

IN THE HON'BLE HIGH COURT OF DELHI AT DELHI
Extraordinary Original Writ Jurisdiction
Writ Petition (Civil) No. 11642 of 2019

IN THE MATTER OF:

Tata SIA Airlines Limited

...PETITIONER

VERSUS

Union of India

...RESPONDENT

SUBMISSIONS ON BEHALF OF INTERNATIONAL TRADEMARK ASSOCIATION (INTA), NEW YORK, USA AS AN *AMICUS CURIAE* IN ACCORDANCE WITH DIRECTION VIDE THE ORDERS DATED 20.12.2019 AND 24.02.2020 PASSED BY THIS HON'BLE COURT ON QUESTION OF LAW PERTAINING TO THE PROCEDURAL REQUIREMENT LAID DOWN UNDER RULE 124 OF THE TRADEMARKS RULES, 2017 FOR ENTRY OF A MARK IN THE LIST OF WELL-KNOWN TRADEMARKS MAINTAINED BY THE REGISTRAR OF TRADE MARKS AFTER THE MARK HAS BEEN DETERMINED TO BE A WELL-KNOWN TRADEMARK BY A COURT OF LAW IN INDIA

IT IS MOST RESPECTFULLY SUBMITTED

1. That the present writ petition filed by the Petitioner, seeking a writ in the nature of '*Mandamus*' against the Respondent, is pending adjudication before this Hon'ble Court. This Hon'ble Court *vide* its order dated November 4, 2019, raised the following question:

“The question raised is whether once a Court has determined a Trade Mark to be well-known, the procedure stipulated under Rule 124 of the Trade Mark Rules, 2017 would have to be followed, including the payment of fees of Rs. 1 lakh, in order to get the Trade Mark included in the list of well-known Trade Marks published by the Trade Mark Registry?”

2. Since this issue would concern a large number of trademark owners, this Hon’ble Court *vide* its order dated December 20, 2019, was pleased to issue notice to associations including the INTA, representing brand owners and IP lawyers to file amicus briefs for assisting the Court. Hence, the present Amicus brief.
3. The amicus curiae herein, International Trademark Association, having its office at the address 675 Third Avenue, 3rd Floor, New York, NY 10017 USA, (hereinafter referred to as INTA), was founded in the year 1878 and is a non-profit membership association of more than 6000 trademark owners and professionals from more than 190 countries all over the world. INTA is dedicated for over the last 128 years to the support and advancement of trademarks and related intellectual property concepts as essential elements of commerce. An essential objective of INTA is to protect the interest of the public and brand owners in the proper use of trademarks. In this regard, INTA strives to advance the development of trademark and unfair competition laws and treaties throughout the world, based on the global public interest in avoiding deception and confusion.
4. INTA has acted several times in the capacity of *amicus curiae* before the European Court of Justice (ECJ) and in the United States of America and several other jurisdictions including India (ref. Samsung Electronics

Company Ltd. & ANR v. Kapil Wadhwa & Ors, before the Supreme Court of India). INTA has been an official non-governmental observer to the World Intellectual Property Organization (WIPO) since 1979 and actively participates in all trademark-related WIPO proposals. INTA has consequently contributed to WIPO trade-mark initiatives such as the Trademark Law Treaty. INTA also is active in other international arenas including the Asia-Pacific Economic Cooperation Forum (APEC), the Association of Southeast Asian Nations (ASEAN), the European Union and the World Trade Organization (WTO). INTA's membership is varied and extensive. Therefore, INTA is a balanced and reliable representative body.

5. The trademark owners carrying on business in India have made considerable investments in India to promote their brands and to prevent unauthorized and unregulated sales. On various occasions, the Indian Courts, after hearing the contentions of the parties and appreciating the evidence filed by the Plaintiffs, have declared those trademarks to be well-known and famous within the meaning of Section 2(1)(zg) of the Trade Marks Act, 1999 (hereinafter, "the **Act**"). Hence, those brand owners shall be directly impacted by the adjudication of issue at hand.

