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The Trademark Reporter®

A BRIEF HISTORY OF HONEST CONCURRENT USE IN INDIAN TRADEMARK LAW*

By Lokesh Vyas** and Praharsh Gour*** ****

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**** This article is based on Lokesh Vyas's *SpicyIP* post titled “Honesty as a Defense vis-à-vis Trademark Infringements: Principle or Provision?” (Feb. 10, 2023) © Lokesh Vyas, 2023), <https://spicyip.com/2023/02/honesty-as-a-defense-vis-a-vis-trademark-infringements-principle-or-provision.html>, which examined the history of honest concurrent use in trademark law. While this article expands and refines that discussion—incorporating new sources, sharpening arguments, and making necessary revisions—some elements from the post remain. We have reworked and rephrased most of the claims, though traces of the post may still be present. Thanks to Swaraj Barooah, who helped curate the *SpicyIP* post, and to *The Trademark Reporter* reviewers and editors for their inputs on this article. Any errors that remain are entirely ours. After all, what better reminder of our *humanity* than the little errors we leave behind? Or, as Alexander Pope put it, “To err is human; to forgive, divine.” Alexander Pope, *An Essay on Criticism*, Part II, line 525 (1711).

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ABSTRACT

Can honest concurrent use serve as a defense in trademark infringement cases? History suggests it can and should. The underlying principle of honest “and” concurrent use has long existed in common law’s doctrine of equity, now codified into statutory law as honest concurrent use (“HCU”). Yet, Indian courts remain divided on its nature—whether HCU is merely a statutory provision, or a broader principle underpinning various provisions in trademark law. This article offers a historical contribution to this question. We argue that some recent rulings by Indian courts that have dismissed it as a defense against infringement yielded a misreading of the law. Highlighting its historical origins, we argue that HCU is more than a provision under Section 12 of the Trademark Act 1999. It is a core principle of trademark law founded in the common law. When understood in this light, its relevance extends beyond mere registration (construed mistakenly by some due to the language of Section 12), allowing it to be invoked as a robust defense in infringement suits.

I. INTRODUCTION

India’s Trade Marks Act of 1999¹ contains a peculiar provision with an explicit moral dimension, titled “Registration in the case of *honest* concurrent use, etc.” and codified in Section 12 of the Act. But why call it peculiar? Is it novel or uniquely Indian? Not quite. This is because by allowing more than one person to register and use the same mark, the provision creates an exception to the typical understanding that a trademark is an exclusive right a proprietor holds. Section 12 states:

In the case of honest concurrent use or of other special circumstances which, in the opinion of the Registrar, make it proper to do so, he may permit the registration by more than one proprietor of the trade marks which are identical or similar (whether any such trade mark is already registered or not) in respect of the same or similar goods or services, subject to such conditions and limitations, if any, as the Registrar may think fit to impose.

Simply put, it allows multiple proprietors to register identical or similar trademarks under honest concurrent use or other special conditions. While this legal quirk has been simmering in the background of common-law jurisprudence for decades (if not centuries), shaping legal outcomes, honest concurrent use (“HCU”) gained attention in recent years after being viewed as limited to

¹ Trade Marks Act, No. 47 of 1999.

registration and not as a valid defense in trademark infringement or passing off cases.

For instance, in 2022, the Delhi High Court in *KEI Industries Ltd v. Raman Kwatra* (“*KEI-1*”), held that “Section 12 is essentially a provision which enables the Registrar to permit registration of a mark which is identical or similar to an existing mark in respect of same or similar goods. It does not envisage honest and concurrent user as a defence to an allegation of infringement of a registered trade mark.”² The Court relied on the Supreme Court’s ruling in *Power Control v. Sumeet Machines*,³ a case that addressed honest concurrent use in the context of copyright infringement, ultimately rejecting the claim. This misplaced reliance nevertheless shaped the outcome in *KEI-1*, which was subsequently followed in another case. The Bombay High Court’s decision in *Abdul Virjee v. Regal Footwear*, which echoed *KEI-1*, reaffirmed that HCU could not serve as a defense in trademark infringement cases.⁴ Then came a judicial U-turn in *Raman Kwatra v. KEI Industries* (“*KEI-2*”), in which the Delhi High Court overruled *KEI-1*, marking a notable shift in the legal landscape.⁵

Tellingly, while *KEI-2* overruled *KEI-1*, the issue of HCU was not examined in detail other than to remark: “Section 12 . . . would follow that where special circumstances exist that warrant grant of registration of identical or similar trademarks in respect of similar goods and services, the person claiming entitlement to such registration may also be entitled to resist a restraining order for use of such trademark.”⁶ Furthermore, this was a prima facie view, making the observation susceptible to being set aside by a more judicially rigorous decision in future.

Thus, the question remains unresolved as to whether HCU is a valid defense to trademark infringement claims in India. While these cases have been analyzed and commented on,⁷ a historical

² (2022) SCC OnLine (Del.) 1459, p. 24 ¶ 46.

³ (1994) 2 SCC 448.

⁴ MANU/MH/0001/2023. The Bombay High Court in a very recent order dated September 22, 2025, reiterated this interpretation, summing up its finding in one line: “Section 12 of T.M. Act, 1999 cannot constitute a defence in an action for infringement.” See *SML Limited v. Safex Chemicals India Ltd.*, Commercial IP Suit No. 432 of 2025.

⁵ MANU/DE/0066/2023.

⁶ MANU/DE/0066/2023, ¶ 49.

⁷ See, e.g., Eashan Ghosh, *Kwatra v. Kei Industries: Honest Concurrent Use Unvisited, Prosecution History Revisited*, Medium (Jan. 9, 2023), available at <https://medium.com/@EashanGhosh/kwatra-v-kei-honest-concurrent-use-unvisited-prosecution-history-revisited-7fd5e1b9f766> (last visited Sept. 8, 2025); Eashan Ghosh, *Kei Industries v. Kwatra: No Honest Concurrent Use Defence Against Trade Mark Infringement*, Medium (May 19, 2022), available at <https://medium.com/@EashanGhosh/kei-industries-v-kwatra-no-honest-concurrent-use-defence-against-trade-mark-infringement-b924b264178e> (last visited Sept. 8, 2025); see generally P.T. Shrivani, *Defence of Honest Concurrent Use vis-a-vis trademark protection: How much longer will this hold for brand proprietors?*, Medium (Aug. 24, 2017), available at

examination of the principle in the Indian context—crucial to understanding its trajectory—remains absent. Building on the previous work by one of the authors of this article (Lokesh Vyas) and expanding the historical discussion, we argue that it is a foundational principle of trademark law, not merely a provision confined to Section 12.⁸

Our key claim is that HCU operates on two levels in Indian trademark law, as aptly emphasized by Professor Eashan Ghosh.⁹ First, under Section 12 of the Trade Marks Act, 1999, in which the term “honest concurrent use” is explicitly codified, a proprietor can register a mark by proving honest concurrent use despite an existing registration. This requires an affirmative showing by the junior applicant. Second, it serves as a defensive principle in trademark litigations. Developing Ghosh’s idea of HCU’s dual nature, we trace the legislative history of HCU from its common law origins in the 1860s to its formal inclusion in the Trade Marks Act, 1940. In looking at the judicial evolution of HCU in India, we are confronted with diverse ways in which HCU is treated in infringement and passing off cases as a defense in Indian courts.

After setting the context in Part I, the core argument unfolds in the next two sections, followed by a brief conclusion that foregrounds a future research question for other researchers. Part II traces the history of HCU within common law principles since the 1860s, highlighting its legislative evolution. Part III examines judicial engagement with the issue, analyzing how different courts in India have read HCU in trademark infringement and passing off cases. Doing so will help us look behind the conventional understanding that crept its way recently via the orders passed in *KEI-1* and *Abdul Virjee v. Regal Footwear*, limiting the application of HCU for assessing the registrability of a mark.

<https://medium.com/@shravanipt23787/defence-of-honest-concurrent-use-vis-a-vis-trademark-protection-how-much-longer-will-this-hold-for-c43308f8c92d> (last visited Sept. 8, 2025). There are other discussions on these cases from the aspect of whether a party can go back on admissions made at the time of registering a mark when later appearing before a court in a separate infringement suit. See, e.g., Prahars Gour, *Done, so Dusted? Discussing the Relevance of the Responses Filed Against FERs Issued by Trademark Registry*, SpicyIP (Apr. 26, 2023), available at <https://spicyip.com/2023/04/done-so-dusted-discussing-the-relevance-of-the-responses-filed-against-fer-issued-by-trademark-registry.html> (last visited Sept. 8, 2025).

⁸ This was argued by Eashan Ghosh who considered HCU in two forms—one as a specific form under Section 12 and the other under Sections 32 (protection of a mark on account of distinctiveness despite certain irregularities) and 35 (saving clause for marks derived from name, address or description of goods or services). He says that the spirit of HCU is embedded across various provisions of trademark law, not just in those dealing with registration, under Section 12. See Eashan Ghosh, *Imperfect Recollections: The Indian Supreme Court on Trade Mark Law 253* (2d ed. 2024).

