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Recent Trends in Trademark law: India and the world

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ABSTRACT:

This article has made an honest attempt to understand and present the recent trends in trademark law. It includes an introduction, literature review, research methodology, research question, analysis, and key findings by the author, followed by a conclusion.

List of abbreviations

WIPO	World Intellectual Property Organization
US	United States of America
UK	United Kingdom
PTO	U.S. Patent and Trademark Office

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2.1) WIPO'S definition of trademark:

According to WIPO ' a trademark is a sign capable of distinguishing the goods or services of one enterprise from those of other enterprises.¹ According to WIPO trademark registration provides an exclusive private right to the owner of the registered trademark and a legal certainty in case any litigation takes place in the court of law. According to WIPO, usually, a word or combination of words, letters, and numerals form types of trademarks and may also include three-dimensional figures, symbols, fragrances, colors, etc., and trademark protection is usually granted for a period of 10 years.

2.2) History of trademark

a) History of trademark laws in Europe and the United States of America

The first documented law in the field of the trademark was passed in England in 1266. It was called '**the Assize of Bread and Ale**' and they were in the form of a set of rules that enabled customers to distinguish breads of different bakers. The first case related to which mentioned trademark in England was Southern vs How (1617), it was related to the selling of counterfeited jewels. In France, the first extensive trademark was established in 1857.

In the USA the first trademark act was passed in 1870 and Averill Paints were first to get their trademark registered, but the 1870 act was repealed in 1881.

In Britain, in the year 1875, the parliament enacted the '**Trademarks Registration Act**' and prepared a national register of trademarks.

A significant development was made in 1883 when an international agreement known as **the Paris Convention for the Protection of Industrial Property**, it was the first holistic agreement to provide protection to numerous types of intellectual properties like patents, trademarks, service marks, trade names, etc. and it aimed to curb and put an end to unfair competition.

b) History of trademark In India

The first law related to trademarks in India was the **Trademark Act, of 1940** which was followed by the **Trade and Merchandise Marks Act, of 1958** which encompassed all the

¹ wipo, https://www.wipo.int/about-ip/en/index.html#wipo_content_frame=/about-ip/en/trademarks.html, (last visited June. 6, 2024).

major provisions related to trademarks in the IPC, CrPC, etc. It was finally replaced by the **Trademarks Act, of 1999.**²

3)Literature review:

3.1) 2023 Overview: Trademark Law in India by Lynn Lazaro and Aparna Venkat-In this article the authors have written about the various trademark cases of 2023 that had a significant impact on the trademark law in India.³ The authors have explained the case and the judgment in detail, thus giving a good overview of last year's important trademark cases that shaped the recent trends in trademarks.

3.2) How U.S. Courts Ruled on Trademarks in 2023 by William Stroeve:

In this article, the author has written about the latest cases that have shaped the trend of trademarks in the US in 2023. The author has explained in detail about recent changes and **their** immediate and potential impact on the trademark laws in the UK and the impact on the trademark laws and on the business world.

4)Research methodology:

The author shall use the doctrinal method with great emphasis on secondary sources. The secondary data is gathered through extensive research of several blogs and articles.

5)Research Question:

What are the recent trends in trademark law in various countries?:

6)Data analysis and key findings:

The author has analyzed the data from various secondary sources and thorough interpretation of various blogs and articles.

6.1) Major findings from data collection:

i)India:

The current Trademark legislation in India is the Trademark Act 1999. The salient features of this act are-

- a) It increased the period of protection of the trademark from 7 years to 10 years.
- b) enhanced the types of trademarks by including service marks, well-known marks, and an exclusive clause for collective trademarks.
- c)Several classes of trademarks can now be registered under one application.
- f) Stricter and swift enforcement of penalties for infringement of trademarks.

² wikipedia, https://en.wikipedia.org/wiki/Indian_trademark_law, (last visited June. 6, 2024).

