

## **Trade Marks Act**

In the realm of commerce, trademarks serve as the bedrock of brand identity, distinguishing products and services amidst a sea of competition. India's Trade Marks Act of 1999 represents a pivotal piece of legislation, providing a robust framework for the registration, protection, and enforcement of trademarks in the country. The Trademark Act serves as a fundamental legal framework for protecting the distinctive signs, symbols, logos, and names that businesses use to identify their goods and services. It plays a critical role in the commercial ecosystem by ensuring that trademarks are clearly distinguished from one another, thereby preventing confusion among consumers and safeguarding the reputation and goodwill of businesses.

### **Historical Context and Evolution:**

The Trade Marks Act 1999 replaced the outdated Trade and Merchandise Marks Act of 1958, marking a significant milestone in India's intellectual property regime. Enacted to align with international standards, particularly under the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), the Act reflects India's commitment to modernizing its trademark laws to foster innovation and economic growth.

### **International Framework for Trademark:**

Several international instruments play a significant role in shaping the landscape of trademark protection and enforcement globally. Here are some of the key international agreements and organizations related to trademarks:

#### **1. Paris Convention for the Protection of Industrial Property (1883):**

- The Paris Convention is one of the oldest and most important international agreements related to intellectual property rights, including trademarks.
- It establishes basic principles of trademark protection, such as national treatment and the right of priority, allowing trademark applicants to claim priority based on their first application in any member country.
- The Convention provides a framework for international cooperation and harmonization of trademark laws among its member states.

#### **2. Madrid Agreement Concerning the International Registration of Marks (1891) and Madrid Protocol (1989):**

- The Madrid System provides a centralized mechanism for the international registration of trademarks.

- Under the Madrid System, trademark owners can obtain protection for their marks in multiple countries by filing a single application with the World Intellectual Property Organization (WIPO).
- The Madrid Protocol, which amends and extends the Madrid Agreement, offers additional benefits and flexibility to trademark applicants, making it an increasingly popular choice for international trademark registration.

### 3. **World Intellectual Property Organization (WIPO):**

- WIPO is a specialized agency of the United Nations responsible for promoting and protecting intellectual property rights worldwide.
- WIPO administers various treaties and agreements related to intellectual property, including trademarks, patents, and copyrights.
- WIPO's activities in the field of trademarks include the administration of the Madrid System, the development of international norms and standards for trademark protection, and the provision of technical assistance and capacity-building programs to member states.

These international instruments and organizations play a crucial role in promoting global harmonization, facilitating international trademark registration, and enhancing the protection and enforcement of trademark rights across borders.

### **Rights and Protections Afforded u/s 34:**

Upon registration, trademark owners are granted exclusive rights to use the mark in connection with the designated goods or services, safeguarding their brand identity and market presence. The Act provides robust enforcement mechanisms to protect trademark rights against infringement, including civil remedies such as injunctions, damages, and seizure of infringing goods. Criminal penalties are also prescribed for trademark counterfeiting and infringement.

Under the Indian Trade Marks Act of 1999, the **doctrine of prior use** is a significant principle that governs trademark rights. The doctrine essentially grants protection to a trademark based on prior commercial use, regardless of whether the mark is registered or not. The doctrine of prior use recognizes that the rights to a trademark are acquired through the actual use of the mark in commerce rather than solely through registration. In essence, whoever uses a trademark first in connection with specific goods or services gains priority rights to that mark in that particular geographical area. The doctrine applies to both registered and unregistered trademarks. While registration provides certain advantages, such as nationwide

protection and the ability to claim statutory damages in case of infringement, prior use establishes ownership rights even without registration. To establish prior use, the trademark owner must demonstrate continuous and bona fide use of the mark in the course of trade before the filing date of the conflicting trademark application. Evidence of prior use may include sales records, advertising materials, invoices, and other documents that establish the use of the mark in commerce.