⁹ *Id.*; see also W. Alberts, *Trade Mark Conflicts: Honest Concurrent Use Is Alive and Well*, 83 *THRHR* 260, 267-69 (May 2020).

Given the intricate nature of this section, our methodology deserves a specific explication. Acknowledging the inconsistency in the approach of the Indian courts, we start by looking at the cases that the Bombay High Court relied on in *Abdul Virjee v. Regal Footwear* to back this point. We opt for this case because while the division bench overruled the Delhi High Court's decision in *KEI-1*, *Abdul Virjee's* interpretation of HCU (limited to registration, disregarding it as a defense) still stands valid. Therefore, the methodology adopted here is to look at the cases cited supporting the unilateral understanding of HCU, assess the overall context in which it was said, and understand the limitations (if any) applicable to the courts there for restricting its interpretation. Once we have clearly established the context in which the courts interpreted the HCU in those cases, we compare it with interpretations of HCU over time to understand whether and how courts have built up their understanding toward a broader interpretation of HCU, which can be read into various provisions of the 1999 Act today. From that, we build our case by looking at how courts may have shifted their understanding of HCU. We have identified least four kinds of cases involving HCU: (1) HCU was not accepted as a defense against infringement allegations; (2) HCU was read along with acquiescence; (3) HCU was cited as a standalone defense, and (4) HCU was read as a broader principle present not only in Section 12 but also in other provision across the Trade Marks Act.

A few disclaimers are in order. Limiting our discussion to HCU in India and its interpretations, we avoid delving into the factual details and broader issues of the cases discussed. With the common law system as the foundation of our discussion cutting across both High Courts and the Supreme Court, a few technical points regarding judicial functioning merit a mention. First, in India, the decisions of the Supreme Court bind all the High Courts,¹⁰ whereas the decisions of the High Court of an Indian State hold only a persuasive value on the courts of other states.¹¹ Within a High Court, the decision on a division bench (consisting of two judges) is binding on the Single Judge Benches,¹² while the composite Single Judge Benches may disagree with the views expressed by other Single Judge Benches on the interpretation of a provision and refer the contentious issue to a larger (division) bench to decide.¹³

¹⁰ "The law declared by the Supreme Court shall be binding on all courts within the territory of India." India Const. art. 141.

¹¹ See generally, e.g., *Valliamma Champaka Pillai v. Sivathanu Pillai and Ors*, 1979 AIR 1937.

¹² See, e.g., para. 27, *M/S RSPL Limited v. Mukesh Sharma & Anr*, (2016) SCC OnLine (Del.) 4285.

¹³ See, e.g., para. 14, *Vodafone India Ltd v. The Commissioner of Central Excise, Mumbai II*, (2015) SCC OnLine (Bom.) 4791.

Second, while civil remedies in trademark suits in India include permanent injunctions, damages, and accounts of profits,¹⁴ adjudication of IP matters takes time in India, especially trial and final arguments.¹⁵ To not leave the plaintiff remediless, India has a mechanism to grant interim injunctive relief if the plaintiff can satisfy the three required elements, namely prima facie case, balance of convenience, and irreparable harm.¹⁶ Being mindful of this unique situation, as a caveat, it is important to highlight upfront that many of the referred cases in the paper concern decisions passed against interim injunction applications, which are not binding.¹⁷ Thus, we may see some conflicting opinions in our discussion below.

Thirdly, given the historical focus of this article, it is essential to mention that trademarks as *property* rights are relatively modern constructs compared to other forms of intellectual property.¹⁸ It originated in fraud and deceit, with close ties to a mark being an act of communication, sparking intense historical debates over whether trademarks should be considered property rights at all.¹⁹ While this

¹⁴ See Trade Marks Act, § 135(1) (“Relief in suits for infringement or for passing off.—(1) The relief which a court may grant in any suit for infringement or for passing off referred to in section 134 includes injunction (subject to such terms, if any, as the court thinks fit) and at the option of the plaintiff, either damages or an account of profits, together with or without any order for the delivery-up of the infringing labels and marks for destruction or erasure.”).

¹⁵ A division bench of the Delhi High Court in *Intex Technologies India Ltd. v. Telefonaktiebolaget L M Ericsson*, 2023:DHC:2243-DB, attributed this to low Judge-population ratio. See also *Bajaj Auto Ltd. v. TVS Motor Company Ltd.*, (2009) 9 SCC 797; Chugh, S., *The Culmination of a Saga: How the Delhi HC Resolved the Two-Decade Long ‘Lacoste v. Crocodile International’ Impasse*, SpicyIP (2024), available at <https://spicyip.com/2024/09/the-culmination-of-a-saga-how-the-delhi-hc-resolved-the-two-decade-long-lacoste-v-crocodile-international-impasse.html> (last visited Sept. 8, 2025); Reddy, P., *143 patent infringement lawsuits between 2005 and 2015: Only 5 judgments*, SpicyIP (2017), available at <https://spicyip.com/2017/06/143-patent-infringement-lawsuits-between-2005-and-2015-only-5-judgments.html> (last visited Sept. 8, 2025); Gour, P., *DHC’s IPD Annual Report a positive step for transparency – here’s how it could go further*, SpicyIP (2023), available at <https://spicyip.com/2023/05/dhcs-ipd-annual-report-a-positive-step-for-transparency-heres-how-it-could-go-further.html> (last visited Sept. 8, 2025).

¹⁶ *M/s. Gujarat Bottling Co. Ltd. & Ors v. The Coca Cola Co. & Ors*, 1995 AIR 2372.

¹⁷ *Zenit Mataplast (P) Ltd. v. State of Maharashtra*, (2009) 10 SCC 388. An illustration of how interim injunctions usually work their course out is showcased in *Novartis AG v. Natco Pharma Ltd.*, MANU/SCOR/93953/2024, where the Court ruled that after the patent-in-suit expired, the interim injunction passed by a single judge bench of the Delhi High Court had already run its course and thus the concerned division bench should not have passed a detailed order as the interim injunction was not binding.

¹⁸ Brad Sherman & Lionel Bently, *The Making of Modern Intellectual Property Law: The British Experience, 1760-1911*, 95-118 (1999).

¹⁹ Lionel Bently, *From Communication to Thing: Historical Aspects of the Conceptualisation of Trade Marks as Property* in *Trademark Law and Theory: A Handbook of Contemporary Research*, 3-41 (Graeme B. Dinwoodie & Mark D. Janis, eds., 2008).

article does not delve into the broader historical evolution of trademark law, the background—of the transition of trademarks from a remedy against deceit and fraud, by being a communicative act, to being an asset-based rationale by the second half of the 19th century—is crucial for understanding the contested origins of what we now call “honest and concurrent use.” Treating HCU as merely a statutory provision overlooks the deeper historical foundations of our modern trademark law.

Fourthly and finally, before we get to understanding the evolution of HCU, it is essential to understand when a use of a mark would be regarded as “honest and concurrent.” Is there a need for actual use of the mark to claim this exception or would a mere prior adoption be sufficient? Indian courts have tried to address these nuances on different instances. An understanding that seems to be common throughout the years is that “honesty of adoption and user is *sine quo non*” for application of Section 12.²⁰ On the yardstick of honesty, courts have held that the use should not be dishonest,²¹ should be bona fide,²² and should not be fraudulent,²³ often at the risk of using these terms interchangeably. On concurrent use, while courts have clarified that concurrent use means simultaneous and contemporary use, they have placed it at a secondary footing by clarifying that in case of a dishonest use, no amount of concurrent use can justify the use of the similar or identical mark.²⁴ And on use itself, it has been interpreted that to claim the benefit of Section 12, the claimant must have *used* the mark, but it has been clarified that

²⁰ Kores (India) Limited v. Khoday Eshwarsa and Son and Anr., MANU/MH/0391/1984 at ¶ 11 (“It is obvious that the honesty in adoption and the user in *sin-qua-non* for considering the applicability of sub-section (3) of section 12 of the Act. The knowledge of the registration of the identical mark may be important factor but is not conclusive on the point of honesty of user. The honesty of user is a commercial honesty and the circumstances which led to the adoption of the trade mark in the first instance are of considerable importance to consider whether the use of the mark is honest or otherwise. If the user from its inception was tainted then it would be difficult to purify it subsequently.”); see also *Mr. Sushil Jindal v. Jindal Electricals and Anr.*, MANU / IC / 0003 / 2008 at ¶ 18 (“... A mere concurrent use is not sufficient for the purpose of Section 12 of the Act but the concurrent use should be honest concurrent use. Honesty of adoption and user is the *sine quo non* for application of Section 12 of the Act. Where the adoption or subsequent user of the mark is proved to be dishonest, no amount of user will help the applicant. The claim for concurrent user implies simultaneous and contemporaneous use. . .”).

²¹ *Intex Technologies (India) Ltd & Anr. v. M/S Az Tech (India) & Another*, MANU/DE/0625/2017.

