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Introduction

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Preface

The Indian Journal of Legal Affairs and Research is a testament to our unwavering commitment to excellence in legal scholarship. This volume presents a curated selection of articles that reflect the diverse and dynamic nature of legal studies today. Our contributors, ranging from esteemed legal scholars to emerging academics, bring forward a rich tapestry of insights that address critical legal issues and offer novel contributions to the field. We are grateful to our editorial board, reviewers, and authors for their dedication and hard work, which have made this publication possible. It is our hope that this journal will serve as a valuable resource for researchers, practitioners, and policymakers, and will inspire further inquiry and debate within the legal community.

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Description

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POST-LIMITATION REMEDIES AGAINST DECLARATION OF WELL-KNOWN TRADEMARKS UNDER RULE 124(4) OF TRADEMARKS RULES, 2017.

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I. ABSTRACT

The recognition and identification of a trademark as a "Well-known" trademark according to Trade Marks Act, 1999, bestows a unique position of the mark based on its classification under Sections 11 (6) and 11 (7), and the process is governed by Rule 124 of Trade Marks Rules, 2017. The grant of this status has large commercial ramifications as it brings certain special legal rights, such as increased enforcement rights and inter-class protection. Accordingly, the process of obtaining this status and later challenging the same will have considerable commercial implications. Rule 124(4) procedurally provides an opportunity to lodge third-party objections within a limited period of thirty days, following which there seems no further remedy available under the Rules. This procedural silence pertaining to the post-grant review creates a lack of certainty for the anguished parties who failed to act within the narrow time-frame of thirty days, due to various reasons. In this paper, the discussion focuses on whether the end of this period makes the declaration absolute and unassailable, and discusses the various options open to a third party who is aggrieved. Using a doctrinal method of analysis based on applicable statutes and judicial precedents, the paper shows how the lack of an explicit process of post-declaration remedy against such a "Well-known" grant does not preclude the exercise of an option to appeal or seek a Writ of Jurisdiction. The assertions advanced in this paper are fundamentally based in case law research, relying on judgments and relevant discussions of the Delhi High Court, Calcutta High Court, and the IPAB. Thus, the paper opines that the need for legislative elucidation regarding the post-grant process is absolutely crucial for proving clarity and confidence to all necessary parties concerning their respective trademarks.

II. KEYWORDS

Well-Known Trademark, Rule 124(6) of Trade Marks Rules, Post-Declaration, Post-Grant Review, IPAB, Registrar of Trade Marks, Writ Jurisdiction.

III. SUBSTANTIVE QUESTION

"What is the remedy available under the Trademarks Act, 1999, to challenge the status of well-known trademark granted by the Trademark Registry, categorically when the time to raise objection has been expired under Rule 124 (4) of Trademark Rules."

IV. ANALYSIS & FINDINGS

1. Legal Nature of a "Well-Known" Trade Mark

A Well-known trade mark possesses a strong reputation among its consumer groups that its usage elsewhere would create an apprehension of a trade affiliation with the actual owner of the mark, in an ordinary man's mind. The legal nature of a well-known trademark, viewed through the lens of finality and appealability, is best characterised as non-conclusive, and inherently revisable. The recognition of a particular mark as being "Well-known" should not be considered as a final determination inter-parties but only an administrative or judicial declaration of an existing mark based upon facts and evidence present at the given point of time. The Bombay High Court in the case of "***TikTok Limited v. Registrar of Trade Marks***"[1]. has clarified that such recognition is purely discretionary on the part of an appropriate authority and is solely grounded on relevant, even supervening, circumstances and does not preclude future objections.

The statute also precludes finality as per rule 124(6) Trade Mark rules under which the Registrar may strike out a mark as being well-known following an inquiry. As can be seen, this rule allows for the revocation of a well-known status which is frequently referred to in "*Kamdhenu Ltd. V Registrar of Trade Marks*". In other words, well-known trademark status, although inherently authoritative in character, is never exempted from being open for future challenge.

