

# All Things IP



Submitted by

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India has had one of the fastest-growing economies over the past decade and this has triggered a spurt in the growth of cross-border trade and commerce, with various transnational corporations establishing a business footprint here. The growth of businesses and brands has ushered in a proactive approach that aids multinational companies in protecting their well-known trademarks in India against infringement and passing off by third parties.

In order to harmonise national trademark laws with its international obligations under the Paris Convention dealing with protection of well-known trademarks, the Indian Trademarks Act, 1999 gives statutory recognition to the principle of well-known trademarks. The Indian Trademarks Act safeguards trans-border reputation of trademarks by laying down that a mark can be considered well known in India even if it has not been used in India, or has been neither applied for nor registered in India and has cast a duty on the Registrar of Trademarks to protect such well-known trademarks. Various decisions by IP courts in the country on this subject matter are in line with the judicial trends prevalent in other developed nations on the aspect of protection of well-known trademarks based on their trans-border reputation.

In another positive change, the Indian Trademark Rules were amended in 2017 to prescribe a formal statutory procedure to make an application to the Registrar of Trademarks for recognition of a trademark as well-known in India. While the new procedure to seek a determination of a trademark as well-known may seem to eliminate the cumbersome requirement to have a trademark declared as well-known only through legal proceedings, it nevertheless increases the onus on the Registrar of Trademarks to exercise its discretionary powers in arriving at such a determination. It would now be interesting to see how various brand owners and companies take advantage of this statutory provision to seek a determination of their trademarks being well-known—a decision that could help them in judicially enforcing their proprietary rights during infringement and passing off actions.

For more information on IP Protection strategies for your business please write back to us at: [saisunder@eshwars.com](mailto:saisunder@eshwars.com)