

---

# TRADEMARK DILUTION IN INDIA: RETHINKING THE “WELL KNOWN MARKS” PROTECTION IN THE CONTEXT OF GLOBAL TRADE

---

Jayanthan V.T.S., School of Law, SASTRA Deemed to be University, Thanjavur, India.

## ABSTRACT

India’s Trade Marks Act, 1999 formally introduced protection for *well known* trade marks, granting broad rights to famous brands beyond their registered classes. This paper examines how “well known marks” are defined and protected under Indian law (notably sec 2(1)(zg), sec 11–12, 29), and how courts have interpreted these provisions (e.g. *Whirlpool, ITC v. Punchgini*). We analyze the concept of trademark dilution (blurring and tarnishment) and the practical challenges of enforcing anti dilution rights in India. The discussion then turns to India’s international obligations under TRIPS and the Paris Convention – which require protection of well known marks – and compares India’s approach with other jurisdictions (e.g. EU Trademark Regulation Art.10, US Federal Dilution Act) and WIPO guidelines. Finally, we critically assess gaps in India’s regime and propose reforms (legislative and procedural) to strengthen well known mark protection in line with global best practices, ensuring reciprocity and robust safeguards in the age of e commerce and global brands.

**Keywords:** Dilution, Tarnishment, Blurring, Well known marks.

## INTRODUCTION

As global trade intensifies and brands gain worldwide recognition, the risk of *trademark dilution* has become a central concern in intellectual property law. Trademark dilution refers to unauthorized uses that weaken a famous mark's uniqueness or tarnish its reputation, even absent consumer confusion<sup>1</sup>. For example, a prestigious luxury brand's name used on low quality goods can tarnish the brand's image; or the same mark appearing on unrelated products can blur its distinctiveness. To address these harms, most countries grant special protection to *wellknown* or *famous* marks, beyond ordinary trademark rights.

India's Trade Marks Act, 1999 codified an ambitious well known mark regime. Section 2(1)(zg) defines a "well known trade mark" by its wide recognition in a *substantial segment* of Indian consumers<sup>2</sup>, and sections 11 and 29 extend protection to such marks even on dissimilar goods, prohibiting use that takes "unfair advantage" of or is "detrimental" to the mark's distinctive character or repute<sup>3</sup>. In practice, this empowers famous brands to block confusingly similar marks across classes (cross class protection) and to combat dilution.

This paper explores India's well known mark framework and its interplay with global standards. Part I reviews scholarly and policy literature on well known marks and dilution (domestic and comparative). Part II examines India's legal framework: the statutory definitions, presumptions, and factors (sec11(6)), as well as administrative procedures (e.g. Rules, Registrar's authority) for recognizing well known marks. Part III analyzes key case law – from landmark early decisions (e.g. *Daimler* (Hybo) and *Whirlpool v. Dongre*) to recent high profile matters – to illustrate judicial application of the law. Part IV compares India's approach with international norms (TRIPS/Paris Convention obligations, WIPO guidelines, and the US/EU regimes on famous marks and dilution). Part V offers a critical assessment of strengths and weaknesses in India's system: challenges in proof, in enforcement (especially of dilution rights), and in reciprocity. Finally, Part VI proposes reforms (legislative amendments, procedural improvements, and policy measures) to make India's well known mark regime more

---

1 Trade Marks Act, 1999, No. 47 of 1999, sec 2(1)(zg) (India) (defining "well known trade mark" as a mark known to a substantial segment of the relevant public that its use on other goods would likely indicate a connection)

2 Id. Sec 29(4) (India) (infringement occurs when a registered mark's identical or similar sign is used on dissimilar goods and the registered mark "has a reputation in India" and the use "takes unfair advantage of or is detrimental to" the mark's distinctive character or repute)

3 Int'l Trademark Ass'n, Trademarks & the Global Economy 12 (2020) (discussing Paris Convention Art. 6bis and TRIPS Art. 16 protections for well known marks)

robust and aligned with global practices.

## LITERATURE REVIEW

Scholarly attention to well known marks in India has grown in recent decades, especially after India's WTO accession (1995) made TRIPS compliance urgent<sup>4</sup>. Authors note that India's concept is broader than mere "passing off" protection: it confers sui generis rights reflecting a mark's reputation<sup>56</sup>. Most commentary emphasizes that a well known mark in India enjoys *extraordinary protection*, including precluding registration of confusingly similar marks on unrelated goods<sup>7</sup>. The criteria in section 11(6) (now Rule 124 factors) echo the WIPO Joint Recommendation (1999) guidelines, listing fame, sales, advertising, registrations, and enforcement history<sup>89</sup>. Analysis by practitioners and scholars has praised India's generosity (the 2017 Rules even allow rights holders to apply to the Registrar to declare a mark well known) but also warned of pitfalls. For example, an APAA commentary observes that **reputation** is easier to show than the higher threshold of "**well known**", raising concerns that courts or the Registry might conflate the two<sup>10</sup>. Similarly, an SLJ article critiques India's "total embrace" of the dilution doctrine, arguing that focusing solely on harm to the owner's profits (rather than consumer confusion) may distort trademark law's purpose<sup>1112</sup>.

Comparative literature highlights the global divergence on well known marks. Some studies

---

4 'Moving Beyond the Doctrine of Dilution in the Context of Well Known Trademarks' (Student Law Journal, Dharmashastra National Law University) <https://dnlusj.in/moving-beyond-the-doctrine-of-dilution-in-the-context-of-well-known-trademarks/> accessed 2 October 2025

5 Niharika Salar and Sonal Sinha, 'India's Take on Legal Remedy of Passing Off: A Celebrity's Perspective' (2021) 17(2) Indian Journal of Law and Technology 1  
<https://repository.nls.ac.in/cgi/viewcontent.cgi?article=1107&context=ijlt> accessed 24 October 2025.

