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CROSS-BORDER TRADE MARK INFRINGEMENT IN INDIA

Introduction:

When there is unauthorized use of a service mark or, more specifically, a trade mark either on or in connection with goods and services, which is likely to cause mistake, deception, or confusion concerning the goods and services, it is called a trade mark infringement.¹ With the growth of globalization, there has been an increased supply of goods and services between countries through imports and exports, i.e., international trading. This nature of the increased transfer of goods and services between countries has also led to the rise of the possibility of trade mark infringement taking place across countries. This has been due to the increased competition in markets, where firms are no longer just competing with other domestic companies but also international firms, in their own country and internationally. This paper will analyse how cross-border trade mark infringement operates, and the different international treaties on protections of brands against such infringement applicable in India, as well as the treatment of cross-border trade mark infringement in Indian legislature and judiciary in terms of legal approaches and remedies.

Companies, primarily, adopt trade marks to advertise their products. However, over time trade marks signify the nature and quality of the product over a period of time and are therefore very important to a company, or entity, or person.² In order to gain the upper hand in terms of innovation and technology, companies also attempt to steal company names to sell their products. When companies in another country use the brand name of a company not established in that country with the purpose of capitalizing on the name of such a company's brand name,

¹ *About Trademark Infringement*, UNITED STATES PATENT AND TRADEMARK OFFICE, (2nd July, 2021, 10:00 AM) <https://www.uspto.gov/page/about-trademark-infringement>;

Trade Marks Act, 1999, Section 29.

² *Syntex Laboratories Inc. v. Norwich Pharmacol Co.*, 169 USPQ 1 (2nd Cir 1971).

it is called cross-border trade mark infringement.³ In such a situation, another company or firm uses the name of the widely known company to sell their products due to the confusion created by having the same name. In the current world market scenario, names have powerful implications. For example, Samsung and Apple not only stand for companies that produce phones, but they are brands that also stand with the quality of product and service provided by them. So, cross-border trade mark infringement is a problem of trade mark infringement that takes place internationally instead of domestically. Such infringement on trade mark rights has become infinitely easier with the widespread use of the internet, increased traveling, and technology, making it easier to create cheap replications of branded products.⁴ Counterfeit products are an extremely used method for expensive branded products like Louis Vuitton, Gucci, Chanel, and other such brands, where second, third and fourth copy of each of their product is available, distinguished by a few insignificant differences.

This problem is amplified for many reasons, especially the issue of the company's trade mark in only one country. When a product is launched in a particular country, it only takes the trade mark rights of that country. However, the notice of the product launch is worldwide, and every competitor of the company based in another country has notice of such product. In order to save their product from trade mark infringement in international markets, the firm needs to take the trade mark rights of the product internationally. Gaining such an international permit is not an easy task and takes up time. So, until such an international permit is received, other companies have the time to misappropriate the brand name of such famous brands and make it their own. Most often than not, companies, despite having extensive popularity find that their name has been appropriated by some other company, which is no way, shape, or form related to their brand. This can result in trade disputes where the famous company has to rely on its global reputation and goodwill since the company cannot apply for infringement considering they have not yet received trade mark rights in the country. Therefore, it is essential to understand the forms of legal recourses available when such an issue with a trade mark arises.

³ Intepat, *Cross Border Trademark Infringement*, INTEPAT, (2nd July, 2021, 10:05 AM) <https://www.intepat.com/blog/trademark/cross-border-trademark-infringement/>.

⁴ Mukul Baveja, *Trans-Border Reputation: Protection of Foreign Trade Marks in India*, MONDAQ, 26 November 2018, (2nd July, 2021, 10:00 AM) <https://www.mondaq.com/india/trademark/758124/trans-border-reputation-protection-of-foreign-trade-marks-in-india>.

