
WELL-KNOWN TRADEMARKS IN INDIA: LEGAL PROTECTION, JUDICIAL INTERPRETATION AND DIGITAL ENFORCEMENT ISSUES

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ABSTRACT

With the trend of globalization and online trading, the protection of well-known trademarks has now become a crucial issue in intellectual property. According to Section 2(1)(zg) of the Trade Marks Act, 1999, a well-known trade mark is one which has been recognised by a significant portion of public as being indicative of origin such that application on other goods or services might indicate a connection with original owner. Such marks create goodwill and consumer confidence on a large-scale and therefore deserve extensive protection among classes of goods and services.

This study analyses the legal and jurisdictional system in respect of well-known marks under Indian law, examining the definition as have been provided by Sections 11 (6)-(9) with Indian Trademarks Act, 1999. Analysis of case laws Cadbury India Ltd. v. Neeraj Food Products, Tata Sons Ltd. v. Manu Kosuri and PepsiCo Inc. v. Hindustan Coca-Cola Beverages Pvt. Ltd., this article examines the manner in which Indian courts have evolved trans-border reputation, anti-dilution and bad-faith principles as well.

The paper also discusses digital environment issues such as domain squatting, counterfeiting and online infringement and compares approach of EU, US and UK with that of India. Insights The judicial outlook Although over the years Indian judiciary has emerged as a stronger safe guarder of well-known marks, procedural lapses and weak online enforcement persist. Therefore, the study concludes that law reform, cross-jurisdictional principles, and greater collaboration with private sector representatives in the online sphere are crucial to creating a protection environment where brands can exist without tarnishing their reputations in the digital era.

Keywords: well-known trademarks, judicial interpretation, digital infringement, domain squatting, trans-border reputation, anti-dilution protection, brand integrity, E-commerce platforms.

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INTRODUCTION

A trademark is far beyond just a label for trade and businesses, it depicts the reputation, goodwill and quality of a brand. Eventually, some trademarks attained exceptional recognition and become associated with a specific source of goods or services in the public consciousness. Indian law has categorised these trademarks as “well-known trademarks”. Section 2(1)(zg) of the Trade Marks Act, 1999, has defined well-known trademark as “a mark which has become so 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 with a person using the mark in relation to the first-mentioned goods or services.”²

Recognizing and protecting well-known trademarks is crucial for ensuring fair competition and preventing consumer deception. This protection helps maintain the distinctiveness and reputation that brands build over years of consistent use and consumer trust.³ These trademarks are seen as prime assets, and any improper use can lead to serious detriment that are not just limited to the owner but also for consumers who has trust in the brand reputation as a benchmark of quality.

In the current tech era, the relevance of well-known trademarks has become even more important. The expansion of electronic commerce, e-marketing, and social networking has unlocked abundant opportunities for brands to scale, but it has also introduced contemporary complexity in avoiding misuse and abuse.⁴ Issues like digital overreach, illegal domain squatting, and the commercial counterfeiting in the international platform have diminished geographical distinctions and raised the chance of well-known marks being abused without authorization.⁵ The online anonymity and the swift distribution of infringing activities make enforcement notably demanding. For that reason, there is a rising necessity for strong judicial protection and preventive actions to safeguard the reputation of well-known trademarks in the online world.

² The Trade Marks Act, 1999, No. 47 of 1999, Sec. 2(1) (zg), INDIA CODE (Ministry of Law & Justice, 1999),

³ World Intellectual Prop. Org. (WIPO), Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, art. 2 (1999).

⁴ Shilpi Bhattacharya, The Protection of Well-Known Trademarks in India: Issues and Challenges in the Digital Era, 10 J. INTELL. PROP. RTS. 216, 218 (2022).

⁵ Christian Louboutin SAS v. Nakul Bajaj, (2018) 76 PTC 508 (Del. H.C.) (holding that online marketplaces may be liable for actively promoting counterfeit goods).

This research intends to examine the legal framework and judicial interpretations contextual to well-known trademarks in India. It points out how courts have developed standards to protect brand reputation. Moreover, it confronts today's problem of digital enforcement and examines major judicial cases like Cadbury India Ltd. v. Neeraj Food Products,⁶ Tata Sons Ltd. v. Manu Kosuri⁷ and PepsiCo Inc. v. Hindustan Coca-Cola Beverages Pvt. Ltd.⁸ The study also contrasts the India's approaches in line with those of the European Union, the United States, and the United Kingdom. In the end, it is designed to spot the weaknesses in current enforcement methods and suggests policy and procedural changes to enhance the protection of well-known trademarks in the digital marketplace. To preserve brand integrity and consumer trust, it's important to have judicial recognition, aligned legal standards, and preventive administrative enforcement. Ensuring safety to well-known trademarks not just promotes fair trade but also strengthens India's intellectual property framework on the global stage.