³ ilms.academy, <https://www.ilms.academy/blog/landmark-cases-related-to-trademark-law-in-india>, (last visited June. 6, 2024).

g) The trademark registration process was simplified under this act.

A recent development in the field of trademarking happened in 2017 when the trademark rules of 2017 gave the power to the registrar to give recognition to well-known trademarks under section 11(9) of the Trademark Act. In the case of **Whirlpool Co. & Anr.v.N.R. Dongre**, the court held that though Whirlpool was not a registered trademark in India, it held a good ‘transborder reputation’ hence the defendant who started selling washing machines under the same name had infringed on the rights of the plaintiff Whirlpool Co. Before 2017 only the courts and tribunals could determine the which marks came under the definition of well-known trademarks, however after the Trademark rules 2017 came into force even the registrar could give recognition of a well-known mark to a trademark.⁴

Since a trademark can be acquired from the previous owner through registration and assignment deed, a recent development has been made in which the court has allowed the previous owner of the trademark to use the trademark for selling its products. In the recent case of **KRBL Ltd. v. Vikram Roller Flour Mills Ltd. (2023)** since the defendant has been using the mark INDIA GATE since 1979 and the petitioner since 1993, it has the advantage of ‘prior use’ of the trademark and hence it can sell the ‘Dalia’ under the trademark INDIA GATE and such an act is not an infringement on the rights of the petitioner.⁵

Another important recent trend in the sphere of trademarking has been in the field of metaverse. A metaverse is composed of virtual and augmented reality, it creates a 3D virtual world by using blockchain technology and digital media. There has been an increase in trademark registration of metaverse marks and designs.⁶ Such marks contain the word ‘metaverse’ and hence the fact that the word metaverse has become a common and customary word and if any registration is done then it is a direct violation of **Section 9(1)(c) of the Trademarks Act, 1999,⁷ which states that ‘The trademarks...which consist exclusively of marks or indications which have become customary in the current language or in the bona fide and established**

⁴ Whirlpool Co. & Anr.v.N.R. Dongre

⁵ KRBL Ltd. v. Vikram Roller Flour Mills Ltd. (2023)

⁶ thefashionlaw, <https://www.thefashionlaw.com/questions-brands-should-be-asking-about-trademark-protection-in-the-metaverse/>, (last visited June. 6, 2024).

⁷ Trademarks Act, 1999, 9 (1)(C), No. , Acts of Parliament, 1999 (India).

*practices of the trade, shall not be registered.*⁸ The judiciary in India is yet to take a substantive decision and provide for regulation for rising trademark applications for the metaverse.

An important aspect of trademark infringement in India has been the nonavailability of an infrastructure that would alert the trademark owner if his mark has been infringed. Many times, many small businesses keep on using the trademark of a brand for years before it is brought to the notice of the original trademark owner and thus it causes an unfair advantage to the infringer and leads to loss of revenue and the market trust and goodwill for the original trademark owner/

ii)US:

In the US the trademark is governed by the Lanham Act of 1946 which was amended in 1996. Under the Lanham Act, only a mark that is distinctive in nature can be considered for registration, thus the source of the mark should be easily identifiable for it to be recognized as a trademark. In the US registration of a mark is done based on a) by being the first to use the mark in commerce; or (2) by being the first to register the mark with the U.S. Patent and Trademark Office ("PTO")

In a recent judgment in the case of **Jack Daniel's v. VIP Products(2023)**, the Supreme Court held that if a trademark is used as a 'source identifier' in the field of creative works,⁹ it can lead to trademark infringement and that the famous **Rogers v. Grimaldi test does not apply when the trademark is used by the alleged infringer as a mark.**¹⁰ **The Rogers v Grimaldi test laid down that** a) First, the Court must determine whether the work at issue is expressive and Second, if the work is expressive, then the plaintiff must show that the defendant's use of the trademark either (i) is not artistically relevant to the work, or (ii) is explicitly misleading to consumers as to the source or content of the work.¹¹¹² In the US there has been an increase in cases related to cybersquatting and non-fungible tokens and an extreme overlapping of these