6. As a representative body, INTA seeks to provide a perspective to effectively assist and contribute in advancement of law in the interest of public at large and that of the right holders in a global economy. Accordingly, as the aspect of well-known trademarks involves significant rights of its members, INTA is putting forth a perspective on the issue so as to assist this Hon'ble Court in the adjudication of the question of law involved in the present case.

SUBMISSIONS FOR CONSIDERATION

7. INTA supports the principle that once a Court has determined a trademark to be well-known, the procedure stipulated under Rule 124 of the Trade Mark Rules, 2017 (hereinafter, “the **Rules**”), *i.e.* the filing of an application for determination and payment of requisite fees, is not required to be followed to have a trademark included in the List of Well-Known Trademarks published by the Trade Mark Registry (Respondent/Registrar). Filing of an application, examination of the application or depositing of any fee is not required to have a trademark declared as well-known by the Respondent/Registrar when such declaration and determination regarding that exact same mark has already been made by a Court of law in India.
8. A trademark owner cannot and should not be made to go through the hurdle of a lengthy process of collating data and documents and filing it with the Trade Marks Registry and proceeding with the payment of additional fees along with an examination of such application when such review and examination was already been made by a Court after careful consideration of the evidence placed on the Courts’ records by the trademark owner. Accepting the opposite view would lead to a situation where potentially one could have a Respondent/Registrar declaring a trademark as not being well-known when a Court has already determined that legal situation with a decision that is final and binding. The unity of the legal system does not cope with two different definitions of the same factual reality.
9. Therefore, the examination of the same set of evidence by the Respondent/Registrar under Rule 124 of the Rules is unnecessary, cumbersome, time-consuming and merely a ministerial act which has the potential of contradicting a Court decision that is final and binding.
8. The contention of the Respondent/Registrar is contrary to the statutory scheme of the Act that despite a trademark being declared as well-known

by a Court, an applicant still has to go through the procedures formulated under the Rules including payment of fees of Rs. 1,00,000. A brief description of the relevant provisions of the Act and the Rules is as below:

- Section 2(1)(zg) of the Act - Definition of a well-known trademark.
- Section 11(6) and 11(7) of the Act lists down the factors that may be taken into account for determining if a trademark is well known. These factors include whether any court has recognized a mark as well known.
- Section 11(8) of the Act states that “*where a trademark has been determined to be well known in at least one relevant section of the public in India by any court or Registrar, the Registrar shall consider that trade mark as a well-known trade mark for registration under this Act.*”.
- Section 11(9) of the Act lists factors that are not necessary to be considered while determining a mark as well-known.

Rule 124 of the Rules lays down the procedure for filing an application in the Trade Marks Registry for determination of a trademark as well known and to be included in the List of Well-Known Trademarks by the Registrar. The Rules came into force on 06.03.2017 (superseding the Trade Marks Rules, 2003), and this provision for filing an application for determination of a well-known trademark by the Registrar was introduced for the first time in these Rules.

124. Determination of Well-Known Trademark by Registrar. —

(1) Any person may, on an application in Form TM-M and after payment of fee as mentioned in First schedule, request the Registrar for determination of a trademark as well-known. Such request shall be accompanied by a statement of case along with all the evidence and documents relied by the applicant in support of his claim.

(2) The Registrar shall, while determining the trademark as well-known take in to account the provisions of sub section (6) to (9) of section 11.

(3) For the purpose of determination, the Registrar may call such documents as he thinks fit.

(4) Before determining a trademark as well-known, the Registrar may invite objections from the general public to be filed within thirty days from the date of invitation of such objection.

(5) In case the trademark is determined as well-known, the same shall be published in the trademark Journal and included in the list of well-known trademarks maintained by the Registrar.

(6) The Registrar may, at any time, if it is found that a trademark has been erroneously or inadvertently included or is no longer justified to be in the list of well-known trademarks, remove the same from the list after providing due opportunity of hearing to the concerned party.