²² *Ansul Industries v. Shiva Tobacco Company*, (2007), ILR 1Delhi409.

²³ *Id.*

²⁴ *Ansul Industries v. Shiva Tobacco Company*, (2007), ILR 1Delhi409; *The Timken Company v. Timken Services Private Ltd.*, MANU/DE/1628/2013; *Suzuki Motor v Suzuki (India) Limited*, MANU/DE/2288/2019.

adoption also plays a supporting role and should not be regarded as immaterial.²⁵

We understand that these varying yardsticks might seem confusing²⁶ and thus would prescribe for understanding the Bombay High Court's listing of the following factors in *Kores (India) Limited v. Khoday Eshwarsa and Son and Anr.* for determining whether a use would fall under the bracket of HCU or not:²⁷

- (1) The honesty of the concurrent use;
- (2) The quantum of concurrent use shown by the petitioners having regard to the duration, area and volume and trade and to goods concerned;
- (3) the degree of confusion likely to follow from the resemblance of the applicants' mark and the opponents' marks;
- (4) Whether any instance of confusion have in fact been proved, and;
- (5) The relative inconvenience which would be caused to the parties and the amount of inconvenience which would result to the public if the applicants' mark is registered.

In the above case, the Court does take into account not just the moral elements associated with the use and the longevity of the use itself but also the impact such use may have, to make a holistic assessment.

II. LEGISLATIVE EVOLUTION

The origin of HCU is contested. A British judge (Lord Diplock) traced it to the common law, whereas a scholar (Phillip Johnson) presents a strong counterargument by placing it in post-registration property rights in a mark. (More on them below.) Though HCU is undeniably linked to the law of registration of trademarks, which emerged only in 1875 and was explicitly codified by statute in the 20th century, its underlying idea can be found even earlier. As outlined above, we frame HCU as a broader principle underpinning various honest and concurrent uses by trademark owners—a principle rooted in the common law. Without picking sides, in our understanding, both interpretations of HCU are valid. This gives

²⁵ Ved Prakash Malhotra v. M/S. Abhinav Export Corporation, MANU/TN/6696/2023.

²⁶ In addition to the synonymous-seeming conditions, interestingly the court in *Lupin Laboratories v. M/S. Jain Products* has bestowed an extremely heavy burden of proof on the defendant to establish honesty in adopting the similar mark, by holding that the efforts of the defendant to establish honesty “must be such, which will satisfy the conscience of the Court that the user was honest.” *Lupin Laboratories v. M/S. Jain Products*, MANU/MH/0289/1998.

²⁷ *Kores (India) Limited v. Khoday Eshwarsa and Son and Anr.*, MANU/MH/0391/1984 at ¶ 11.

rise to two distinct yet interconnected ideas: first, Honest Concurrent Use, explicitly recognized under Section 12 of the Trade Marks Act of 1999, and second, Honest and Current Use, which surfaces across multiple provisions traditionally seen as valid defenses in trademark law.²⁸

Lord Diplock's remark in a 1972 case on the common-law origins of the principle in two 1860s British cases is oft-cited. In Diplock's words,

A right of property of this character [in a trademark] calls for an accommodation between the conflicting interests of the owner of the monopoly, of the general public as purchasers of goods to which the trade mark is affixed, and of other traders. This accommodation had been substantially worked out by the Court of Chancery by 1875.

The interest of the general public requires that they should not be deceived by the trade mark. It ought not to tell a lie about the goods. Two main kinds of deception had been the subject of consideration. These were misrepresentation (a) of the character of the goods to which the trade mark was attached, and (b) as to their origin, i.e. that they were the product of some other manufacturer.

But the interest of the public in not being deceived about the origin of goods had and has to be accommodated with the vested right of property of traders in trade marks which they have honestly adopted and which by public use have attracted a valuable goodwill. In the early 19th century trade was still largely local; marks which were identical or which closely resembled one another might have been innocently adopted by traders in different localities. In these their respective products were not sold in competition with one another and accordingly no question of deception of the public could then arise. With the rapid improvement in communications, however, in the first half of the 19th century markets expanded; products of two traders who used similar marks upon their goods could thus come to be on sale to the same potential purchasers with the consequent risk of their being misled as to the origin of the goods. Furthermore, it was accepted that as an adjunct of the goodwill of the business the right to use a trade mark might be acquired by more than one successor if the goodwill of the business were divided, as it might be, for instance, where the business had formerly been carried on in partnership or from more than one manufactory or shop. To meet this kind of situation, the

²⁸ We can see instances of both these situations in Indian trademark litigation scene with courts reading HCU as a standalone defense under § 12 and also as a broad defense/principle along with other provisions of the Act. See Part III *infra*.

doctrine of honest concurrent user was evolved. Under this doctrine, a trade mark remained entitled to protection in cases where the use of it had not originally been deceptive but a risk of deception had subsequently arisen as a result of events which did not involve any dishonesty or other wrongful conduct upon the part of the proprietor of the mark. If, however, his own wrongful conduct had played a part in making the use of the mark deceptive, the Court of Chancery would not grant him an injunction against infringement. This was but a particular application of the general equitable doctrine that he who seeks equity must come with clean hands.

In cases of honest concurrent user, neither of the owners of the mark could restrict the other from using it, but as against a usurper who infringed it either owner of the mark could obtain an injunction: *Dent v. Turpin* (1861) 2 J. & H. 139 and *Southorn v. Reynolds* (1865) 12 L.T. 75.²⁹

Lord Diplock traced the origins of HCU to the “common law” trademark or English equity doctrine—a view challenged by Professor Phillip Johnson in his detailed chapter on the topic.³⁰ Highlighting the uncertainty involved in the common law trademark lacking a property interest before the 1860s, Johnson argues that *Dent* and *Southorn* do not establish concurrent common law rights, as such rights become relevant only when a mark gains exclusivity, which was not a norm until then.³¹ Per Johnson, the Court in these cases did not protect an exclusive proprietary right but merely prevented misrepresentation. This way, rather than legitimizing concurrent rights in a single mark (as in HCU), these cases allowed the simultaneous use of two marks where no misrepresentation occurred—an approach applied in pre-registration cases. Johnson rightly notes that the first case, *Dent v. Turpin*, involved two users of a mark—both deriving their rights from a common predecessor—who were independently allowed to seek an injunction against a third party.³² The other case, *Southorn v. Reynolds*, with similar facts involving two persons, sons of a father who had originated the manufacture of such pipes, relied on *Dent* and reached a similar conclusion based on nearly identical facts. However, neither case involved a dispute between “concurrent users” as is generally required in HCU claims. Instead, the action was taken against another party. This makes it difficult to accept the remarks of Lord Diplock.

²⁹ General Electric Co. v. General Electric Co. Ltd., 1 WLR 729 at 742-43 (1972).

³⁰ Phillip Johnson, *The Rise and Fall of Honest Concurrent Use*, in *Trade Mark Law and Sharing Names*, 31-50 (Ilana Simon Fhima, ed., 2009).

³¹ *Id.* at 34.

³² *Dent v. Turpin*, *Tucker v. Turpin*, 70 Eng. Rep. 1003 (1861).

Johnson traced the “real beginnings” of HCU to the “Three Mark Rule,” a “transitional arrangement” created after the Trademark Act of 1875 that required registration but lacked remedies for pre-1875 mark users.³³ The 1875 Act granted exclusive rights to the first registrant, with no provision for prior users—except for joint registration with court approval.³⁴ This strict rule, claimed Johnson, risked injustice where multiple traders had used a mark before August 1875. On top of this, the Act also required registration for infringement claims, triggering a flood of registrations. To mitigate refusals, the 1876 Amendment Act allowed prior users to obtain certificates of refusal, preserving their common law rights. However, it left another question open: “How many traders were allowed on the register before certificates of refusal should be issued for further similar marks.” It was in this context that the registrar, following the Lord Chancellor’s advice, introduced the “Three Mark Rule,”³⁵ as per which no more than three identical marks could be registered. If more traders had been using the mark, additional applicants were refused registration but retained their common law rights.

Notably, while tracing this “real beginning” of HCU, Johnson offered three more reasons why HCU should not be traced to common law. First, passing off, one of the two prevalent causes of action in the pre-registration era, does not recognize HCU as a defense. Instead, it only factors into whether misrepresentation occurred.³⁶ Second, HCU applies only to trademark registration, not as a defense against infringement. Third, when registration was

³³ Johnson, *supra* note 30, at 35-39.

³⁴ Edward Morton Daniel, *The Trade Marks Registration Act, 1875, And The Rules Thereunder; With Introduction, Notes, And Practical Directions As To Registering Trade Marks, Together With The Merchandise Marks Act, 1862, With Notes, And A Copious Index To The Whole* 86 (1876) (Rule 29, Registration of joint owners as separate owners of separate trademarks: “Where diverse persons claim to be severally entitled to the goodwill of a business concerned in the goods with separate trade respect to which a trade mark has been registered, such persons, or any of them, may, if they all consent thereto, and on the production of the proper evidence, and on payment of the prescribed fee, be registered separately as separate proprietors of such trade mark. If all of such persons so entitled do not so consent, the registrar shall not, without leave of the Court, register any of them as separate proprietors of such trade mark.”).