International Treaties

Trade mark, as evident, is an international concept, and it enables a person to distinguish between the goods and services provided by different companies, firms, or entities. Considering the impact of globalization, trade mark issues now cross borders. Therefore, when there is any form of dispute arising in terms of a trade mark, it is essential that there is some form of consensus on which law is to be applied. Currently, four primary trade mark laws are applicable internationally, or the conventions or protocols that influence the making of trade mark laws in any country signatory to such protocol. Firstly, there is the Paris Convention, 1883, or the Protection of Industrial Property which India signed in 1998. The second agreement is the Trade-Related Aspects of Intellectual Property Rights (“TRIPs”) created by the World Trade Organization (“WTO”). The third is a recommendation created by the World Intellectual Property Organization (“WIPO”) called the WIPO’s Joint Recommendation Concerning Provisions on Protection of Well-Known Marks as a directory structure for forming trade mark laws for member countries. Lastly, there is the Madrid System based on two agreements, the Madrid Agreement, 1891, and the Madrid Protocol, adopted in 1989.

The Paris Convention applies solely to industrial property. Industrial property, here, includes marks, patents, utility models, trade names, industrial designs, repression of unfair competition, and geographical indicators.⁵ The signatory countries of this convention are duty-bound to provide to nationals of other countries the same protection it provides to the nationals of their own country. Moreover, the convention dictates that well-known trade marks are to be given protection by signatory countries, even if the mark has not yet been registered in their country.⁶ Furthermore, if an applicant has applied for the trade mark in another country, which is a signatory of this convention, and then proceeds to apply for a trade mark in another signatory country for the same goods and services or mark and so on, then it will be assumed that the application had been made in the second country on the same day as the first one. However, the protection provided to well-known trade marks is limited to when a company uses a confusingly similar mark to provide the same goods. If the company is not involved in the same business, such protection is not accorded to it.

⁵ Mukul Baveja, *Trans-Border Reputation: Protection of Foreign Trade Marks in India*, MONDAQ, 26 November 2018, (2nd July, 2021, 10:00 AM) <https://www.mondaq.com/india/trademark/758124/trans-border-reputation-protection-of-foreign-trade-marks-in-india>.

⁶ Paris Convention for Protection of Industrial Property, 21 U.S.T. 1583; 828 U.N.T.S. 305, Article 6bis.

The TRIPs Agreement mainly removed the problems with the Paris Convention and added clauses to make protection better for well-known trade marks. The agreement only outlines the minimum standard of protection afforded to companies in signatory countries and directs these countries to change their trade mark laws to include such protection. Countries have the right to extend these rights according to their preferences and needs.⁷ TRIPs Agreement firstly extended the protection of well-known marks to services, which was limited to goods under the Paris Convention.⁸ The agreement also added a clause stating that countries are to look at the knowledge of the public concerning the trade mark involved in the dispute to check whether it deserves the status of a well-known mark.⁹ Finally, the agreement added that even if the goods and services provided by the companies are different, the one with a higher reputation can bring an action to protect their trade mark, unlike the Paris Convention.¹⁰ However, this protection under TRIPs against dissimilar goods and services is only available if the trade mark of the better-known company was already registered in the country.

WIPO's Joint Recommendation Concerning Provisions on Protection of Well-Known Marks ("WIPO's Joint Recommendation" or "The Recommendation") was created to correct the loopholes in TRIPs and Paris Convention. The Recommendation sets a clear outline as to how a country is to decide what a well-known mark is. For this purpose, the Recommendation under Article 2(1) provides a non-exhaustive list to member countries to help them determine whether the mark is a well-known mark.¹¹ The list is non-exhaustive, as member countries have the right to add their own tests in these determination factors,¹² and the test or factors provided by the Recommendation are merely directory and not compulsory for any country to apply.¹³ Moreover, finally, the Recommendation fixed the issue with the TRIPs Agreement article 16(3)¹⁴, which required mandatory registration for protection in dissimilar goods and services case and removed such requirement.¹⁵

To become a signatory of the Madrid System, it is enough if the country is a signatory of the Paris Convention and can then become a party to either Madrid Agreement or Madrid Protocol,

⁷ Declaration on TRIPs Agreement and Public Health, WT/MIN(01)/DEC/2, Article 1(1).

⁸ Declaration on TRIPs Agreement and Public Health, WT/MIN(01)/DEC/2, Article 16(2).

⁹ *Id.*

¹⁰ Declaration on TRIPs Agreement and Public Health, WT/MIN(01)/DEC/2, Article 16(3).