9. Therefore, the scheme of Act and the Rules provide for two distinct opportunities to determine a trademark to be well-known either by:

(a) The Registrar of Trade Marks (the “Registrar”) or a Court in a contested matter including the proceedings before Intellectual Property Appellate Board (hereinafter the “IPAB”). This determination is covered under Section 11(8) of the Act; or

(b) The Registrar, on an application in accordance with the procedure prescribed under Rule 124 of the Rules.

While the former involves a contested matter, the latter is not an adversarial process unless an objection is filed during the later proceedings.

10. Section 11(8) expressly states that once a trademark has been determined to be well-known in at least one relevant section of the public in India by any Court or Registrar, the Registrar shall consider the trademark as a well-known trademark for registration under this Act. The use of the word “*shall*” in Section 11(8) leaves no room for further determination or deliberation by the Registrar. This Section 11(8) is without any condition or limitation. Thus, a trademark determined as well-known by a Court has to be included in the List of Well-Known Trademarks.

11. Rule 124 provides that any person may request the Registrar for determination of a trademark as a well-known trademark. On the contrary, Section 11(8) states that once the determination has been made by a Court, the Registrar shall consider the trademark as well-known. Therefore, this is indicative that Rule 124 does not encompass situations in which a determination to this effect has already been made by a Court. Before 06.03.2017, there was no specific mechanism available to the proprietors to

have their trademarks determined as well-known trademarks by the Registrar unless that trademark was involved in an adversarial action. To fill this gap, the Rules framed in 2017 expressly introduced an alternate mechanism, under Rule 124, by which an application for well-known status can be filed, and a trademark can be determined as a well-known trademark by the Registrar. It is important to note that language of Rule 124(1) reads as:

“Any person may, on an application in Form TM-M and after payment of fee as mentioned in First Schedule, request the Registrar for determination of a trade mark as well-known. Such request....”

As can be noted from above, the application under Rule 124 is a request to the Registrar for determination of well-known status. But, as per the mandate of Section 11(8) of the Act, there is no room for further determination or deliberation by the Registrar if a Court has already determined a trademark as well-known. Therefore, the said Rule merely provides an alternate mechanism and not an exclusive or mandatory mechanism, which is required to be followed in each case. The said is also corroborated by the use of the word “*may*” in Rule 124 of the Rules. Any procedure, which is the exclusive procedure generally, uses the word “*shall*”, for example: Section 18 of the Act and Rule 23 provides the exclusive procedure for registration of a trademark and use the word “*shall*” instead of “*may*”. Therefore, this is indicative of the fact that Rule 124 does not encompass situations in which a determination to this effect has already been made by a court.

12. Therefore, the scheme of the Act and Rules is clear that the intention of the legislature was to create a distinction and to facilitate the inclusion of well-

known trademarks by either of the two ways, *i.e.* Court/Registrar determined well-known trademark in contested matters or through an application under Rule 124. The legislative intention is also clear that a party does not always have to go through a contested proceeding in a Court/IPAB for a trademark to be declared well known. Thus, if a trademark has been determined or recognized as a well-known trademark in an adversarial proceeding, then the Registrar is required to include such a trademark in the List of Well-Known Trademarks. This act of entering a trademark already “*determined*” to be well known by the Court/IPAB or Registrar in an adversarial matter is a ministerial act to be performed by the Registrar and does not require the filing of an application, supporting documentary evidence, paying fees of Rs. 1,00,000/- and following the procedure prescribed by Rule 124 of the Rules.