³⁵ Johnson, *supra* note 30 at 36.

³⁶ In passing off cases, the key question is whether the defendant’s use of the mark misleads consumers by misrepresenting the mark. Simply arguing that the defendant also had a right to use the mark (HCU) is irrelevant. Why? Suppose someone starts using a mark dishonestly (e.g., copying another brand). Over time, if the original owner doesn’t take legal action, the public may accept the copied mark as a legitimate. At this point, there is no longer a *misrepresentation*, even though the original act was dishonest. The upshot is that if passing off were based on HCU, the dishonest user could never establish rights. But passing off is about *misrepresentation*—if deception disappears over time, the claim fails. In other words, even if a trademark’s distinctiveness is weakened by dishonest conduct, a passing off claim will only succeed if the original owner acts while the public is still misled. If they wait too long, misrepresentation disappears, and passing off fails.

introduced, separate provisions governed cases where goodwill was split between successors. Thus, *Dent* and *Southorn* would not have been HCU cases but succession cases, placing the doctrine's true origins in the era of trademark registration.

Johnson's argument is nuanced and persuasive—he rightly points out that *Dent* and *Southorn* do not involve “concurrent use” as in HCU. However, limiting HCU to the registration framework downplays a fundamental question that trademark law has grappled with before and after registration: can two people legitimately own and enforce rights over the same or similar marks? And as Johnson agrees, the law has responded to this question affirmatively. While the legal basis has shifted from passing off and fraud to property-based rights, the core issue of honesty or the morality embedded in these questions has remained central. Even before registration, concurrent users retained enforceable rights, either to enjoin third parties or to be recognized as co-owners of the mark. This challenges the view that HCU is purely a statutory construct.

Interestingly, if we examine commentaries from the pre-registration period, cases involving questions of joint use of trademarks on the count of honesty can be found even before the 1860s. For example, Edward Lloyd's 1865 commentary on trademark law suggests that concurrent use—though not in the typical HCU sense—was already recognized as a common defense in infringement cases.³⁷ In the section titled “Grounds of Defence to a Bill for Infringements,” Lloyd discusses two key ways in which defendants could challenge trademark cases involving the question “whether there can be any exclusive property in a name, is illustrated by those cases where the parties against whom an injunction is sought, or some of them, bear the same name with the parties seeking that relief.” First, when the defendant's use of the name appears merely a pretext to mislead the public and divert trade from the plaintiff, the court will intervene to prevent such fraudulent use, even if the defendant has a legitimate claim to the name.³⁸ The second way, directly relevant to this article, is “if the name is already used bonâ fide, there is no such property in a mere name as to entitle the Court to interfere.” For this second way, Lloyd discusses *Dent v. Turpin*—the same 1861 case in which Lord Diplock described the origin of HCU and Johnson contested—to clarify that the exclusive right over a mark was not a sole right but could be exercised by more than one person.

³⁷ Edward Lloyd, *The Law of Trade Marks, with Some Account of Its History and Development In the Decisions of the Courts of Law and Equity*, 59-77 (2d ed., 1865).

³⁸ See, e.g., *Croft v. Day*, 49 Eng. Rep. 994 (Rolls Ct. 1843); *Rodgers v. Nowill*, 67 Eng. Rep. 1191 (1846); *Holloway v. Holloway*, 51 Eng. Rep. 81 (1850).

The Merchandise Marks Act of 1862 shows this statute contained a similarly open-ended, morally charged provision named “Conviction not to affect any Right or Civil Remedy.” This was numbered Section 11, stating that:

The provisions in this act contained of or concerning any act, or any proceeding, judgment, or conviction for any act hereby declared to be a misdemeanor or offence, shall not nor shall any of them take away, diminish, or prejudicially affect any suit, process, proceeding, right, or remedy which any person aggrieved by such act may be entitled to at law, in equity, or otherwise, and shall not nor shall any of them exempt or excuse any person from answering or making discovery upon examination as a witness or upon interrogatories, or otherwise, in any suit or other civil proceeding: Provided always, that no evidence, statement, or discovery which any person shall be compelled to give or make shall be admissible in evidence against such person in support of any indictment for a misdemeanor at common law or otherwise, or of any proceeding under the provisions of this Act.³⁹

After a few failed attempts to implement legislation for nationwide registration in India,⁴⁰ the Indian Merchandise Marks Act of 1889 was enacted. While not precisely codifying HCU as such, it contained a similarly modelled provision under the heading “Unintentional Contravention of the Law relating to Marks and Descriptions.” This provision allowed a person to take defense against infringement “if that he had, at the time of the commission of the alleged offence, no reason to suspect the genuineness of the mark or description.”⁴¹

India’s first Trade Marks Act, enacted in 1940, explicitly incorporated HCU under Section 10(2), limiting its scope to registration, as an exception to the general principle in Section 10(1). It is notable that, unlike the 1999 trademark law, the 1940 Act described HCU under the heading “Prohibition of registration of identical or similar trade mark,” thus framing it as a relative ground of refusal. However, the underlying idea of multiple users coexisting—rooted in common law, as noted by Judge Diplock—

³⁹ The Merchandise Marks Act § 11 (1862), 25 & 26 Vict. C. 88.

⁴⁰ See the three-part series of Aparajita Lath at *SpicyIP* published on February 16, 2021: A. Lath, *The Grand Old Indian Trade Marks Register: Episode 1 (1877- 1881)*, Spicy IP (2021), available at <https://spicyip.com/2021/02/the-grand-old-indian-trade-marks-register-episode-1-1877-1881.html>; A. Lath, *The Grand Old Indian Trade Marks Register: Episode 2 (1881-1920s)*, Spicy IP (2021), available at <https://spicyip.com/2021/02/the-grand-old-indian-trademarks-register-episode-2-1881-1920s.html>; A. Lath, *The Grand Old Indian Trademarks Register: Episode 3 (1920-1940)*, Spicy IP (2021), available at <https://spicyip.com/2021/02/the-grand-old-indian-trademarks-register-episode-3-1920-1940.html> (last visited Sept. 8, 2025).

⁴¹ Indian Merchandise Marks Act § 8(c) (1889).

extended beyond this singular provision. Other sections, such as Section 25 (Saving for vested rights)⁴² and Section 26 (Saving for use of name, address, or description of goods),⁴³ reinforced this principle by allowing multiple users under certain conditions.

This dual HCU framework continued in the Trade and Merchandise Marks Act of 1958, which introduced Section 12(3) with explicit HCU wording and HCU-based defensive principles in Sections 32, 33, and 34. With modifications, the Trademark Act of 1999 kept the explicit HCU under Section 12 and other HCU-based defenses under Sections 34 and 35. Notably, although parallel, respective HCU provisions—Section 10(2) of the 1940 Act, Section 12(3) of the 1958 Act, and Section 12 of the 1999 Act—along with other HCU-based provisions like Sections 25 and 26 of the 1940 Act, Sections 32, 33, 34 of the 1958 Act, and Sections 34 and 35 of the 1999 Act, were not equivalent. While each had distinct nuances, and the relevant act today is the 1999 Act, this discussion is beyond this article’s ambit and does not impact the historical claim in this section. The judicial engagement with these acts and provisions is undertaken in the next section.

In sum, while the phrase “honest concurrent use” has been mentioned in a single provision since 1940, its core principle—recognizing honest and concurrent use—has permeated multiple provisions in Indian trademark law. This point was well captured in the 1955 Report on Trademark Law Revision:

It is of vital importance to health, commerce and trade, that trade marks should be effectively protected and unfair and improper trade practices should be suppressed, but, on the other hand, it is also of equal importance that fair and

⁴² See The Trade Marks Act § 25 (1940), which provides:

“Saving for vested rights. Nothing in this Act shall entitle the proprietor of a registered user of a registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date prior

(a) to the use of the first-mentioned trade mark in relation to those goods by the proprietor or a predecessor in title of his, or

(b) to the registration of the first-mentioned trade mark in respect of those goods in the name of the proprietor or a predecessor in title of his,

whichever is the earlier, or to object (on such use being proved) to registration of that identical or nearly resembling trade mark in respect of those goods under sub-section (2) of Section 10.”

⁴³ See The Trade Marks Act § 26 (1940), which provides:

“No registration of a trade mark shall interfere with any *bona fide* use by a person of his own name or that of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business, or the use by any person of any *bona fide* description of the character or quality of his goods, not being a description that would be likely to be taken as importing any such reference as is mentioned in clause (b) of section 21 or in clause (b) of section 57.”

legitimate competition should not be unduly interfered with. The law of Trade Marks should therefore keep these twin aims in view and while protecting trade marks and the rights of a registered proprietor by suppressing unfair competition in its myriad forms, must also see that the honest trader who has no fraudulent intent is not handicapped in conducting his business. The law must have regard also to the interest of the general public.⁴⁴

While history suggests that HCU holds the potential to be more than just a statutory provision, have Indian courts recognized it as such? Next, we examine how Indian courts have engaged with and interpreted HCU, tracing its judicial evolution, if any.