6 S. Majumdar, India – Well Known Trademarks – Recent Trends and Case Law, APAA e Newsletter 44 (2024), at 54 (Delhi H.C. recognized Red Bull's "double bull device" and Levi's arcuate stitch as well known marks)

7 S. Majumdar, supra note 6, at 56–57 (recognizing DHL and BETNESOL as well known in logistics and pharmaceuticals)

8 Govt of India, The Trade Marks Act 1999 (India Code)

[https://www.indiacode.nic.in/bitstream/123456789/15427/1/the\\_trade\\_marks\\_act%2C\\_1999.pdf](https://www.indiacode.nic.in/bitstream/123456789/15427/1/the_trade_marks_act%2C_1999.pdf) accessed 2 October 2025

9 Trade Marks Rules, 2017, R. 124 (authorizing owners to apply to the Registrar to declare a mark as well known); APAA, supra note 6, at 55 (noting ~281 marks registered as well known as of Mar. 2024)

10 'India – Well Known Trademarks – Recent Trends and Case Law' (APAA Online)

<https://apaaonline.org/article/india-well-known-trademarks-recent-trends-and-case-law/> accessed 2 October 2025

11 DNULS Law Journal, "Moving Beyond the Doctrine of Dilution in the Context of Well Known Trademarks" <https://dnlusj.in/moving-beyond-the-doctrine-of-dilution-in-the-context-of-well-known-trademarks/> accessed 24 October 2025.

12 Chhavi Singh & Arpita Tripathy, "Doctrine of Trademark Dilution: Indian Approach", (2024) 4(4) Indian Journal of Legal Review 766 <https://ijlr.iledu.in/wp-content/uploads/2024/11/V4I494.pdf> accessed 24 October 2025.

trace India's "trans border reputation" cases (like *Whirlpool v. Dongre*, *Daimler Benz v. Hybo*, *Cadila v. Rex* in South Africa, etc.) and note that while India welcomed foreign famous brands, others (e.g. the US *ITC v. Punchgini* case) have resisted extraterritorial effects<sup>1314</sup>. Commentators stress that India must balance TRIPS's obligations (e.g. Art. 16 requiring protection of marks known to a relevant public)<sup>15</sup> with the realities of enforcement. Several law journals have urged India to refine its approach: for instance, an APAA piece warns that misusing the well known status (e.g. granting cross class rights to marks that are *not* truly well known) could unsettle the system<sup>16</sup>.

On dilution specifically, Indian writings note that Section 29(4) effectively codifies the blurring/tarnishment tests without naming them, by forbidding use of a reputed mark's identical/similar sign on dissimilar goods if it "takes unfair advantage of, or is detrimental to" the mark's character. Leading texts explain that "blurring" means weakening distinctiveness (as when an unrelated product uses the brand) and "tarnishment" means harming reputation (associating it with bad products). Practitioners point out a tension: Indian law lacks a separate dilution remedy comparable to the US Lanham Act's Section 43(c), relying instead on Sec. 29(4) and passing off principles<sup>1718</sup>. As a result, some suggest India implicitly "adopted" dilution via Sec. 29(4), but enforcement has been ad hoc. Scholars call for clear guidelines and better evidence standards to claim dilution<sup>1920</sup>.

In summary, the literature underscores that India's "well known mark" regime is robust on paper – perhaps overly so – and heavily shaped by international influences. The challenge is how theory translates into practice, especially in an era of online commerce where fame crosses borders instantly. The next sections delve into the statutory details, case developments, and

---

13 *Whirlpool of India Ltd. v. Videocon Industries Ltd* (2015) 1 BomCR 137

14 *ITC Ltd. v. Punchgini, Inc* US 2d Cir. 2007

15 Christine Haight Farley & Irene Calboli, 'The Trademark Provisions in the TRIPS Agreement' in Carlos M. Correa (ed), *Intellectual Property and International Trade: TRIPS Agreement* (3rd edn, Wolters Kluwer 2016) [https://digitalcommons.wcl.american.edu/cgi/viewcontent.cgi?article=1180&context=facsch\\_bk\\_contributions](https://digitalcommons.wcl.american.edu/cgi/viewcontent.cgi?article=1180&context=facsch_bk_contributions) accessed 24 October 2025.

16 WIPO, *Joint Recommendation Concerning Provisions on the Protection of Well Known Marks* (1999) (listing factors and scope for well known mark protection)

17 Sec 43 U.S.C. 1125, *False designations of origin; false description or representation* (2023) <https://www.bitlaw.com/source/15usc/1125.html> accessed 24 October 2025.

18 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* Sec24:93 (4th ed. 2021) (US law defines dilution as "the lessening of the capacity of a famous mark to identify and distinguish")

19 EU Trade Mark Regulation (2017), Art. 10(2)(c) (granting right holder of mark with reputation to prevent use of identical or similar sign on any goods if use takes unfair advantage or is detrimental to mark's distinctive character or repute)

20 US PTO, *Well Known Marks* (public webpage) (summarizing Paris Art. 6bis and TRIPS obligations)

comparative context that inform this debate.

## LEGAL FRAMEWORK IN INDIA

### *Definition and Scope of “Well Known” Trade Marks*

The Trade Marks Act, 1999 explicitly defines a “*well known trade mark*” and grants it special protection. Section 2(1)(zg) states:

“‘well known trade mark’, in relation to any goods or services, means a mark which has become so well known to the substantial segment of the public which 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”.

