentation, at fairs or exhibitions of goods/services to which the trade mark applies;
- (iv) 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 use or recognition of the trade mark;
- (v) record of successful enforcement of rights in that trade mark, in particular, extent to which the trade mark has been recognised as well-known trade mark by any Court or Registrar under that record.

A trade mark may be limited to colours or combinations of colours

The Act also provides that where a trade mark has been determined to be well-known in or at least one relevant section of the public in India by any Court or Registry, the Registrar shall consider that trade mark as a well-known trade mark for registration under this Act.

Provisions dealing with well-known marks were explicitly set out in the leading judgement by the Intellectual Property Appellate Board at Chennai in the case of *Soci t  Des Produits Nestl  SA vs Jai Ram*, where relevant factors for determining a mark as well known by a relevant sector of public were determined to be duration, extent and geographical area of any use of the mark. It was further held that the purpose of the Act is not only to protect the proprietor of the trade mark but also the public at large, who would be the victims of deception and confusion. Maggi, the trade mark of the applicants, was considered as having acquired wide reputation among the public at large by sales and advertisements in relation to culinary products. Hence, the mark Maggi of the respondent was not allowed to remain on the register, even though it had been registered for safety razors, on the grounds that Maggi is a well known trade mark and its use, even for safety razors, is likely to create an association and linkage between the businesses of the parties.



In *Shell Brands International AG and Anr vs Mr Pradeep Jain*, the Delhi High Court held that Shell, the plaintiff's mark for petroleum products, was well known and had acquired secondary significance due to long usage. However, the word Shell was still a common dictionary word and if words of common parlance are used for their common parlance significance, then such use constitutes due cause justifying its use. In such circumstances, lack of commonality of goods or services is grounds to permit use of such trade mark by another party and no monopolistic right can be conferred in respect thereof. Merely because a trader acquires registration (of a mark) does not mean that they become its exclusive owner. The defendant's use of Shell was confined to its corporate name for textiles and bedcovers trade. The defendant manufactured covers or shells of

quilts/sheets, which are then filled with stuffing. It did not participate or engage in petroleum or allied business. Nothing on record suggested that petroleum products were associated with the export of Shell bedcovers. In

these circumstances, the Court denied injunctive relief and damages.



Trade mark limitations

A trade mark may be limited to colours or combinations of colours. In case of honest concurrent use or of other special circumstances that in the opinion of the registrar make it appropriate, the registrar may permit registration by more than one proprietor of trade marks that are identical or similar (whether any such trade mark is already registered or not) in respect of same or similar goods or services, subject to any conditions and limitations that the registrar may see fit to impose.

A trade mark is not registrable if it:

- is not distinctive or capable of distinguishing goods or services of one person from those of another person;
- consists exclusively of marks or indications that are directly descriptive of any characteristics or qualities, quantity, intended purpose, values, geographical origin or time of production of goods or services; or
- comprises generic names and marks common to trade.

It is clear that there is no exclusive right in generic marks as held in the important case of *Heinz Italia vs Dabur*. Heinz filed an infringement suit against Dabur

using the mark Glucose-D on the ground that the mark is phonetically and visually similar to its registered trade mark Glucon-D. The Kolkata High Court as well as Supreme Court rejected the claim on the ground that Glucose-D is a generic mark and its use cannot be prevented, notwithstanding similarity with Glucon-D.



Also in the case of *Cadila vs Dabur*, two leading ayurvedic preparation manufacturers of India were sued by Cadila, a leading manufacturer of artificial sweetener on account of use of mark Sugar Free since 1988 for artificial sweeteners. The Court rejected Cadila's claim to prevent others from using the generic mark Sugar Free on the ground that no one can claim monopoly on such words, which are in the public domain.



A trade mark is also not registrable if:

- because of its identity or similarity to an earlier trade mark and identity or similarity of goods or services covered by the trade mark, there exists likelihood of confusion on the part of public, and there is a likelihood of association with an earlier trade mark;
- its use in India is liable to be prevented by virtue of the law of passing-off or copyright law;
- a mark is filed in bad faith to affect the rights relating to the earlier trade mark.
- it will by its very nature deceive the public or cause confusion;
- it contains matter likely to hurt people's religious sensibilities;
- it contains scandalous or obscene matter; or
- it contains or consists of any matter, the use of which is prohibited by the Emblems and Names (Prevention of Improper Use) Act 1950.