III. JUDICIAL EVOLUTION OR JUDICIAL CONVOLUTION?

HCU's judicial journey appears less like an evolution and more like a tangled convolution. Indian courts, with their interpretative enigma, have engaged with HCU in at least four ways when confronted with infringement claims: (1) Those cases where it is read alongside acquiescence. These are cases where the courts have treated HCU dismissively while focusing on the defense of acquiescence, undermining its potential as a substantive defense. (2) Those cases where its applicability as a defense is dismissed outright.⁴⁵ Here, courts have refused to read HCU as a defense in infringement cases, restricting it to instances concerning only the registration of a mark. (3) Those cases where it is treated as a standalone defense stemming from Section 12. And finally, (4) those cases where it's treated as a broad principle underlying different provisions in the Trade Marks Act. This category includes cases where the courts have refused to read the HCU in silos, as merely a part of Section 12, but as a broad principle whose presence can be felt across different provisions in the Trade Marks Act.

While the present language of Section 12 allows the Registrar to register a trademark that might be similar or identical to an existing registered or unregistered mark, this was not always the case. As underscored in the above paragraphs, before the 1999 Act,

⁴⁴ Report of Shri Justice N. Rajagopala Ayyangar on Trade Marks Law Revision, at 3, ¶ 11 (1955), available at https://spicyip.com/wp-content/uploads/2015/02/Ayyangar_Committee_Report_Trademarks_2015.pdf (last visited Sept. 8, 2025).

⁴⁵ Although we saw cases where the court refused to accept that the defendant's use was honest or concurrent (*see, e.g.*, *M/S Inder Industries v. M/S Gemco Electrical Industries*, MANU/DE/2852/2012; *M/S Radico Khaitan Limited v. M/S Brima Sagar Maharashtra Distillaries*, MANU/DE/3230/2014; *The Timken Company v. Timken Services Private Ltd.*, MANU/DE/1628/2013; *Suzuki Motor vs Suzuki (India) Limited*, MANU/DE/2288/2019), there were only a couple of cases where the court has refused HCU as a defense outright. For consistency, instead of a separate section for such cases, we have discussed them in the course of the wider discussion in the relevant parts.

under the 1958 and 1940 Acts, HCU was an exception mentioned in the provision containing the relative ground of refusal. This made it susceptible to being applied only against registered trademarks. However, what about protection against unregistered marks?⁴⁶ This issue was resolved by the Supreme Court in *London Rubber v. Durex Products* (1963).⁴⁷

This appeal arose from the decision to deny registration to Durex Products for the mark DUREX for contraceptives based on London Rubber's opposition. The Supreme Court interpreted the HCU under Section 10(2) as a broad exception applicable to both registered and unregistered trademarks, because otherwise, an unregistered mark would receive a higher degree of protection compared with a registered mark. as HCU would be available only against registered marks. Another crucial clarification by the Supreme Court was that the use of the mark under HCU need not be large and substantial; rather, it merely needs to be commercial in nature. On this, the Court opined that the objective of HCU is to protect both the public against any confusion and small trademark proprietors.⁴⁸

London Rubber is one of the most cited decisions on HCU and was instrumental in adopting an expansive reading of the provision

⁴⁶ See, e.g., Trade Marks Act § 10 (1940), which provides:

Prohibition of registration of identical or similar trade mark—

(1) Save as provided in sub-section (2), no trade mark shall be registered in respect of any goods or description of goods which is identical with a trade mark belonging to a different proprietor and already on the register in respect of the same goods or description goods, or which so nearly resemble such trade mark as to be likely to deceive or cause confusion.

(2) In case of honest concurrent use or of other special circumstances which, in the opinion of the Registrar, make it proper so to do he may permit the registration by more than one proprietor of trade marks which are identical or nearly resemble each other in respect of the same goods or description of goods, subject to such conditions and limitations, if any, as the Registrar may think fit to impose.

See also Trade and Merchandise Marks Act § 12 (1958), which provides:

Prohibition of registration of identical or deceptively similar trade marks—

(1) Save as provided in sub-section (3), no trade mark shall be registered in respect of any goods or description of goods which is identical with or deceptively similar to a trade mark which is already registered in the name of a different proprietor in respect of the same goods or description of goods.

(3) In case of honest concurrent use or of other special circumstances which, in the opinion of the Registrar, make it proper so to do, he may permit the registration by more than one proprietor of trade marks which are identical or nearly resemble each other (whether any such trade mark is already registered or not) in respect of the same goods or description of goods, subject to such conditions and limitations, if any, as the Registrar may think fit to impose.

⁴⁷ AIR 1963 SC 1882.

⁴⁸ Ghosh, *supra* note 8, at 253.

in the context of registration of a mark. The contribution of this decision is clear from the phrase “(whether any such trade mark is already registered or not)” in Section 12,⁴⁹ which is similar to the Court’s reading above. However, the interpretation of HCU in trademark infringement and passing-off disputes hasn’t always met with such a broad interpretation.

A. The Interplay Between Acquiescence and HCU

Contrasting the above finding with the most recent adoption of this interpretation is the Bombay High Court decision in *Abdul Virjee v. Regal Footwear*.⁵⁰ In this case, the plaintiffs asserted that they had used REGAL/ REGAL FOOTWEAR/ REGAL SHOES marks since 1954, whereas the defendants had used the REGAL/ REGAL FOOTWEAR marks since 1963. The defendant claimed the defense of acquiescence on the part of the plaintiff and that its use was protected under HCU. Siding with the plaintiff, the Court held that the 1999 Act’s reading of the HCU is “only in a limited context as permitting the Registrar of Trade Mark to register trade mark which is identical/similar to an existing registered trade mark and for identical/similar goods.”⁵¹ Therefore, the Court seemed to imply that HCU is only relevant at the trademark prosecution stage and not independently as a defense in the infringement proceedings,⁵² if the impugned mark is not registered.

Interestingly, for this understanding, the Court relied primarily on a 1989 case of the Delhi High Court, namely *Hindustan Pencils v. India Stationary Products*,⁵³ to reiterate that it is a well-settled

⁴⁹ See Trade Marks Act § 12 (1999) (emphasis added).

⁵⁰ MANU/MH/0001/2023.

⁵¹ *Id.* at ¶ 110.


⁵² This understanding is also reflected from the Delhi High Court’s decision in *M/S Radico Khaitan Limited v. M/S Brima Sagar Maharashtra Distilleries*, MANU/DE/3230/2014, where the Court accepted that while HCU may be a defense for the principle of “one mark one proprietor” (i.e., identical marks can be registered under different proprietors), it cannot be a defense in trademark infringement cases. In *Manmohan Garg v. Radha Krishnan Narayan Das Firm (1991)*, 1993 MPLJ 909, the defense of HCU was raised under Section 30(1)(d) of the Trade and Merchandise Marks Act of 1958, which states that use of a trademark will not be an infringement when “the use of a registered trademark, being one of two or more trademarks registered under this Act which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration under this Act” and not as Section 12(3). Although the Court rejected the defendant’s plea owing to its dishonest adoption of the mark, it acknowledged that Section 30(1)(d) “is meant to protect an honest concurrent user only, that use must be bona fide and lawful exercise of existing legal right.” The Court did not analyze the defense further; however, its assertion on lawful exercise of legal rights perhaps can be interpreted to mean that registration of the impugned mark is *sine qua non* for claiming the defense of HCU and thus Section 12(3) cannot be claimed as a defense on a standalone basis.

⁵³ 1990 AIR (Del.) 19.

principle that HCU will not act as a shield against the Court's power to grant an injunction and cannot be "press ganged" as a defense to trademark infringement.⁵⁴ This approach has also been adopted in other cases such as *Cadila v. Sami Khatib*,⁵⁵ *Winthrop v. Eupharma*,⁵⁶ and *Kirloskar Diesel v. Kirloskar Proprietary*.⁵⁷

Herein lies a hitch, however. The *Hindustan Pencils* case should not be read to support such an understanding. Courts citing *Hindustan Pencils* often overlook a crucial nuance in interpreting the decision: the *Hindustan Pencils* case primarily addresses acquiescence,⁵⁸ with the observations on HCU being made in passing. This is because, historically, the defense of acquiescence has been read along with HCU, with the fulcrum of the defendant's justification for using an allegedly similar mark resting on the former.

1. *Hindustan Pencils* and Pre-1958 Cases on HCU and Acquiescence

*Hindustan Pencils*⁵⁹ involved a dispute over the defendant's use of a word mark and device identical to the plaintiff's NATRAJ word mark and  (Dancing Natraj) device mark. Interestingly, the defendants didn't oppose the allegation of infringement and based its defense on delay and laches on the part of the plaintiff to file the suit. Also, the defendants did not raise the defense of HCU, which was brought in by the Court itself while interpreting the *J. R.*

⁵⁴ MANU/MH/0001/2023, ¶ 110.

