How to Determine Well Knownness of a Trademark – Part 1 - Trade Marks Act, 1999

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In continuation to our previous post on Well Known marks, in this post we will be discussing the factors that should be taken into consideration while determining the well knownness of a mark.

Section 11(6) and Section 11(7) of the Trade Marks Act, 1999 discusses the factors that the Registrar of Trademarks shall take into account while determining the well knownness of a trademark. Section 11(6) provides specific factors for assessing well knownness of a trademark, and Section 11(7) provides specific criteria for the said factors.

“Section 11(6) states that – 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 trademark 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 presentation, 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 publication 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 trademark, in particular, the extent to which the trademark has been recognised as a well known trademark by any court or Registrar under that record.

Section 11 (7) states that “The Registrar shall, while determining as to whether a trade mark is known or recognised in a relevant section of the public for the purposes of sub-section (6), take into account –

i) the number of actual or potential consumers of the goods or services;

(ii) the number of persons involved in the channels of distribution of the goods or services;

(iii) the business circles dealing with the goods or services, to which that trade mark applies.

In addition to this, Section 11(9) of the Trade Marks Act lists the factors that the Registrar shall not take into consideration while determining the well knownness of a trademark. These factors include:

i) The Trademark has been used in India;

ii) The trademark has been registered;

iii) The application for registration of the trademark has been filed in India; or

iv) The mark is well known to the public at large in India.

The factors provided in the Trade Marks Act, 1999 for determining the well knownness of a mark are exhaustive in nature and the Registrar is not bound to restrict himself only to these factors for determining well knownness of a
trademark. The Honorable Delhi High Court in Tata Sons Ltd. Vs. Manoj Dodia and Ors., (MANU/DE/0980/2011) has discussed at length, the factors which are to be considered for determining the well knownness of a trademark.

The relevant para reads as follows:

“13. Trade Marks Act, 1999 does not specify the factors which the Court needs to consider while determining whether a mark is a well known mark or not, though it does contain factors which the Registrar has to consider whether a trademark is a well known mark or not. In determining whether a trademark is a well known mark or not, the Court needs to consider a number of factors including

1. The extent of knowledge of the mark to, and its recognition by the relevant public;
2. the duration of the use of the mark;
3. the extent of the products and services in relation to which the mark is being used;
4. the method, frequency, extent and duration of advertising and promotion of the mark;
5. the geographical extent of the trading area in which the mark is used;
6. the state of registration of the mark;
7. the volume of business of the goods or services sold under that mark;
8. the nature and extent of the use of same or similar mark by other parties;
9. the extent to which the rights claimed in the mark have been successfully enforced, particularly before the Courts of law and trademark registry; and
10. actual or potential number of persons consuming goods or availing services being sold under that brand.

A trademark being well known in one country is not necessarily determinative of its being well known and famous in other countries, the controlling requirement being the reputation in
By the collective reading of Section 11(6) and 11(7) of the Trade Marks Act, 1999, and the factors provided by the Delhi High Court, it is clear that a person claiming a well known status for this mark shall submit cogent, clear and convincing evidence to prove all the aforesaid factors in each jurisdiction independently. The fact that the trademark is well known in one jurisdiction will not give rise to a presumption of well knownness in another jurisdiction.

In our subsequent posts, we shall discuss at length each factor contributing to the well knownness of a mark.