13. Prior to the enforcement of the Rules in 2017, a total of 84 marks have been included by the Respondent/Registrar in the List of Well-Known Trademarks, amongst which, 80 trademarks have been determined to be well-known trademarks by the Courts/IPAB and other authorities, while only 4 trademarks have been determined to be well-known by the Respondent/Registrar *vide* opposition proceedings. This shows that the Respondent/Registrar, before the enforcement of the Rules in 2017, accepted the determination of trademarks as being well-known by competent authorities other than itself (in compliance with Section 11(8) of the Act), and included them in its List of Well-Known trademarks. There is no change in the Act in this regard.
14. It is respectfully submitted that the Rules were enforced on 06.03.2017 and Rule 124 was introduced for the first time. Before the introduction of Rule 124, the Registrar was, as mentioned above, including in the List of Well-Known Trademarks all the trademarks determined by Courts and IPAB as

being well-known. However, after the enforcement of the new Rules, there was no amendment to the existing Section 11 of the Act. Therefore, even post the framing of new Rules w.e.f. 06.03.2017, the Registrar should include a trademark which has already been determined to be well-known by Court/IPAB in the List of Well-Known Trademarks without any further determination by the Registrar and payment of prescribed fees.

15. In light of the above, one can only conclude that it is unreasonable for a proprietor to file a detailed application with supporting documentary evidence under Rule 124 and pay a fee of Rs. 1,00,000 to have its trademark determined as well-known when this has already been done so by a Court. This would, besides leading to a potential conflicting decision as mentioned above, lead to duplication of costs, procedures and acts akin to “*double taxation*”. In other words, for a mere ministerial act of entry in a list, it is not fair to have a proprietor to pay for and go through an onerous process. Therefore, the Registrar, either *suo moto* or on a letter along with a copy of the judgement of the Court holding the mark to be well known, has to include the said trademark in the List of Well-Known Trademarks maintained by the Registry and it is quite clear that Rule 124 is not attracted or applicable in such cases.

16. It is submitted that it is a settled position of law that technical rules and procedures are not to be given precedence over substantial justice. The aim of the Courts at all times should be to render substantial justice and the procedural law, which is only handmaid of Justice, should not be given precedence over it. In the case at hand, when a Court has determined a trademark to be well known under Section 11(8) of the Act, Rule 124 cannot override Section 11(8) of the Act as the Rules are subordinate legislation. Giving precedence to Rule 124 over Section 11(8) of the Act is unreasonable and illogical and will result in duplication as the same process

that has taken place before the Court for determining the trademark as well-known will be carried out again before the Registrar. This could never have been the intention of the Legislature. Section 11(8) of the Act will be rendered toothless and irrelevant when a trademark determined as well-known by a Court cannot be included in the List of Well-Known Trademarks maintained by the Respondent/Registrar until an application is filed under Rule 124(1) of the Rules.

17. It is pertinent to note that under Section 11(8) of the Act, when a trademark has already been determined as being “well-known” by a Court or Respondent/Registrar, then all proceedings *post facto* such determination, are by necessary consequence merely ministerial acts of entering the determined well-known the mark on the List of Well-Known Trademarks and there is absolutely no requirement to go through further procedures under Rule 124.

18. The contentions at paragraph 6 of the Counter Affidavit filed by the Respondent/Registrar in the subject Writ Petition wherein the Registrar has stated that in cases where a trademark has been determined as a well-known trademark by a competent court/tribunal, it shall be published under Rule 124(5), not under Rule 124 (4), and will be included in the List Of Well-Known Trademarks. However, in paragraph 7 of the said Affidavit, there has been an undue requirement of filing the Form TM-M as prescribed under Rule 124(1) for processing of the mark for publication. The dichotomy here is that the requirement of Form TM-M under Rule 124(1) is for filing a request for determination of a mark as a well-known trademark and not for processing of trademarks already determined by Court/tribunal as a well-known trademark. The plain reading of Rule 124(1) sufficiently clarifies this position.

