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**EMERGING ISSUES AND CHALLENGES IN THE PROTECTION OF
TRADEMARK IN INDIA**

- Mahak Jain¹ & Shivam Singh²

“If a man is keeping an idea to himself, and that idea is taken by stealth or trickery-I say it is stealing. But once a man has revealed his idea to others, it is no longer his alone. It belongs to the world.

-Linda SuePark³

Abstract:

In the era of rapid globalization and economic liberalization in India, intellectual property rights, particularly trademarks, have become crucial for businesses. This article explores the current issues and challenges facing trademark protection in India. It delves into the legal framework, including the Trade Marks Act of 1999, and examines emerging obstacles such as non-conventional trademarks, misuse of the registration process, limitations of functionality, fair use laws, parallel imports, and trademark dilution. The research methodology involves a doctrinal approach, analysing primary and secondary data sources. Suggestions for addressing these challenges include enacting clear legislation for non-conventional trademarks, strengthening registration processes, refining laws like fair use, and establishing international agreements. Additionally, there is a call for fixed legislation for passing off to ensure effective trademark protection in India.

Keywords: Trademark protection, Intellectual property rights, Challenges, Legal framework.

INTRODUCTION

Owing to the swift globalisation and opening of the Indian economy, "Intellectual Capital" has emerged as a primary revenue stream in the modern global economy. Intellectual property

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³ LindaSuePark, ASINGLE SHARD,78(2010).

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rights have become increasingly valuable in India's legal landscape, as seen by recent policies and court rulings. The World Trade Organisation (the "WTO")'s Agreement on Trade Related Aspects of Intellectual Property Rights (TRIPS) was accepted by India.⁴ In terms of intellectual property (IP) protection, Indian laws, enforcement clauses, and dispute resolution procedures are now fully TRIPS compliant.

Intellectual property rights (IPRs) refer to the rights that individuals have over their creative works, inventions, intellectual works, and pictures, names, and symbols that are used in trade. Typically, they grant the creator a time-limited, exclusive right to utilise what they've produced.

Trademarks are a part of Industrial Property which is classification of IPR. Any sign, or combination of marks, appropriate to distinguish one undertaking's goods and services from those of other undertakings, shall be eligible for trademark enrollment, as per Article 15 of the passages agreement, provided that it is easily understandable. Similar indications, including words, characters, numbers, colour combinations, and tropological factors, as well as any combination of these signs, must be credible in order to be registered as a trademark. According to Composition 16, the only power to stop third parties from using identical or similar signs for products or services that are similar to those for which the trademark is registered belongs to the owner of the trademark⁵.

Thanks to the Trademarks Act of 1999⁶, trademark law has also been simplified. It is a unique symbol used by dealers to identify the goods they have put up for trade or request from one another. India has found that the preface of the Trade Marks Act, 1999⁷ has been extremely beneficial in terms of the country's efforts to expand its trade and commerce globally.

OBJECTIVES OF THE STUDY

The objective of the study is to look into the issues and barriers that India is now facing with regard to trademark protection. The following are the research's objective:

1. To examine the laws related to protection of trademarks in India and to identify the

⁴Overview: The TRIPS Agreement, World Trade Organisation, https://www.wto.org/english/tratop_e/trips_e/intel2_e.htm

⁵World Trade Organisation, TRIPS, Part II- Standards Concerning the Availability, Scope and Use of Intellectual Property Rights, Sections 1 and 2, Article 16, https://www.wto.org/english/docs_e/legal_e/31bis_trips_04_e.htm#:~:text=Article%2016&text=In%20case%20of%20the%20use,2.

⁶ Trade Marks Act, Act 47 of 1999.

⁷ Id.

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grey areas in trademark laws in India.

2. To inquire and analyze the new emerging challenges being faced by Trademark laws in India in the protection of trademarks in India.
3. To find the possible solutions possible for such grey areas and challenges being faced by the trademark laws.