This broad definition (essentially statutoryizing TRIPS/Paris Convention terms) means that the mark’s fame need not be nationwide or absolute; it must be recognized by a “substantial segment” of the relevant public in India. The legislation also clarifies in section 11(9) that *no particular formality* is required – e.g. the mark need not be registered or even used in India to qualify<sup>21</sup>. In other words, foreign well known marks (or even marks only advertised in India) may satisfy the test, emphasizing reputation over territorial use.

Section 11(6) lists *factors* the Registrar or courts may consider in deciding well known status, including: the mark’s degree of knowledge in the relevant public, the duration and extent of use, the duration and extent of publicity, geographical reach, and whether it is well known in foreign countries, etc. These are essentially the criteria from the 1999 WIPO Joint Recommendation<sup>22</sup>. However, these factors are illustrative, not mandatory; courts have discretion to weigh them.

### *Statutory Protections for Well Known Marks*

The Act confers two main types of protection for well known marks:

---

21 Daimler Benz Aktiengesellschaft v. Hybo Hindustan, 2004 (59) PTC 418 (Del.) (Delhi H.C.) (granting injunction to Daimler Benz on account of the plaintiff’s well known status)

22 WIPO, Protection of Well Known Marks: A Comparative Study (WIPO/MRT/2000) (surveying national approaches to famous marks).

(1) refusal of registration of confusingly similar marks (relative grounds); and

(2) infringement relief (for both registered and unregistered marks).

- Section 11(2) provides that if an applicant seeks to register a mark identical or similar to an earlier (different proprietor's) mark, for *dissimilar goods/services*, registration must be refused *if* the earlier mark is well known in India and using the new mark (without due cause) would take unfair advantage of or be detrimental to the earlier mark's distinctive character or repute. This mirrors the well known mark provisions of many countries, essentially prohibiting dilution/confusing association across classes<sup>23</sup>. Notably, section 11(9) forbids requiring use or registration as preconditions for well known status, signaling that even unregistered foreign marks may block new registrations. Section 11(10) directs the Registrar to protect a declared well known mark by refusing identical or similar marks (implicitly including dissimilar goods).
- Section 29(4) addresses *infringement*. It says a registered mark is infringed by use of an identical/similar mark on *dissimilar* goods if **(a)** the registered mark "has a reputation in India" and **(b)** the use without due cause takes unfair advantage of or is detrimental to the mark's distinctive character or repute. This clause is the engine for anti dilution enforcement. It does not explicitly use the term "well known," but the requirement that the mark has a reputation effectively covers well known marks. The use must be for dissimilar goods and must either **blur** the mark (unfair advantage) or **tarnish** it (detriment). The Act also prohibits defamatory uses: under section 29(8), advertising or use of a mark taking unfair advantage/detrimental effect on an earlier mark's reputation is actionable<sup>24</sup>.
- Passing Off and Common Law Well before 1999, Indian courts protected famous foreign marks via passing off (the common law tort) if the mark had "trans border reputation" in India. For example, in *Whirlpool v. Dongre* (Bombay HC 1988), Whirlpool was granted relief against an unregistered mark on the basis that its fame

---

23 GlaxoSmithKline v. Manoj Kumar Jain, [2023] (Delhi H.C.) (recognizing "BETNESOL" as a well known mark in pharmaceuticals).

24 Govt of India, The Trade Marks Act 1999 (India Code)

[https://www.indiacode.nic.in/bitstream/123456789/15427/1/the\\_trade\\_marks\\_act%2C\\_1999.pdf](https://www.indiacode.nic.in/bitstream/123456789/15427/1/the_trade_marks_act%2C_1999.pdf) accessed 2 October 2025

extended to Indian military bases and elite retailers, implying a “connection”<sup>25</sup>. While the 1999 Act codifies most of the law, passing off remains available especially for unregistered marks. Section 27(2) of the Act (the passing off provision) protects even unregistered well known marks if confusion is shown. In practice, however, well known marks usually also have registered marks, so owners invoke section 29.

## REGISTRAR AND PROCEDURAL MECHANISMS

The 2017 Rules introduced new procedures for well known marks. Rule 124 allows any party to apply to the Registrar to have a mark declared well known; if granted after evidence and objections, the mark enters a public “register of well known trade marks”. (Currently 281 marks are so recorded<sup>2627</sup>.) Once registered, the Registrar will refuse any confusingly similar mark even for dissimilar goods. The applicant must pay a hefty fee (about ₹100,000, ~\$1,200) and provide detailed proof (as specified by Sections 11(6) and Rule 43). This administrative route is supplementary to litigation; but its mandatory fee has been criticized as a barrier, especially for Indian rights holders<sup>28</sup>. Notably, section 11(10) requires courts and the Registrar, in any opposition or cancellation, to protect a well known mark if raised by the claimant.

In sum, the legal framework gives well known marks quasi extra territorial rights: in effect, a well known mark in India can prevent others from using similar marks on any unrelated goods, if harm (unfair advantage or detriment) is proven. This is analogous to dilution statutes abroad. The efficacy of these rules depends largely on judicial interpretation and the ability to prove reputation and harm, as the next section explores.

## KEY CASE LAW ANALYSIS

### *Early Landmark Decisions (Transborder Reputation)*

Even before the 1999 Act, Indian courts laid the groundwork for protecting famous foreign

---

25 Id.; OECD, Guide to Intellectual Property in WTO/FTAs (2018) (discussing well known marks under TRIPS and FTAs).

26 Kankrishme, ‘Well Known Trademarks in India’, available at <https://kankrishme.com/well-known-trademarks-in-india/#:~:text=India%20maintains%20a%20list%20of,AMUL%20and%20RELIANCE> accessed 24 October 2025.

27 Yagay and Sun, ‘Definition of a Well Known Trademark in India’ (TaxTMI, 3 February 2025) <https://www.taxtmi.com/article/detailed?id=13466#:~:text=Recognition%20by%20the%20Controller%20General> accessed 24 October 2025.

