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## **A CRITICAL STUDY ON THE PROTECTION OF WELL-KNOWN TRADEMARKS UNDER INDIAN LAW**

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### **ABSTRACT**

Intellectual Property Rights play an important role in protecting creations of the human intellect, with trademarks serving as key indicators of the origin, quality, and reputation of goods and services. In the modern global marketplace, certain trademarks acquire extensive recognition and goodwill among consumers, leading to their classification as well-known trademarks. Such marks require a higher degree of legal protection because their value extends beyond product identification to safeguarding brand reputation and consumer trust. This research paper examines the legal framework for the protection of well-known trademarks in India and analyses the procedures, judicial developments, and challenges associated with their recognition and enforcement. The paper traces the historical evolution of trademark law, beginning with the Industrial Revolution and the development of trademark protection in India from the Trade and Merchandise Marks Act, 1958 to the Trade Marks Act, 1999. It further explores the influence of international instruments such as the Paris Convention and the TRIPS Agreement, which laid the foundation for extending protection to well-known marks, including protection across dissimilar goods and services.

**Introduction:-**

Intellectual Property (IP) is traditionally divided into two main categories: industrial property and copyright. Industrial property includes patents, trademarks, industrial designs, and geographical indications. Copyright protection applies to creative works such as literary, artistic, and musical creations. It also covers related rights, including the rights of performers over their performances, producers over sound recordings, and broadcasters over radio and television programs. Intellectual property rights are generally understood as a collection of exclusive legal rights granted to the rightful owner of the intellectual creation.

The origin of trademark law can be traced back to the Industrial Revolution, a period marked by large-scale production of goods. As production increased, manufacturers felt the need to distinguish their products from those of others by using specific marks or symbols. These marks were also used in advertisements, helping consumers identify particular products and associate them with certain manufacturers. Over time, these marks developed goodwill and reputation among consumers. As a result, the necessity to protect this goodwill became important, leading to the development and adoption of trademark laws across different countries.

The Paris Convention on Industrial Property in 1883 covered the first mention of "Well-Known Marks." However, the specific steps for registering for Well-known Marks are not outlined in this convention. It completely gave the member nations the authority to create legislation protecting well-known marks.<sup>1</sup>

In India, trademark law was originally influenced by the British Trade Marks Act of 1938, based on which a draft law was prepared in 1940. Later, with several modifications, it was enacted as the Trade and Merchandise Marks Act, 1958, which governed trademark law in India for many years. This legislation has now been replaced by the Trade Marks Act, 1999. In addition, the Trade Marks Rules, 2017, which replaced the earlier Trade Marks Rules, 2002, lay down the procedures and regulations necessary for implementing the provisions of the Act.

With the introduction of the Trade Marks Rules, 2017, the Government of India established a new procedure for seeking protection of well-known trademarks. Under these rules, an applicant can apply to the Registrar by filing Form TM-M to request that their trademark be

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<sup>1</sup> Paris Convention for the Protection of Industrial Property (1883), Article 6bis

officially recognized and declared as a well-known trademark in India.

### **What is Well Known Trademark?**

A “well-known trademark,” in relation to any goods or services, refers to a mark that has become widely recognised by a substantial segment of the public that uses those goods or receives those services. Due to such recognition, if the same mark is used in connection with different goods or services, consumers are likely to assume that there is a commercial connection between those goods or services and the original proprietor of the mark.<sup>2</sup>

Globalization has brought the entire world under one roof and eliminated any barriers to trade or business. These actions also made it necessary to safeguard the "Well-Known Trade Marks" that are in use all over the world. In common language, well-known trade marks are those that are recognized worldwide. For example, "Apple" is well-known for its superior computer technology, which demonstrates a standard quality set by Apple Inc.

A well-known trademark is a mark that has gained widespread recognition and reputation among a large section of the public due to its long use, quality, and popularity. Unlike ordinary trademarks, which are protected mainly within a specific category of goods or services, a well-known trademark enjoys a higher level of legal protection because consumers strongly associate the mark with a particular business or source. When people see such a mark, they immediately connect it with a specific company, even if the mark is used for different or unrelated products.

Under Indian law, a well-known trademark is defined in the Trade Marks Act, 1999 as a mark that has become so widely known among the relevant public that the use of a similar or identical mark on other goods or services would likely create an impression that there is a connection with the original owner. The purpose of this protection is to prevent unfair advantage, misuse, or damage to the reputation of the famous mark.