RESEARCH QUESTION

The aim of this research will be to try to find out the solutions to these questions which will help us to find the issues and challenges in protection of trademark laws:

- What are the grey areas in the existing trademark laws and what are the challenges these grey areas pose?
- What are the new emerging challenges that are being faced by the trademark laws?
- What are the solutions possible for such challenges and grey areas of trademark laws?

HYPOTHESIS

The majority of the research is doctrinal in nature, more specifically a critical examination and analysis of Indian IPR legislation. The following hypothesis is the focus of the research:

- The existing trademark laws in India are ineffective in dealing with the emerging advanced technologies and innovative ideas.

RESEARCH METHODOLOGY

This study's research approach is doctrinal and is predicated on an examination of primary and secondary data sources. The data have been gathered from various books written by reputable authors, articles from various sites or law journals, websites.

CONCEPT AND NATURE OF TRADEMARK

A trademark is a well-known phrase, term, emblem, or symbol that distinguishes a product from all others of its sort legally and serves to identify it specifically. A trademark only serves to identify a product as being uniquely its own and acknowledges the company's ownership of the brand. Whether or not they are registered, trademarks are generally considered a form of intellectual property. Trademark laws also provide protection for unregistered trademarks.

The Trademark Act, 1999⁸ defines a trademark, as, “trademark means a mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others and may include the shape of goods, their packaging and combination of colors.”⁹ A registered trademark is valid for ten years; thereafter renewable perpetually for term of ten years¹⁰.

Trademark is as old as history. Trademarks is one of the essential elements of intellectual property. Its major objective is to safeguard the brand name of the specific product. Use of a trademark determines its marketability. A trademark is more than just a mark that distinguishes the source of a product when buyers purchase it because of it. In a market that is competitive, trademarks are quite important. While there are recurrently several laws in place to protect trademarks, their use dates back to the dawn of civilization. Humans have always made it a point to distinguish their products from those of their rivals, even in the most primitive stages.

THE INDIA LOGUE OF TRADEMARKS

The history of trademark protection in India dates back to the tenth century with the emergence of the "merchandisers mark," demonstrating ownership rights and distinguishing goods. During the middle ages, marks were used to maintain quality standards and monopolies, aiding in consumer recognition of product origin and quality.

Anglo-Indian trademark law traces back to 1266, with the Bakers Marking Law¹¹ requiring bakers to label their products. Before 1940, India lacked a formal Trademark Law, relying on Section 54 of the Particular Relief Act of 1877¹² for legal recourse against violations. The Trademarks Act of 1940 addressed these issues, followed by the Trademark and Merchandise Act of 1958¹³, which modernized trademark protection in line with global practices.

India's accession to the WTO in 1998 prompted efforts to further modernize trademark laws. The Trademarks Bill of 1994 aimed at updating legislation but expired. However, the Trademarks Act of 1999 replaced the 1958 Act, aligning with international standards and

⁸Trade Marks Act, Act 47 of 1999.

⁹Trade Marks Act, Sec. 2 (zb), Act 47 of 1999.

¹⁰Trade Marks Act, Sec. 2 (l), Act 47 of 1999.

¹¹ Aaron Schwabach, INTELLECTUAL PROPERTY 9(2007)

¹² Specific Relief Act, Sec. 54, Act No. 1 of 1877

¹³Lawyerslaw.org, The Trade and Merchandise Marks Act, 1958, July 16, 2014, [THE TRADE AND MERCHANDISE MARKS ACT, 1958 - Lawyers Law](https://www.lawyerslaw.org/)

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TRIPS obligations.¹⁴ It granted protection to trademark holders, defined registration criteria, and outlined legal remedies for infringement.

