



Well Known Trademarks and Concurrent Users: A Critical Analysis

Purnima Prabhakar¹ and Dr. Namah Dutta²

¹Assistant Professor of Law, Rajiv Gandhi National University of Law, Patiala, India.

²Assistant Professor of Law, Chandigarh Group of Colleges, Jhanjeri, Mohali, India.

Email: ppurnima786@gmail.com, namahdutta@gmail.com

ABSTRACT: *The recognition and safeguarding of well-known trademarks have emerged as pivotal aspects of contemporary intellectual property law, particularly in the context of globalization and the digitalization of brand identities. This paper presents a critical analysis of the evolution of the legal concept of "well-known trademarks" in India, alongside the parallel development of the defense of "honest concurrent use." As brand equity gains increasing legal and commercial significance, both legislative frameworks and judicial interpretations have progressively strengthened protections for well-known marks, extending their scope even to unrelated goods or services in specific circumstances. The study delves into the historical roots of this evolution, examining international instruments such as the Paris Convention, the TRIPS Agreement, and WIPO resolutions. It further analyzes the domestic trajectory through the Trademarks Act, 1999, and the Trademark Rules, 2017. Through a review of landmark judicial decisions, the paper demonstrates how the enhanced protection afforded to well-known trademarks has gradually undermined the viability of the honest concurrent use defense.*

KEYWORDS: *Trademark, Well-Known Marks, TRIPs, WIPO, Concurrent Users.*

INTRODUCTION

A trademark serves as a critical instrument through which a trader establishes a distinctive association between their goods and the consuming public. These marks—comprising signs, logos, colors, symbols, designs, or any combination thereof—endow a product with a unique identity and are pivotal in securing protection against infringement under various domestic and international legal frameworks. The distinctiveness of such identifiers not only enhances consumer recognition but may also, over time, elevate the mark to the status of a "well-known trademark." The determination of what constitutes a "well-known trademark" is jurisdiction-specific and is guided by statutory criteria set forth in national trademark laws. Proprietors of such marks are vested with enhanced legal rights, enabling them to take action against unauthorized users who attempt to register or use deceptively similar marks, even in relation to dissimilar goods or services. Importantly, a trademark need not possess global recognition to qualify as well-known; recognition among a relevant section of the public is deemed sufficient.

The growing forces of globalization and market integration have underscored the necessity of affording robust protection to well-known trademarks. At the same time, defendants in

infringement proceedings may invoke several defenses, including that of honest and concurrent use—asserting good faith adoption without knowledge of the pre-existing mark.

The Indian legal framework, particularly the Trademarks Act, 1999, acknowledges such defenses under specified circumstances. As a signatory to the TRIPS Agreement and a participant in the World Intellectual Property Organization (WIPO) frameworks, India has aligned its domestic laws with international standards concerning the protection of well-known marks.

In accordance with these obligations, the Trademarks Act, 1999 has been amended to extend protection to well-known trademarks across both similar and dissimilar categories of goods and services. For a mark to attain well-known status, the proprietor must meet the conditions prescribed under the Act and comply with the procedural requirements stipulated in the Trademarks Rules, 2017.

Paris Convention

The concept of well-known trademarks received its first formal international recognition under the Paris Convention for the Protection of Industrial Property. Article 6bis of the Convention obligates member states to protect trademarks that, although not registered or used in their jurisdiction, enjoy substantial reputation among the public. Often referred to as "famous marks," these trademarks are safeguarded against unauthorized use that may lead to consumer confusion.

Clause (1) of Article 6bis requires member countries to refuse or cancel the registration and prohibit the use of marks that constitute a reproduction, imitation, or translation of a well-known trademark, especially when such use is likely to cause confusion. This applies even when the imitation pertains only to an essential part of the mark.

Clause (2) provides that the proprietor of a well-known mark may seek cancellation of infringing registrations within a prescribed time limit. While no limitation period applies to marks registered in bad faith, a general minimum period of five years is often upheld for seeking cancellation in other cases.

Despite its pioneering role, the Paris Convention's protection regime has notable limitations:

- a. It restricts protection to similar goods or services, excluding dissimilar categories.
- b. It does not extend protection to service marks, focusing primarily on goods.

