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**COMPARATIVE ANALYSIS OF TRADEMARK LAWS IN INDIA AND
UNITED KINGDOM**- Vrinda Saran Mathur¹**ABSTRACT**

This paper compares trademark laws in India and the UK, focusing on key similarities and differences. In India, governed by the Trademarks Act, 1999, a first-to-file system grants exclusive rights to the registrant. Both registered and unregistered trademarks receive protection. The UK, under the Trademarks Act 1994 (adjusted post-Brexit), operates similarly, with the UK Intellectual Property Office overseeing trademark matters. However, differences exist, notably in the scope of protection and filing procedures. India allows multi-class registration, while the UK follows a single-class system. Understanding these distinctions is crucial for businesses, legal practitioners, and policymakers navigating trademark issues in both jurisdictions.

INTRODUCTION

Ideas possess immense commercial potential, often surpassing the value of tangible assets such as land or gold. However, an idea remains intangible until it is translated into property. Securing value for an idea is best achieved through its protection as intellectual property, granting creators, inventors, and authors exclusive rights over their creative or innovative concepts for a defined duration. These rights, known as intellectual property rights, are governed by intellectual property law. Ideas can manifest in various forms, such as books, designs, or inventions, each of which is afforded distinct intellectual property protection, including copyrights, patents, and trademarks. This study focuses specifically on the aspect of trademarks.

A trademark denotes a mark associated with commerce, serving to identify the origin of goods or services and differentiate them from those of others. By safeguarding the goodwill of a business, trademarks deter unauthorized individuals from exploiting the reputation

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established by others, as one cannot profit where they have not invested. Historically, India regulated trademarks through the Indian Merchandise Marks Act of 1889 and the Trade Marks Act of 1940, which were subsequently replaced by the Trade & Merchandise Marks Act of 1958, later supplanted by the Trademarks Act of 1999.

According to the Trademarks Act of 1999², a trademark encompasses a broad range of identifiers, including brands, labels, names, or even combinations thereof, such as colours or shapes of goods and their packaging. This legislation facilitates the registration of trademarks concerning goods and services. To qualify for registration, a trademark must be capable of distinguishing the goods or services of one entity from another and should not merely describe their nature, quality, or characteristics. While registration is not compulsory, it provides significant legal benefits and protections for trademark holders.

Chapter 1

1. “Comparison of Trademark Law in India & United Kingdom”

The key differentiation between registration process of trademark in between India and the United Kingdom is based on use of the trademark. Particularly, it is found that the registration process in India follows the concept of “proposed to be used” principle which means that even if the trademark has not been used in the market but there is intention of the mark being used then the mark can be registered. However, as compared to the concept of “prior use” that is followed in the United Kingdom wherein a mark that has to be registered should be well established in the market before qualifying for the procedure of registration.

Additionally, India recognizes dilution of trademarks, allowing actions against similar marks, while the UK focuses on preventing the passing off of goods by another producer. These differences highlight distinct approaches to trademark protection in India and the UK.

Trademark laws in India and the UK share common principles as both countries adhere to international agreements like the TRIPS Agreement ³(Trade-Related Aspects of Intellectual Property Rights). However, there are also notable differences in their approaches and specific regulations. Here's a comparison:

Heading	India	United Kingdom
Legal Framework	The primary legislation governing trademarks in India is the Trade	In the UK, trademark law is primarily governed by the

²TradeMarks Act, 1999

³Trade Related Aspects of Intellectual Property Law

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	Marks Act, 1999, along with the Trade Marks Rules, 2017.	Trade Marks Act 1994, which was updated to align with the EU Trademark Directive and EU Trademark Regulation before Brexit. Post-Brexit, UK trademark law may have undergone further amendments to reflect its independent status outside the EU.
Registration Process	In India, the trademark registration process involves filing an application with the Trademarks Registry, which conducts examination and publication before registration.	Similarly, in the UK, trademark registration involves filing an application with the Intellectual Property Office (IPO), which examines the application for compliance with legal requirements.
Use Requirement	Trademark registration in India does not require evidence of prior use, but there's a provision for cancellation if a trademark remains unused for a continuous period of five years.	Prior use of a trademark is not necessarily required for registration in the UK, but evidence of use may be required to defend against non-use challenges or oppositions
Classification	Nice Classification system for the classification of goods and services.	Nice Classification system for the classification of goods and services.
Duration	Trademark registration in India is initially valid for 10 years from the date of filing and can be renewed	Similarly, trademark registration in the UK is initially valid for 10 years

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	indefinitely for successive periods of 10 years each.	and can be renewed indefinitely for successive periods of 10 years each.
Enforcement	Trademark infringement cases in India are dealt with through civil remedies, including injunctions, damages, and account of profits. Criminal action is also available in certain cases of counterfeiting.	Enforcement of trademark rights in the UK involves civil remedies like injunctions, damages, and accounts of profits. Criminal sanctions are available for certain trademark offenses.
Ownership	They recognize rights based on registration, but common law rights may also exist in unregistered trademarks through use.	They also recognize rights based on registration, but common law rights may also exist in unregistered trademarks through use.
Parallel Importation	They have regulations governing parallel importation, though specific provisions and their interpretation may differ.	They have regulations governing parallel importation, though specific provisions and their interpretation may differ.