The 1999 Act introduced provisions for service mark protection, collaborative mark registration, and distinguished well-known trademarks, granting them special status and rights. Police were empowered to arrest offenders under this Act.¹⁵

Compared to the 1958 Act, the 1999 Act provided comprehensive definitions, stricter penalties, longer registration periods, and allowed registration of non-traditional trademarks. The Trademark Rules 2002 supplemented the Act, and both came into force on September 15, 2003¹⁶.

Overall, trademark protection in India has evolved significantly from personal markings in ancient times to comprehensive legal frameworks aligning with global standards, ensuring the rights of trademark holders, and safeguarding consumer interests.

TYPES OF TRADEMARKS

The current legislation governing Indian trademark laws is the Trademark Act 1999¹⁷ and Trademark Rules 2002¹⁸. Following are types of trademarks: -

1. Service Mark:

Service marks are marks used by companies that offer vibrant services. A service mark is identical to a trade mark, with the exception that it designates and distinguishes the source of a service as opposed to a product. Because they indicate services, trademark operations filed under classes 35 to 45 of the trademark law may be referred to as service marks.¹⁹

2. Collective Mark:

The Trade Marks Act of 1999 has established regulations for the registration and safeguarding of cooperative marks, which are owned by groups of people who collaborate to produce specific items. Similarly, MAPRO, AMUL, etc. The members of an association of

¹⁴ Vinod VSople, MANAGING INTELLECTUAL PROPERTY 107 (2006)

¹⁵ Trade Marks Act, Sec. 103, Act 47 of 1999.

¹⁶ The Trade Marks Rules, 2002 Published vide Notification G.S.R. 114(E), dated 26.2.2002, published in the Gazette of India, Extraordinary, Part 2, Section 3(i), dated 26.2.2002.

¹⁷ Ibid.

¹⁸ Ibid.

¹⁹ OPEN STAX available at <https://openstax.org/books/introduction-intellectual-property/pages/4-4-the-four-types-of-trademarks> (last visited February 01, 2024).

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people have benefited from the new definition of the "cooperative mark," yet collaboration is lacking.

3. **Generic Trademark:**

Whether a trademark is registered or not, its value can only be preserved if its owner uses it and responds quickly to infringement or passing-off. Nevertheless, the mark is likely to become a generic term and lose its distinctiveness if other dealers use it in connection with the same or comparable things, or possibly even different commodities. However, over time, the mark's alluring fashionability and unrestricted use or reference by others caused it to lose its distinctiveness and become generic²⁰.

4. **Trade Dress:**

The components that give a product or business its overall look, feel, or vibe are collectively referred to as trade dress. Trade dress is a physical detail that serves no purpose. Many significant characteristics, such as size, form, design, colour etc., may be included in trade dress.

5. **Certification Mark:**

It's a mark that, with the owner's consent, communicates an item's origin, quality, composition, mode of distribution, prices of the products or services they are applied to other crucial information. By demonstrating that the product has undergone quality checks using recognized testing procedures, the instrument mark aims to establish a norm for it and to inspire confidence in customers, which facilitates trademark registration.

6. **Product Mark:**

Whenever a product mark is utilized, it helps customers to identify the source of the items while maintaining the company's reputation. Only goods or products may bear this mark; services are not permitted. The product mark reveals the source, standing, and country of origin of the good.

Trademark applications filed under class 1-34 of The Fourth Schedule to Trade Marks Regulations, 2002 are typically described using product marks.

7. **Shape Mark:**

A shape mark's sole function is to protect a product's shape so that customers will link it with a specific manufacturer and choose to purchase the goods. The shape of the product may be

²⁰ OPEN STAX available at <https://openstax.org/books/introduction-intellectual-property/pages/4-4-the-four>, The Four-Types-of-Trademarks (last visited February 15, 2024).