¹¹ Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, 1999 Article 2(1).

¹² Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, 1999 Article 2(1)(c).

¹³ Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, 1999 Article 2(2)(a).

¹⁴ Declaration on TRIPs Agreement and Public Health, WT/MIN(01)/DEC/2, Article 16(3).

¹⁵ Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks, 1999 Article 2(3)(a)(i).

or both. India signed the Madrid Protocol on 8th April 2013 and is yet to join the Madrid Agreement. The Madrid Agreement aimed to create a mechanism where it became possible for people to make one international registration applicable to every country instead of filing for different trade marks in different countries. The protocol is intended to simplify the intentions of the Madrid Agreement in terms of international trade mark registration.¹⁶ Thus, the Madrid system's main aim remains to make the international system of filing for trade marks easier and allow one single trade mark registration to protect the trade mark in the signatory countries.

Indian Statutes and Actions Against Cross-Border Trade Mark Infringement

The rights of a company or entity concerning their trade mark fall under the company's Intellectual Property Rights ("IPR"). Intellectual property allows an owner or inventor to have a monopoly over their creation. IPR, in India, is governed under The Patents Act, 1970 (as Amended in 2005), The Trade Mark Act, 1999, and The Copyrights Act, 1957. The Trade-Mark Act, 1999 operates as the prevailing act governing trade marks disputes. Before the application of the Trade Mark Act, 1999, the first act to regulate trade in India was the Trade Marks Act of 1940, followed by the trade and Merchandise Marks Acts of 1958. The UK Trade marks Act heavily influences the Indian Trade Marks Act, and the prevailing act has been influenced by the UK Trade Marks Act of 1994. Until this act, foreign companies or entities had barely been provided any protection under Indian statutes.

The new act has also been drafted keeping in mind the TRIPS Agreement, 1994, as well as WIPO's Joint Recommendation, of which India is a signatory. In the new act, the Indian legislature and judiciary have departed from the original idea of foreign companies or plaintiffs having to acquire a trade mark in India in order to win a dispute. Now, the Indian government and courts have preferred to rely on the foreign or international reputation of brands¹⁷ as well as provides protection for "well-known trade mark."¹⁸ These sections have been provided by Indian legislative in order to protect foreign companies in case there is a breach of their trade mark in India; that is, there is cross-border trade mark infringement in India. Well-known mark, here, stands for when the mark or logo of a specific company has become so prominent that the use of a similar mark or logo will create a belief that the product belongs to such company.

¹⁶ Vicenç Feliú, *International Trademark Law - The Madrid System*, HAUSER GLOBAL LAW SCHOOL PROGRAM, September-October 2007, (2nd July, 2021, 10:20 AM), https://www.nyulawglobal.org/globalex/International_Trademark_Law.html.

¹⁷ Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999, Section 2(zg).

¹⁸ *Id.*

Such marks or logos should create uncertainty or confusion in the buyer's mind, who believes that the goods and services belong to the company with a better reputation. They can, therefore, also lead to a detriment in the reputation of such a company.

Moreover, foreign companies are protected from local companies making a trade mark registration using their logos or brand names by the Trade Mark Act, 1999. The statute provides for conditions where a trade mark can be rejected on the grounds of similarity of goods and services which is already covered by an earlier trade mark which provides the same goods and services;¹⁹ on the basis of similarity of trade mark already existing.²⁰ Additionally, section 11(7)²¹ of the act is based on the WIPO Joint Recommendation but has made the test for the same much smaller. It specifies that a trade mark will be rejected based on the number of consumers or potential consumers as well as the number of trade channels used by the trade mark to determine whether it is well known. If it is, it cannot be acquired by another company.

Furthermore, section 9²² of the act provides for absolute grounds of refusal to register trade marks. If trade marks are devoid of any distinctive characteristics, to set it up apart from other such trade marks, and it is hard to distinguish its goods and services from another company's, such can be refused.²³ Lastly, if the trade mark is bound to cause confusion or is likely to deceive people into believing that the goods and services provided are from another company, such will not be approved.²⁴

Following these foreign statutes, Indian statutes, now, also recognize and protect trade-dress. Trade-dress, much like a trade mark, is an unregistered source identifier. In *Walmart Stores Inc. v. Samara Bros Inc.*,²⁵ the court defined trade-dress as an identifier. The design, colour, packaging, or schematic arrangement can distinguish a particular product from the rest. During cases of trade-dress, the court needs to look into whether the shape, colour, printing, and so forth would lead to any form of confusion between products of the two companies, and to do so, the distinctive features of both need to be looked at.²⁶ Thus, Indian statutes have grown to

¹⁹ Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999, Section 11(1)(a), 11(1)(b).