While there are similarities due to international agreements and principles, differences arise from each country's legal tradition, legislative framework, and evolving jurisprudence. It's crucial for businesses operating in both jurisdictions to understand and comply with the specific requirements of each country's trademark laws.

1.1 The key differences in the trademark registration timelines⁴ between India and the UK are:

- India: It typically takes 10-24 months to register a trademark in India. The Indian Trademark Registry faces a backlog, with an average of just 12 sanctioned individuals holding the position of assistant registrar or above. The government is working to

⁴Refers to the time taken to register a trademark and publish it in the journal

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address the delays, including plans to incorporate the Madrid System requirements and use more electronic communication.

- **United Kingdom (UK):** The UK has one of the fastest and most predictable trademark registration timelines, taking about 3.5-4 months from filing to registration. The UK trademark registration process is considered efficient and cost-effective compared to other countries.

In summary, the trademark registration process in the UK is significantly faster, taking around 3.5-4 months on average, while in India it can take 10-24 months due to the backlog and limited resources at the Trademark Registry. The UK is considered one of the fastest and most predictable countries for trademark registration.

1.2 Well Known Trademarks ⁵in India & United Kingdom

These trademarks enjoy a high level of reputation and goodwill, often transcending geographical boundaries. Key characteristics of well-known trademarks include:

- **Distinctiveness:** Well-known trademarks possess unique and recognizable qualities that set them apart from others in the marketplace.
- **Reputation:** These marks have built a strong reputation and goodwill among consumers over time through consistent use and quality of products or services.
- **Extensive Use:** Well-known trademarks are typically extensively used in commerce and may be present in multiple countries or regions.
- **Protection:** Well-known trademarks are afforded a higher level of protection under trademark law to prevent unauthorized use or infringement by third parties seeking to capitalize on their reputation.
- **Cross-Industry Recognition:** Well-known trademarks may be recognized across different industries or sectors, indicating their widespread popularity and influence.

Well-known Trademarks: India and UK, Both countries recognize the concept of well-known trademarks and provide protection beyond the specific goods or services for which the mark is registered. Well-known trademarks enjoy enhanced protection under trademark laws in both India and the UK. Here's how they are defined and protected in each jurisdiction:

Country	Definition	Protection
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⁵Well Known Trademarks refer to marks that are widely recognized by the general public as representing a particular brand or product.

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India	In India, well-known trademarks are defined under Section 2(1)(zg) ⁶ of the Trade Marks Act, 1999. According to this provision, a well-known trademark is one that is widely recognized by the public in India as being associated with a particular product or service.	Well-known trademarks in India enjoy broader protection beyond the specific classes for which they are registered. They are protected from infringement and passing off even if they are not registered in a particular class. Additionally, the Indian courts take into account various factors to determine the reputation of a trademark, including the duration, extent, and geographical area of use, promotion of the trademark, and its recognition among relevant sections of the public.
United Kingdom	In the UK, the concept of well-known trademarks is not explicitly defined in the Trade Marks Act 1994. However, well-known trademarks are recognized and afforded protection under common law principles and through judicial interpretation.	Well-known trademarks in the UK also enjoy broader protection, particularly against the use of similar or identical marks on goods or services that are not identical or similar to those for which the trademark is registered. Protection is

⁶Section 2(1)(zg)“well-known trade mark”, in relation to any goods or services, means 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 between those goods or services and a person using the mark in relation to the first-mentioned goods or services.(Trademarks Act,1999)

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		granted based on the reputation and goodwill associated with the mark, and the courts consider factors such as the extent of use, duration, and geographical scope of the trademark's reputation.
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While the definitions and specific legal provisions may vary between India and the UK, both jurisdictions recognize the importance of protecting well-known trademarks to prevent dilution of their distinctiveness and to safeguard consumers from confusion or deception. Businesses with well-known trademarks in either country benefit from enhanced legal protections that go beyond the scope of traditional trademark rights.