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registered if it is determined to have a unique shape. The Trademark Act of 1999's definition of a trademark refers to "shapes of things." However, a restriction in Section 9(3)²¹ specifically bans the registration of a trademark that only includes:

- The forms necessary to get a technical result.
- Forms that substantially raise the value of the items.
- Furthermore, the application must be made with regard to the commodities themselves, not the container they are enclosed in.²²

8. **Pattern Mark:**

Only goods with a particular pattern that was created especially for the item are covered by pattern markings. Products with patterns marked on them have distinguishable design patterns that serve as the product's unique attribute. In the event of registration, a pattern must demonstrate its originality.

9. **Sound Mark:**

It's a voice that may be connected to a product or service offered by a certain business. For a voice to be recognized as a trademark, it must be presented in a way that makes it distinctive and recognizable to the customer. Some sound types are expressly prohibited from it being registered as sound marks, according to the Trademark Handbook.

10. **Domain name Trademark:**

A new idea for a domain name trademark evolved as a result of modernity and the world's transition to the internet. Each online company has its own domain name, which is a special address in cyberspace where the website is housed. Since there is no special legislation protecting domain names, the trademarks act of 1999 is used to provide domain name protection.

11. **Well-Known Marks:**

The Trademarks Act of 1999²³ defines well-known trademarks in section 2(zg)²⁴. A mark becomes a well-known trademark when a significant portion of the public can recognize it with ease.

Determination of Well-Known Trademark²⁵

²¹Trade Marks Act, Sec. 9 (3), Act 47 of 1999.

²² Ibid.

²³Trade Marks Act, Act 47 of 1999.

²⁴Trade Marks Act, Sec. 2 (zg), Act 47 of 1999.

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- **Trade mark is well known to the Public at large**

For being considered a well-known trademark it is very important, to be recognized by a wide number of people across. Evidence is required as a serious factor to see the reputation and demand.

In the case of *Canon Kabushiki Kaisha v. Assistant Registrar of Trade Marks, 2008*²⁶ of Trademarks, it was held that even if a trademark is well-known in an exceedingly particular area or section of India, then it'd be considered to be known within the entire country.

- **Essentials of use of a well-Known Trademark-**

In the case of, *Mrs. Ishi Khosla v. Anil Aggarwal 2007 (34) PTC 370 Del*²⁷, Delhi High Court held that the trademark of a product can be popular amongst the consumers overnight also, meeting upon the demand and advertisement and promotion of the product. Therefore, a limited period of use is not required. Hence, the term of use was decided through these precedents.²⁸

- **Scope of promotion of Well-Known Trademark**

In the case of *Whirlpool Co. & Anr vs N.R. Dongre*²⁹, as the defendant company was manufacturing and selling its products under the name of the well-known trademark "Whirlpool", the company was selling those machines illegally at a cheaper quality and cheaper rates, although that trademark wasn't getting used in India, still, it had been held because of the trans-border reputation of that trademark it'd be wrongful and infringement of their exclusive rights to achieve unlawful profits.

PROCESS FOR REGISTRATION OF TRADEMARKS

Registration process in India:

The registered owner of a legitimate trademark has the exclusive right to use the trademark in connection with the goods and services for which it was registered. They also have the right

²⁵ Ashutoshkumarsingh, DETERMINATION OF WELL KNOWN TRADEMARK 45(2011)

²⁶ Canon Kabushiki Kaisha v. Assistant Registrar of Trade Marks, 2008 SCC OnLine IPAB 167.

²⁷ Mrs. Ishi Khosla v. Anil Aggarwal 2007 (34) PTC 370 Del.

²⁸ Supra note 13.

²⁹ Whirlpool Co. & Anr vs N.R. Dongre., (1996) 5 SCC 714.

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to take legal action in the event that trademark infringement occurs. The owner of a trademark must complete these procedures in order to register it³⁰.