LEGAL FRAMEWORK IN INDIA

In terms of protecting well-known trademarks in India, the Trade Marks Act of 1999 is the major contributor. This legislation not only integrates global best practices from the TRIPS Agreement and the Paris Convention but also gives legal recognition to well-known marks. It empowers both the Registrar and the judiciary to step in and prevent any misuse, even if it involves goods or services that are completely unrelated.

1. Statutory Basis under the Trade Marks Act, 1999

The term "well-known trademark" made its formal launch in Indian law through Section 2(1)(zg) of the Trade Marks Act, 1999. This section defines it as a mark that is broadly known to a segment of public, to the extent that using it on different goods or services would suggest a connection to the original owner.⁹

Moreover, Section 11 outlines the reasons a trademark might be denied registration. Specifically, Section 11(2) offers protection for well-known trademarks by stating that a mark cannot be registered if it is identical or similar to an existing well-known mark, especially if

⁶ Cadbury India Ltd. v. Neeraj Food Prods., (2007) 35 PTC 95 (Del. H.C.).

⁷ Tata Sons Ltd. v. Manu Kosuri, (2001) PTC 432 (Del. H.C.).

⁸ PepsiCo Inc. v. Hindustan Coca-Cola Beverages Pvt. Ltd., (2003) 27 PTC 305 (Del. H.C.).

⁹ The Trade Marks Act, 1999, No. 47 of 1999, Sec. 2(1)(zg), INDIA CODE (Ministry of Law & Just., 1999)

using it would unfairly benefit from or harm its distinctiveness or reputation.¹⁰ One of the most crucial parts of the Act is Section 11(6), which sets out the criteria for determining whether a mark qualifies as well-known. These criteria include:

- How well the mark is recognized among the relevant public;
- The duration, geographical reach, and extent of its use and promotion;
- The record of successful enforcement and judicial acknowledgment; and
- Any other factors that the Registrar deems significant.¹¹

This adaptable list allows both the Registrar and the courts to take into account both domestic and international recognition when deciding if a mark is well-known.

Additionally, Sections 11(7), 11(8), and 11(9) offer more insights. Section 11(8) states that once a court recognizes a mark as well-known, the Registrar must consider it well-known in future cases.¹² Section 11(9) makes it clear that it's not necessary for a mark to be used or registered in India to gain recognition, which means that foreign marks with a strong global reputation can still be protected, showing India's commitment to the idea of transnational reputation.¹³

2. The Role of Judiciary and Intellectual Property Appellate Board (IPAB)

Judiciary has always played a very important role in giving life to the concept of well-known marks in India. Even before the enactment of the 1999 Act, courts were extending protection to internationally recognized marks like "BENZ," "WHIRLPOOL," and "APPLE," on the premise of trans-border reputation.¹⁴ This case had to do, for example, with the decision of the Delhi High Court in *Daimler Benz AG v. Hybo Hindustan*, which held that the "BENZ" mark should receive protection even for unrelated goods, in that it represented an exceptional quality or reputation throughout the world.¹⁵

¹⁰ Id. Sec. 11(2).

¹¹ Id. Sec. 11(6).

¹² Id. Sec. 11(8).

¹³ Id. Sec. 11(9).

¹⁴ *Whirlpool Co. v. N.R. Dongre*, (1996) PTC 415 (Del. H.C.).

¹⁵ *Daimler Benz AG v. Hybo Hindustan*, (1994) PTC 287 (Del. H.C.).

The Intellectual Property Appellate Board (IPAB) before being abolished in 2021 under the provision of the Indian Tribunals Reforms Act, 2021, the IPAB was acting as an appellate authority to the decisions of the Registrar, including disputes arising from the recognition or refusal regarding well-known marks.¹⁶ Since the enactment of the Tribunals Reforms Act, 2021, such functions have been brought under the jurisdiction of the High Courts, thus providing direct judicial oversight on appeals relating to trademarks.

Indian courts through judicial precedent, whereby cleared that well-known marks are not only protected in similar or identical mark but also protected against dilution, misrepresentation, and bad faith registration.¹⁷ In fact, such consistent judicial recognition has been instrumental in forming a robust enforcement mechanism under Section 11.

3. Instructions from Controller General of Patents, Designs and Trade Marks (CGPDTM)

Under the Trade Marks Rules, 2017, Rule 124 constituted a formal mechanism allowing proprietor to apply for inclusion of their marks in the official List of Well-Known Trademarks.¹⁸ Subsequent to the same, the Public Notice No. CG/Public Notice/2017/217 was issued by the CGPDTM on May 22, 2017, laying down the Guidelines for Filing an Application for Well-Known Trademark Status.¹⁹ Amongst others, these guidelines state that:

- Application must be electronically filed in Form TM–M along with a fee of ₹1,00,000;
- The applicant must produce evidence of reputation of the mark including but not limited to, judicial recognition, turnover, and advertising material;
- The mark is published in the Trade Marks Journal for opposition, If the acceptance is given, and thereafter included in the official list.

