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Report Q214

National Group: Indian Group
Title : **Protection against the dilution of a mark**
Contributors : Tehemtan N. DARUWALLA,
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I. Analysis of current law and case law.

1. *Do the laws of your country provide for protection against dilution of a trade mark? If so, which laws?*

The Trade Marks Act, 1999 in India, incorporates the concept of “well known marks” as appears in Article 6 Bis of the Paris Convention for the Protection of Industrial Property. The laws of India do provide protection against dilution of a trade mark. The common law actions on the ground of passing off have provided protection against dilution of a trade mark as well. This is so even before the coming into force on 15th September, 2003 of the new Trade Marks Act, 1999.

2. *Is there a legal definition of “dilution” in your legislation or case law?*

There is no legal definition of the expression “dilution” in India’s Trade Marks Act, 1999. In fact the word “dilution” of a trade mark is not even mentioned in the section pertaining to infringement of a trade mark. The

word “dilution” is not referred to in the definition of “Well known trade mark” under the said Act.

However there are references to “dilution of trade marks” in reported cases decided by High Courts in India but wisely they have not deigned to define it!

3.1. Which trade marks are afforded protection against dilution? What are the eligibility criteria? (Please only briefly list the eligibility criteria here; more detailed explanations will be required below).

Various types of trade marks are protected against dilution in India such as:

- 1) Indian National Trade Marks
- 2) Registered Trade Marks in India
- 3) Application for registration of a trade mark in a Convention Country or a country which is a member of a group of countries or union of countries or Inter-Governmental Organization as referred to in Section 154 of the Indian Trade Marks Act, 1999.
- 4) “Well-known trade marks” as defined in **sub-section (zg) of Section 2** of the Indian Trade Marks Act, 1999 is reproduced below:-

“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.”

The criteria for refusal of registration of a trade mark are given in some sub-sections of **Section 11** of the Act and which are given below :-

Sub-section (2) states that :

“A trade mark which –

- a) is identical with or similar to an earlier trade mark; and
- b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered in the name of a different proprietor,

shall not be registered if or to the extent the earlier trade mark is a well-known trade mark in India and the use of the later mark without due cause would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trade mark.”

Sub-section (3) provides that :

“A trade mark shall not be registered if, or to the extent that, its use in India is liable to be prevented –

- a) by virtue of any law in particular the law of passing off protecting an unregistered trade mark used in the course of trade; or
- b) by virtue of law of copyright.

The expression “earlier trade mark” for the purposes of the said **Section 11** means –

“(a) a registered trade mark or convention application referred to in Sec 154 which has a date of application earlier than that of the trade mark in question,

taking account, where appropriate, of the priorities claimed in respect of the trade marks;

(b) a trade mark which, on the date of the application for registration of the trade mark in question, or where appropriate, of the priority claimed in respect of the application, was entitled to protection as a well-known trade mark.”

Section 29 of the Indian Act deals with infringement of registered trade marks. The structure of **sub-section (4)** of **Section 29** differs from the earlier sub-sections inasmuch as it sets out the standards required for plaintiff to establish dilution of his trade mark in relation to goods or services which are not similar to those for which the trade mark is registered. The emphasis is on identity or similarity of the mark qua the registered trade mark alone but in relation to goods or services which are not similar to those for which the trade mark is registered. **Section 29 (4)** does not refer to the need for proving confusion. **Sub-section (4)** of **Section 29** is reproduced below :

Section 29 (4):

“A registered trade mark is infringed by a person who, not being a registered proprietor or a person using by way of permitted use, uses in the course of trade, a mark which –

(a) is identical with or similar to the registered trade mark; and

(b) is used in relation to goods or services which are not similar to those for which the trade mark is registered; and

(c) the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.”

3.2. To be eligible for protection against dilution, does a mark need to be distinctive? If so, does the protection depend upon the mark being inherently distinctive or are marks that have acquired distinctiveness through use also protected?

To be eligible for protection against dilution, the mark should have distinctive character. It is not necessary to enter into a nice discussion as to whether the mark is inherently distinctive or has acquired distinctiveness through actual use. Both are protected. Conditions set out in answer to 3.1 apply.

3.3.1. To be eligible for protection against dilution, does a mark need to have a reputation or be well-known or famous? If so, when does a mark have a reputation, when is it well-known or when is it famous? Are the factors mentioned in paragraph 15 and 22 above relevant for determining whether a mark has a reputation, is well known or famous? For what point in time does this have to be assessed?