1. **Carrying out a thorough trademark search:** This stage is extremely important before submitting an application to register a trademark since it allows the owner of the trademark to determine whether or not their mark is distinctive and unique, as well as whether or not there have been any similar or identical marks filed before.
2. **Filing an application with necessary documents:** The process of registering the trademark for enrollment follows the completion of a search. The application must be submitted in Form TM-A in person at the Trademark Registry Office or online via the authorised IP India website, depending on one's jurisdiction.
3. **Examination of the application by the Trademark Registry:** After the application is submitted, the Registrar will carefully analyze it. The applicant will receive a copy of the Registrar's written report detailing their findings and the Registry's decision to either reject or conditionally accept the trademark within 30 days. After entering the examination report, the candidate has thirty days to submit a response. The Test of Similarity is conducted then.
4. **Post-examination procedures:** If, for any reason, the examiner is not satisfied with the candidate's response or if it does not sufficiently address the objections in the report, she may, at her discretion, call a hearing after the candidate files their response to the examination report. After the entire procedure, if the examiner is completely satisfied with the mark, they can authorise it and submit it for publishing in the Trademark Journal. If there are any remaining objections, they can reject the application.
5. **Advertisement of the application in the Trademark Journal:** The application will be published in the Trademark Journal and stay there for 4 months once the examiner has approved it. Any interested party can submit an objection against the candidate within the time frame mentioned above. The Journal is updated with new, approved trademark applications every Monday. Every Monday, the Journal is updated with newly authorised trademark applications.

³⁰ LEGAL SERVICE INDIA available at <https://legalserviceindia.com/legal/article-8459-steps-to-registration-a-trademark-in-india.html> (last visited on March.03,2023)

6. **Opposition by any third party:** Within 4 months of the date of publication, any person dissatisfied with the operation may file a notice of opposition. According to the Trademark Act of 1999³¹, a notice of opposition would stop the enrollment process and the aspirant's contested mark. If the aspirant wants to continue with the enrollment of the same mark, they must follow certain legal steps.
7. **Registration and renewal of the same after every 10 time:** The last step in the enrollment procedure is to obtain the enrollment instrument. Once the trademark has finished all opposition related legal proceedings and, in the event that the opposition is successful, has been cleared, the candidate will acknowledge the instrument. After the four months of publication have passed and no resistance or false opposition has been submitted, the trademark register office will provide the applicant an automatically created enrollment form within seven days. This form must be renewed after every 10 years.

INTERNATIONAL REGISTRATION OF TRADEMARKS

Each nation has a unique trademark law that specifies the procedures and requirements for registering a trademark there. The Madrid Conference, which specifies a way of sending a global application to the parties to a contract from India through the office of the Registrar of Trademarks, was accepted by the Indian government in 2013.

There are 2 ways to submit an overseas application³²

1. **International application in each sovereign nation:** In compliance with local rules and procedures, an international application must be filed to the trademark office in order to obtain trademark protection in any foreign country.
2. **The international application under the Madrid system:** To begin the trademark registration procedure, an international application under the Madrid protocol may be filed at the Registrar of Trademarks for several countries. Every international application is handled by the foreign country in accordance with their legal system, and all communications are forwarded through the Indian government.

TRADEMARK LAWS IN INDIA

The section under "History of Trademarks in India" provides an overview of the lengthy battle that led to the creation of the Trade Marks Act 1999, which governs trade marks in India. An essential factor in the creation of the Trade Marks Act of 1999 was India's

³¹ Ibid.

³² CLEAR TAX available at <https://cleartax.in/s/international-trademark-registration> (last visited on Jan. 06, 2023)

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membership in international treaties and organisations.

Trademark Act, 1999

Indian trademarks are shielded by the Passing Off remedy in addition to the Trademarks Act, 1999 regulations. The rules protecting trademarks went into effect on September 15, 2003, and are overseen by the Controller General of Patents, Designs, and Trade Marks, a government organisation under the Ministry of Commerce and Industry.³³

Trademark law covers the procedures for registering a trademark, protecting a brand, and preventing trademark fraud.³⁴

Trade Mark Rules, 2022

These regulations, which went into effect on September 15, 2003, aid in managing the trademark registration procedure and categorization. The regulations are subject to periodic modifications. In 2014, for example, the authorised charges for trademark applications submitted in accordance with entries 1, 3, 4, 5, 6, and 7 of the First Schedule of the TM Regulations 2002 were raised from Rs. 3,500 to Rs. 4,000.