These guidelines stress accountability and public involvement. By 2025, more than 150 marks were recognized by CGPDTM as well-known, including AMUL, TATA, RELIANCE, and

¹⁶ The Tribunals Reforms Act, No. 33 of 2021, Sec 3.

¹⁷ ITC Ltd. v. Philip Morris Prods. SA, (2010) 42 PTC 572 (Del. H.C.).

¹⁸ Trade Marks Rules, 2017, Gazette of India, Rule 124 (India).

¹⁹ Controller General of Patents, Designs & Trade Marks, Guidelines for Filing an Application for Well-Known Trademark Status (May 22, 2017) (India)

COCA-COLA.²⁰

However, scholars have pointed that the absence of fixed timelines and uniform criteria could result in delays and uncertainty in this already ambiguous affair.²¹ Any further enhancement of procedural clarity and coordination between the judiciary and the Registry would work towards improving the general effectiveness of the well-known marks law in India.

JUDICIAL RECOGNITION AND CASE LAW ANALYSIS

Judicial interpretation has been the most important factor in developing the concept and protection of well-known trademarks in India. Even before the statutory recognition under the Trade Marks Act, 1999, Indian courts had been consistently protecting marks with global reputation by applying principles of trans-border reputation and unfair advantage. The courts have accepted that the intrinsic value of a trademark lies in its good will, and protecting well-known marks is an advantage in the interest of both the businessmen and the consumers.

1. Cadbury India Ltd. v. Neeraj Food Products (2007)

In this case, Cadbury India, trademark owner of “CADBURY GEMS” and its distinctive multi-coloured pillow pack, filed suit against Neeraj Food Products for offering "JAMES BOND" in the same colour combination and design with chocolate.²² The Delhi High Court ruled that the defendant's product is deceptively similar in its appearance and get-up, which would easily mislead the consumers regarding the source of origin.

The Court ruled in favour of Cadbury that the trade dress and the packing could also be elements that would be entitled to protection as a well-known mark.²³ The judgment established that even imitating or using visual scheme of as well-known goods amounting to passing off and dilution, even if the infringer uses a different name. This case established that the protection granted to well-known marks was not only for identical word marks but could include even overall appearance and consumer perception.

²⁰ Controller General of Patents, Designs & Trade Marks, List of Well-Known Trade Marks in India (Feb. 2025).

²¹ S.S. Rana & Co., Well-Known Trademarks in India: Legal Landscape and Protection, MANAGING INTELL. PROP. (2024).

²² Cadbury India Ltd. v. Neeraj Food Prods., (2007) 35 PTC 95 (Del. H.C.).

²³ Id.

2. Tata Sons Ltd. versus Manu Kosuri & Others (2001)

The plaintiff, Tata Sons Ltd, the owner of the famous “TATA” mark, came to court for injunction against the defendant who had registered domain names like “tatainfotech.com” and “tatafinance.com.”²⁴ The Delhi High Court recognized TATA as a household name having an enormous goodwill both in India and abroad.

It was held by the Court that the existence of domain names with the “TATA” mark in registration by other parties constitutes cybersquatting as well as mala fide use.²⁵ It also observed that domain names perform functions of trademarks in the digital space; their function is identifying the source and origin of goods and services. Hence unauthorized registration of such names amounts to passing off.

This case represented a revolution in the protection of well-known trademarks in cyberspace. The Court effectively extended the traditional trademark protection to the online environment and has confirmed that the principles of passing off apply to cases into the virtual world.

3. PepsiCo Inc. v. Hindustan Coca-Cola Beverages Pvt. Ltd. (2003)

In this case, PepsiCo, the owner of the slogan "Yeh Dil Maange More", acted against Coca-Cola for its commercial usage of the phrase "Yeh Dil Maange No More", where the Coca-Cola has used it in its advertising campaign.²⁶ The PepsiCo informed the court that this slogan was indeed much popularized and then recognized solely with the identity of the brand.

The Delhi High Court, held that the slogan had acquired distinctiveness and a reputation through enormous advertisement. The court allowed comparative advertising, but not when such advertising harms or unjustly takes exploitation of any goodwill generated by another brand.²⁷ The court ruled that the defendant's slogan amounted to misrepresentation and unfair advantage thus diluting the mark of famous PepsiCo.

This created a wider ambit of well-known marks protection not only to advertising phrases but also slogans that can either be held as trade mark of the brand, thus suggesting an extension of

²⁴ Tata Sons Ltd. v. Manu Kosuri, (2001) PTC 432 (Del. H.C.).

²⁵ Id.

²⁶ PepsiCo Inc. v. Hindustan Coca-Cola Beverages Pvt. Ltd., (2003) 27 PTC 305 (Del. H.C.).

²⁷ Id.

trade mark to include creative expressions that have become distinct in themselves to form a brand identity entirely apart from the traditional trademark.