A trade mark is not registrable for shapes of goods: if the shape is the natural shape of the goods; the shape of goods is necessary to obtain a technical result; or the shape gives substantial value to the goods;

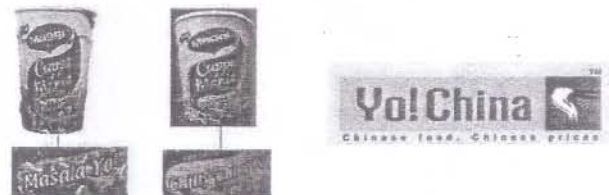
In the case of *Smithkline Beecham (SKB) vs Hindustan Lever Limited (HLL)*, the Delhi High Court rejected the claim of passing off filed by Smithkline

Beecham in respect of the shape of the tooth brush against Hindustan Lever (Unilever India) on the ground that the shape was primarily functional and utilitarian and therefore not capable of trade mark protection.



Smithkline Beecham *Hindustan Lever Limited*

Further, in order to maintain an action by the owner of a trade mark against an infringer, it is important that the infringer should be using the mark as a trade mark and not merely in a descriptive manner. This concept is amply illustrated in the case of *Moods Hospitality vs Nestle*, a case on non-use of a trade mark in which the owners of Yo! China, a Chinese restaurant chain, filed a case against Nestlé, objecting to its using the mark Masala Yo! and Chilly Chow Yo! as flavour descriptors on its Maggi Cuppa Mania noodle packaging. The Division Bench refused to grant an injunction on the ground that use of the mark Yo! by Nestle is not a trade mark usage, and hence does not amount to infringement. It was also clarified that protection for goods does not automatically give protection for services and vice versa.



India's classification system

The fourth schedule of the Rules provides classification of goods and services which corresponds to international classification as laid out in the Nice Classification. The fourth schedule has been amended in the notification dated May 20 2010 and is divided into two parts: classes 1 to 34 (goods) and 35 to 45 (services).

The pre-existing Class 42 read as follows:

"Providing of food and drink; temporary accommodation; medical, hygienic and beauty care; veterinary and agricultural services, legal services, scientific and industrial research; computer programming; services that cannot be classified in other classes."

After the amendment, class 42 has been substituted and now states:

"42. Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of

computer hardware and software.

43. Services for providing food and drink; temporary accommodation.

44. Medical services, veterinary services, hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.

45. Legal services; security services for protection of property and individuals; personal and social services rendered by others to meet needs of individuals.”

With this amendment there is apparent transparency

in services of trade mark owners and it brings the fourth schedule in sync with the Nice Classification.

The norms of registrability of trade marks in India are well established and have been reasoned out through various judicial pronouncements. Well-known marks are also recognised in India, but the burden of proof has to be discharged for the claim. The addition of classifications of services is a good initiative and points to positive steps being taken by India to fall in line with international norms.

Prietika Siingh



Prietika has practised in India for more than 26 years. Prietika spent her initial legal career at Hindustan Unilever, India's largest fast moving consumer goods Company and a 51% owned subsidiary of Anglo-Dutch multinational Unilever. She left her high-profile job in 2007 and joined the legal profession. Thereafter for two years she was a retainer for Hindustan Unilever and Reliance Hsez, among the larger business houses. Since 2007, she has also been associated with INTTL Advocare Intellectual Property Attorneys, initially as senior associate and presently as partner.

Her vast experience of more than 26 years has helped her to develop good interpersonal skills and she is adept at leading a large team of lawyers both in-house and external to ensure effective delivery, interacting with senior management to give business friendly solutions. Prietika has a rich experience in handling IP prosecution and enforcement matters. She comes up with innovative solutions to complex issues. Presently she is heading the prosecution team at INTTL Advocare. Under her guidance and leadership, the prosecution team is growing from strength to strength.

Dheeraj Seth



Dheeraj Seth is a senior associate at INTTL Advocare. Having more than nine years of experience in the field of trade mark and copyright prosecution, Dheeraj leads a team of competent lawyers in initiating and contesting trade mark applications, oppositions, rectifications, assignments and licensing and is also responsible for initiating international trade mark filings. Dheeraj has been rendering opinions on various complex IP issues. Dheeraj has also been actively involved in criminal and civil enforcements in respect of infringing and counterfeit goods. He is member of the Bar Council of Delhi.



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IP issues are vital for any company that wants to do business in India. As the country's economy expands and its IP system develops, the challenges posed to IP owners have evolved to include new topics such as ambush marketing, online IP infringement and the protection available to well-known trade marks.

This guide, the seventh produced by Managing IP and the largest ever, provides an essential update on important developments to India's IP system such as pharmaceutical patent disputes, planned amendments to the country's copyright law and the consequences of India's forthcoming accession to the Madrid Protocol. It also includes a series of articles giving practical advice on how to protect and enforce patents, copyrights and trade marks in this key market.

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