⁵⁵ *Cadila Pharmaceuticals Limited v. Sami Khatib*, MANU/MH/0497/2011.

⁵⁶ *Winthrop Products Inc. v. Eupharma Laboratories Ltd.*, MANU/MH/0094/1997.

⁵⁷ *Kirloskar Diesel Recon Pvt. Ltd. and Ors. v. Kirloskar Proprietary Ltd. and Ors.*, MANU/MH/0033/1996.

⁵⁸ As explained by the Supreme Court in *Power Control Appliances v. Sumeet Machines Pvt. Ltd.*, (1994) 2 SCC 448, acquiescence is more than mere delay in filing a suit; rather it involves tacit or express positive act on part of the plaintiff toward the defendant's use of its mark:

Acquiescence is sitting by, when another is invading the rights and spending money on it. It is a course of conduct inconsistent with the claim for exclusive rights in a trade mark, trade name etc. It implies positive acts; not merely silence or inaction such as is involved in laches. In *Harcourt v. White*[.] Sr. John Romilly said: "It is important to distinguish mere negligence and acquiescence." Therefore, acquiescence is one facet of delay. If the plaintiff stood by knowingly and let the defendants build up an important trade until it had become necessary to crush it, then the plaintiffs would be stopped by their acquiescence. If the acquiescence in the infringement amounts to consent, it will be a complete defence as was laid down in *Mouson (J. G.) & Co. v. Boehm*. The acquiescence must be such as to lead to the inference of a licence sufficient to create a new right in the defendant as was laid down in *Rodgers v. Nowill*.

Id. at ¶ 26 (internal footnotes omitted).

⁵⁹ *M/S. Hindustan Pencils Pvt. Ltd. vs M/S. India Stationery Products Co.*, AIR 1990 Del. 19.

*Parkington and Co. Ltd.*⁶⁰ decision by J. Romer on the factor of “honesty” while adopting a similar mark.⁶¹ In doing so, the Court opined that where there is an honest concurrent use, the inordinate delay may defeat a claim of damages.⁶² However, considering the general public’s interest, an injunction should not be refused.⁶³ That means in case of inordinate delays, the Court can issue an injunction if it concludes that the public might be misled into buying goods manufactured by the defendant, thinking them to be those of the plaintiff. However, things were held to be different in the case of acquiescence, where the plaintiff gives tacit or express permission to use the impugned mark to the defendant. Relevant here is the remark by the Court:

In such a case **the infringe[r] acts upon an honest mistaken belief that he is not infringing the trade mark of the plaintiff and if, after a period of time when the infringe[r] has established the business, reputation, the plaintiff turns around and brings an action for injunction, the defendant would be entitled to raise the defence of acquiescence.** Acquiescence may be a good defence even to the grant of a permanent injunction because the **defendant may legitimately contend that the encouragement of the plaintiff to the defendant’s use of the mark in effect amounted to the abandonment by the plaintiff of his right in favour of the defendant and, over a period of time, the general public has accepted the goods of the defendant resulting in increase of its sale.**⁶⁴

On a quick read, it may seem like the Court’s rationale associating acquiescence with HCU is misplaced, since the defense of HCU was neither raised by the defendant nor was it countered by the plaintiff. The dispute concerned the issue of delay in filing the civil suit, and thus, passing the above comments without any argument or any judicial backing might make this susceptible to being labeled as *obiter dicta* and not as a rationale. The High Court thrust the justification for allowing a defense of acquiescence, tied up with HCU, on the defendant’s belief that over the period, the general public would start to associate the impugned mark with them.⁶⁵

⁶⁰ (1946) 63 RPC 171.

⁶¹ AIR 1990 Del. 19, ¶ 31.

⁶² *Id.*, ¶ 38.

⁶³ *Id.*, ¶ 32.

⁶⁴ *Id.*, ¶ 33 (emphasis added).

⁶⁵ Interestingly, the element of time or duration of using a mark to claim exception of honest and concurrent use was also discussed by the Supreme Court’s decision in *London Rubber Co. Ltd v. Durex Products*, wherein the Court gave a broad guideline stating

However, the Court's understanding behind reading acquiescence along with HCU in *Hindustan Pencils* might stem from the fact that prior to the 1958 Act, acquiescence was not an express provision under the Indian trademark law. Therefore, courts have historically often read acquiescence within the ambit of "special circumstances," which was a part of the provision concerning HCU.⁶⁶

This can be observed from *Amritdhara Pharmacy v. Satyadeo Gupta*.⁶⁷ Although the judgment was passed in 1962, it stems from a trademark opposition case from the 1950s and thus was adjudged under the 1940 Act. The trademark applicant (respondent in this case) argued that it had been using its LAKSHMANDHARA mark since 1923, and by 1946, it had generated considerable goodwill, as evidenced by its revenue. However, its registration was objected to by the appellant, who argued that the mark is similar to their AMRITDHARA mark. The Trademark Registrar held that the appellant knew about the impugned mark, and yet it waited for close to twenty-five years before opposing the mark after it was published in the *Trade Marks Journal*. The Court agreed with the Registrar's finding and held that the appellant's inaction could amount to acquiescence and be read as a part of "special circumstances" under Section 10(2).

Even before the 1940 Act, the courts had read HCU and acquiescence together. For example, in *Moolji Sicca & Co. v. Ramjan Ali*,⁶⁸ a dispute concerning similar labels on *biris*,⁶⁹ the defendant asserted the defense of acquiescence. The plaintiff argued that when it learned about the defendant's use of the impugned label, it sent a letter objecting to such use. Ruling in favor of the plaintiff, the Calcutta High Court relied on the understanding of Lord Justice Cotton in *Proctor v. Bennis*:⁷⁰

It is necessary that the person who alleges this laying by should have been acting in ignorance of the title of the other man [thus should be using the impugned mark honestly without the knowledge of the original mark], and that the

that commercial use of the mark for a considerable period should be the only factor taken into account by the Court while considering the honest and concurrent use defense. See *London Rubber v. Durex Products*, AIR 1963 SC 1882. See also Ghosh, *supra* note 8 at 253.

⁶⁶ The words "special circumstances" have been a part of the HCU defense under Section 10(2) the Trademark Act of 1940, and under Section 12(3) Trade and Merchandise Marks Act, 1958. See also Meenu Paul, "Acquiescence" of Proprietor of a Trade Mark in the Use of His Trade Mark by the Other: "Meaning" and "Consequence" Under the Trade Marks Law in India, 3(1) NALSAR L. Rev. 20, 21 (2006).

⁶⁷ AIR 1963 SC 449.

⁶⁸ AIR 1930 (Cal.) 678.

⁶⁹ A particular kind of cigarette native to India and other South Asian countries.

⁷⁰ 4 RPC 333.

other man should have known that ignorance and not mentioned his own title [acquiescence].⁷¹

Similarly, in *Devi Dass and Co. Banglore v. Althur Abboyye Chetty* (1940),⁷² the Madras High Court interpreted that for a defendant to claim acquiescence, “it must be shown that the plaintiff has stood by for substantial period and thus encouraged the defendant to expend money in building up a business associated with the mark.”⁷³ When compared to the finding of *Hindustan Pencils*, one can see that in both cases, the courts have held that the plaintiff’s inaction (despite being aware of the defendant’s mark) must result in concurrent use by the defendant.

Later, when the Trade and Merchandise Marks Act of 1958 replaced the 1940 Act, dedicated provisions for HCU and acquiescence came in. While HCU was a part of Section 12(3) of the 1958 Act, acquiescence was provided for under Section 30(1)(b),⁷⁴ without expressly using the latter term. Regardless of this categorization, we could find the courts interpreting HCU and acquiescence in the same breath.

2. Post-1958 Interpretation on Acquiescence: *Sumeet Machines Pvt. Ltd.*

After 1958, the oft-cited *Hindustan Pencils* and other cases faithfully relied on an interpretation of the HCU limitations vis-a-vis acquiescence.⁷⁵ However, the decision that has had the most

⁷¹ *Id.* at 357.

⁷² AIR 1941 (Madras) 31.

⁷³ *Id.* at ¶ 7.

⁷⁴ Section 30(1)(b) Trade and Merchandise Marks Act (1958) states:

Acts not constituting infringement.

(1) Notwithstanding anything contained in this Act, the following acts do not constitute an infringement of the right to the use of a registered trade mark:

(b) the use by a person of a trade mark in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark if, as to those goods or a bulk of which they form part, the registered proprietor or the registered user conforming to the permitted use has applied the trade mark and has not subsequently removed or obliterated it, or has at any time expressly or impliedly consented to the use of the trade mark.