4. Trends and Judicial Approaches

Emerging from the judgments above, several judicial trends that underpin India's approach to protection of well-known trademarks become evident:

a) Recognition of Trans-Border Reputation:

Indian courts have constantly maintained that any foreign mark finds protection in India, even in the absence of use or registration, when it is given recognition worldwide. In *Whirlpool Co. v. N.R. Dongre*, this clear principle was established, wherein the Supreme Court looked into international reputation and recognized the mark WHIRLPOOL as a well-known trademark.²⁸

b) Protection Extended Beyond Goods and Services:

Dissimilar goods were protected from the application of the dilution principle concerning well-known marks. In *Daimler Benz AG v. Hybo Hindustan*, the protection was awarded to the mark "BENZ" against its use on undergarments, making sure that reputation, not similarity of goods, was the deciding factor.²⁹

c) Protection within the Digital Environment:

The rise of e-commerce and internet domains has attracted the application of traditional principles of passing off to cyberspace. The *Tata Sons and Yahoo! Inc. v. Akash Arora* cases have been central to issues regarding online infringement and domain squatting.³⁰

d) Judicial Declarations as Guiding Principles for Administrative Recognition:

Once a mark has been declared well-known by a court, the Registrar must treat it as well known in subsequent proceedings as per Section 11(8) of the Trade Marks Act, 1999. This induces judicial discipline and influences administrative recognition under Rule 124 of the Trade Marks

²⁸ *Whirlpool Co. v. N.R. Dongre*, (1996) PTC 415 (Del. H.C.), aff'd, (1998) 8 SCC 1 (India).

²⁹ *Daimler Benz AG v. Hybo Hindustan*, (1994) PTC 287 (Del. H.C.).

³⁰ *Yahoo! Inc. v. Akash Arora*, (1999) PTC 201 (Del. H.C.).

Rules, 2017.

5. The challenges in judicial recognition

Whereas the Indian judiciary has been very proactive, there are still some issues that remain:

- Absence of Uniform Standards, sometimes divergent courts may adopt differing criteria for determining well-known status, arriving-usually at conflicting results.³¹
- Inordinate delays in procedure, even though judicial recognition exists, the official inclusion process in the CGPDTM's list can take a long time.
- Difficulties in digital enforcement, the borderless nature of online infringements makes it difficult to enforce injunctions against foreign entities.
- Evidential burden, Trademark owners often find it difficult to prove the extent of their reputation, especially in cross-border cases, through surveys and documentary evidence.

Yet against such odds, Indian courts have showcased their movement towards being progressive and dynamic in protecting the well-known trademarks' reputation. The degree of judicial creativity manifested by the courts and their adaptability to a digital world has been a hallmark of this development.

CHALLENGES IN THE DIGITAL ERA

The Internet challenged the trademark system in the modern age. The internet has opened up the avenue for the trade-marks to become known to a wider audience. Still, with this very opportunity, it has opened another box of challenges for the protection of well-known marks. Online infringements, cybersquatting, counterfeiting, and other forms of cross-border abuses have become order since time immemorial, often erasing the good-will established literally over the years by some of the well-established brands. The very anonymity and borderless nature of the internet provide advantages to infringers in terms of violating well-known marks while putting jurisdictional and enforcement control far out of reach.

³¹ S.S. Rana & Co., Well-Known Trademarks in India: Legal Landscape and Protection, *MANAGING INTELL. PROP.* (2024).

1. Online Infringement and Unauthorized Use

Online infringement generally means the misuse of trademarks in the digital environment, deceptive advertisements, impostor social media accounts, or deceptively made listings of products. Well-known marks become particularly vulnerable because not only do they attract bona fide customers, but also infringers seeking to capitalize on their fame.³²

In *Yahoo! Inc. v. Akash Arora*, the Delhi High Court deemed the using of the domain name “YahooIndia.com” passing off and stated: “a domain name serves the same function as a trademark.”³³ The court recognized that consumers often rely on online identifiers just as they do on physical trademarks, which would cause confusion and dilution if such identifiers were used without authority. Similarly, in *Tata Sons Ltd. v. Manu Kosuri*, the court restrained the defendants from using domain names which included the “TATA” mark and held that trademark protection does extend to cyberspace.

But enforcing such rights online remains a challenge. Infringers often hide their identity, utilize proxy servers, and work in multiple jurisdictions. The fast-paced nature of digital content also makes timely injunctions impossible to achieve.³⁴ This explains why courts are now extending trademark protections into cyberspace, while procedural enforcement still trails behind.

2. Domain Squatting

Cybersquatting is described as a registration of domain names with bad faith from the owner, with intent to sell or divert traffic from domains that bear similarities to trademark rights.³⁵ Courts in India have dealt with these cases following the principles of passing off and unfair competition. In *Rediff Communication Ltd. v. Cyberbooth*, the court in Bombay went on to state, “A domain name is more than an Internet address; it identifies the business itself.”³⁶ The court held that “Radiff.com” was registered to deceive users, thereby injuring the goodwill associated with the plaintiff’s “Rediff.com” mark.