Apart from the expression “well-known” trademark as defined in the Indian Act as reproduced in answer to Q. 3.1 above, the word “famous” is not defined. It is necessary for a trademark to be eligible for protection to have a “reputation”. Reputation should be distinguished from “esteem”. The reputation must be in India – whether inherently or having travelled to India and which is referred to by courts as “trans-border reputation”. But trans-border reputation has to be proved.

It is not a condition precedent for a mark to be “well-known” or “famous” in order to prove that a mark has a “reputation”. To determine whether and when a mark has a “reputation” is a question of fact.

The factors mentioned in paragraphs 15 and 22 of the “Working Guidelines” are relevant for determining whether a mark has a reputation or is “well-known”.

In India so far as the Registrar of Trade Marks is concerned, to determine whether a trademark is “well-known”, he has to take into account certain facts. For the sake of good record sub-section (6) of section 11 of the Indian Act (which to a great extent follows the 1999 WIPO Recommendations and especially Article 2 thereof) is reproduced below:

“The Registrar **shall**, while determining whether a trade mark is a well-known trade mark, take into account any fact which he considers relevant for determining a trade mark as a well-known trade mark including –

- i) The knowledge or recognition of that trade mark in the relevant section of the public including knowledge in India obtained as a result of promotion of the trade mark;
- ii) The duration, extent and geographical area of any use of that trade mark;
- iii) The duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and representation, at fairs or exhibition of the goods or services to which the trade mark applies;

- iv) The duration and geographical area of any registration of or any application for registration of that trade mark under this Act to the extent they reflect the use or recognition of the trade mark;
- v) The record of successful enforcement of the rights in that trade mark, in particular, the extent to which the trade mark has been recognized as a well-known trade mark by any Court or Registrar under that record.”

The factors that should **not** be taken into consideration as set out in **sub-section (9) of section 11** of the Indian Act (which is somewhat along the lines of Article 2 of 1990 WIPO Recommendation) is quoted below:

“The Registrar shall **not** require as a condition, for determining whether a trade mark is a well-known trade mark, any of the following, namely:-

- i) that the trade mark has been used in India;
- ii) that the trade mark has been registered;
- iii) that the application for registration of the trade mark has been filed in India;
- iv) that the trade mark -
 - a) is well-known in; or
 - b) has been registered in; or
 - c) in respect of which an application for registration has been filed in, any jurisdiction other than India; or
- v) that the trade mark is well-known to the public at large in India.”

3.3.2 *For a mark to have a reputation or to be considered well known or famous, must it meet a certain knowledge or recognition threshold? If so, what is that threshold? What percentage of population awareness is required? How widespread must the awareness be across the country? If a mark is well known or famous in one country, what effect, if any, does this have with regard to other countries?*

There cannot be any rigid formula or a rigid threshold to determine whether a mark meets a certain knowledge or recognition threshold to qualify to be a “well-known” or “famous” trade mark. There is neither any fixed percentage of population awareness being required nor how widespread must the awareness be across the country. Each case would depend upon its own facts and circumstances. The criterion to determine whether the mark is “well-known” is already set out in answer to Q. 3.1 and 3.3.1. These criteria and factors can be taken into account.

The awareness of a mark in a foreign country but not in India may not be relevant.

The very definition of a “well known trade mark” in S.2 (zg) envisages that the mark in relation to goods or services has become well-known to the substantial segment of the public which uses such goods or services 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.

3.3.3 *What is the relevant population in determining the knowledge, recognition or fame of the mark, the general public at large or the relevant sector of public? Is recognition or fame in a limited product market ("niche market") sufficient?*

What should be the relevant population to determine the knowledge or recognition or fame of the mark would naturally depend on the nature of the goods or services, whether such goods are of a specified variety or just sold across the counter. It would depend on the trade channels in which those particular members of the public are involved. Hence, it may not be appropriate to refer to "the general public at large" but to the "substantial segment of the public which uses such goods or receives such services".

Subject to what is mentioned above, the recognition or fame in a limited product market ("niche market") which is only aimed at a relatively small but specialized group of consumers may not be eligible for protection against dilution.

3.4 *To be eligible for protection against dilution, is it required that the mark has been used in, or that the mark has been registered or that an application for registration of the mark has been filed in the country where protection is being sought.*

There is no statutory law on anti-dilution in India. There is no requirement prescribed that the mark has to be used in India or that the mark must be registered in India or that an application for registration of the mark has been filed in the country where protection is sought, namely, India. However, in a passing-off action, reputation in the mark prevailing in India would have to be proved.