The Convention does not define specific criteria for determining whether a mark qualifies as well-known, leaving it to the discretion of national legal systems.

Trips Agreement

The TRIPS agreement was formed to raise the standard of recognition and protection to the goods and services. The provisions for well-known trademark as mentioned under Article 16(2) and (3) of the agreement is a further extension of the Paris Convention.

Clause (2) and (3) of Article 16 provides for a mutatis mutandis application of Article 6bis of the Paris convention to the services and dissimilar goods respectively. Clause (3) of Article 16 grants protection against the use of well-known trademarks to dissimilar goods and services provided that a link is established between the owner of those goods and services and use of such trademark; and it may damage the interest of the owner of such registered trademark.

Criteria for Determining a Well-Known Trademark

To grant protection as a Well-Known Trademark under the TRIPS agreement it is necessary to establish that the relevant knowledge of trademark is acquired by the substantial part of the public including those obtained through promotion of the trademark in that member country.

WIPO Joint Resolution

This resolution is applicable to the member countries of both the Paris Convention and WTO treaty. It seeks to define the factors that help in determining a mark as well known;

- a. Number of registrations of trademarks worldwide;
- b. Extent and duration of use of the mark;
- c. duration of publicity associated with the mark and its relevant extent;
- d. degree of knowledge of the mark; and
- e. Proof of instances where the owner has been able to establish his prior rights over those of the infringer.

Relevant Sector of the Public

It is defined under Article 2(2) of the resolution and shall include the actual/potential consumers; the concerned business circle and the person involved in the distribution of such goods and services to which the mark applies. Article 4 and 5 of the resolution deals with the conflicting marks and business identifiers, respectively and lays down the requisite measure that the owner of well-known mark may take to protect his interest. The WIPO resolution does not necessitate the mark to be registered or used in the member states or in the other jurisdiction for it being recognized as a well-known trademark.

LITERATURE REVIEW

Abhishek Chaudhari [1] gives an insight into the existing laws on well-known trademark in India and explains the concept and growth of well-known trademark and the defense of honest concurrent use in India through various case laws. The author critically analyzes the infringement of mark u/Sec.29 of the act but failed to take into consideration various other criteria that may affect the defense of honest use by a concurrent user.

P.T. Shravani [2] seeks to give a statutory explanation of the various limitations imposed on the use of an identical mark by a person other than the owner of the original mark. The article explains the impact of advancement in technology on strengthening the protection of well-known marks and thereby weakening the defense of an honest concurrent user. The author, therefore, highlights the need to discharge the onus of honest use of mark by the concurrent user through concrete evidence.

Eashan Ghosh [3] discusses the evidentiary requirements for establishing a mark as "well-known" under Indian trademark law, highlighting the need for a structured "evidence-for-benefits matrix."

Vivek Kumar Choudhary [4] explains the inherent conflict between the robust protection granted to well-known trademarks and the diminishing viability of the honest concurrent user defense. Choudhary's work specifically delves into how the strengthening of well-known trademark rights, often driven by globalization and international legal obligations, creates significant hurdles for parties seeking to rely on the defense of having independently and honestly adopted a similar mark.

DISCUSSION

Well Known Trademark

A well-known trademark refers to a mark that has acquired a high degree of recognition and distinctiveness among a significant segment of the public within a given jurisdiction. The notion of reputation as the foundation for well-known trademark protection was first judicially acknowledged in the case of JG v. Stanford. In the Indian legal context, the concept has undergone considerable evolution and is now explicitly codified under the Trademarks Act, 1999, along with further procedural clarity provided by the Trademark Rules, 2017.

Trademark and Merchandise Act, 1958

This act does not expressly provide for protection of well-known marks but makes a reference under sec.47 (1) of the act. It provides that when an invented word used in a trademark gains such a reputation that its usage with other goods may certainly establish a connection between those goods and the proprietor of the mark of earlier registered goods, an application may be made by such proprietor for the defensive registration of Well-Known trademark for such goods. The test laid down for such protection was likelihood of the deception caused by such goods.

Daimler Benz Aktiegessellschaft & Anr. vs. Hybo Hindustan, the case relates to protection of the well-known trademark, i.e. BENZ' granted to plaintiff against its automobiles industry. The court declared mark being used by the defendant for its undergarment business as an infringement to an already registered mark and recognized the trans-border reputation associated with the brand.