Though the main global architecture—the Uniform Domain Name Dispute Resolution Policy

³² *Yahoo! Inc. v. Akash Arora*, (1999) PTC 201 (Del. H.C.)

³³ *Tata Sons Ltd. v. Manu Kosuri*, (2001) PTC 432 (Del. H.C.)

³⁴ Shilpi Bhattacharya, *The Protection of Well-Known Trademarks in India: Issues and Challenges in the Digital Era*, 10 J. INTELL. PROP. RTS. 216, 219 (2022).

³⁵ World Intell. Prop. Org. (WIPO), *Overview of Domain Name Dispute Resolution* (2020), <https://www.wipo.int/amc/en/domains>

³⁶ *Rediff Comm’n Ltd. v. Cyberbooth*, (1999) 4 Bom. C.R. 278 (Bom. H.C.).

under ICANN - provides indirect means to resolve such disputes, enforcement, in reality, is often slow and remains optional.³⁷ There is no specific law against cybersquatting in India comparable to the United States, where the Anti cybersquatting Consumer Protection Act tutelages bad-faith domain registration.³⁸ So mainly, Indian courts have relied on equitable doctrines, which do work at times; however, the pattern is very slow and not uniform across cases.

3. E-Commerce and Online Marketplace Liability

E-commerce platforms like Amazon, Flipkart, and Snapdeal have transformed the way consumers gain access to brands. While this boom has changed the lives of many, it also has associated lots of risks, such as unauthorized sales, counterfeit goods,³⁹ and trademark infringement. Product titles and descriptions frequently use a well-known mark to draw buyers' attention, notwithstanding the extreme case when products are unrelated or counterfeit.

Intermediaries cannot claim safe harbour from the liability of for sale or counterfeit goods when they actively promote and sell counterfeit goods, said the Delhi High Court in the case of Christian Louboutin SAS v. Nakul Bajaj. The court held that if an intermediary participates in promoting or shipping counterfeit goods, it could be treated as a contributory infringer." With this declaration the Indian jurisprudence was majorly advanced toward the global trend of holding digital intermediaries accountable.

Though the Information Technology (Intermediary Guidelines and Digital Media Ethics Code) Rules, 2021, require the platforms to remove infringing content on receipt of notice, there is inconsistent application.⁴⁰ There is an urgent need for clear legislative standards that strike a balance between reducing intermediary liability and nurturing innovation in digital trade.

4. Counterfeiting and Grey

Counterfeiting is one of the most blatant assaults on established trademarks. This process is enabled by online platforms and social media, which counterfeiters use to market and sell goods

³⁷ Internet Corp. for Assigned Names and Numbers (ICANN), Uniform Domain Name Dispute Resolution Policy (1999)

³⁸ Anti cybersquatting Consumer Protection Act, 15 U.S.C. Sec. 1125(d) (1999).

³⁹ Christian Louboutin SAS v. Nakul Bajaj, (2018) 76 PTC 508 (Del. H.C.).

⁴⁰ Information Technology (Intermediary Guidelines and Digital Media Ethics Code) Rules, 2021, Gazette of India, G.S.R. 139(E) (India)

on a large scale, often under the very same logos or packaging. Counterfeiting represents a deliberate assault on brand reputation, gives rise to consumer deceit, and severely undermines public safety.

Civil and criminal remedies for counterfeiting are provided by the Trade Marks Act, 1999. These remedies include injunctions, damages, and an order of imprisonment under Sections 102-104.⁴¹ Enforcement is sought to be made even more difficult, as counterfeit networks, known to function on anonymous online identities, often operate across national borders.

Grey market is the other kind of problem. Unauthorized importation or sale of genuine branded goods constitutes grey marketing since it undermines the trademark owner's authority. The Delhi High Court ruled in *Kapil Wadhwa v. Samsung Electronics Co. Ltd.* that parallel import can infringe a trademark if it interferes with the proprietor's control over its quality or distribution. While such trade may not always concern counterfeit goods, it undermines the brand's distribution strategy and diminishes consumer confidence in quality assurance.⁴²

5. Cross-Border Enforcement Difficulties

Cross-border enforcement has remained one of the World Wide Web's most challenging tickets when it comes to the protection of well-known marks. Digital infringements often start from out of India, with a limited jurisdiction on local courts against those seated abroad. While India is a signatory to international treaties like the Paris Convention and the TRIPS Agreement, these treaties neither provide for the direct enforcement of their provisions.⁴³

Without a global mechanism for enforcement, brand owners are often left with no options other than to start multiple actions in different jurisdictions, incurring severe costs and delays. Enhanced cooperation with inter-governmental organizations like WIPO and ICANN, and mutual recognition of injunctions, could greatly improve the enforcement regime.⁴⁴ Until then, the protection of well-known trademarks in cross-border digital space is disorganized and ambivalent.

⁴¹ The Trade Marks Act, 1999, No. 47 of 1999, sec. 102–104, INDIA CODE (Ministry of Law & Just., 1999)

⁴² *Kapil Wadhwa v. Samsung Elecs. Co. Ltd.*, (2012) 50 PTC 719 (Del. H.C.)