On the other hand, in the case of Statutory infringement action, under Section 29 (4) of the Trade Marks Act, 1999 on the basis of a well-known mark, it would be necessary to prove that the mark is registered and that registered trade mark has a reputation in India and the use of the rival mark without due cause takes unfair advantage of or is detrimental to, the distinctive character or repute of the registered trade mark.

3.5 *Are there any other criteria a mark must comply with to be eligible for protection against dilution?*

There does not appear to be any other criteria.

3.6 *Is eligibility for protection against dilution a matter of law or an issue of fact? Who bears the burden of proof regarding the eligibility criteria? How does one prove that a mark meets the eligibility criteria? Are sales and advertising figures sufficient or is survey evidence required? Which evidential standard must this proof satisfy?*

Eligibility for protection against dilution is an issue of fact. To prove that a mark has a reputation is also an issue of fact.

The burden of proof that a trade mark has reputation in the country in which the action is brought, would be on the party claiming that it is so. Under Section 103 of the Indian Evidence Act, the burden of proof as to any particular fact lies on the person who wishes the court to believe in its existence, unless it is provided by any law that the proof of that fact shall lie on any particular person.

Under Sub-section (4) of Section 29 which deals with Infringement of registered trade marks and is quoted in answer to Q.3.1. above (which is

worded in almost identical terms as in Section 10 (3) of the U.K. Act), the necessary statutory ingredients to prove would be upon the plaintiff or the claimant. However, as has been rightly held by Mr. Justice Neuberger J in the PREMIER BRANDS U.K. LTD. vs. TYPHOON EUROPE (2000 F.S.R. 767 @ pg 792) the words “ being without due cause” although not plainly expressed as such, really represent a proviso or exception to the generality of Section 10 (3) of the U.K. Act. In those circumstances if an alleged infringer wishes to rely on those words, it is up to it to establish that it falls within the exception, rather than up to a proprietor of the mark to establish that the proviso does not apply.

How one can prove that a mark meets the eligibility criteria would depend on the nature of the mark; the nature of the goods in respect of which the mark is used; the degree of resemblance between the marks, whether they are phonetically or visually similar and/or whether the idea of the mark is similar; the class of purchasers who are likely to buy the goods bearing the marks they require and the degree of care they are likely to exercise in purchasing and/or using the goods; the mode of purchasing the goods or placing orders for the goods.

To prove reputation, sales and advertising figures are helpful but apart from sales figures, courts may require orders placed for the mark and invoices as well.

Survey evidence may be relied upon but courts have criticized the methodology in the nature of the questions put in the survey.

3.7 *Is there any registry of eligible marks in your country? If so, what is the evidentiary value of registration? Can it be challenged in litigation?*

There is a Register of trade marks in India. However, there is no separate Register of well-known trade marks or famous trade marks as such in India.

4. *Does your law require the existence of a 'mental association' or 'link' between the earlier trade mark and the later trade mark? If so, in which circumstances does a 'mental association' or 'link' between the earlier trade mark and the later trade mark exist? Are the factors mentioned in paragraph 27 and 28 above relevant for assessing the existence of such a 'mental association' or 'link'? Are there other factors to take into account? Is the assessment of a link a question of fact (so something that can be established by market surveys), or is it a question of law to be established by the courts or authorities on the basis of such factors?*

There is no statutory law on this aspect. However, the need to establish a 'link' or 'linkage' or 'mental association' of the offending mark with that of the plaintiff or claimant is one of the vital essentials for securing relief in any claim for dilution. This was so held by the High Court of Delhi in an erudite judgment delivered by Mr. Justice S. Ravindra Bhat in the case of *ITC Ltd. v Philip Morris Products Sa and Others* reported in 2010 (42) PTC 572 (Delhi).

The dilution theory presumes some kind of 'mental association' in the reasonable buyer's mind between the two parties and the mark.