The Trademark Act, 1999

The Trademarks Act, 1999 grants statutory protection of well-known mark to both Indian and Foreign marks.

Definition:

Sec.2 (1) (zg) of the Trademark Act defines 'Well Known Trademark'. It states that a well-known trademark should be in relation to a good or service used by a substantial segment of public indicating a connection between those goods or service and the proprietor of first mentioned goods.

Sec.11 (6), (7) and (9) of the 1999act, lays down certain guidelines for determining a well-known trademark.

- I. Recognition or Knowledge of the trademark among the relevant segment of the public.
- II. The extent, duration of the mark and geographical area where it is used and promoted.

Rolex Sa vs. Alex Jewellery Pvt. Ltd. & Ors. [5]

The defendants were engaged in the sale of Jewellery under the trade name 'Rolex' that was primarily related with the mark of the 'plaintiff'. The court held that the mark holds recognition among the substantial public & is 'well known mark'. Therefore, such use of the mark may cause apprehensions in the mind of the public regarding its association with that of the plaintiff. Hence, the court passed the order of interim injunction against the defendant for using 'Rolex' as its trade name.

Microsoft Corporation v. Kurapati Venkata Jagdeesh Babu [6]

The HC of Delhi held that 'MICROSOFT' was a well-known mark as it holds a unique recognition worldwide. Taking into consideration the extensive use & popularity among the people of India, the court restricts the use of the mark by the defendant in any of his businesses whether similar or dissimilar.

III. A record of successful registration of the mark; its enforcement and recognition by a court or registrar shall be maintained.

Honeywell International v. Pravin Thorat & Ors [7]

In this case the court held the mark to be a well-known mark as it held recognition under three arbitration cases due to its extensive and long use across the world.

Sec.11 (9) provides that registration of the mark is not a pre-condition for attaining the status of well-known trademark. Recognition of the trademark among the people involved in its distribution channel is also one of the determinative factors.

The Trademark Rules, 2017

The Trademark rules, 2017 provides for filling a separate application before the registry against the prevailing adversarial system to determine the 'well known' status of a trademark. The application may be filed by depositing fees of Rs.1 lakh along with a TM-M form. The mark holder attaches the relevant statement of case with evidences supporting his claim. Information related to potential/ actual consumers; advertisement and promotion charges; any judgment of the court which determines the trademark as well-known should also be attached. The registry may on the examination of the attached documents, if satisfied, will add the mark to this list of well-known trademarks and inform the same to the applicant.

Concurrent Users

It refers to the users that have similar or identical marks on similar/dissimilar goods. Defense of honest concurrent use of a mark is used to establish the bonafide intention of the applicant.

Trademark Act, 1999 [8]

Sec.12 of the act lays down the doctrine of honest concurrent user. It states that where the registrar of the Trademark is convinced of the honest/bonafide concurrent use of the similar/identical marks, he may grant its registration to more than one proprietor. The burden lies on the applicant that the use of the mark has been honest and with any prior knowledge of the similar existing mark. The registration of such marks is not obligatory and is dependent on his own discretion.

The first two cases that led to the emergence of the doctrine of concurrent users were Dent v. Turpin and Southorn v. Reynolds. The rationale behind the defense was to consider how far it will affect the interest of the public. The relevant factors to prove the honest concurrent use as laid down in the case of Kores (India) Ltd. v. M/s Khoday Eshwarsa and Son¹ were as follow:

- a. Honesty and Quantum of concurrent use of the mark with the goods concerned in relation to the duration, area & volume of the goods.
- b. Extent of confusion that may arise among the public ensuing to the resemblance of the marks & the resultant inconvenience.

¹ Kores (India) Ltd. v. M/s Khoday Eshwarsa & Son 1985(1) BOMCR423

- c. Whether there persist certain instances where the confusions have been proved in fact.

Documents to Prove Concurrent Use of the Mark

Proof of the expenditure on advertisement of the mark and the related entries in the accounts book showing yearly sales of goods and services under the registered mark should be attached. Evidence reflecting the time for which the said mark is being used should be attached thereby.