⁷⁵ *Cadila Pharmaceuticals Limited v. Sami Khatib*, MANU/MH/0497/2011; *Winthrop Products Inc. v. Eupharma Laboratories Ltd.*, MANU/MH/0094/1997; *Kirloskar Diesel Recon Pvt. Ltd. and Ors. v. Kirloskar Proprietary Ltd. and Ors.*, MANU/MH/0033/1996; *Ansul Industries v. Shiva Tobacco Company* (2007), ILR 1Delhi409. A few years after the Delhi High Court’s decision in the *Hindustan Pencils* Case, the Court passed the decision in *Apple Computer Inc. v. Apple Leasing & Industries* (1991), MANU/DE/0919/1991, where it gave out a separate yardstick to consider the dynamics between acquiescence and HCU. The Court held that if the delay in filing the suit impacts the defendant’s defense of HCU, then such a delay can be used as a defense by the defendant. *See also* Ghosh, *supra* note 8, at 239.

resounding impact on this interplay was issued by the Supreme Court in *Power Control Appliances v. Sumeet Machines Pvt. Ltd.*⁷⁶

Sumeet Machines resolved two limitations that were left unresolved by the cases before it: first, whether the accepted principles of delays can be extended to the claims of acquiescence, and second—which is relevant for this article—whether injunctive reliefs can be opposed by a “composite defence of delay, acquiescence, and concurrent use.”⁷⁷ In the Court’s words:

41. . . there can be only one mark, one source and one proprietor. It cannot have two origins. Where, therefore, the first defendant-respondent has proclaimed himself as a rival of the plaintiffs and as joint owner it is impermissible in law. Even then the joint proprietors must use the trade mark jointly for the benefit of all. It cannot be used in rivalry and in competition with each other.⁷⁸

The Court also observed that “. . . plea of honest and concurrent user as stated in Section 12(3) of 1958 Act for securing the concurrent registration is not a valid defence for the infringement of copyright.”⁷⁹

However, the courts that rely on this case fail to consider that these observations cannot be viewed as a general principle governing HCU. Instead, they must be read in the context of the facts of the case, because these observations were, to say the least, highly fact-specific. The judgment concerned three suits consequent to tumultuous family dynamics. The suits alleged infringement of the plaintiffs’ copyright, SUMEET trademark, and design, respectively, all related to the common products: mixers. The defendant was an enterprise started by the plaintiff’s proprietor’s son. The defendant initially marketed the plaintiff’s SUMEET products and then started using the same trademark for its competing products.

The Madras High Court refused to pass an interim injunction order because of the plaintiff’s acquiescence to the defendant’s HCU. The High Court relied on the defendant’s explanation that the plaintiff’s proprietor was aware of the defendant’s use of the mark and had signed different warranties and guaranties to banks and other regulators, allowing the defendant to use the SUMEET mark for marketing the products. The Court also deferred to the fact that the defendant’s proprietor was also a director in the plaintiff’s company. The Supreme Court took a different view, passing the above-quoted observation. Indeed, the Supreme Court called out the

⁷⁶ (1994) 2 SCC 448.

⁷⁷ Ghosh, *supra* note 8, at 239.

⁷⁸ (1994) 2 SCC 448, ¶ 41.

⁷⁹ *Id.*, ¶ 42.

High Court for weighing the approvals given to the son and how the family business of the plaintiff is run, and reminded the High Court that both the defendant and its proprietor were different entities.⁸⁰ Therefore, the observation of “one mark one proprietor” cannot be read as a blanket bar on the application of the HCU defense and is to be read as a finding on joint ownership instead.⁸¹

The subsequent observation on the HCU is also problematic because the Court completely ignored the fact that there were separate suits concerning trademarks and designs in this dispute. So, while the defense of HCU may not apply to copyright infringement, the case also had an allegation of trademark infringement to which the defense could have been applied. Therefore, seemingly, the Court emphasized the defense of acquiescence, and once that was dismissed, it didn’t take the defense of HCU seriously.

B. Reading HCU as a Standalone Defense

Returning to square one, we can see that courts have rejected the application of HCU as a defense in infringement or passing-off cases where it has been used alongside acquiescence and often has been treated as an inferior defense. On the flip side, this also means that the interpretation in *Hindustan Pencils* or *Power Control Appliances* should not be read to mean a blanket ban on using HCU as a defense in those cases where the defendant has solely relied on it. This is because, as seen above, the courts have not thoroughly assessed the provision.

This brings us (back) to the decision in *KEI Industries v. Raman Kwatra and Anr. (KEI-1)* by a single-judge bench of the Delhi High Court wherein the Court interpreted that HCU cannot be used as a defense in infringement proceedings, relying on *Sumeet Machines*.⁸² In *KEI-I*, while it seems like the defense of acquiescence was raised by the defendant, the same was neither argued before the Court by the parties nor assessed by the Court separately. As mentioned in the introduction, this understanding was overruled by a Division Bench of the Delhi High Court in *Raman Kwatra v. KEI Industries*.⁸³ Much like *KEI-1*, acquiescence was not discussed by the division bench. However, as said above, the Court did not venture deep into its opinion of HCU and only restricted it to a prima facie finding.⁸⁴

⁸⁰ *Id.*, ¶ 43.

⁸¹ However, it is pertinent to note that the Madras High Court did not use the term “Joint Ownership” and instead referred to the defendants as “joint collaborators.”

⁸² Para. 46 at pg. 24, 2022 SCC OnLine Del 1459 (citing *Power Control v. Sumeet Machines* (1994)), 2 SCC 448.

⁸³ Para. 49, MANU/DE/0066/2023.

⁸⁴ *Id.*

This lack of clarity on the interpretation of HCU as a standalone defense allows us to pivot away from the decisions stemming from the *Abdul Virjee*, *Hindustan Pencils*, and *Sumeet Machines* line of judgments.

The Delhi High Court decision in *Jain Rubber Industries v. Crown (P.) Ltd.*⁸⁵ is one of the foremost cases that was an exception to this norm of reading HCU and acquiescence together. In this case, the Court denied the plaintiff an interim injunction against the defendant's use of the CROWN trademark.⁸⁶ Although there were parallel trademark prosecution proceedings concerning the registration of the defendant's mark⁸⁷ and revocation of the plaintiff's mark, the Court focused on the defendant's submissions that it was the honest prior and concurrent user of the mark to deny the interim relief to the plaintiff. For this, the Court relied on Section 12(3) of the Trade and Merchandise Marks Act of 1958, and read the defense of HCU to stem from there.⁸⁸

Another case where the standalone defense of HCU protected the defendant from being enjoined is the Bombay High Court's decision in *Datamatics Global Services Limited v. Royal Datamatics Private Limited*.⁸⁹ Here, the dispute was over the defendant's use of DATAMATICS. The Court first held that the term was descriptive and generic, and the plaintiff could not seek protection over it.⁹⁰ Regardless, the Court also assessed the HCU defense raised by the defendant and held that the defendant had been honestly using the mark for nineteen years and has been providing services to reputed information technology brands, which would save it from infringement proceedings.⁹¹

⁸⁵ MANU/DE/0237/1988.

⁸⁶ *Id.*, para. 7.

⁸⁷ The Delhi High Court, in *Metro Playing Cards v. Wazir Chand Kapoor (1971)*, AIR 1972 (Del.) 248, had clarified that until the time an HCU-claiming user gets a registration for its mark, a proprietor of similar trademark can file a trademark infringement suit against it. *Id.*, para. 13. Thus, merely filing a trademark application will not save such subsequent user from an infringement suit. This view was echoed in *M/S. Hitachi Ltd. v. Ajay Kumar Agarwal*, para. 21, (1996) ILR 1 (Del.) 359, and is contradictory to the Karnataka High Court's decision in *D. Adinarayana Setty v. Brooke Bond Tea of India Ltd.* (1959), AIR 1960 (Kant.) 142, where the Court opined that the defendant should seek a stay on the infringement hearing while the Registrar decides on its MANU/MH/0410/2011 application. The latter is a more traditional approach toward HCU, akin to the Bombay High Court's decision in *Abdul v. Regal*, MANU/MH/0001/2023, where the Court held that Section 12 concerns only the Trademark Registry.

⁸⁸ *Jain Rubber*, MANU/DE/0237/1988, ¶ 5.

⁸⁹ MANU/MH/0410/2016.

⁹⁰ *Id.*, ¶¶ 7-8.

⁹¹ *Id.*, ¶ 9.