⁴³ Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299.

⁴⁴ World Intell. Prop. Org. (WIPO), Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks (1999).

COMPARITIVE STUDY: EU, US, AND UK APPROACHES TO PROTECTING WELL-KNOWN TRADEMARKS ONLINE

Well-known trademark protection constitutes an international concern, especially in this digital age when the internet has almost completely done away with physical boundaries within a commercial context as well as on the side of infringing goods. The different jurisdictions have created their own kinds of systems which often tend to be different over time but usually overlap either with respect to the type of unauthorized use of famous marks or the conditions under which such kinds of unauthorized usage are subject to protection. The comparative study of the approaches of the European Union, United States of America, and the United Kingdom, will be beneficial for strengthening the enforcement framework of India.

European Union

In fact, the European Union has perhaps the most developed systems of trademark protection for well-known trademarks. The marks with reputation are easily made protectable specifically by EU Trade Mark Regulation and EU Trade Mark Directive against similar goods or dissimilar ones.⁴⁵

Article 9(2)(c) of the EUTMR and Article 10(2)(c) of the EUTMD entitles a proprietor of a mark with reputation to prevent the use, by an identical or similar sign, of which such use takes unfair advantage of or is detrimental to, the distinctive character or reputation of the mark.⁴⁶ Thus, the framework introduces the "anti-dilution principle", which aims to preserve the unique value beyond the possibility of confusion among consumers by well-known marks.

One way in which the Court of Justice of the European Union has fulfilled its key interpretative role with regard to such provisions has occurred in *L'Oréal SA v. Bellure NV*, whereby it was established that using a similar mark in comparative advertising while taking advantage of a well-known brand's reputation is considered unfair gain from that use, even if consumers are not misled.⁴⁷ The jurisprudence of the CJEU has combined with the administrative procedures of the EU Intellectual Property Office (EUIPO) to form a twin enforcement structure that

⁴⁵ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union Trade Mark, 2017 O.J. (L 154) 1.

⁴⁶ Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015, 2015 O.J. (L 336) 1.

⁴⁷ *L'Oréal SA v. Bellure NV*, [2009] E.C.R. I-05185 (CJEU)

effectively controls online infringement and keyword advertising misappropriation.

In addition, the Digital Services Act (DSA) of the EU, adopted in 2022, brings more stringent due diligence obligations to online platforms by making them require proactive monitoring for infringing content and their prompt removal.⁴⁸ Thus, the complete legal framework preserves balance between brand protection and innovative developments in the digital world.

United States

The United States has long recognized the need for special protection for the famous marks, on and offline. The Lanham Act offers the foundation of trademark law in the US and contains strong provisions on both dilution and cybersquatting. Since its onset, the FTDA has been protecting famous marks against the dilution of distinctiveness or tarnishing of reputation against both competition and confusion.⁴⁹ The courts have applied these doctrines to online cases of unauthorized use of keywords, domain names, and comparative advertising.

To curb domain abuse, the Anti cybersquatting Consumer Protection Act was adopted in 1999.⁵⁰ The ACPA gave trademark owners the right to sue for bad-faith registration of domain names identical or confusingly similar to their marks, providing for damages by statute and transfer of domain name, thus offering an effective legal solution against the harmful practice of cybersquatting.

The United States has further fostered cooperation among courts, online platforms, and enforcement agencies, enabling the swift removal of counterfeit listings and the misuse of famous marks. The synergistic approach to statutory specificity and technological enforcement has set the United States' blueprint for online trademark protection in good stead as a global benchmark.

United Kingdom

Since Brexit, the UK continues to apply many of the EU-inspired protections under its Trade Marks Act 1994, which also continues to protect marks with reputation against dilution and

⁴⁸ Regulation (EU) 2022/2065 of the European Parliament and of the Council of 19 October 2022 on a Single Market for Digital Services (Digital Services Act), 2022 O.J. (L 277) 1.

⁴⁹ Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, 120 Stat. 1730 (codified at 15 U.S.C. Sec. 1125(c)).

⁵⁰ Anti cybersquatting Consumer Protection Act, 15 U.S.C. Sec. 1125(d) (1999).

unfair advantage.⁵¹ A trademark with a reputation in the UK is protected against the use of identical or similar marks upon dissimilar goods or services under Section 10(3) of the Act where such use constitutes an unfair advantage or is detrimental to the trademark's repute.⁵²

UK courts have broadly interpreted these provisions to include online misuse and keyword advertising. The Court of Appeal in *Interflora Inc. v. Marks & Spencer plc* found that the use of a competitor's trademark as a keyword in Google Ads was actionable as a trademark infringement if it was found to be unfairly benefiting from the mark's reputation.⁵³

Besides, the UK Intellectual Property Office has procedures for opposition and invalidation on the basis of the reputation of an earlier mark administratively. In UK 2023, the Online Safety Act provides further protective measures by laying obligations on digital platforms to stop harmful and infringing online content.⁵⁴ Together, these combine to invigorate the system in the UK, stressing both protection by courts and regulation by platforms in a proactive advisory capacity.