19. It is an established principle of law that Rules cannot take precedence of the Act. Rules are framed for giving effect to the provisions of the Act and not vice versa. The Act and Rules have to be harmoniously construed, and in case of any conflict, the Act shall take precedence over the Rules. Any benefit given by the provisions of a statute cannot be divested by the Rules. The Rules merely flesh out what is already contained in the statute and must, therefore, be construed along with the statute. In determining either the general object of a legislation or the meaning of its language in any particular passage, it is obvious that the intention which appears to be most accord with convenience, reason, justice and legal principles should, in all cases of doubtful significance, be presumed to be the true one. An intention which produces an unreasonable result should not be imputed to a statute if there is some other construction available. It is, thus, unreasonable and is in error to presume that the introduction of the new Rule 124 has vitiated the effect of Section 11(8) of the Act to the extent that now a Court order in itself is not a sufficient ground for inclusion of a determined well-known trademark in the list of well-known marks. The need for an application under Rule 124(1) even after the determination of a trademark as a well-known mark by a Court is not in consonance with either the intention of the Legislature or the Act.

20. The position and procedure of determination of a trademark as being well-known within the meaning of Section 2(1)(zg) of the Act has remained unchanged from the date of the Act coming into force on 15.09.2003. The only change that has come about with the framing of the Rules on 06.03.2017, which laid down the procedure for Determination of Well-Known Trademark by the Registrar in non-adversarial matters under Rule 124. This did not change any position and in fact, additionally provided a means for a party to get a mark declared as well-known without a party initiating any adversarial proceedings. Simply, the purpose of Rule 124 was

to provide an additional method for the determination of a well-known trademark.

21. It is also the understanding of INTA that by mechanically and mandatorily enforcing the application of Rule 124 despite a trademark being determined well-known under Section 11(8) shall render Section 11(10) of the Act otiose. Section 11(10) requires the Registrar to protect a well-known trademark against an identical or similar trademark. By not considering that trademark as a well-known trademark unless the same is entered in the List of Well-Known Trademarks renders otiose the provisions of Section 11(10) of the Act.
22. The whole exercise would be contradictory wherein a brand owner has to go through the procedure prescribed under Rule 124 by filing a petition with affidavits and documents with the payment of a fee of Rs. 1,00,000 (Rupees One Lakh), despite the fact that the trademark is already determined to be well known by the Court and no further determination is required to be made and for simply publishing the trademark in the Trade Mark Journal's and including in the List of Well-Known Trademarks.
23. Therefore, in the humble opinion of INTA, once a Court has determined a Trademark to be well-known, the procedure stipulated under Rule 124 of the Rules is not attracted and not required to be followed, including the payment of fees of Rs. 1 lakh, in order to get the trademark included in the List of Well-known Trademarks published by the Trade Marks Registry. It is also an interpretation consistent with the settled position of law in the interest of right holders and consumers at large. INTA is grateful for being permitted to bring this perspective for kind consideration by this Hon'ble Court.

24. For the sake of convenience, the summary of INTA's view is as follows along with certain additional recommendations regarding application of Rule 124:
- A. The rights of the Court/IPAB to declare a trademark as a well-known trademark should not be taken away in line with the provisions of the **Act**. In short, once a Court declares a trademark to be a well-known trademark, the process of including a trademark in the List should be ministerial and optional and the List itself should not be the only determinant as to whether a trademark is well-known.
 - B. If the brand owner decides to include such trademark (as determined by the Court as well-known) in the List of Well-Known Trademarks, the brand owner should not be made to go through the procedure set out under Rule 124 and the trademark should be directly included in the List of Well-Known Trademarks without the requirement of fees.
 - C. For the process under Rule 124, the Trade Marks Registry should be directed to follow the principles of a well-known trademark whilst adjudicating, and avoid entries in the List which merely set out the well-known nature for a restricted category of goods/services;
 - D. In case of inclusion of a trademark in the List without a Court determination, the process set out in Rule 124 has to be in line with the opposition/cancellation process followed under the Act including to allow the person objecting to have access to the documentary evidence filed by the brand owner and vice-versa;
 - E. In case of inclusion of a trademark in the List without a Court determination, the fees payable under Rule 124 should envisage a refund in case of rejections; and,

25. INTA seeks leave to rely on documents a list whereof is hereto annexed, as well as any additional documents placed on record with the permission of this Hon'ble Court.

INTERNATIONAL TRADEMARK ASSOCIATION

THROUGH

Vaibhav Vutts

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