Chapter 2

2. LEGAL PROTECTION of TRADEMARK

The Trade Marks Act of 1940⁷ marked the inception of a system for registering and legally safeguarding trademarks in India. However, this Act was later replaced by the Trade and Merchandise Act of 1958. Subsequently, the Trade Marks Act of 1999⁸ superseded the previous legislation, officially coming into force in 2003. The preamble of this Act underscores its objective to establish a framework for the registration and enhanced protection of trademarks for both goods and services, along with the prevention of fraudulent mark usage.

This comprehensive legislation addresses various aspects of trademarks, including associated marks, service marks, well-known marks, certification marks, and collective marks. It establishes mechanisms for their protection through registration and outlines civil and criminal remedies for their enforcement. Notably, trademark registration empowers rights holders to pursue legal action against infringement. Additionally, the Act preserves the option for pursuing actions under common law for passing off concerning unregistered trademarks.

⁷Received the assent of the Governor General on the 11th March, 1940. An Act to provide for the registration and more effective protection of Trade Marks. It was extended to British India

⁸The Act which is in practice till today- Trademarks Act, 1999

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2.1 The Action of Passing Off

The Supreme Court has defined passing-off action in *Cadila Healthcare Ltd v. Cadila Pharmaceuticals Ltd*⁹ as “the species of unfair trade competition or of actionable unfair trading by which one person, through deception, attempts to obtain an economic benefit of the reputation, which the other has established for himself in a particular trade or business”.

The action of passing off can be done by using the trade name, trade mark or other get up of the plaintiff as to induce in potential purchasers the belief that his goods or business were those of plaintiff. The tort lies in misrepresentation by the defendant. The misrepresentation is aimed at the potential buyers of the goods or services, who are invited to buy the goods believing that the goods are of the plaintiff. This might be done through confusing or deceitful use of the trade names, marks or other indications used by the plaintiff in respect of such goods or services.

The passing off action is to correct an actionable wrong, based on the broader common law principle that nobody has any right to represent his goods or business as the goods or business of somebody else. The principle is that “trading must not only be honest but must not even unintentionally be dishonest”. The purpose of passing off action is to protect commercial goodwill and to ensure the purchasers are not exploited and dishonest trading is prevented. For that, the plaintiff must establish that his business or goods have acquired the reputation. Where the defendants’ goods are marked with the trademark of plaintiff or made-up or described as calculated to mislead the ordinary purchaser, it is this tendency to mislead or confuse which forms the gist of passing off action. There is no need to establish fraud or actual deception or actual damages in such cases.

The law of passing off arises when there is misrepresentation, goodwill is harmed in the course of trade, which causes damage to the trade or goodwill of the trader by whom the. The characteristics of passing – off are discussed and explained in number of cases.

Lord Diplock in *Erven Warnik B.V. v. Townend*¹⁰,

1. Misrepresentation;
2. Made by person in course of trade
3. To prospective consumers of his or ultimate consumers of goods or services supplied by him.
4. Which was calculated to injure business or goodwill of another trade (in the sense that

⁹*Cadila Healthcare Ltd v. Cadila Pharmaceuticals Ltd* 2001 (2) PTC 541 SC

¹⁰*Erven Warnik B.V. v. Townend* [1979] AC 731

this is reasonably foreseeable consequence), and

5. Which caused actual damage to a business or goodwill of a trader by whom the action was brought, or in a quietmet action would probably do so.

There are three main elements of the tort of passing off which were also referred as “classical trinity” in *Harrods v. Harrodian School*¹¹ is:

1. Reputation;
2. Deception; and
3. Damage

Once a misrepresentation is established it is reasonable to infer that the customers of the goods bought them on that misrepresentation unless there is evidence to the contrary. In the case of *Reckitt & Colman*¹², it was stated that according to the law of passing off no man could pass off his goods as those of another. It may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. Firstly, goodwill has to be established or the reputation attached to goods or services which he supplies in the mind of purchasing public by association with the identifying “get up” under which his particular goods or services are offered to the public as distinctive specifically of the plaintiff goods and services. Secondly, he must demonstrate a misrepresentation by the defendant to the public leading or likely to lead the public into believing that goods or services offered by him are goods and services of the plaintiff. Thirdly, he must demonstrate that he suffers or likely to suffer damage by reason of erroneous belief engendered by the defendant’s misrepresentation that the source of defendant’s goods or services is the same as the source of those offered by the plaintiff.

There are two necessary elements, first a misrepresentation expressed or implied but not necessarily fraudulent and second a consequent likelihood of damage to the plaintiff’s goodwill.