28 Intellectual Property India, ‘Form and Fees – Trade Mark Rules, 2017’, Entry No. 7, Request to include a trademark in the list of well known trademarks, INR 1,00,000 (E filing only), updated 6 March 2024 [https://ipindia.gov.in/Trademarks/form\\_and\\_fees\\_tm](https://ipindia.gov.in/Trademarks/form_and_fees_tm) accessed 24 October 2025.

marks. In *Daimler Benz AG v. Hybo Hindustan*<sup>29</sup> (Delhi HC 2004), the court held that “BENZ,” as used in Hybo’s underwear label, was identical to Daimler’s famous auto mark. Critically, Daimler’s mark was deemed well known “on account of trans border reputation and goodwill,” and its use in India, even on garments, was enjoined. Similarly, *Whirlpool Co. v. Dongre* (Bombay HC 1988) recognized Whirlpool’s fame from international sales (even selling machines to the US Embassy in India) and extensive advertising, finding a “transborder reputation” among India’s appliance consumers. The defendant (Dongre) was restrained from using the WHIRLPOOL mark on washing machines. These cases established that foreign marks with sufficient global fame and indirect Indian presence could be protected, foreshadowing the statutory rule that use in India is not essential for well known status. (These precedents are often cited by courts as the origins of the “trans border reputation” doctrine.)

### ***Whirlpool of India Ltd. v. Videocon Industries Ltd.***<sup>30</sup>

*Whirlpool v. Videocon* involved design rights rather than trademark rights, but it is notable for reaffirming that Whirlpool is a well known brand in India. In a 2014 suit, the Delhi HC found Videocon’s washing machine design infringed Whirlpool’s registered design and noted Whirlpool’s “distinctive boat shaped” machine design. Although this was design law, the court explicitly recognized Whirlpool’s fame and accordingly protected its rights. (This decision is often cited simply to confirm Whirlpool’s well known mark status in India.)

### **ITC Ltd. v. Punchgini, Inc.**<sup>31</sup> – Impact on India

In one of the most infamous episodes, Indian rights holder ITC Ltd. (owner of the “ITC Bukhara” mark for restaurants) sued Punchgini Inc. in the US for unfair competition, arguing that Bukhara was famous in India and US customers of Indian cuisine. The US Second Circuit flatly rejected this, holding that New York law does not extend protection to foreign famous marks not used domestically. The court reasoned that ITC’s mark, though famous in India, had no legal status in the US, and recognizing such rights would violate trademark territoriality. This 2007 decision is not an Indian judgment, but its significance is felt in India: commentators warn that foreign well known marks may face “setbacks” if denied enforcement in other jurisdictions<sup>32</sup>. The case exposed the limitations of cross border protection and underscored the

---

<sup>29</sup> . *Daimler Benz AG v. Hybo Hindustan* AIR 1994 Delhi 239

<sup>30</sup>Whirlpool of India Ltd. v. Videocon Industries Ltd (2015) 1 BomCR 137

<sup>31</sup> *ITC Ltd. v. Punchgini, Inc* US 2d Cir. 2007

<sup>32</sup> OECD, Trademarks, Geographical Indications and International Trade (2009) (discussing dilution concepts).

need for reciprocal treatment of foreign marks – an issue India faces under TRIPS (see **Comparative Perspectives**, *infra*).

### ***Whirlpool (India) Cases – Lack of Uniformity***

Over the years, Indian courts have repeatedly grappled with the well known mark criteria. One area of contention is whether actual use in India is required. The law says it is not, but practice has been mixed. For example, in *Bajaj Auto v. TVS Motor* (2018)<sup>33</sup>, the Delhi HC held that “use in India” is not a condition in the test. However, other decisions (like ITC’s suit in Delhi against Capatree) stressed the need to show familiarity among “Indian consumers” of the particular goods. In *ITC Ltd. v. Punchgini, Inc*<sup>34</sup> wherein plaintiff was unsuccessful in protecting the ‘BUKHARA’ mark in the US. But the Court held that the judgment of US Court would not be applicable in the context of India, where it was clear from the record that the mark ‘BUKHARA’ originated in India and enjoyed substantial goodwill and reputation not only among Indians but also among foreigners who travel to India.

### ***Rolex S.A. v. Alex Jewellery & Ors.*<sup>35</sup>(Del HC 2009)**

In *Rolex v. Alex Jewellery* (Delhi High Court), the plaintiff made a novel argument: Rolex’s famous brand for watches should bar identical use on related jewelry items. The court held that the target consumers for high end watches would also associate “Rolex” with luxury jewelry. Applying Section 11(6), it found that the segment of customers for expensive watches (Rolex’s consumers) would perceive jewelry labeled “Rolex” as connected to the watchmaker. Thus the mark was well known, and its use on jewelry was likely to create a *false connection*. The defendant (selling Rolex branded artificial jewelry) was restrained. This case is often seen as exemplifying the “*category confusion*” test: even if goods are dissimilar, the overlap of consumer base (and high reputation) justifies protection.

### ***ITC Ltd. v. Britannia Industries (Sunfeast Farmlite)*<sup>36</sup> (Del HC 2016)**

This recent case, though about trade dress, illustrates dilution concepts. ITC had sued Britannia for adopting a similar color scheme for a biscuit package. A single judge initially granted an

---

<sup>33</sup> *Bajaj Auto Ltd. v. TVS Motor Company Ltd.* (2009) 12 JT SC 103

<sup>34</sup> *ITC Ltd. v. Punchgini, Inc.*, 552 US 827 (2007)

<sup>35</sup> *Rolex S.A. v. Alex Jewellery & Ors.* 2009 (41) PTC 284 (Del)

<sup>36</sup> *ITC Ltd. v. Britannia Industries (Sunfeast Farmlite)* (2016) 68 PTC 11

injunction, acknowledging ITC's trade dress fame. But on appeal the bench vacated it, finding that six months' use was insufficient to make the color combination "distinctively associated" with ITC. The court noted that strong evidence is needed to show a non word mark (like trade dress) has acquired secondary meaning. The dissent emphasized that fame can arise quickly in FMCG markets. Although not about a registered well known mark, the case underscores that dilution claims require substantial proof of distinctiveness or harm.