Lessons for India's Digital IP Enforcement Strategy

A comparative study of these jurisdictions reveals many lessons for India as it moves on to further strengthen protection of well-known trademarks in the digital context:

- **Enact Specific Anti-Cybersquatting Legislative Provisions:**

India should follow the example of the ACPA in the U.S. and enact a statutory remedy directly for bad-faith domain name registration and misuse instead of reliance on common-law passing off actions.

- **Increase Responsibility of Platforms:**

The Directive of the European Union on Digital Services and the Online Safety Act of the United Kingdom draw out accountability from digital platforms. India's Intermediary Guidelines, 2021, can borrow from those laws and extend trademark-specific obligations to e-

⁵¹ Trade Marks Act 1994, c. 26 (U.K.)

⁵² Id. Sec. 10(3).

⁵³ *Interflora Inc. v. Marks & Spencer plc*, [2014] EWCA Civ 1403 (C.A.).

⁵⁴ Online Safety Act 2023, c. 49 (U.K.)

commerce and social media intermediaries.

▪ **Establish Unified Digital IP Enforcement Authority:**

Establishing a specialised digital cell for IP under the CGPDTM or Ministry of Commerce would streamline cooperation with online platforms and also international organizations such as the WIPO and the ICANN.

▪ **Encourage Administrative Remedies:**

The EU and UK models show that administrative recognition and opposition procedures may be effective. The growth of India's Rule 124 process under the Trade Marks Rules, 2017, will provide clear timelines and more transparency for quicker protection of highly reputed marks.

▪ **Foster Cross-Border Cooperation:**

India should work with international IP agencies and build a common global network for digital enforcement for rapid cross-border de-activation of illegal websites and counterfeit listings.

FUTURE-ORIENTED STRATEGIES

The world is changing rapidly, however, and with it the advent of digital commerce and the need for future origins of well-known marks. In a nutshell, while India's Trade Marks Act, 1999, and judicial pronouncement have been very beneficial for laying a strong foundation, the current framework needs to be improved to tackle the identified difficulties pertaining to online infringement, counterfeiting, and the procedural inconsistencies seen. The following recommendations are given with comparative insight from that of the EU, the US, and the UK, and an analytical study of judicial trends in India, aimed at strengthening well-known trademarks' protection in this new digital age.

▪ **Strengthening Digital Vigil & Anti-Counterfeiting Measures**

Digital enforcement is the backbone of modern trademark protection. Traditional enforcement mechanisms are no longer sufficient with the development of online markets, social media, and cross-border trading.

This centralized system would have to be set up in India under the CGPDTM for the

identification and flagging of potential abuse of well-known marks online.⁵⁵ Other high-tech elements may include use of AI-powered brand monitoring, auto-detection of counterfeit listings, and integration with customs and e-commerce databases for proactive protection.

Brand owners would be well served by encouraging registration under the Amazon Brand Registry, Alibaba IP Protection Platform, and their likes for early takedowns.⁵⁶ Also, legislative reforms would impose mandatory duties on e-commerce intermediaries with respect to seller verification and timely removal of infringing listings. The Information Technology (Intermediary Guidelines and Digital Media Ethics Code) Rules, 2021, may be amended to introduce trademark-specific due diligence requirements for online platforms.⁵⁷

To help fight counterfeiting, India may consider adopting a system similar to that of the European Union's IP Enforcement Portal, which allows right-holders to share data for faster interception of counterfeit assemblies at borders.⁵⁸ Increased financing and, hence, coordination within DPIIT, Customs Authorities, and Cybercrime Cells could further give the anti-counterfeiting effort a boost.

▪ **Judicial Guidelines Clarified Recognizing Market Well-Known Marks**

Judicial recognition is very influential in protecting well-known marks in India. Unfortunately, different interpretations and contradicting evidentiary standards often result in uncertainty. The Courts must develop uniform judicial guidelines on evidentiary criteria in determining well-known status under Section 11(6) of Trade Marks Act, 1999.⁵⁹

These guidelines may include:

- Minimum evidence requirements of reputation, duration of use or advertising expenditure, and recognition surveys;
- Weightage in favour of previous judicial recognition or administrative listing by the

⁵⁵ Online Safety Act 2023, c. 49 (U.K.)

⁵⁶ Amazon Brand Registry, Protect Your Brand (2024), <https://brandservices.amazon.in>; Alibaba Group, IP Protection Platform (2024), <https://ipp.alibabagroup.com>

⁵⁷ Information Technology (Intermediary Guidelines and Digital Media Ethics Code) Rules, 2021, Gazette of India, G.S.R. 139(E) (India).