The concept of a well-known trademark has been incorporated into the Trade Marks Act, 1999 to provide enhanced protection. This protection is not limited only to the specific goods or services for which the mark has gained recognition. Instead, it extends to prevent the use of the same or similar mark in relation to other goods or services where such use may lead a

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<sup>2</sup> Section 2(1)(zg), The Trade Marks Act, 1999

substantial section of the public to believe that there exists a trade connection between the new goods or services and the original trademark owner. In essence, the law seeks to safeguard the reputation and distinctiveness of a well-known mark by preventing misuse that could create an association or misleading impression in the minds of consumers.<sup>3</sup>

### **Procedure and Requirements for recognition of Well-Known Trademarks in India:-**

#### **(A) Rule 124 of Trademark Rules, 2017**

This rule enables trademark owners to submit a request to the Registrar for the granting of a "well-known" trademark. The owner must submit the TM-M form. Prior to the creation of this law, a mark could only be deemed well-known following a protracted process of legal actions, rectification, and opposition. It allows the owner to request a well-known trademark without initiating legal actions. This saves a great deal of time and allows the owner to obtain the tag for a well-known trademark without any needless procedures. This aids the registrant in deciding whether to apply a well-known mark tag to that specific mark. When determining whether a mark is well-known, the Registrar must consider seven of the clauses in subsections (6) to (9) of Section 11<sup>4</sup>. This aids the registrant in deciding whether or not to give that specific mark a well-known mark tag. Before granting, the registrar may request any more pertinent documents as it sees proper and may consider any public objections to the aforementioned application within 30 days after the invitation to objection. If that mark is designated as a well-known trademark, it will be listed in the Registrar's list of well-known trademarks and published in the trademark journal.

#### **(B) Trade Marks Act, 1999**

##### 1. Preservation of well known trademarks in all classifications:-

"A trademark that: (a) is identical to or similar to an earlier mark; and (b) is to be registered for goods or services that are not similar to those for which the earlier mark is registered in the name of a different proprietor shall not be registered if or to the extent that the earlier mark is a well-known trademark in India and the use of the later mark without due cause would take unfair advantage of or be detrimental to the

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<sup>3</sup> Ahuja V.K, Intellectual Property Rights in India, Lexis Nexis Butterworths Wadhwa, Nagpur 1<sup>st</sup> Edition, 2009, 457

<sup>4</sup> Trade Marks Act, 1999, Section 11(6) to (9)

distinctive character or repute of the earlier mark."

This section explains the significance of a well-known trademark and how it might be used unfairly, but it also prohibits anyone from engaging in such unfair practices.

## **2. Well Known Trademark: Determining Factors**

The Registrar must consider any information that he deems pertinent when deciding whether or not a trademark is well-known. These facts include: the trademark's awareness or familiarity within the relevant segment of the public, including information acquired in India as a result of the trademark's promotion; Duration, scope, and location of any use of that trademark; Duration, scope, and geographic reach of any trademark promotion, such as publicity, advertising, and presentation, at trade shows or exhibitions of the products or services to which the trademark applies.

### **Paris Convention:**

The oldest multilateral industrial property pact is the Paris Convention for the Protection of Industrial Property. It came into effect on July 7, 1884, after being signed in Paris on March 20, 1883. Article 6 of the Paris Convention, which provides for the regime for the protection of well-known marks by enacting that the Union's member states may refuse or cancel registration and forbid the use of marks that cause confusion as being reproduction, imitation, or translation of a particular nation's well-known mark, established the doctrine of well-known marks for the first time in 1883. When a significant element of a mark is a reproduction of a well-known mark, the provision also applies. Because the Paris Convention did not specify measures pertaining to the protection of well-known trademarks or their recognition procedures, the signatory countries were free to address these issues as they saw fit. As a result, most countries do not process applications related to the recognition of well-known trademarks until the owners of such marks explicitly demonstrate the need for the recognition, and the majority of countries do not have a separate independent application procedure for recognition of well-known marks.<sup>5</sup> The Paris Convention for the Protection of Industrial Property is one of the earliest international agreements aimed at protecting intellectual property rights across member countries. It established important principles such as national treatment, priority rights, and protection against unfair competition. With respect to trademarks, Article 6bis of the

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<sup>5</sup> Paris Convention

Convention introduced the concept of protecting well-known trademarks by requiring member states to refuse or cancel the registration of marks that imitate or reproduce a well-known mark and may cause confusion among consumers. The Convention does not provide a fixed definition of a well-known trademark, allowing member countries to determine recognition standards through their domestic laws. This flexibility enabled countries like India to develop independent legal procedures for recognizing and protecting well-known trademarks.