²⁰ Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999, Section 11(2)(a).

²¹ Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999, Section 11(7).

²² Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999, section 9.

²³ Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999, Section 9(1)(a).

²⁴ Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999, Section 9(2).

²⁵ *Walmart Stores Inc. v. Samara Bros Inc.*, (2000) 529 US 205 (SC) (India).

²⁶ *Smithkline Beecham plc. v. Hindustan Lever Ltd.*, (2000) PTC 83 Del (India).

protect trade mark rights of companies as is suitable for the country, while keeping in mind the various international treaties it is a signatory of.

The matter of jurisdiction is decided by the relevant instruments as well as the national rules of the country.²⁷ Relevant instruments in India includes Trade Mark Act, 1999, Paris Convention, TRIPs Agreement, and the Madrid Protocol. The Trade Mark Act, 1999, decides which court is competent to decide the matter at stake.²⁸ In matters of infringement, the case goes to the District Court where such alleged infringement has occurred, that is, the defendant's jurisdiction.

The Trade Marks Act, 1999 provides both civil and criminal remedies to companies whose trade mark rights have been infringed. Under civil remedies, a company can get a permanent injunction against the company that used their trade mark.²⁹ A permanent injunction stops a company from doing an action or committing an action permanently and includes *an ex-parte* injunction or an interlocutory order. An *ex-parte* judgment is an injunction given against the defendant, with or without hearing his defence, and it operates until the defendant's defence is presented.³⁰ An interlocutory order is also a temporary order given by the court when the litigation is going on,³¹ and it operates till the final judgement is pronounced by the court.

One form of *ex-parte* order includes the *Anton Pillar Order* that the court can pass if it believes that the defendant is likely to get rid of any incriminating evidence against him. The Kerala High Court used the Anton Pillar order in *National Garments v. National Apparels*.³² However, suppose there is a possibility of the defendant's assets being cancelled or dissipated so that the judgement pronounced would be unenforceable against the defendant. In that case, the court can pass a *Mareva Injunction*. Under this injunction, the court has the power to freeze the assets of the defendant.³³ The court also has the power to allow a raid on the defendant's premise to secure any infringing goods. Such an order passed by the court is a *John Doe Order* and was

²⁷ Dr. Annabelle Bennett & Mr. Sam Granata, *When Private International Law Meets Intellectual Property Law: A guide for Judges*, WORLD INTELLECTUAL PROPERTY ORGANISATION & HAGUE CONFERENCE ON PRIVATE INTERNATIONAL LAW, (Geneva, 2019), https://www.wipo.int/edocs/pubdocs/en/wipo_pub_1053.pdf; Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999, Section 134.

²⁹ Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999, Section 135(1).

³⁰ Ryan Wilson, *Using Ex-parte and Ad-interim Injunctions to Enforce Trademark Rights in India*, SUJATA CHAUDHRI IP ATTORNEY, 30 June 2016, (11 July, 2021, 12:30 PM) <https://sc-ip.in/2016/06/30/using-ex-parte-and-ad-interim-injunctions-to-enforce-trademark-rights-in-india/>.

³¹ Cornell Law School, *Interlocutory Order*, LEGAL INFORMATION INSTITUTE, (11 July, 2021, 12:40 PM) https://www.law.cornell.edu/wex/interlocutory_order.

³² *National Garments v. National Apparels*, AIR 1999 Ker 119 (India).

³³ *Koninklijke Philips Electronics v. Overseas Business Corporation & Ors.*, Decided on 12 July 2018, Suit No. 76 of 2001, Delhi High Court (India).

used by the court in *Taj Television v. Raj Mandal*.³⁴ The principle of *Norwich Pharmacal Order* laid down in *Souza Cruz v. N.K. Jain*³⁵ allows the court to pass an order where discovery against a third-party, not the defendant, to the suit is needed.