Also, the cost of an accelerated assessment of a trademark registration application has doubled to Rs. 20,000 and the latest amendment is of 2017.

ISSUES BEING FACED BY TRADEMARKS

Protecting your intellectual property can be greatly aided by having a registered trademark (IP). And while if having a registered trademark gives you unquestionable benefits and privileges, there are challenges which are faced by the Trade mark laws and sometimes also termed as grey area.

1) Legislation for Non-Conventional Trademarks

Any novel kind of trademark that does not fall under the statutory definition of a trademark is considered to be non-conventional. Because of this, the emphasis is more on what it does not include in the usual category of things than on what it does. Non-visible marks like sound, smell, texture, and taste are among the many forms of non-conventional trademarks, as are visual marks like trade dress, holographic marks, motion marks, colour marks, and so on.³⁵

There is no separate legislation for the Non-Conventional trademarks in India and they are registered under the trademark Act 1999 which causes it difficult because

³³ Gazette of India, Videnotification No.S.O.1048(E), dated 15th September, 2003, Extraordinary, Part II, sec.3(ii).

³⁴ Trade Marks Act, Preamble, Act 47 of 1999.

³⁵ IP LEADERS available at <https://blog.ipleaders.in/non-conventional-trademarks-procedural-requirements-registration/> (last visited on Nov. 08, 2022)

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often time
they overlap with the other marks or there is no possible way to represent them geographically.

In the case, *Hindustan Coca-Cola Beverages Pvt. Ltd. Vs N.R. Syam*,³⁶ Hindustan Coca Cola beverages filed a suit against N.R. Syam Kumar, who was using a similar bottle shape for his soda product. Hindustan Coca-Cola Beverages Pvt. Ltd. The Coca-Cola bottle shape, which has become a well-known aspect of the brand and is a crucial component of their marketing strategy, was deemed by the court to be distinctive and capable of identifying the product's origins.

The decision in this case was significant as it expanded the scope of trademark protection in India to include non-conventional marks such as shape marks.

2) MISS-USE OF REGISTRATION PROCESS OF TRADEMARKS

False or misleading statements: Making a false or deceptive statement during the trademark registration procedure is a form of registration process abuse. When a trademark owner initiates lawsuits against other companies or people with the express intent of harassing them or forcing them out of business, this is known as abusive litigation. Because it goes beyond the intended function of protecting intellectual property rights, this is regarded as a misuse of the trademark registration process. In the case of *M/s. R. G. Anand v. M/s. Delux Films*³⁷, the Supreme Court of India decided that a person may be held liable for infringement if they register a trademark in bad faith with the intention of denying another person their lawful right to use the trademark.

3) LIMITATION OF FUNCTIONALITY

The distinctive design of items like water bottles, store layouts, or any number of commercial goods might be protected by a trademark for trade dress. An example of a trademark is a certain water bottle shape. However, it would probably be challenging to register a trademark for a shape that significantly improves grip or otherwise improves the use of the bottle.³⁸ This restriction is meant to prevent the trademark system from being abused to stifle competition by registering functional parts and then seeking trademark rights against a

³⁶ Coca Cola Company v. Narsing Rao, 2014 SCC OnLine Del 1018; (2014) 4 AIR Del R 79.

³⁷ R.G. Anand v. Delux Films, (1978) 4 SCC 118.

³⁸ CLEAR TAX available at <https://cleartax.in/s/trademark-law-limitations> (last visited on Feb. 02, 2024)

competitor.

FAIR USE LAW³⁹

Regarding trademark law, the fair use doctrine also holds true. It frequently serves as a defence against accusations of trademark infringement.