⁵⁸ European Union Intellectual Property Office (EUIPO), IP Enforcement Portal: Overview (2024), <https://euiipo.europa.eu>

⁵⁹ The Trade Marks Act, 1999, No. 47 of 1999, Sec. 11(6), INDIA CODE (Ministry of Law & Just., 1999),

CGPDTM; and

- Clear differentiation between well-known marks and marks that have a reputation ensuring procedural consistency.

The Delhi High Court may take the lead, since it already operates as a nodal court for IP matters under the Intellectual Property Division framework.⁶⁰ A consolidated judicial manual or model guidelines worthy of an approval by the Supreme Court would make for predictability and avoid arbitrary decisions across jurisdictions.

In addition, the CGPDTM's process under Rule 124 should include a standardized evaluation checklist for applicants for well-known status, as well as maximum periods for disposal.⁶¹ Transparency in publication and public objections would enrich procedural fairness and diminish redundancy between judicial and administrative recognition.

▪ Partnering with Online Platforms for Efficient Enforcement

A synergy in enforcement between trademark authorities, courts, and online intermediaries is now a necessity in a digital environment. The US and EU have adopted collaborative models whereby platforms, regulators, and right holders share responsibility in enforcement for their trademarks.⁶²

This can be translated into a Public-Private Digital Enforcement Partnership, where the CGPDTM, major e-commerce platforms, and industry associations such as FICCI and CII will come together to build shared databases of infringing sellers and counterfeit listings. Such partnerships would enable real-time notice-and-action systems, automated suspension of repeat infringers, and transparency in online takedown processes.

All platforms must publish an annual IP transparency report outlining the number of trademark takedowns processed, those that are pending, and preventive measures adopted.⁶³ Moreover, linking the database of well-known marks as held by the CGPDTM with backend systems of

⁶⁰ Delhi High Court (Intellectual Property Division) Rules, 2022, Gazette of India, G.S.R. 505(E)

⁶¹ Controller General of Patents, Designs & Trade Marks, Guidelines for Filing an Application for Well-Known Trademark Status (May 22, 2017) (India), <https://ipindia.gov.in>

⁶² Regulation (EU) 2022/2065 of the European Parliament and of the Council of 19 October 2022 on a Single Market for Digital Services (Digital Services Act), 2022 O.J. (L 277) 1.

⁶³ European Commission, Guidelines on Transparent Reporting by Online Platforms (2023), <https://digital-strategy.ec.europa.eu>

e-commerce would automatically identify protected brands during seller registration or product listing.

The ongoing National E-Commerce Policy would further become necessary not to leave out digital IP cooperation, based on the model provided in the EU's Digital Services Act. The balance of responsibility among right holders, platforms, and regulators would be assured.⁶⁴

CONCLUSION

Well known trademark protectable essential seconds the modern intellectual property regimes. On this time-digital economy, where the brand visibility extends beyond country's border and into various online platforms, recognition of well-known trademark becomes the hallmark of effective trademark safety. Indian courts, through progressive interpretation, have invariably recognized goodwill and reputation to extend to famous marks protection against dissimilar goods, domain misuse, and online infringement.

The Trade Marks Act, 1999 itself, Sections 11(6) to 11(9), makes a strong statutory basis for the creation of well-known marks. However, judicial creativity has added to it, and it was equally important in extending this protection right up to new technological realities. *Cadbury India Ltd. v. Neeraj Food Products*, *Tata Sons Ltd. v. Manu Kosuri*, and *Christian Louboutin SAS v. Nakul Bajaj* are but a few of the cases to illustrate the way the Indian courts have interpreted the law of trademarks to tackle the challenges posed by the digital world and thus reinforce the relationship between judicial innovation and the integrity of brands.

Otherwise progress, challenges continue, however persistent. There have been challenges of enforcement within the continued cross territories, namely online counterfeiting, cybersquatting, and unauthorized uses of e-commerce platforms. Because in most cases, enforcement fails because of slow processes of administrative recognition, differences in the standards applied by courts, and the lack of coordination in terms of operations involving court, trademark registry, and online intermediaries. Cross-border digital infringements also show limits of traditional enforcement measures and necessitate greater international efforts.

Thus, India needs legal and policy reforms on three main fronts to keep up with evolving

⁶⁴ Department for Promotion of Industry and Internal Trade (DPIIT), Draft National E-Commerce Policy (2023), <https://dpiit.gov.in>

challenges:

- Installation of stricter digital monitoring and anti-counterfeiting systems,
- Clarification of judicial and administrative standards for recognizing well-known marks, and
- Increased collaboration between government authorities, the judiciary, and online platforms. These reforms will benefit the effective protection of well-known marks along with the increase of consumer trust and fair competition in the market.

In summary, the efficacy of brand protection in this digital age is best via judicial recognition. But within itself, this must go hand in hand with proactive legislative reform as well as technological enforcement mechanisms in order for India to remain globally competitive as well as credible in the IP ecosystem. Harmonizing law, policy, and innovation can give India a competitive edge in the protection of well-known trademarks while providing greater access to equity, integrity, and consumer protection in this digital age.

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