### **Cases Related to Doctrine of Prior Use**

In an era of rapid technological advancement and digital commerce, the Trade Marks Act 1999 remains adaptive to emerging challenges in the digital space. Provisions within the Act address issues such as online trademark infringement, domain name disputes, and counterfeiting in e-commerce platforms. This adaptability underscores the Act's relevance in navigating the complexities of trademark enforcement in the digital age. The doctrine of prior use under the Trademark Act, 1999, is a fundamental principle that protects the rights of a person or entity who has been using a trademark before it was registered by another party. This doctrine ensures that the earlier user of the mark can continue to use it, even if a subsequent party registers the mark. Here are some key cases that illustrate the application of this doctrine in India:

- a) **S. Syed Mohideen v. P. Sulochana Bai (2016)**: P. Sulochana Bai filed a suit against S. Syed Mohideen for infringement of her registered trademark "Iruttukadai Halwa." S. Syed Mohideen argued that he had been using the trademark for a long time and that his use of the mark predated the registration of Sulochana Bai's trademark.

The Supreme Court held that the rights of a prior user are superior to those of a subsequent registrant. The Court emphasized that under Section 34 of the Trademark Act, 1999, the prior continuous user of the trademark has superior rights over the registered owner of the trademark.

- b) **Neon Laboratories Ltd. v. Medical Technologies Ltd. & Ors (2015)**: Medical Technologies Ltd. was the registered owner of the trademark "Profol" for an injectable drug, while Neon Laboratories Ltd. claimed to be the prior user of the same trademark for the same product. Neon Laboratories Ltd. filed a suit for infringement against Medical Technologies Ltd.

The Supreme Court ruled in favor of Neon Laboratories Ltd., stating that the rights of the prior user are superior to the rights of the subsequent registrant. The Court

emphasized that the actual use of the trademark by Neon Laboratories Ltd. before the date of registration by Medical Technologies Ltd. granted them the right to use the trademark.

- c) **Milmet Industries & Ors v. Allergan Inc (2004)**: Allergan Inc., a US-based company, had registered the trademark "Ocuflox" for an eye care product in India. Milmet Industries claimed prior use of the trademark "Ocuflox" in India for their eye care product and filed a suit against Allergan Inc.

The Supreme Court held that the rights of a prior user prevail over the rights of a registered trademark owner. The Court underscored the importance of Section 34 of the Trademark Act, 1999, which protects the rights of a prior user over those of a subsequent registrant.

- d) **Century Traders v. Roshan Lal Duggar & Co. (1978)**: Century Traders claimed to be the prior user of the trademark "RAJARANI" for their incense sticks and filed a suit against Roshan Lal Duggar & Co. for infringing on their trademark. Roshan Lal Duggar & Co. argued that they had registered the trademark and thus had exclusive rights.

The Delhi High Court held that the rights of the prior user are superior to those of the registered owner. The Court emphasized that even if the subsequent user had registered the trademark, the prior user's rights would still prevail.

- e) **Uniply Industries Ltd. v. Unicorn Plywood Pvt. Ltd. & Ors (2001)**: Uniply Industries Ltd. filed a suit against Unicorn Plywood Pvt. Ltd. for infringement of their registered trademark "Uniply." Unicorn Plywood Pvt. Ltd. claimed that they had been using the trademark "Uniply" for a long time before Uniply Industries Ltd. registered the trademark.

The Madras High Court ruled in favor of Unicorn Plywood Pvt. Ltd., stating that the prior user of the trademark has superior rights over the registered owner. The Court reiterated that under Section 34 of the Trademark Act, 1999, the rights of the prior user are protected.

#### Conclusion:

The Trademark Act is a vital component of intellectual property law, providing essential protections that benefit businesses, consumers, and the economy. By securing brand identity, promoting fair competition, and protecting consumers, the act fosters a healthy marketplace where innovation and quality can thrive. As the digital landscape continues to evolve, ongoing adaptations to the law will be necessary to address new challenges and ensure that trademarks

remain a powerful tool for economic growth and consumer protection. Through continuous refinement and international cooperation, the Trademark Act can effectively support the dynamic needs of the modern marketplace.