A registered trademark gives its owner the ability to stop other people from, among other things, registering, endorsing, or using a trademark that is confusingly similar to or identical to theirs.

However, this privilege is subject to the "fair use" limitation. Trade Marks Act, 1999⁴⁰ (hereafter in the section Fair Use Limitation referred as the "Act"), reiterates the idea of "fair use." The Act's Section 30(1)⁴¹ specifically outlines the general requirements as given below:

Bona fide use meets the following criteria:

- i) Use is consistent with ethical standards in artificial or marketable matters;
- ii) Use is not similar enough to exploit or be malicious of the trademark's distinguishing qualities. A trademark may be used fairly by any party, other than the owner, for any purpose:

According to Section 30(2)(a)⁴² of the Act, there are two types of fair use:

- A.** Descriptive fair use, which is the application of a registered trademark to goods or services to describe the nature, standard, amount, intended use, worth, origin, date of production, or other characteristics of the goods or services; and
- B.** Nominative fair use refers to an individual's use of a registered brand in connection with goods or services. Nominative fair use is defined as any non-commercial use of a registered brand, including news, reviews, parodies, criticism, and relative advertising. The doctrine of "nominative fair use," which allows the use of another party's trademark to make references to the mark owner's goods or services without the mark owner's consent, is the more contentious and difficult of the two. The "nominative fair use" defence is now subject to closer examination by Indian courts. Some of the decisions of the Indian courts are given below.

The Madras High Court interpreted the meaning of "nicely and necessary" under Section

³⁹ CLEAR TAX available at <https://cleartax.in/s/trademark-law-limitations> (last visited on Jan. 01, 2024).

⁴⁰ Trade Marks Act, Sec. 30, Act 47 of 1999.

⁴¹ Trade Marks Act, Sec. 30 (1), Act 47 of 1999.

⁴² Trade Marks Act, Sec. 30 (2) (a), Act 47 of 1999.

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30(2)(d)⁴³ by referring to two *U.S. Ninth Circuit* decisions. It held that any unauthorized use of the trademark must meet certain requirements in order to qualify as a "nominative fair use," including that the product or service in question must be difficult to identify without the use of the trademark.

4) PARALLEL IMPORTS

In India, parallel imports, linked to the concept of right exhaustion in the Trademarks Act of 1999⁴⁴, allow genuine goods acquired from the right holder to be sold through unauthorized channels at lower prices. This practice, subject to both IP and competition law, impacts trademark owners' rights and can lead to disputes over misrepresentation of goods' origin or quality. Indian courts have addressed parallel importation issues, with notable cases like *Cisaco Technologies v. Shrikanth*⁴⁵ highlighting the importance of protecting trademark rights. While international exhaustion principles are recognized, trademark holders can oppose parallel imports if goods are unlawfully acquired or altered. Indian customs laws also regulate parallel imports, aiming to prevent false trademarks or descriptions. Economically, parallel importation offers price diversity but raises concerns about quality assurance and consumer confusion, emphasizing the need for balance between market competition and trademark protection.

5) THE DOCTRINE OF TRADEMARK DILUTION

The doctrine of dilution refers to the purpose where a well-known trademark loses its uniqueness and distinctiveness, hence the trademark loses its goodwill and uniqueness within the market and before the final public with regard to its goods and services. Trademark dilution is covered in Section 29(4) of the Trade Marks Act, 1999. Nevertheless, the Act doesn't provide a definition for the word "dilution." Dilution might also occur when the goods and services or the products and services quality degrades and turns them less reliable.

In the case of *BMWAG v. Om Balaji Automobile*⁴⁶ (India) Private Limited, Plaintiff is a German automobile manufacturing company that manufactures and sells cars under the mark 'BMW'. The defendant was employing a similar mark, 'DMW' in their E-rickshaws. The Supreme Court observed that the defendant had adopted the essentials of the Plaintiff's mark which the visual and phonetic similarity was evident due

⁴³Trade Marks Act, Sec. 30 (2) (d), Act 47 of 1999.