*C. The Embodiment of HCU in Different Provisions
Across the Trade Marks Act*

Diving a little deeper into different instances involving HCU as a defense, we can see that apart from the above cases, Indian courts have also read HCU as a broader principle, not only limited to acquiescence cases but underpinning other provisions of the Trade Mark Act of 1999.⁹²

Relevant here is *Löwenbräu AG and Anr. v. Jagpin Breweries and Anr.*⁹³ In this case, both parties were based in Germany and wanted to expand their business in India. The plaintiff, proprietor of the LÖWENBRÄU marks, sought an injunction against the defendant's use of a deceptively similar mark. In contrast, the defendants sought to vacate a previously granted ex parte order. The defendants argued that the mark LÖWENBRÄU has been used extensively by many breweries in Germany, that the defendants have been using the mark since 1999 in India, and one of the defendants has been recognized as a prior user in Germany. Considering the facts of the case, the Court held that it cannot ignore the usage of the mark in countries abroad.⁹⁴ In the defense against the allegation of infringement, the Court adopted a broad approach and read HCU not only as a subset of a single provision but as a principle that could be traced across different provisions of the Trade Marks Act.⁹⁵

The Court held that:

Concurrent and honest user was a valid defence against an action for infringement under the Trade Mark and Merchandise Marks Act, 1958. Legal rights of a third party to use a mark without causing infringement of a mark registered under the said 1958 Act, is protected under Section 159(5) of the Act. Defendants will be entitled to benefit and defend this action relying upon honest and concurrent use. Even otherwise Sections 9(1), 30(1) and (2) and 35 of the Act do recognise honest concurrent use and on the conditions mentioned therein being satisfied, defend a suit for infringement. Honest and concurrent user is always recognised as a defence to action alleging infringement.⁹⁶

⁹² This argument has also been made by some leading trademark scholars like Eashan Ghosh. See Ghosh, *supra* note 8, at 256-273.

⁹³ MANU/DE/0022/2009.

⁹⁴ *Id.*, ¶ 27.

⁹⁵ *Id.*, ¶ 29.

⁹⁶ *Id.*

What the Court meant to insinuate here is that HCU was protected under the 1958 Act and as per Section 159(5)⁹⁷ of the Trade Marks Act, 1999, when a particular use of a registered mark that is not infringing any mark before the commencement of the Act, then the continued use of that mark will not be an infringement. Thus, the Court carried forward that defense from the 1958 Act. Among the other provisions cited by the Court, references to Sections 30 and 35 are particularly interesting. This is because, under Sections 30(1), 30(2),⁹⁸ and

⁹⁷ Trade Marks Act § 159(5) (1999) (“Notwithstanding anything contained in this Act, where a particular use of a registered trade mark is not an infringement of a trade mark registered before the commencement of this Act, then, the continued use of that mark shall not be an infringement under this Act.”).

⁹⁸ *Id.* § 30. This section states:

Limits on effect of registered trade mark.—

(1) Nothing in section 29 shall be construed as preventing the use of a registered trade mark by any person for the purposes of identifying goods or services as those of the proprietor provided the use—

- (a) is in accordance with honest practices in industrial or commercial matters, and
- (b) is not such as to take unfair advantage of or be detrimental to the distinctive character or repute of the trade mark.

(2) A registered trade mark is not infringed where—

- (a) the use in relation to goods or services indicates the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services or other characteristics of goods or services;
- (b) a trade mark is registered subject to any conditions or limitations, the use of the trade mark in any manner in relation to goods to be sold or otherwise traded in, in any place, or in relation to goods to be exported to any market or in relation to services for use or available for acceptance in any place or country outside India or in any other circumstances, to which, having regard to those conditions or limitations, the registration does not extend;
- (c) the use by a person of a trade mark—
 - (i) in relation to goods connected in the course of trade with the proprietor or a registered user of the trade mark if, as to those goods or a bulk of which they form part, the registered proprietor or the registered user conforming to the permitted use has applied the trade mark and has not subsequently removed or obliterated it, or has at any time expressly or impliedly consented to the use of the trade mark; or
 - (ii) in relation to services to which the proprietor of such mark or of a registered user conforming to the permitted use has applied the mark, where the purpose and effect of the use of the mark is to indicate, in accordance with the fact, that those services have been performed by the proprietor or a registered user of the mark;

(d) the use of a trade mark by a person in relation to goods adapted to form part of, or to be accessory to, other goods or services in relation to which the trade mark has been used without infringement of the right given by registration under this Act or might for the time being be so used, if the use of the trade mark is reasonably necessary in order to indicate that the goods or services are so adapted, and neither the purpose nor the effect of the use

35,⁹⁹ a use of a similar trademark can be exempted if such use is honest in accordance with industrial and commercial practices and can be used in relation to goods or services indicating quality or geographical origin. In the present case, it was argued that the mark LÖWENBRAU denotes the country of origin.¹⁰⁰ Interestingly, the Court did not refer to Section 12 of the Act, which allows honest and concurrent users to register a similar mark. While the Court does not specify this principle, in our opinion, the Court interpreted Section 12 to be applicable only on registration issues but nonetheless accepted that the principle of HCU is present in other provisions across the statute.

The reference to Section 12 was made by a Division Bench of the Delhi High Court in *Goenka Institute of Education v. Anjani Kumar Goenka & Anr.*¹⁰¹ The dispute here concerned the appellant's adoption of "Goenka" in their trademarks for their educational institution. Deciding an appeal against the order of a single judge, the Court relied on Section 12. It divided its application into three aspects: assessment of honesty, assessment of concurrent use, and imposition of any conditions and limitations.¹⁰² On the first two legs, the Court held that the appellant's use of the mark was honest owing to a trust deed bearing the name "GOENKA" and also considered that "Goenka" was the surname of the trustees. Under the Trade Marks Act, Section 35, inter alia, allows bona fide use of one's name (in this case, surname) in relation to their goods or services.

After applying this exception, the Court, to avoid any confusion in the general public, passed certain directions to include certain disclaimers, mentioning the name of the trust wherever the name of their institution is used. The latter direction resonates with the sentiments expressed by the Gujarat High Court in *Good Life*

of the trade mark is to indicate, otherwise than in accordance with the fact, a connection in the course of trade between any person and the goods or services, as the case may be;

(e) the use of a registered trade mark, being one of two or more trade marks registered under this Act which are identical or nearly resemble each other, in exercise of the right to the use of that trade mark given by registration under this Act.

⁹⁹ *Id.* § 35 ("Saving for use of name, address or description of goods or services.—Nothing in this Act shall entitle the proprietor or a registered user of a registered trade mark to interfere with any bona fide use by a person of his own name or that of his place of business, or of the name, or of the name of the place of business, of any of his predecessors in business, or the use by any person of any bona fide description of the character or quality of his goods or services.").

¹⁰⁰ *Löwenbrau AG and Anr. v. Jaggin Breweries and Anr.*, MANU/DE/0022/2009, ¶ 30.

¹⁰¹ MANU/DE/2229/2009. This decision was also relied on by the Delhi High Court in *Cadila Healthcare Ltd. v. Diat Foods*, MANU/DE/2546/2010, ¶ 18, to hold that the Court can, akin to the powers of the Trademark Registrar under Section 12, give directions for the use of the marks in order to ensure that no confusion occurs.

¹⁰² *Id.*, ¶ 12.

Industries v. J R J Foods Pvt. Ltd., where the Court held that “the necessity for invoking Section 12 would arise only when the similarity between the two marks is such as is likely to cause confusion in the public including likelihood of association with other marks.”¹⁰³

The *Goenka* decision was important not only because the Court interpreted HCU under Section 12 as a defense, but also because it tied it up with another exception under Section 35, allowing the use of one’s surname.

In sum, given these disparate readings of HCU, the recent judicial dismissals of HCU as a defense are unfounded. Instead, HCU is a broad principle embedded across multiple provisions of the Trade Mark Act. This is evident not only in the 1999 Act but also in its predecessor statutes.

IV. FINAL REMARKS

From all this textual talk, there are two key takeaways. First, like everything else in law, the history of HCU extends beyond the provision itself—it is deeply tied to the broader principle of honest and concurrent use, which has long been embedded in trademark law. Despite clear traces of HCU principles in common law and subsequent codifications, Indian courts have reviewed and considered the issue in distinct ways, shaped by the facts presented before them and the arguments advanced by the parties. Second, India has cycled through three trademark legislations over the last century, each positioning HCU slightly (if not much) differently. Yet, as our analysis suggests, the underlying idea of honest and concurrent use has remained a consistent thread running through all these legal frameworks.

That said, the history of HCU in Indian law remains somewhat unclear, mainly due to the lack of clarity in judicial engagement. But why is that the case? Why do courts interpret and rely on precedents the way they do? Several factors could be at play, like heavy judicial burdens, the peculiar nature of trademark disputes that often end at the interim stage, and the mechanical reliance/citation of cases without conscious engagement. However, another critical issue lurks beneath the surface: problematic interpretations, even those at odds with historical understanding, often escape scrutiny because of a lack of scholarly attention in the country. Various scholars have noted the broader issue of trademark law being underexplored in legal scholarship. In India, this gap is even more apparent where trademark law, especially its historical aspects, has received sparse academic engagement, making the interpretative gaps all the more glaring.

¹⁰³ MANU/GJ/3045/2022, ¶ 16.

We hope this article opens up a research space for other intellectual property scholars to engage with, interrogate, and even contest our claims and observed patterns. Because, as they say, to critique is to care!

*À bientôt!*¹⁰⁴

¹⁰⁴ “See you soon.” Merriam-Webster (2025), <https://www.merriam-webster.com/dictionary/%C3%A0%20bient%C3%B4t> (last visited Oct. 9, 2025).