⁸ Antony, A. (Trade marks and the metaverse: Recent trends in India, SC IP, (June. 2, 2024, 7:19 AM), <https://www.sc-ip.in/post/trade-marks-and-the-metaverse-recent-trends-in-india>

⁹ Jack Daniel's v. VIP Products(2023),

¹⁰ Rogers v. Grimaldi

¹¹ Dreyer, A.J. et al. (2023) Supreme Court sharply limits applicability of Rogers v. Grimaldi test for trademark infringement: Insights: Skadden, Arps, Slate, Meagher & Flom LLP, Insights, Skadden, Arps, Slate, Meagher & Flom LLP, (June. 2, 2024, 7:19 AM), <https://www.skadden.com/insights/publications/2023/06/supreme-court-sharply-limits-applicability>

¹² Skadden Arps Slate Meagher & Flom LLP, Supreme Court Sharply Limits Applicability of Rogers v. Grimaldi Test for Trademark Infringement, lexology, (June. 2, 2024, 7:19 AM), <https://www.lexology.com/library/detail.aspx?g=0b020f3b-ec00-4f68-ab2d-4102a26d2ba5>

cases. In the case of **Hermes International vs Rothschild (2023)**, **Hermes** sued Mason Rothschild for trademark infringement for digitally creating different variations of Hermes bags and selling them as Nonfungible tokens and the court ruled in favor of Hermes International as Rothschild created confusion in the minds of the customers in the garb of artistic liberty and thus the court ruled that trademark protection is available in the sphere of non-fungible tokens (NFT).¹³ The US federal law is limited by territory and the said law is not applicable if sales and infringement occur in a foreign land. In the recent case of **Abitron Austria vs. Hetric International**, the Supreme Court held that the Lanham Act does not have an extra-territorial reach, and the term 'use in commerce' is any such commerce that can be regulated by the Congress and thus, it limited the scope of Lanham act in extra-territorial sale of goods and infringement.¹⁴

In the US we can thus see that there has been a plethora of new entrants in the sphere of trademark law like NFT, cybersquatting, and extra-territorial infringement of trademarks and thus there has been an increase and diversification in litigation. There has been confusion regarding the overlapping of artistic value and trademark infringement, thereby putting several statutorily backed tests to a new experiment.

iii)UK

In the UK the trademark is governed by Trademark Act, 1994. Under this act to be recognized as a trademark a mark should have the following features:

- a) It should be distinctive and not deceptive or common names and surnames.
- b) A mark can be a logo, picture, three-dimensional figure, etc.
- c)The mark should be similar to an already registered trademark.
- d)the act provides for a remedy for 'passing off' of the trademark. In the UK there has been a rise in cases relating to overlapping of trademark infringement along with copyright infringement and passing off. In the recent case of **Lidl v Tesco (2023)** the line between conscious, blatant infringement and deceptive infringement and passing off became thinner as Tesco used a sign of yellow circle on a blue square background like the one used by Lidl products thus causing confusion in the minds of the customers and taking unfair advantage of

¹³ Hermes International vs Rothschild (2023), Hermes

¹⁴ Abitron Austria vs. Hetric International

the repute of another brand under section 10(3) of the Trademark Act. Also, Tesco was accused of infringing the copyright along with the trademark of Lidl, and as Lidl has established a good reputation in the market the act of Tesco caused an unfair advantage to it at the cost of reputation and goodwill of Lidl. Tesco was held liable for the trademark infringement.

Conclusion and the way forward:

Trademarks are an important intellectual property and with the changing nature of technology, the concept of trademark is seeing an upgrade and changes. Trademark is a dynamic sphere of Intellectual property, and it is very important that the laws are in sync with the changing dynamic of the world. With the introduction of AI and virtual reality, the trademark has witnessed an overlap with patent and copyright and thus several previously laid down regulations have been put to the test for a developing country like India it is very important that new regulations are laid down in a holistic manner.



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