Cases where Defense does not Apply

- a. The Trans border reputation of brands or marks-

The court in the case of Whirlpool Co. & Anr. vs. N R Dongree² and Indian Shaving Products Ltd. v. Gift Pack & Anr.³, recognized the impact of fast dissemination of information through advancement in technology on the development of Trans border reputation of goods and services.

- b. Where there exists a likelihood of confusion and interest of general public may be affected.

In Dalip Chand Aggarwal v. Escorts⁴, the court held that the size of the business was not the determinative factor for obtaining honest concurrent use; it was the likelihood of confusion that the use of similar/identical mark may cause among the general public.

- c. The increasing possibility of the further expansion of the businesses by brands may restrict its use even for dissimilar goods by the concurrent user.
- d. With a paradigm shift in the method of advertisement and vast spread of information over borders through advancement in technology, brands have now turned out be more global than local.
- e. Use of a unique trademark grants the proprietor an advantage over all the other assertions made over its use by the concurrent users. There is less likelihood of the defendant to be able to prove his honest use of the mark in such circumstances.

Case Laws and Critical Analysis

- a. Sunder Parmanand Lalwani & Ors vs. Caltex (India) Ltd.⁵

The court, recognizing the applicant's significant reputation and the likelihood of consumer confusion, held that the adoption of a similar mark by the respondent was in bad faith. Accordingly, it granted exclusive use of the well-known mark to the applicant.

- b. Kirloskar Diesel Recon Pvt. Ltd. v. Kirloskar Proprietary Ltd.⁶

In this case, the Bombay High Court held that the protection of a well-known trademark extends across all classes. Recognizing the goodwill associated with the 'Kirloskar' mark, the Court ruled that even its use for unrelated goods by the defendant could create a likelihood of confusion and thus barred its continued use.

- c. Tata Sons vs. Manoj Dodia & Ors⁷

² Whirlpool Co. & Anr. vs. N R Dongree, 1994 IVAD Delhi 667

³ Indian Shaving Products Ltd. vs. Gift Pack & Anr. (1998) PTC 698 (Del)

⁴ Dalip Chand Aggarwal vs. Escorts, AIR 1981Del 150

⁵ Sunder Parmanand Lalwani & Ors vs. Caltex (India) Ltd, AIR 1969 Bom. 24

⁶ Kirloskar Diesel Recon Pvt. Ltd. vs. Kirloskar Proprietary Ltd, AIR 1996 Bom 149

⁷ Tata Sons vs. Manoj Dodia & Ors. CS (OS) No. 264/2008

The court observed that the doctrine of dilution has gained prominence, especially concerning well-known trademarks. It held that even without causing confusion, the defendant's use of the mark for dissimilar goods could weaken its distinctiveness and harm its association with the plaintiff.

d. Goenka Institute of Education & Research vs. Anjani Kumar Goenka & Anr.⁸

The court in this case adopted a lenient approach towards the applicability of well-known trademark on educational institutions. While upholding the defense of honest concurrent user, it directed the parties concerned to give an additional account of information to the general public to make it distinguishable from other sources using similar mark.

e. Kabushiki Kaisha Toshiba vs. Toshiba Appliances and Ors case⁹

In this case the court took into consideration the vulnerability of the well-known trademark in the IT-savvy world. The court highlighted that with rapid advancement in technology, international business, and wide coverage of branding and advertising through magazine, periodicals and television, information about well-known mark are circulated all around the world. The goods may enjoy protection of trans border reputation of well-known mark even in countries where it might not have been registered.

f. Vranjilal Manilal & Co. vs. Bansal Tobacco Co.¹⁰

The case deals with the imposition of territorial limitations by court on grant of defense of an honest concurrent user. The issue in this case was related to use of '22' by defendants as part of their trademark for 'bidis' and other products. The contentions raised by the defendant were found true and hence the court while allowing him the defense limited its activities to the states of UP, Bihar and West Bengal.

g. Champagne Moet & Chandon vs. Union of India & Ors¹¹

The dispute centered on the use of the trademark 'MOET' by both parties. The plaintiff claimed prior use but failed to provide sufficient evidence, while the defendant demonstrated continuous use since 1967 and established goodwill. Citing acquiescence and dissimilarity of goods, the defendant argued no harm to the plaintiff's business. The court, finding merit in the defendant's case, upheld the registration in his favor.