Such kind of 'mental association' was found in the case decided by Mr. Justice Mahinder Narain reported in AIR 1994 DELHI 239, in *Daimler Benz Aktiengesellschaft and Anr. vs. Hybo Hindustan*. In this case defendant sold

underwear and undergarments for men with the representation thereof of a man with his legs separated and hands joined together above his shoulders, all within a circle to indicate the strong suggestion of the link between the three pointed star of "Mercedes Benz" car and the undergarments sold by the defendant. The Judge rightly used caustic words against these acts of the defendant as quoted below :-

"I think it will be a great perversion of the law relating to Trade Marks and Designs, if a mark of the order of the "Mercedes Benz", it's symbol, a three pointed star, is humbled by indiscriminate colourable imitation by all or anyone; whether they are persons, who make undergarments like the defendant, or any one else. Such a mark is not up for grabs – not available to any person to apply upon anything or goods. That name, which is well known in India and world wide, with respect to cars, has as is its symbol, a three pointed star."

On the "dilution" aspect, the Judge at paragraph 18, held as follows:-

"In the instant case, "Benz" is a name given to a very high priced and extremely well engineered product. In my view, the defendant **cannot dilute**, that by user of the name 'Benz' with respect to a product like underwears."

The factors mentioned in paragraph 27 of the Working Guidelines on the aspect of the existence of a 'link' which must be assessed globally, taking into account relevant factors as the ECJ confirmed in *Intel Corp vs. CPM (U.K.) Ltd.* case as mentioned therein, and the factors mentioned in paragraph 28 of the said Working Guidelines which deals with dilution by blurring under the U.S. law would be relevant for assessing the existence of such 'mental association' or 'link'.

Other factors which could be taken into account are the well known principles of comparison of rival trade marks as laid down in a host of cases decided in U.K. such as the *Pianotist* case in the brilliant analysis by Lord Justice Parker reported in (1906) 23 RPC 774 and on the idea of the mark; on where goods are known by a name suggested by the mark and many other cases including the doctrine of imperfect recollection and which have been followed and even improved upon by the various High Courts in India and the Supreme Court of India.

The assessment of a 'link' is a question of fact but to be ultimately determined by the court. This question of fact will have to be established within the legal framework in India and will be decided by the court or the relevant authority such as The Registrar of Trade Marks on the basis of the law of trade marks in India.

It is not necessary that the assessment of a 'link' must be established by market surveys. Ultimately, it will be a question which will be decided by the judge whilst assessing the evidence led by the plaintiff or claimant or by the Applicant or Opponent before the Registrar of Trade Marks.

5. *Does such 'mental association' or 'link' between the earlier trademark and the later trademark automatically result in detriment to the earlier trademark's repute or distinctive character? Or does detriment have to be proved over and above the existence of a 'mental association' or 'link'?*

The 'mental association' or 'link' between the earlier trademark and the later trademark does not automatically result in detriment to the earlier

trademark's repute or distinctive character. Detriment will have to be proved by evidence along with the 'mental association' or 'link'.

6. *Are the same factors taken into consideration to assess the existence of detriment as those already discussed for the link? Are there additional ones?*

The factors referred to in the above answers are relevant.

7. *Must actual dilution be proved or is a showing of likelihood of dilution sufficient? Whose burden of proof is it? How does one prove dilution or likelihood of dilution? Does detriment require evidence of a change in the economic behaviour of the average consumer or that such change in behaviour is likely? If so, what is a change in the economic behaviour of the average consumer? Is reduced willingness to buy goods sold under the earlier mark a change in the economic behaviour? How do you prove a change in the economic behaviour of the average consumer or likelihood of such change in behaviour?*

This question, whether actual dilution be proved or is a showing of likelihood of dilution sufficient, has not as yet been tested in India.

The burden of proof would be on the plaintiff or claimant to prove dilution or likelihood of dilution.

Evidence of a change in the economic behaviour of the average consumer or that such change in behaviour is likely, may assist the trademark owner.

Reduced willingness to buy goods sold under the earlier mark could assist in proving change in the economic behaviour.

If there is any evidence of instance of actual confusion then that would considerably assist the claimant. If members of the public complain to the

trademark owner or make a grievance because they are confused with the later mark and its user, then that would also assist the trademark owner or claimant.

8. *What is the extent of protection afforded to marks which are eligible for dilution protection? May the owner of the earlier trademark object*

- *to the registration of a later trademark?*
- *to the actual use of a later trademark?*
- *in respect of dissimilar goods only or also in respect of similar goods?*

The extent of protection afforded to marks which are eligible for dilution protection has been discussed above and especially in answer to question 3.1 and 3.3.1.