One of the actions a company can institute is a case of “passing-off” to defend its rights of trade mark. Passing-off is not defined in any particular act. However, it is based on principles defined under sections 27(2), 134(1)(c), and 135 of the Trade Mark Act, 1999.³⁶ The action is based on the principle that “no man be allowed to sell his goods under the pretence that they belong to another man.”³⁷ Use of trade mark is a superior defence in a passing-off action, and without the use of trade mark, no passing-off action can be brought against the defendant. Another action that a company can take is “infringement” under section 134 of the Trade Mark Act, 1999,³⁸ and is based on particulars of offenses. The mark used should be identical or very similar enough to deceive people, the goods and services must be covered in registration, and the use of the mark must be in the same course of trade so as to create the deception that it is a registered trade mark. However, just proving that the registered trade mark is identical or highly similar to the original trade mark is enough. The mark may or may not have caused the plaintiff any injury. A critical difference between a passing-off action and infringing action was established in *Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories*,³⁹ where the court states that passing-off action is a common law remedy against deceit, that is, where a person passes off their goods as those of another. On the other hand, an infringement suit is against a person who infringed the rights of a registered trade mark. The use of trade mark is not essential in a passing-off action; however, without such proof, an infringement action cannot be brought against anyone.

The court, other than these, can also ask the defendant to pay to the petitioner, or the company whose trade mark was copied, damages, and rendition of accounts they have faced due to the defendant’s actions. Moreover, it can also ask for delivery of the infringing goods of the defendant for their destruction so as to save the petitioner company from any further loss created due to the selling of these already made goods.

³⁴ *Taj Television & Anr. v. Raj Mandal & Ors.*, [2003] FSR 22 (India).

³⁵ *Souza Cruz v. N.K. Jain*, 1997 PTR 97 (India).

³⁶ Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999, sections 27(2), 134(1)(c), and 135.

³⁷ *Perry v Truefitt* (1842) 6 Beav. 66;

Cadbury India Limited and Ors. V. Neeraj Food Products, 142 (2007) DLT 724, MPR 2007(2) 269 (India).

³⁸ Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999, section 134.

³⁹ *Kaviraj Pandit Durga Dutt Sharma v. Navaratna Pharmaceutical Laboratories*, 1965 AIR 980 (India).

The Trade Mark Act, 1999 also deals with criminal remedies available to a company against a company, entity, or person that is using their trade mark. Chapter XII of the Act lays down the offences, procedures, and penalties of a criminal remedy. Suppose a company has used a false trade mark or false description⁴⁰ or has offered goods and services under false description or trade mark,⁴¹ that is used another company's trade mark to pass it off as that company's goods. In such a case, the company is liable for fines ranging from \$1000 to \$4000 and/or imprisonment between 6 months to 3 years, depending on the nature of the breach. If there is a subsequent breach of offences listed in section 103 or section 104, the penalty can be of a fine ranging from \$2000 to \$4000 and/or imprisonment between 1 to 3 years.⁴² Moreover, if a company falsely represents that they have registered the trade mark, they can be liable to be imprisoned for up to 3 years and a fine.

Both civil and criminal actions can be brought parallelly in India. There is no need to wait for either of the actions to be over to bring up the other. Criminal action allows a company to start an action against an unknown party, and thus, the identity of infringers is not necessary to be revealed for or during the auction. Moreover, this permission to start actions against unknown people in criminal action extends to initiating search and seizure proceedings against both unknown and known people. Allowing both actions to run together ensures that a party whose rights have been infringed is able to attain justice in all possible areas of law.

India's judicial precedents on Cross-Border Trade mark Infringement

Indian courts, before the new act, used to support the trade mark rights of domestic companies over foreign companies, even though there was an apparent infringement on the brand of the foreign company.⁴³ However, after India became a signatory of the TRIPS Agreement and the Trade Marks Act, 1999 was passed, the judiciary started to protect foreign companies in this matter under Section 35 of the Trade Marks Act, 1999.⁴⁴ Indian courts, much like Indian statutes with respect to Trade mark rights, use English or UK precedents as a guiding source. Therefore, UK precedents have been used by Indian Courts in matters of cross-border trade

⁴⁰ Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999, Section 103.