CRITICAL ANALYSIS

Protection of well-known trademark grants protection against any misuse of such mark. Though the trademark act did not recognize the registration of an already registered or identical mark it provided an exception to the general rule through the defense of concurrent use. It grants protection to the concurrent user of the mark against its honest use. Onus lies on the defendant to prove the innocent use of such mark. But with the increasing protection granted to Well-known trademark around the globe has weakened this defense. Recognition among the substantial public of the state is sufficient to claim the protection as well-known mark against both similar and dissimilar goods. Trans border reputation acquired by the brands or marks through new and innovative techniques of advertisements has increased the burden on the

⁸ Goenka Institute of Education & Research vs. Anjani Kumar Goenka & Anr., FAO (OS) No. 118/2009

⁹ Kabushiki Kaisha Toshiba vs. Toshiba Appliances and Ors, 2008 (37) PTC 394 (SC)

¹⁰ Vranjilal Manilal & Co. vs. Bansal Tobacco Co., (2001) PTC99 (Delhi)

¹¹ Champagne Moet & Chandon vs. Union of India & Ors, LPA No. 588/2011

concurrent user to establish the honest use of such mark. Easy accessibility of information through advancement of technology raises a question on the contentions made by the defendant of the unfamiliarity with the prior registration of an identical mark. Through the analysis of above-mentioned case laws, it could be drawn that with the widening scope of protection under well-known mark has further increased intricacies for the honest concurrent user of an identical mark. While the courts have adopted a lenient view in case of educational institutions it fails to specify the extent of proof that a concurrent user may give of his honest use in all other cases.

CONCLUSION

Recognition as a 'well-known' trademark confers a heightened level of protection, extending beyond the traditional confines of similar goods or services, even in the absence of registration within a specific territory. This status is granted to marks that have garnered substantial trans-border reputation and recognition amongst a significant segment of the public in India, not necessarily a majority. Prior to explicit statutory provisions, the concept of well-known trademarks was acknowledged under the Trade and Merchandise Marks Act through actions against passing off. The foundational principles underpinning the Indian legal stance are rooted in international conventions like the Paris Convention and the TRIPs Agreement, which broadened the scope of protection to encompass dissimilar goods and services, acknowledging the extensive goodwill associated with such marks. Conversely, the defense of honest concurrent use, initially intended to safeguard the interests of parties who innocently adopted and used the same or similar marks, presents a growing challenge in the contemporary globalized landscape. The ease of access to information facilitated by technological advancements increasingly casts doubt on claims of genuine innocent adoption by subsequent users. Judicial pronouncements in India reflect a discernible trend towards prioritizing the protection of globally recognized trademarks against claims of honest concurrent use. While acknowledging the initial rationale behind this defense, the courts have become increasingly circumspect in its application, particularly where the well-known mark possesses significant international repute. The underlying principle guiding these decisions is the prevention of unfair advantage and potential consumer confusion arising from the use of a mark that has already acquired widespread recognition. The Trade Mark Rules, 2017, have introduced a welcome procedural development by enabling the online application for the registration of a well-known trademark, potentially streamlining the process compared to establishing such status through protracted court battles.

In conclusion, Indian trademark law has made commendable strides in safeguarding well-known trademarks, aligning with international standards. However, there remains a need for more explicit and refined guidelines to address the dilution of the honest concurrent user defense effectively and ensure the robust implementation of the Trade Mark Rules, 2017. This would provide greater clarity and certainty in balancing the protection of globally renowned marks with the legitimate interests of concurrent users in an increasingly interconnected world.

REFERENCES

- [1] Abhishek Chaudhari, "Well Known Trademark Protection in India: Need for Legislative Enactment", IJCRT, Volume 6, Issue 1, pp.1616-1627.
- [2] P.T. Shravani, 'Defence of Honest Concurrent Use vis-a-vis trademark protection: How much longer will this hold for brand proprietors?' available at <https://medium.com/@shravanip23787/defence-of-honest->