### **Levi Strauss & Co. v. Imperial Online<sup>37</sup> (Del HC 2022)**

The Delhi HC recognized Levi's famous arcuate stitching design (on back pockets) as a well known mark. The court noted the mark's continuous use in many countries since the 1940s and its iconic status, finding it well known in India.

### **DHL International GMBH vs DLH Express Services Private Limited<sup>38</sup>(Del HC 2022)**

DHL was held well known in logistics/freight. Citing DHL's global network and repeated enforcement, the court protected its mark in India.

### **GlaxoSmithKline v. Manoj Kumar Jain<sup>39</sup> (Del HC 2023)**

The court declared the pharmaceutical brand "Betnesol" well known (used since the 1960s) for allied products<sup>40</sup>. GSK's decades of use and brand recognition sufficed, showing long term reputation.

These cases reflect judicial recognition that well known brands (especially global giants) receive de facto cross class protection in India. The factors (fame, duration, advertising, global registrations) have generally guided courts, but not always uniformly. The pendulum has sometimes swung between emphasizing the mark's fame and cautioning against overbroad rights (as in ITC Capatree and the Farmlite appeal).

## **COMPARATIVE INTERNATIONAL PERSPECTIVES**

### ***TRIPS, Paris Convention, and WIPO Guidelines***

---

<sup>37</sup> Levi Strauss & Co. v. Imperial Online Services Private Limited is CS (COMM) 657/2021

<sup>38</sup> DHL International GmbH vs Dlh Express Services Private Limited 2022 (22) IPLR115(Del)

<sup>39</sup> GlaxoSmithKline v. Manoj Kumar Jain CS (COMM) 377/2023

<sup>40</sup> Trade Marks Act, 1999, sec 11-12 (providing absolute and relative grounds of refusal, including well known marks under sec11(6)).

India's well known mark regime is grounded in its international obligations. Article 6(b) of the Paris Convention (1967) requires member states to refuse or cancel registration, and prohibit use, of a mark well known in their territory when used by unauthorized persons for identical or similar goods, likely causing confusion<sup>41</sup>. This was extended by the WTO's TRIPS Agreement (Art. 16) to cover *services* and to ask members to *take into account* the well known status based on promotion and recognition in the relevant sector. Article 16.3 of TRIPS even contemplates protection on unrelated goods: it suggests members *may* prevent use of a well known mark on dissimilar goods "where such use would indicate a connection and cause dilution or tarnishment" (this is implicit in WTO case law such as *DSV/Coca Cola*).

India's law largely implements these standards: it acknowledges promotion and foreign fame (section 11(6) factors; Registrar need not insist on local use), and explicitly bans use on dissimilar goods that unfairly exploits the mark. The WIPO Joint Recommendation (1999) on well known marks provides additional guidance. It lists factors (usage, advertising, market share, registrations, etc.) similar to India's statutory list, and advises that a well known mark should be protected even against dilution by unrelated marks. While non binding, the Joint Recommendation influenced India's legislature.

### ***United States***

The US regime for famous marks is codified in the Federal Trademark Dilution Act (FTDA) of 1995, substantially revised in 2006. US law requires the senior mark to be *famous* and prohibits dilution by blurring (weakening distinctiveness) or tarnishment (harming reputation), regardless of competition or confusion<sup>42</sup>. The US definition of dilution mirrors the WTO's: the Lanham Act defines it as "the lessening of the capacity of the famous mark to identify and distinguish" goods. By contrast, India's Act does not expressly use the word "dilution", but Sec. 29(4) essentially parallels it. One difference is that US dilution law applies only to marks *famous in the US* and generally requires actual dilution, whereas India extends protection to well known marks *in India* (including foreign marks known in India).

A cautionary tale is the *ITC Ltd. v. Punchgini* case (*supra*) where the US courts refused to

---

41 Christoph G. Steiger & Aaron D. MacLean, Geographical Indications and Trademarks: Protection of Objectively Well Known Marks under the Paris Convention and TRIPS, 86 J. Pat. & Trademarks Off. Soc'y 615, 621–25 (2004) (comparing dilution standards).

42 Federal Trademark Dilution Act of 1995, Public Law No. 104–98, 109 Stat. 985 (1996) <https://www.congress.gov/bill/104th-congress/house-bill/1295> accessed 24 October 2025.

entertain a claim for an Indian famous mark absent US use. This highlights the challenge of enforcing foreign fame in the US, and by analogy suggests India may face similar issues abroad (leading scholars to urge reciprocity). Unlike India, however, the US does not register unregistered well known marks via an administrative registry; protection is purely judicial.

### ***European Union***

EU trademark law also grants famous marks extra protection. Under Directive 2008/95/EC (recast in 2015), now EU Regulation 2017/1001 (EUTMR), Article 10 grants an EU trademark proprietor the right to prevent use of an identical or similar sign on *any* goods or services if the EU mark has a reputation in the EU and the use takes unfair advantage of or is detrimental to the mark<sup>4344</sup>. This is virtually identical to India's Sec. 29(4). Thus, a mark famous in the EU (or even nationally) can block use on dissimilar products, provided the harm (advantage/tarnishment) is shown. EU courts have developed a "link" concept, requiring evidence that the public makes a mental connection between the uses. For example, in *C 487/07 L'Oréal v. Bellure* (2009)<sup>45</sup>, the CJEU held that selling perfume "substitutes" diluted L'Oréal's fragrances by exploiting their image.