⁴¹ Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999, Section 104.

⁴² Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999, Section 105.

⁴³ *Kabushiki Kaisha Toshiba v. Toshiba Appliances Co.*, 1994 PTC 53 (India).

⁴⁴ Trade Marks Act, 1999, No. 47, Acts of Parliament, 1999, section 35.

mark infringement. But Indian courts, unlike UK Courts, do not differ between the concept of goodwill and reputation, and instead, they see both as the same concept.

One of the first cases to discuss goodwill and reputation being the same was the *Kamal Trading Co. v. Gillette UK Limited*,⁴⁵ where the Bombay High Court held that goodwill of a company is not restricted to only the country where its goods are being sold. Instead, because of globalization, the awareness of the goods sold by the company is known worldwide through magazines, news, and other such mass media. Thus, the goodwill of a company is spread to countries even where its goods are not sold, and as a result, the mark under which its goods are sold acquires a worldwide reputation. Other courts throughout the country then followed this approach.

However, it was only in 1996 that one of the first cases regarding cross-border trade mark violations came to an Indian court. The case was *Whirlpool Co. v. N.R. Dongre*,⁴⁶ which was presented firstly to a Division Bench of Supreme Court of India. here, there was a conflict over the trade mark of washing machines named “whirlpool.” The respondent, here, had, after looking at the trade mark name of the American company whirlpool in magazines and other such forms of advertisement, registered his own washing machine company named whirlpool in India. The court ruled in favour of the petitioner, that is, *Whirlpool Co.*, stating that its reputation was not intrinsic to its country and instead had cross borders with the use of commercial advertisements in magazines that were available in India. Additionally, the court stated that the appliance sold by the company was a standard amenity in every house and was not bound by class. No one should be allowed to bank on the reputation and goodwill which has been acquired by someone else for their benefit. The respondent here appealed to a bigger bench of the Supreme Court, which upheld the decision of the Division Bench.

In giving the decision, the Division Bench had to first look into and then define the concept of trans-border trading. In defining it, Justice Lahoti stated that knowledge and awareness of goods and services provided by a company or brand are important indicators. Both of these indicators in countries where it is not available need to present in order to decide whether the company’s reputation and goodwill surpass the border it is available in. If these indicators are present, then the company can bank on the same for any dispute arising out of trade mark

⁴⁵ *Kamal Trading Co. v. Gillette UK Limited*, 1988 PTC 1 (India).

⁴⁶ *Whirlpool Co. v. N.R. Dongre*, 1996 PTC (16) 583 (SC) (India).

violation across borders. This case thus, established the “trans-border reputation” doctrine in India, which is now to be followed in such issues.

Following this, another case, presented before the Delhi High Court, raised a similar issue where the court relied on doctrine of “trans-border reputation” established by the *Whirlpool* case. It was reiterated by the court in *Blue Cross and Blue Shield Association v. Blue Cross Health Clinic*,⁴⁷ that even though the foreign company had not registered its trade mark in India, because it had a worldwide reputation, which exceeded the country it supplied its goods and services in, another company in India could not use its trade mark. Thereafter, the Supreme Court in *Ruston & Hornby Ltd. v. Zamindari Engineering Co.*,⁴⁸ held that there is no necessity for a company to be carrying on business in the country for it to be eligible to bring an action of passing-off since its reputation is enough for such an action. In *Milmet Ofto Industries & Ors. v. Allergen Inc.*,⁴⁹ as well as *Playboy Enterprises Inc. v. Bharat Malik*,⁵⁰ the court, held that an international company has the right to restrict use of a mark outside of its country, i.e., in India, if it has sufficient worldwide reputation.

The trans-border or cross-border reputation test was also applied in a 2013 Indian case of dissimilar goods, where a Chennai-based restaurant used the name “ZARA” for their restaurant name, and the fashion brand ZARA filed an infringement suit against them. The court, while keeping in mind the brand’s trans-border reputation as well as the fact that ZARA had already filed a trade mark for its name in India in 1993, the case was held in favour of the ZARA fashion brand.⁵¹ The same issue was also seen in the case of *Louis Vuitton v. Louis Vuitton Dak*,⁵² the former was the fashion brand and the defendant a South Korean restaurant that used a similar logo and packaging as the petitioner. The court ruled in favour of Louis Vuitton, the fashion brand, and fined the restaurant \$1250 for trade mark infringement.