Objection to the registration of a later trademark

The owner of an “earlier mark” can oppose a later trademark as applied for; and if it has been registered as a trademark then the owner of the earlier mark can institute proceedings for rectification of the registered trademark under section 57 of the Trade Marks Act, 1999 in India. The owner of the earlier trademark in opposition proceedings could rely on sub-section 2(a) of Section 9 of the Indian Act that the mark shall not be registered as a trademark if it is of such nature as to deceive the public or cause confusion and this would be an absolute ground for refusal of registration. The owner of the latter trademark could also take the relative ground for refusal of registration under Section 11 (1) and under Section 11 (3) on the ground that its use in India is liable to be prevented by virtue of any law, in particular, the law of passing

off protecting an unregistered trademark used in the course of trade or by virtue of law to copyright. This has been discussed in answer to question 3.1 above.

Objection to the actual use of a later trademark

The owner of the earlier trademark can object by an action based on the common law of **passing off** in an appropriate court of competent jurisdiction.

The owner of the earlier trademark can also institute the statutory infringement action of its registered trademark in India under Section 29 of the Indian Act.

Objection in respect of dissimilar goods only or also in respect of similar goods

Under Section 29(4) of the Trade Marks Act 1999, the proprietor of a registered trademark can institute a statutory infringement action against a defendant who's using a mark which is used in relation of goods or services which are not similar to those for which the trademark is registered; and the registered trade mark has a reputation in India and the use of the mark without due cause takes unfair advantage of or is detrimental to the distinctive character or repute of the registered trade mark. Attention is also invited to answer to question 3.1.

9. *What are the legal remedies? May the owner of the earlier trademark file an opposition and/or a cancellation action? May he ask for injunctive relief or*

preliminary injunctive relief? Does your trademark office refuse the registration of a later trademark on grounds of likelihood of dilution?

Legal Remedies

Section 135 of the Indian Act provides that the relief which the court may grant in any suit for infringement or for passing off would include injunctions and at the option of the plaintiff or claimant, either damages or on account of profits, together with or without an order for delivery-up of the infringing labels and marks for destruction or erasure.

The order of injunction may include an ex-parte injunction or any interlocutory order for any of the following matters namely:-

- (a) for discovery of documents;
- (b) preserving of infringing goods, documents or other evidence which are related to the subject-matter of the suit;
- (c) restraining the defendant from disposing of or dealing with his assets in a manner which may adversely affect plaintiff's ability to recover damages, costs or other pecuniary remedies which may be finally awarded to the plaintiff.

The owner of the earlier trade mark can file an opposition and/or a cancellation action. This is discussed in answer to Question 8.

The Trade Marks Office in India may, in an Opposition proceeding refuse the registration of a later trade mark on the grounds of likelihood of dilution.

II. Proposals for adoption of uniform rules

There does not appear any need to have a separate anti-dilution law on Trade Marks so far as India is concerned. The Trade Marks Act, 1999 and the well-developed principles of the common law of passing-off can and do provide protection to owners of Trade Marks. It also covers well-known trade marks.

The Groups are invited to put forward proposals for adoption of uniform rules with a view to protecting trademarks against dilution. More specifically, the Groups are invited to answer the following questions.

1. *Which trademarks should be eligible for protection against dilution? What should the eligibility criteria be? Should recognition or fame in a limited product market ("niche market") be sufficient?*

Trade marks with a reputation should be eligible for protection against dilution. Any anti-dilution law must ensure that trade mark owners should not suffer at the hands of predators who use marks or signs which dilutes the earlier trade mark or causes its tarnishment, or its use without due cause would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trade mark. The answers given to Questions 3.1, 3.2, 3.3.1 and 3.3.2 are relevant on the aspect of minimum requirements.

The recognition or fame in a limited product ("niche market") which is only aimed at a relatively small but specialized group of consumers may not be sufficient to obtain protection against dilution.

2. *Should it be a criteria for being eligible for dilution protection that the mark has been used in, or that the mark has been registered or that an application for registration of the mark has been filed in the country?*

No. The criteria for being eligible for protection against dilution should be that the trade mark has been used to such an extent - wherever it may have been used- so that it is well known to the substantial segment of the public which uses such goods or services in the country seeking protection. Answer to Q.3.4 shows that there is no requirement that the mark must be used in the country or must be registered in the country or that an application must be filed in the country where protection is sought.

3. *Should there be a registry of eligible marks? If so, what should the evidentiary value of registration be? Should it possible to challenge it in litigation?*

No. On what basis will the Registrar of Trade marks decide that a mark is an eligible mark to be put on such a Register? Reputation in a trade mark can be lost or even become common to the trade or become generic, but it will still remain on such a Register.