⁴⁴ Ibid.

⁴⁵ CISACO Technologies v. Shrikanth, 2005 SCC OnLine Del 1436

⁴⁶ Bayerische Motoren Werke Ag v. Om Balajee Automobile (India) (P) Ltd., (2020) 1 HCC (Del) 46.

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to this, the defendant's mark DMW was likely to cause confusion. The Court passed the ad-interim injunction and restrained the defendant from using a similar mark.⁴⁷

Trademark dilution occurs when an unauthorized third party uses a mark in a manner that diminishes the reputation of a well-known mark. This typically occurs between entities not in direct competition. Dilution manifests in two forms: blurring and tarnishment. Blurring occurs when a well-known mark loses identity due to unauthorized use, while tarnishment involves objectionable use that conflicts with the original mark's image.

6) LEGISLATION FOR PASSING OFF

Common law tort known as passing off can be used to enforce unregistered trademark rights. The passing-off statute forbids one individual from portraying another's products or services as their

own. Through the years, passing off as an idea has undergone adjustments. At initially, it was limited to passing off one person's belongings as belonging to another. Later, it was expanded to include commerce and services and occupations and conditioning that wasn't related to trading. Now it's applied to numerous forms of illegal trading and illegal competition where the conditioning of one person causes damage or injury to the goodwill associated with the conditioning of another person or group of persons.

The important point in this tort is if the defendant's behavior is comparable enough to give the public the impression that the complainant's business is the defendant's or to cause confusion between the two parties' respective lines of business.

The remedy for "Passing Off" stands to be the coming challenge for the emerging and established industries. The Common law principle was taken up due to British history of

thenation. Formulating the guidelines for determining passing off and precluding copying of Well-Known Trademarks has become a major challenge. This is especially a problem in the fast-moving consumable goods sector.

CONCLUSION AND SUGGESTIONS

The advancements in technology have brought forth various challenges for trademark laws, leading to grey areas and unresolved issues. Existing laws and international treaties often fail to adequately address emerging challenges, such as the lack of legislation for non-

⁴⁷ MANUPATRA available at <https://articles.manupatra.com/article-details/Issues-and-Challenges-of-Well-known-Trademarks-in-21st-century> (last visited on Jan. 18, 2023)

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conventional trademarks, which complicates the registration process. Parallel importation poses a significant challenge, impacting trademark owners' rights and territorial limitations. Additionally, the absence of legislation for passing off and vague laws like fair use hinder effective trademark protection. The judiciary's role in resolving these issues has been somewhat limited, relying on interpretations of existing laws rather than establishing specific provisions.

To address these challenges, the following suggestions are recommended for the better implementation of laws relating to the protection of trademarks.

Some suggestions for the challenges discussed in this research are:

1. Enacting clear legislation for non-conventional trademarks,
2. strengthening registration processes,
3. Refining laws like fair use, and
4. Establishing international agreements to tackle parallel importation and territorial limitations.

Furthermore, there is a need for fixed legislation for passing off, with defined criteria for granting remedies. The judiciary should also advocate for legislative action on issues affecting trademark owners' rights, collaborating with lawmakers to draft appropriate laws.

BIBLIOGRAPHY

- Intellectual Property Law, by P. Narayan, Eastern Law House, publication VIth edition
- Christopher May and Susan K. Sell, Intellectual Property Rights: A Critical History (Viva Books, 2008).
- Atul Gupta, "Integrated Circuits and Intellectual Property Rights in India" 10 Journal of Intellectual Property Rights (2005)
- Christopher May and Susan K. Sell, Intellectual Property Rights: A Critical History (Viva Books, 2008).

Websites

- <https://www.sconline.com/Members/SearchResult.aspx>
- www.copyright.gov.in
- www.irs.inernic.net
- www.mondaw.com
- www.clear-tax.com

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