Due to growth of technology, the issue of trans-border or cross-border trade mark infringement, now, can also take place on the internet. Internet is an important facilitator in terms of spreading information as well as for creating advertisements for a company’s goods and services. However, it has been noted that this allows for trade mark infringement in terms of marks,

⁴⁷ *Blue Cross and Blue Shield Association v. Blue Cross Health Clinic*, (1990) IPLR 92 (Del) (India).

⁴⁸ *Ruston & Hornby Ltd. v. Zamindari Engineering Co.*, 1970 2 SCR 222 (India).

⁴⁹ *Milmet Ofto Industries & Ors. v. Allergen Inc.*, (2002) 12 SCC 624 (India).

⁵⁰ *Playboy Enterprises Inc. v. Bharat Malik*, 91 (2001) DLT 321 (India).

⁵¹ *Industria De Diseno Textil S A. v. Oriental Cuisines Pvt Ltd & Ors.*, (Cs (Os) 1472 Of 2013 (India).

⁵² *Louis Vuitton v. Louis Vuitton Dak*, 2016 (India).

logos, and goods and services provided by a company internationally. Another issue that can arise is of infringement of trade mark of a company through the domain name. In domain name infringement, one company uses another company's name on their country's internet service and refuses to give up such domain name. In the landmark case of *Yahoo! Inc. v. Akash Arora*,⁵³ the Delhi High Court held that a registered domain is equivalent to trade mark registration and is thus, entitled to equal protection. It was held in *Arun Jaitley v. Network Solutions Private Limited*⁵⁴ that a person or company cannot make use of a well-known name as a Domain name without having a sufficient reason or cause to keep it in their possession. Doing so would be considered as bad-faith registration and violative of Internet Corporation for Assigned Names and Number ("ICANN") policy. However, these rights established by judicial precedents for domain names are not extended to allow a company or entity to police the domains of some other company or entity because the domain name is potentially confusing.⁵⁵

Concluding Note

Due to the growth of globalisation as well as the increasing use of the internet, cross-border trade mark infringement is a part of daily life. Indian law has gradually changed over the years. Initially, during the 90s, domestic companies were protected from foreign claims of trade mark. However, with India entering into agreements like the Paris Convention and TRIPs Agreement, the courts have now started to enter cases with a broader mind. The Indian government and legislative have been very proactive in making changes to statutes and making the best decision for companies or people facing the problem. Even though Indian legislative and judiciary highly rely on UK statutes and judgements as their guiding source, they have adapted changes according to the needs pertinent to India.

It has grown to protect trade mark rights of companies on the basis of their reputation. There are still certain gaps in this approach of the Indian judiciary. For example, if a company does not present evidence of publicity of marks, they are unable to receive the protection under the "trans-border reputation" doctrine. However, these few lacunas are to be covered over time, with the growth of a number of cases reaching the Indian judiciary. Overall, the Indian government and judiciary have been developing the law to protect the rights of foreign

⁵³ *Yahoo! Inc. v. Akash Arora & Anr.*, 1999 IIAD 229, 78 (1999) DLT 285 (India).

⁵⁴ *Arun Jaitley v. Network Solutions Private Limited*, 2011 SCC OnLine Del 2660 (India).

⁵⁵ *Academy of Motion Picture Arts s v. GoDaddy.com Inc.*, Case No. CV 13-08458-ABC (CW), U.S.District Court Central.

companies, for example, the doctrine of trans-border reputation has been extended to dissimilar goods and services as well as domain infringement, and has therefore, resulted in increased remedies available to them. Moreover, Indian law allows a foreign company to pursue both civil and criminal remedies available at the same time, in order to provide satisfactory compensation to them. It is, therefore, safe to conclude that the current remedies in Indian law concerning cross-border Trade Mark infringement highly outweigh the few lacunae present in it.