As is the situation in India, the Trade Marks Registry is terribly overburdened with putting marks on the Register of Trade Marks. There is huge backlog. Why should they be still more overburdened by creation and maintaining a new Register?

The evidentiary value of such a Register would be difficult to sustain. Such an entry in such a Register could certainly be challenged in litigation .

Our Courts in India – and we daresay that Courts in other countries as well – are more than competent and efficient enough to determine whether or not a trade mark should be protected against dilution.

4. *Should the existence of a 'mental association' or 'link' between the earlier trademark and the later trademark be an independent requirement for a trademark dilution claim?*

Yes. The need to establish a “link” or “linkage” or “mental association of the offending mark with that of the claimant is one of the essential element for securing relief in a claim for dilution . This is covered in answer to Q. 4 above.

5. *Should detriment to the distinctive character or reputation of the earlier mark require evidence of a change in the economic behaviour of the average consumer or that such change in behaviour is likely?*

It should not be a pre-requisite that detriment to the distinctive character or reputation of the earlier mark should require evidence of a change in the economic behaviour of the average consumer or that such change in behaviour is likely. It would be difficult to prove the change in the economic behaviour of the average consumer. Surely, there are other factors which would demonstrate dilution of a trade mark or of a well-known trade mark. In the case of tarnishment there would appear to be no need to prove that there would be a change in the economic behaviour of the average consumer.

6. *What should the remedies be for dilution of a mark?*

The remedies given in answer to Q.9 are more than adequate.

Summary

The Trade Marks Act, 1999 in India, incorporates the concept of “well known trade marks” as appears in Article 6 bis of the Paris Convention for the Protection of Industrial Property, though the expression “dilution” is not expressly defined under the Act. However, references to “dilution”, “tarnishment” and “blurring” appear in judgments decided by High Courts.

Various types of trade marks are protected against dilution in India such as:

1. Indian National Trade Marks
2. Registered Trade Marks in India
3. Application for registration of a trade mark in a Convention Country or a country which is a member of a group of countries or union of countries or Inter-Governmental Organization as referred to in Section 154 of the Indian Trade Marks Act, 1999.
4. “Well-known trade marks” as defined in sub-section (zg) of Section 2 of the Indian Trade Marks Act, 1999.

The extent of protection afforded to marks which are eligible for dilution protection are as follows :

- i. The owner of an “earlier trade mark “as defined in the Explanation to sub-section (4) of Section 11 of the Trade Marks, Act, 1999 can oppose a later trade mark as applied for registration before the Registrar of Trade marks. The owner of the earlier trademark in opposition proceedings could rely on subsection 2(a) of Section 9 of the Indian Act that the mark shall not be registered as a trademark if it is of such nature as to deceive the public or

cause confusion and this would be an absolute ground for refusal of registration. The owner of the earlier trademark could take the relative ground for refusal of registration under Section 11(1) on the ground that the impugned trade mark bears identity with the earlier trade mark and similarity of goods or services covered by the trade mark ;

or its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark .

ii. Such a mark can also be opposed under Section 11(3) on the ground that its use in India is liable to be prevented by virtue of any law, and in particular, the law of passing off in protecting an unregistered trade mark used in the course of trade; or by virtue of law of copyright.

iii. The owner of an earlier trade mark can institute proceedings for rectification of a later registered trade mark under Section 57 of the Indian Act.

iv. The owner of the earlier trademark can object by an action based on the common law of passing off in an appropriate court of competent jurisdiction.

v. The owner of the earlier trademark can also institute the statutory infringement action of its registered trademark in India under Section 29 of the Indian Act.

The burden of proof to prove that a trade mark has reputation in the country in which the action is brought, would be on the party claiming that it is so.

There is a Register of Trade Marks which is a record of all registered trade marks in India. However, there is no separate Register of Well known marks in India.

The presence of a 'link' or a 'mental association' is one of the important factors that needs to be established when the plaintiff alleges 'Dilution' of his or her trade mark. The 'mental association' or 'link' between the earlier trade mark and the later trade mark does not automatically result in detriment to the earlier trade mark's repute or distinctive character. Detriment will have to be proved by evidence along with the 'mental association' or 'link'.

Legal remedies include injunctions, damages on account of profits, delivery-up of infringing labels and mark for destruction or erasure, in suits for infringement or passing-off.