### **Trade Related aspect of Intellectual Property Rights**

The protection of well-known marks under Article 6 of the Paris Convention is also enforced under the Trade Related Aspects of Intellectual Property Rights (TRIPS) agreement. Articles 16.2 and 16.3 of the TRIPS agreement have been incorporated into the TRIPS agreement. According to the articles, Article 6 can be applied to services and to goods or services that are not comparable to those for which a trademark is registered. From the Paris Convention to the TRIPS Agreement, the idea of well-known marks developed. The TRIPS Agreement improved the understanding of well-known marks by establishing criteria for determining whether a mark is well-known, such as knowledge of the trademark in the relevant public sector and knowledge acquired by the member in question as a result of trademark promotion. Furthermore, the Paris Convention only addressed goods and offered protection against identical or similar goods, but the TRIPS agreement covers protection against registered trademarks in relation to both goods and services. It also covers dissimilar goods and services to the extent that third-party use is found to indicate a relationship between the owner of the registered mark and the use of such dissimilar goods and services, which can most likely harm the owner's interest. Even while the concept of a well-known trademark has significantly improved, both treaties failed to define the term, leaving it up to the national laws of the various nations.<sup>6</sup>

### **Challenges in the Protection of Well-Known Trademarks in India**

The meaning of a well-known mark in India is given in section 2(1)(zg) of the Trademark Act 1999. The Trademark Act of 1999's Sections 11(2), (6), (7), and (9) particularly address the concept of well-known marks and provide relevant grounds for denial of trade mark registration. However, the phrase "well known mark" is not specifically mentioned in any of the clauses of Section 29 of the Act, which addresses trademark infringement, and it is only

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<sup>6</sup> TRIPS Agreement

used in clause 4 as "registered trade mark, that has a reputation." This makes it extremely difficult to determine the legislature's true intent regarding the protection of well-known marks after registration, which undoubtedly shows that the legislature intended to protect the well-known mark only at the registration stage.

The legislature should take into account and clarify the following issues in addition to the gap in Section 29(4):

1. The terms "a mark which has become so to the substantial segment of the public which uses such goods or receives such services" are ambiguous and leave it up to the courts' interpretation. The Act's definition of a well-known mark does not specify a threshold for determining whether a mark is well-known or not.
2. Since there is no precise definition of a well-known mark, it is therefore unclear how to determine whether a mark qualifies as such in the section on its enforcement. Therefore, the extent of protection granted to well-known marks is negatively impacted in the lack of such appropriate guidelines on well-known marks for enforcement proceedings.
3. When determining the parties' rights, Section 29(4) makes no mention of adoption in bad faith.

As of now, Rule 124 of the Trademark Rules 2017 in India has established new regulations pertaining to the registration of well-known marks. As of now, a well-known mark can be recognised through a trademark infringement lawsuit in court. However, the owner of a trademark can now apply to the registrar to have the trademark determined as a well-known mark. Regarding the recognition and protection of well-known trademarks, the implementation of the current rule is regarded as a significant development. However, the primary issue that has not yet been resolved is whether Rule 124 of the Trademark Rules, 2017 is constitutionally valid. As delegated legislation, rules derive their authority from their parent statute. The Trade Marks Act of 1999 serves as the legal foundation for the Trade Mark Rules of 2017. However, this law does not give the Central Government the authority to establish a whole new process for identifying well-known trademarks. Well-known trademarks are not mentioned in Section 157 of the Act, which outlines the Central Government's rule-making authority under the Trade Marks Act, 1999. Section 157(xli) contains a residuary clause granting the Central Government

the authority to establish regulations for "any other matter, which is required to be or may be prescribed." This provision is widely drafted, like all provisions granting residuary powers. Nevertheless, a residuary provision is still subject to the two most crucial rules of legislative power delegation: the first is that the provisions of the parent legislation cannot conflict with the delegated legislation. Second, Parliament cannot assign the Executive a crucial legislative role. Both of these concepts are violated by the new Rule 124. The rule represents a completely new policy to identify "well-known" trademarks using a non-adversarial process.

### **Legal Structure Governing Well-Known Trademarks in India**

In *Honda Motors Co. v. Charanjit Singh*<sup>7</sup>, the Delhi High Court granted a permanent injunction in a passing off action against the use of the trademark HONDA for pressure cookers, which the plaintiff had utilized in relation to automobiles and power equipment. The court based its decision on the fact that the plaintiff had employed the term HONDA for the past five decades, during which it had garnered international goodwill and reputation, ultimately becoming a household name in India.

In *Sunder Permananad Lalwani v. Caltex India Ltd.*<sup>8</sup>, the Bombay High Court ruled that Caltex India had a legitimate objection to the registration of the watch trademark CALTEX. In this instance, Caltex Ind. Ltd. was the owner of the well-known and monopolistic Caltex trademark, which was used for gasoline, kerosene, and other products. Although the court determined that Lalwani was the owner of the mark for watches in India, Lalwani began using CALTEX on watches in the market. However, registration was denied because Lalwani failed to establish an honest choice of trademark for watches and there was a possibility of customer deception or confusion.