The concept of passing off has its roots in the 17th century, initially categorized under the tort of deceit and defamation by the House of Lords. It wasn’t until the 19th century that this concept gained recognition and began to evolve. In the case of *Singer Manufacturing Co. v. Loog*¹³, the House of Lords established that no individual has the right to present their goods as belonging to another, nor can they employ any means to indirectly deceive a purchaser into

¹¹*Harrods v. Harrodian School*[1996] RPC 697

¹²The Jif Lemon Case (*Reckitt & Colman Ltd v Borden Inc*)

¹³*Singer Manufacturing Co. v. Loog* 163 U.S. 169 (1896)

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believing falsehoods about the origin of the goods. Initially, passing off was primarily associated with trademarks or trade names, wherein an unauthorized party misled consumers into believing that the goods or services offered were those of the authorized owner. Over time, the scope of passing off expanded, with the characteristics of passing off delineated in the Advocate Case and the classical trinity test, as established in the Reckitt Colman case, being upheld in the majority of instances. To bring a passing off suit, three elements must be present: goodwill, deception resulting from misrepresentation, and damage incurred by the owner due to said misrepresentation. These principles became foundational in the UK's passing off law.

Differentiating between general goodwill and commercial goodwill, the court in *Manitoba Fisheries Ltd. v. The Queen*¹⁴ adopted a definition of goodwill that extends beyond mere customer connections to encompass broader commercial value. Goodwill is described as the attractive force that garners custom, not limited to trade connections but extending to various spheres where the mark or entity is recognized. It is cultivated through diligent effort and adds value to the business. To establish goodwill, the *Parke, Davis & Co. v. Empire Laboratories Ltd*¹⁵ case laid down a test, requiring the recognition of a novel design in the market that distinguishes goods and services from others, along with the owner's acquired reputation in the market through the use of that mark.

Before the Trade Marks Act of 1940, passing off actions were already prevalent in India as a means to assert trademark rights. To initiate such a suit, one had to establish ownership of the trademark, demonstrate its reputation and goodwill, and prove that the defendant had used a similar mark to pass off their goods as those of the plaintiff. The evolution of passing off as part of Common law can be understood as originating from tort law, aiming to rectify the defendant's wrongful act of misleading consumers into believing their goods were those of the plaintiff by using the plaintiff's trade name or mark.

The Trade Marks Act of 1958 and the Trade Marks Act of 1999 address passing off.

Section 27 of these Acts specifies that no action for the infringement of an unregistered trademark can be instituted. However, it does not affect the right to pursue actions for passing off goods or services as those of another person, preserving the remedies therein.

Section 27(2) further protects the rights and remedies of prior users, allowing them to pursue passing off actions even if a subsequent user has registered the trademark.

¹⁴*Manitoba Fisheries Ltd. v. The Queen*[1979] 1 SCR 101

¹⁵*Parke, Davis & Co. v. Empire Laboratories Ltd*[1964] SCR 351

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In *Koninkhijke Phillips Electronics v. Kanta Arora*¹⁶, Justice Thakur emphasized that registration of a mark in the trademark registry is irrelevant in a passing off action, as it does not prove the user's rights.

Similarly, in *N.R. Dongre v. Whirlpool*¹⁷, the court affirmed that registration of a trademark does not affect the right to pursue passing off actions. The right to goodwill and reputation in a trademark existed under common law before statutory regulation, and it continues to be recognized under the 1999 Act through Section 27(2) and Section 33.

Conclusion: Trademark law in both India and the United Kingdom serves to protect the distinctiveness and reputation of brands and businesses, albeit with some differences in their legal frameworks.

In India, trademark law has evolved significantly over time, with the Trade Marks Act of 1999 being the primary legislation governing trademarks. This Act provides for the registration and protection of trademarks, service marks, and related marks. It establishes procedures for registration, outlines the rights conferred upon trademark owners, and delineates remedies for infringement, including both civil and criminal penalties. Additionally, passing off actions continue to play a significant role in protecting unregistered trademarks, emphasizing the importance of reputation and goodwill in the Indian trademark regime.

On the other hand, in the United Kingdom, trademark law is primarily governed by the Trade Marks Act of 1994, which was later amended to align with EU directives. However, following Brexit¹⁸, the UK has implemented its own national trademark legislation. Like India, the UK's trademark law provides for registration, protection, and enforcement of trademarks, ensuring that owners can safeguard their brands from unauthorized use. The UK Intellectual Property Office oversees trademark registration and enforcement, while the court system adjudicates disputes and provides remedies for infringement.

In both jurisdictions, trademark law serves to promote fair competition, protect consumer interests, and incentivize innovation and investment in brands and businesses. While there may be variations in specific legal provisions and procedures, the fundamental principles of trademark law remain consistent across India and the United Kingdom.

¹⁶*Koninkhijke Phillips Electronics v. Kanta Arora*2005(30)PTC589(DEL)

¹⁷*N.R. Dongre v. Whirlpool*(1996) 5 SCC 714

¹⁸Brexit was the withdrawal of the United Kingdom from the European Union

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