- concurrent-use-vis-a-vis-trademark-protection-how-much-longer-will-this-hold-for-c43308f8c92ddd (last accessed 6 Dec 2020).
- [3] Eashan Ghosh, "What Should It Take To Be Well-Known? Fashioning An Evidence-For-Benefits Matrix For 'Well-Known Marks' Under Indian Trademark Law, Journal of Intellectual Property Rights, Vol.21, September-November 2016, pp. 327-336.
 - [4] Vivek Kumar Choudhary, "Protection of Well-Known Trademarks and Weakening of Honest Concurrent User Defense", Journal of Intellectual Property Rights, Vol. 15, July 2010, pp. 293-301.
 - [5] Rolex Sa v. Alex Jewellery Pvt. Ltd. & Ors, CS (OS) 41/2008.
 - [6] Microsoft Corporation v. Kurapati Venkata Jagdeesh Babu, CS (OS) 2163/2010 & I.A. No.14225/2010.
 - [7] Honeywell International v. Pravin Thorat & Ors, CS (OS) 3684/2014.
 - [8] The Trademark Act, 1999.
 - [9] Sonal Sodhani, All You Need to Know About "Well-Known Trademarks", available at [https://www.mondaq.com/india/trademark/808148/all-you-need-to-\(last accessed 6Dec2020\)](https://www.mondaq.com/india/trademark/808148/all-you-need-to-(last%20accessed%206Dec2020)).
 - [10] Aditya Singh, 'Concept of Well-Known Trademark', available at <http://www.supremecourtcases.com/index2.php?option=co> (last accessed 4 Dec, 2020).
 - [11] CGPDTM, 'Guidelines for filing well-known trademark', available at <http://www.ipindia.nic.in/newsdetail.htm?333/> (last accessed 6 Dec 2020).
 - [12] Chaitanya Prasad, 'A draft of Manual of Trade Marks Practice & Procedure', available at http://www.ipindia.nic.in/writereaddata/Portal/IPOGuidelinesManuals/1_32_1_tmr-draft-manual.pdf (last accessed 5 Dec 2020).
 - [13] Aishani Singh, 'How to Recognize Well-Known Trademarks in India', available at <https://www.mondaq.com/india/trademark/918306/how-to-recognize-well-known-trademarks-in-india> (last accessed 5 Dec 2020).
 - [14] Rahul Raj, 'Honest Concurrent Use of A Trademark', available at <https://www.intepat.com/blog/trademark/honest-concurrent-use-of-a-trademark/#:~:text=Concurrent%20use%20is%20when%20users,of%20the%20earlier%20registered%20trademark> (last accessed 29Nov 2020).
 - [15] LTC Harms, 'Famous Trademarks', available at https://www.wipo.int/edocs/mdocs/mdocs/en/wipo_ipr_tyo_17/wipo_ipr_tyo_17_t15.pdf (last accessed 4 Dec 2020).
 - [16] Latha R. Nair, 'Tracking the Protection of Well-Known Marks in India: A Befuddled Path to Nirvana?', available at https://www.knspartners.com/UploadFile/Articles/10042018_115922_Well-known%20marks.pdf (last accessed 30 Nov 2020).
 - [17] RNA Technology and IP Attorneys, 'Well Known Marks In India', available at <https://www.legal500.com/developments/thought-leadership/well-known-marks-in-india/> (last accessed 07 Mar 2025).
 - [18] Kanishka Tyagi & Isha Mehta, 'Concurrence in Trade mark usage Concern, not for the Honest', available at <http://docs.manupatra.in/newslines/articles/Upload/BAE80A5E-0108-4C2E-AAA6-43E17820C2C9.pdf> (last accessed 5 Dec 2020).
 - [19] Pooja Kapadia, Aarushi Jain & Gowree Gokhale, 'Registration of a Well-Known Mark In India', available at http://www.nishithdesai.com/information/research-and-articles/nda-hotline/nda-hotline-single-view/article/registration-of-a-well-known-mark-in-india.html?no_cache=1&cHash=7edebbe51be6adf73c86f739a106171?utm_source=Mondaq&utm_medium=syndication&utm_campaign=LinkedIn-integration (last accessed 4 Dec 2020).



This is an open access article distributed under the terms of the Creative Commons NC-SA 4.0 License Attribution—unrestricted use, sharing, adaptation, distribution and reproduction in any medium or format, for any purpose non-commercially. This allows others to remix, tweak, and build upon the work non-commercially, as long as the author is credited and the new creations are licensed under the identical terms. For any query contact: research@ciir.in