In *Bata India Ltd. v. Deputy Registrar of Trade Mark*<sup>9</sup>, it was permitted to register a trademark for sewing machine parts that had the phrase "Artistic device with letters BSC" while the appellant-opposer had been using both "BATA" and "BSC" as a combined trademark for footwear. After adopting BSC in 1975, the respondent developed the mark's goodwill and reputation throughout the state of Punjab. According to the appeal board, there was no issue of confusion or deceit because the appellant had not utilized the BSC mark independently and the

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<sup>7</sup> Honda Motors co. v. Charanjit Singh [2003] 26PTC 1 (Del)

<sup>8</sup> Sunder PermananadLalwani v. Caltex India ltd [1969] 24,36AIR (Bom.)

<sup>9</sup> Bata India ltd. V. Deputy Registrar of Trade mark [2004] 29 PTC 468 (IPAB)

goods were of entirely distinct type.

The plaintiff in *Caterpillar Inc. v. Jorange*<sup>10</sup> was the owner of the trademarks "CAT" and "CATERPILLER" for heavy machinery, construction, and agricultural equipment. They began selling a variety of clothing items in 1996, including jackets, sweaters, sunglasses, and athletic equipment. The plaintiff relied on the transborder reputation that resulted from its use of the trademark in other nations, even though it had not yet introduced the trademark on clothing in India. Additionally, they asserted that when a grant is applied to many products, it may cause confusion, even with well-known brand names. The defendant was prohibited by the court from using the trademarks "CAT" and "CATERPILLER." The Trade Mark Act of 1999, which went into effect in September 2003, formalized well-known marks thanks in part to the significant court precedent set by the aforementioned instances.

## Conclusion

The protection of well-known trademarks has emerged as one of the most significant developments in modern trademark law, particularly in an era characterized by globalization, digital commerce, and cross-border trade. Trademarks today are no longer merely identifiers of goods or services; they represent reputation, consumer trust, goodwill, and the commercial identity of businesses. As markets expand beyond national boundaries, the importance of safeguarding well-known trademarks from misuse, dilution, and unfair exploitation has increased substantially. The Indian legal system has gradually evolved to recognize this reality by developing a structured framework for the recognition and protection of well-known marks. The historical evolution of trademark law demonstrates that the need for protection arose alongside industrial growth and large-scale production. As businesses began distinguishing their products through unique marks and symbols, these marks acquired goodwill among consumers, making legal protection necessary. India's trademark regime, influenced initially by British legislation, has undergone significant transformation—from the Trade and Merchandise Marks Act, 1958 to the modern Trade Marks Act, 1999. The 1999 Act marked a major shift by incorporating international standards and formally recognizing the concept of well-known trademarks, thereby strengthening the protection available to reputed brands. A key advancement in Indian trademark law has been the introduction of the Trade Marks Rules, 2017, particularly Rule 124, which created a dedicated procedure for recognizing well-known

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<sup>10</sup> *Caterpillar Inc. 100 NE v. Jorange* [1999] 570 PTC (Mad).

trademarks. International conventions have played a crucial role in shaping Indian law. The Paris Convention introduced the idea of protecting well-known marks by requiring member states to refuse or cancel confusingly similar trademarks. The TRIPS Agreement further expanded this protection by extending it to services and dissimilar goods and by recognizing reputation acquired through promotion and global recognition. Although these international instruments did not provide a precise definition of well-known trademarks, they laid the foundation for national laws, including India's, to develop their own standards. Judicial decisions in India have significantly contributed to the evolution of well-known trademark protection. Courts have consistently emphasized goodwill, reputation, and consumer perception while granting protection to famous marks. Cases such as those involving HONDA, CALTEX, BATA, and CATERPILLER demonstrate the judiciary's willingness to prevent misuse of reputed marks even across unrelated product categories. Through these decisions, Indian courts have recognized doctrines such as transborder reputation, passing off, and dilution, thereby strengthening the protection available to trademark owners.

In conclusion, India has made considerable progress in establishing a comprehensive legal regime for the protection of well-known trademarks. The combined influence of statutory provisions, international obligations, and judicial interpretation has created a strong foundation for safeguarding brand reputation and preventing unfair commercial practices. However, for the system to function more effectively, clearer statutory definitions, stronger enforcement guidelines, and legislative refinement are necessary. As commerce continues to evolve in the digital and global marketplace, the protection of well-known trademarks will remain essential for maintaining consumer confidence, encouraging fair competition, and promoting innovation. Strengthening this area of law will not only protect trademark proprietors but also contribute to the overall growth and credibility of India's intellectual property regime.