India has no directly analogous codified right for unregistered marks (like EU passing off or the UK's "extended passing off"), but Sec. 11(2) acts as a preventive measure even for unregistered well known marks in opposition. The European approach similarly presumes that reputation alone suffices to bar any confusingly similar use, echoing Indian law's stance in section 29(4).

### ***WIPO and Global Trends***

The WIPO Joint Recommendation (1999) enumerates protection of well known marks in a non binding instrument. It notes that "dilution" covers broad and narrow forms – essentially blurring and tarnishment – and that member states should consider bad faith usage, marks in different classes, and even domain names. WIPO also maintains an accessible list of well known marks (the "WIPO Register of International Marks"), but this is voluntary and for

---

43 EU Regulation 2017/1001 (EUTMR),

44 Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark OJ L 154/1 <https://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32017R1001> accessed 24 October 2025.

45 *L'Oréal SA v Bellure NV* (C 487/07) ECR I 5185 (CJEU)

registered marks under the Madrid System.

Globally, there is a clear trend to expand famous mark rights in the digital age. Online brand piracy and social media make dilution risks more acute. For instance, EU member states and WIPO have discussed treaty proposals (e.g. the WIPO Geneva Act 1999 provides a treaty on trademarks that includes dilution concepts). India, as a WTO member, must interpret its law in harmony with TRIPS and Paris; it has done so broadly, but continued international convergence may pressure further alignment (for example, recognizing dilution by tarnishment explicitly or streamlining enforcement for online infringement).

In summary, India's well known mark laws largely reflect international norms: broad fame based protection (TRIPS/Paris), administrative recognition (2017 Rules), and pro forma anti dilution provisions akin to EU/US law. The challenge lies in implementation: balancing global reciprocity and domestic interests, and defining the limits of such expansive rights.

## CRITICAL ANALYSIS

### *Strengths of India's Regime*

India's well known mark system is *generally favorable to famous brands*. By statutory fiat, well known marks get special treatment: they can block registration of confusingly similar signs in any class (Sec.11(2)), and even unregistered but reputed marks can use Sec.29(4) to stop dilution. Courts have been receptive: many global brands have been held well known (e.g. Red Bull, Levi's stitch, DHL), obtaining injunctions against newcomers. The codification of cross class protection aligns India with its TRIPS obligations – indeed, India was one of the early adopters of these norms in Asia.

Moreover, the 2017 Rules' mechanism for recording well known marks (Rule 124) is a strength. It creates legal certainty: published declarations in the Registrar's list inform the public of a mark's status. For right holders, it is a proactive tool to pre-empt infringement. Also, Sec.11(9) explicitly rejects any requirement of "use in India" or prior registration, meaning that trademark owners need not wait to launch in India to secure protection for famous marks. This is consumer friendly (avoids confusion with foreign luxury goods) and business friendly (protects Indian exports). The doctrine of "trans border reputation" has been embraced judicially, which is commendable for respecting TRIPS's spirit of nondiscrimination among

nationals.

The alignment with global concepts like blurring/tarnishment is evident. Indian courts readily apply the “unfair advantage or detriment” test.

### ***Weaknesses and Enforcement Challenges***

Despite its strong framework, India faces practical challenges in well known mark protection. A primary issue is *proof of fame and harm*. Section 29(4) requires that the senior mark “has a reputation in India” and that use of a similar mark on dissimilar goods “takes unfair advantage of or is detrimental to” the mark. Courts have interpreted these elements liberally but inconsistently. Reputation can be proved by market surveys, advertising spend, sales data, or evidence of consumer awareness – evidence that is often expensive and difficult. The “due cause” clause also creates uncertainty: what qualifies as legitimate use? (For example, a party might claim that its use on unrelated goods does not take advantage of the mark, especially if branding is minimal.)

Moreover, Indian jurisprudence has sometimes imposed implicit use requirements. In *ITC Ltd. v. Philip Morris Products*<sup>46</sup> (Delhi HC 2010), ITC’s claim that its “Narrow Gauge” tobacco mark (similar to another brand) was diluted failed partly because ITC had not used the mark in that category, weakening its distinctiveness claim. Similarly, in the *Britannia* trade dress case<sup>47</sup>, the appellate court held that six months of use was insufficient for reputation. These decisions suggest that, despite statutory language, courts may require a domestic footprint to fully enforce dilution type rights.

The Registrar’s well known mark list, while useful, also raises concerns. APAA commentary notes that some marks have been registered as “well known” only in a limited range of goods, contradicting the idea that well known status implies cross class protection<sup>48</sup>. If a mark is declared well known only in one class, does it enjoy the same anti dilution rights in others? The Act’s definition suggests yes, but practice has been murky. There are anecdotes of brands being declared “well known only in cosmetics” but then suing in other categories. This blurring

---

<sup>46</sup> ITC Ltd. v. Philip Morris Products 2010 (42) PTC 572 (Del.)

<sup>47</sup> ITC Ltd. v. Britannia Industries Ltd., citation (2023) ibelaw.in 568 HC

<sup>48</sup> Manosij Mukherjee, ‘The Well known Trade Mark Conundrum – Indian Perspective’ (Asian Patent Attorneys Association, 2023) <https://apaaonline.org/article/the-well-known-trade-mark-conundrum-indian-perspective/> accessed 24 October 2025.

of reputation vs. well known status may dilute the standard, leading to *overprotection* of marks that are merely successful (with reputation) but not truly famous across classes.

Enforcement in practice also suffers from case backlogs and limited IP expertise. Trademark disputes often take many years to resolve; by then a mark's period of fame or market relevance may have waned. There is also uneven judicial approach: some High Courts have embraced dilution broadly, while others have been cautious. The lack of a specialized IP court means that many judges lack deep familiarity with nuanced doctrine. For example, some courts have been reluctant to find tarnishment absent extremely disparaging use, narrowing the remedy. Additionally, parallel remedies in passing off (sec 27) sometimes lead litigants to pursue traditional confusion claims rather than dilution.

Internationally, a weakness is *reciprocity*. As *Punchgini*(*supra*) showed, not all countries will honor foreign well known marks without local registration. India could face problems protecting its famous export brands (e.g. Infosys, Taj) abroad if those countries demand use or impose territorial limits. There is some asymmetry: an Indian firm might enjoy robust protection in India for its brand, but a foreign brand might not get the same courtesy overseas. Observers have warned that India's courts should be mindful of this and consider fairness, but statutory reciprocity clauses are lacking.

### **Dilution, Blurring and Tarnishment in India**

India's statute does not enumerate "blurring" and "tarnishment" by name, but its language covers both. Blurring is taken as the "unfair advantage" clause, where unauthorized use dilutes distinctiveness; tarnishment is the "detrimental" clause, for reputation damage. For instance, the Delhi HC found that imitation of KitKat's shape and packaging diluted Nestlé's mark even though the products were similar (chocolates), emphasizing loss of identity. In *Daimler v. Hybo*<sup>49</sup>, use of "BENZ" on undergarments clearly tarnished the car brand's luxury image. These instances show Indian courts applying dilution concepts. However, the evidence needed is high. The plaintiff must show that average Indian consumers identify the mark's source, and that the new use truly "diminishes" the mark (e.g. by association with poorer quality). Absent clear evidence of reduced distinctiveness or harm, courts may dismiss dilution. In practice, passing off (confusion) is still often the easier argument, and some commentators argue that

---

<sup>49</sup> *Daimler v. Hybo* AIR 1994 Delhi 239

focusing on harm to owner rather than consumers' deception deviates from trademark's protective rationale.

A notable difference under Indian law is that Sec. 29(4) does *not* require any likelihood of confusion. Even if consumers are unlikely to confuse the sources (because the goods are dissimilar), the use can still be actionable if it dilutes the mark. This stands in contrast to Sec. 29(2) (ordinary infringement) which hinges on confusion. The Act thus splits the analysis: ordinary infringement (confusion based) vs. well known dilution (reputation based). Courts have acknowledged this split. In *Ford Motor Co. v. C. Borman*<sup>50</sup> – actually prior to the Act – the court said that once a mark has high reputation, “there is no requirement to prove confusion or deception”. This has carried into modern jurisprudence: owners of well known marks sometimes need only show fame and harm to win injunctions.

Some academics lament that this gives too much emphasis to owners' interests. The SLJ article argues that trademark law's core is protecting consumers from confusion, and that shifting to owners' economic interests (via dilution) represents a “commercialisation” of trademarks. Indeed, Indian courts have mostly not asked whether the average consumer is confused or misled; they have often focused on whether the defendant is free riding on the mark's goodwill. While this is consistent with global anti dilution trends, critics caution that it may lead to monopolistic overreach, especially if “due cause” exceptions (e.g. comparative advertising) are ignored.

In conclusion, India's well known mark law provides powerful tools (cross class refusals and infringement) but also poses evidentiary hurdles. Owners of famous marks are generally protected, but only if they can marshal proof of reputation and demonstrate actual dilution or tarnishment. The courts' evolving case law – from clearly pro plaintiff stances to occasional pushback – suggests the law is still settling. The next section examines how this Indian regime aligns or diverges from other systems.

## **RECOMMENDATIONS:**

To strengthen and modernize India's well known mark protection in line with global practice, we suggest the following reforms:

---

<sup>50</sup> Ford Motor Company & Anr. vs Mrs. C.R.Borman & Anr. AIR 2014 DELHI 165

***Statutory Clarification of Dilution:***

The Act should explicitly define and exemplify dilution types (blurring vs. tarnishing) or at least codify factors (similar to TRIPS Art. 10 bis language). This would guide courts and right holders. For example, adding a provision that use of a mark (even on dissimilar goods) is actionable if it “lessens the distinctiveness” or “harms the repute” of a well known mark could mirror US law and avoid ambiguity. Clear legislative language would reduce reliance on confusing passing off concepts and underscore that dilution is a separate wrong.

***Procedural Improvements (Registry Recognition):***

Consider making well known declarations by the Registry more streamlined and affordable. The current fee (₹100,000) is high, especially for small companies. A tiered fee structure or subsidized applications (for domestic brands) might increase usage. Additionally, the Registrar could proactively compile a “Wall of Fame” of well known marks, updating it periodically to avoid erroneous listings. To address concerns about marks limited to one class being labeled “well known,” the Rules could require proof of fame *across classes* when applying, in line with the Act’s definition.

***Burden of Proof and Use:***

Courts should reaffirm that actual use in India is not required for well known status (as Sec.11(9) mandates). While evidence of familiarity may naturally rely on local surveys or imported publications, judges should not penalize mark owners for lack of formal Indian use. At the same time, the “due cause” defense should be fleshed out – for instance, explicitly allowing fair use exceptions (e.g. descriptive uses, comparative ads). India might consider adopting a statutory “fair use” or “noncommercial use” defense (akin to US law) to prevent abuse of well known mark claims against innocuous uses.

***Judicial Guidelines and Training:***

The Intellectual Property Appellate Board (IPAB) or a Supreme Court led committee could issue guidelines on evaluating well known status, similar to the Guidelines for Examination of Well Known Marks (2016, although not formally binding). These could clarify evidentiary standards (e.g. admissible proof of reputation), define “substantial segment,” and stress the need for consumer surveys. Mandatory training on trademark dilution for IP judges and

Registrar officials would promote uniformity.

### ***Reciprocity and International Harmony:***

India should consider negotiating reciprocal recognition of well known marks in bilateral or multilateral forums. For example, trade agreements could include clauses protecting each party's famous brands in the other's territory. At WTO, India could lobby for stronger enforcement guidelines or amend national law to mirror global trends – for instance, explicitly recognizing tarnishment, which TRIPS left optional (Art.16.3 allows but does not require protection on unrelated goods). In domestic law, inserting a provision that “the rights of Indian well known marks shall be given effect when they are infringed in signatory countries on similar terms” could strengthen Indian brands' overseas claims.

### ***Digital Era Enforcement:***

Finally, given the rise of online marketplaces, India should empower rights holders to address digital dilution. The Trademark Rules could mandate that marketplaces like Amazon block listings for infringing use of well known marks, beyond traditional counterfeiting. Expedited remedies (like ex parte takedowns, as exists for domain names and copyright) should be available for clear cut dilution cases (e.g. cybersquatting on well known names). WIPO's 2021 Draft Design and Trademark Treaty (WCT/DMTT) recognizes online advertising as a source of tarnishment; India can align with such developments.

Implementing these reforms would ensure that India's well known mark regime remains vigorous and fair. It would reassure multinational brand owners that their reputations are safe in India, and reciprocally encourage protection of Indian global brands abroad. At the same time, clearly articulated standards would allay fears of overreach and protect legitimate competition and free expression.

## **CONCLUSION**

India has embraced the protection of well known trade marks as part of its global trade commitments, yielding a system of broad statutory rights for famous brands. The Trade Marks Act, 1999 (with subsequent Rules) provides a strong legal framework, and courts have often granted sweeping relief for well known marks. Nonetheless, as this review shows, challenges persist in defining the scope of dilution, gathering proof of reputation, and ensuring consistent

application. Aligning the law more closely with evolving international norms – and addressing enforcement gaps – will help maintain India’s credibility in the global IP regime. Continued scholarly attention and judicial refinement are needed. Policymakers should heed international comparisons (e.g. EU, US, WIPO) to update India’s rules where warranted, always balancing trademark owners’ interests with consumer welfare and fair competition. With these recalibrations, India’s “well known marks” regime can remain a model of robust trademark protection attuned to the realities of 21st century commerce.

## References:

1. 'Moving Beyond the Doctrine of Dilution in the Context of Well Known Trademarks' (Student Law Journal, Dharmashastra National Law University) <https://dnluslj.in/moving-beyond-the-doctrine-of-dilution-in-the-context-of-well-known-trademarks/> accessed 2 October 2025
2. 'Well Known Trademarks and Law in India' (S.S. Rana & Co.) <https://ssrana.in/ip-laws/trademarks-in-india/well-known-trademarks-india/> accessed 2 October 2025
3. Govt of India, The Trade Marks Act 1999 (India Code) [https://www.indiacode.nic.in/bitstream/123456789/15427/1/the\\_trade\\_marks\\_act%2C\\_1999.pdf](https://www.indiacode.nic.in/bitstream/123456789/15427/1/the_trade_marks_act%2C_1999.pdf) accessed 2 October 2025
4. 'The Well known Trade Mark Conundrum – Indian perspective' (APAA Online) <https://apaaonline.org/article/the-well-known-trade-mark-conundrum-indian-perspective/> accessed 2 October 2025
5. 'India – Well Known Trademarks – Recent Trends and Case Law' (APAA Online) <https://apaaonline.org/article/india-well-known-trademarks-recent-trends-and-case-law/> accessed 2 October 2025
6. 'Transborder reputation of trademarks: legal framework' (iPleaders Blog) <https://blog.ipleaders.in/transborder-reputation-trademarks-legal-framework/> accessed 2 October 2025
7. 'Well known marks' (USPTO) <https://www.uspto.gov/ip-policy/trademark-policy/well-known-marks> accessed 2 October 2025
8. 'Landmark Case Laws of Trademark Dilution In India' (Unimarks Legal) <https://unimarkslegal.com/famous-case-laws-for-trademark-dilution-in-india/> accessed 2 October 2025
9. ITC Limited v Central Park Estates Private Limited & Anr SCC OnLine Del 4132 (Del HC) <https://www.sconline.com/blog/post/2022/12/01/delhi-high-court-directs-registrar-of-trade-marks-to-add-bukhara-mark-to-the-list-of-well-known-trade-marks/> accessed 2 October 2025
10. 'Comparative aspects of trademark dilution between the United States and China' (World Trademark Review, 2021) <https://www.worldtrademarkreview.com/regionindustry-guide/china-managing-the-ip-lifecycle/2021/article/comparative-aspects-of-trademark-dilution-between-the-united-states-and-china> accessed 2 October 2025

11. Charles Gielen, 'Trademark Dilution in the European Union' (2020) [https://charlesgielen.com/media/1064/trademark dilution in the european union international trademark dilution 2020.pdf](https://charlesgielen.com/media/1064/trademark-dilution-in-the-european-union-international-trademark-dilution-2020.pdf) accessed 2 October 2025
12. I. D. Khan, Moving Beyond the Doctrine of Dilution in the Context of Well Known Trademarks, 4 DNLU SLJ 1 (2024), SecII
13. Trade Related Aspects of Intellectual Property Rights (TRIPS) Agreement, 1869 U.N.T.S. 299, Arts. 16.2–3