[1] TikTok Ltd. v. Registrar of Trade Marks, 2025 SCC OnLine Bom 2323 (Bombay High Court, June 10, 2025).

2. Analysing Rule 124(4) of Trademark Rules, 2017.

Rule 124 (4): "Before determining a trademark as well-known, the Registrar may invite objections from the general public to be filed within thirty days from the date of invitation of such objection."[2]

Rule 124(4) of the Trade Marks Rules, 2017 regulates third-party participation in the determination process of a well-known trademark status, provided that such participation is bound to a procedural limit. Certain blogs have expressed that this mechanism is largely administrative and is alien to the adjudicatory framework of the Trade Marks Act, 1999 as it is fundamentally distinct from opposition or rectification proceedings, as it does not confer a statutory right to be heard. They have also observed that this objection stage is meant to prevent over-extension of trademark monopolies and to ensure that trans-class protection is granted only after adversarial scrutiny.[3]

The form of the Rule 124(4) demonstrates that the lack of objections does not make the decision final but only closes the window for that process. Yet, the rules remain silent regarding the available post-decision remedies when such window stands shut.

3. Post-limitation Remedies to Challenge a Well-Known Status of a Trade Mark.

3.1. <u>Representation U/ Rule 124 (6) of Trade Mark Rules, 2017.</u>

(6)"The Registrar may, at any time, if it is found that a trademark has been erroneously or inadvertently included or is no longer justified to be in the list of well-known trademarks, remove the same from the list after providing due opportunity of hearing to the concerned party."[4]

Though Rule 124(6) doesn't directly provide for any procedure for a third party to participate, one can safely infer the legitimacy of the right based on judicial precedents . In ***"Pernod Ricard India Pvt. Ltd. v. Controller General of Patents, Designs and Trade Marks"[5]***, the appellant, being the aggrieved party, *"submitted a representation to the Registrar to grant an opportunity of hearing in the proceedings" (para 3).* The

[2] Trade Marks Rules, 2017, r. 124(4) (India).
[3] T. Prashant Reddy, *The 'Well Known' Trademark Under the New Trade Mark Rules, 2017*.
[4] Trade Marks Rules, 2017, r. 124(6) (India).
[5] Pernod Ricard India Pvt. Ltd. v. Controller General of Patents, Designs and Trade Marks, 2011 SCC OnLine IPAB 48 : [2011] IPAB 47 (IPAB, September 12, 2011).

IPAB assumed that the filing of such a representation was a legitimate practice of the trademark administration and did not raise any issue regarding the maintainability of such a proceeding. Digging furthermore into the same decision, the Board held that *"justness requires us to consider whether by restoration any third party would be prejudiced,"* further elaborating *"the Registrar correctly afforded the appellant to take part in the TM12 and TM13 proceedings."* The above mentioned is consistent with Rule 124(6), where the Registrar is empowered to withdraw any erroneous or incorrect declaration of a mark as being well known after duly hearing the matter, notwithstanding the procedural silence in the Rule, thereby indicating that such a representation can be made.

3.2. Appeal under Section 91 of Trade Marks Act, 1999.

(1)"Any person aggrieved by an order or decision of the Registrar under this Act, or the rules made thereunder may prefer an appeal to the Appellate Board within three months from the date on which the order or decision sought to be appealed against is communicated to such person preferring the appeal."

Section 91 of Trade Marks Act, 1999 offers the possibility of challenging the orders made by the Registrar under Rule 124. There is an explicit precedent for the same, as illustrated in the case of "***Kamdhenu Ltd. v. Registrar of Trade Marks***"[6], where the Delhi High Court took cognizance of an appeal raised against the Registrar's refusal to declare the trademark as being well-known. At the outset, the Court expressly noted the maintainability of the appeal, observing that –

"1. The present appeal has been filed by the Appellant-M/s Kamdhenu Ltd. under Section 91(1) of the Trade Marks Act, 1999…challenging the impugned order …. passed by the Respondent No. 1-Registrar of Trade Marks, New Delhi under Rule 124 of the Trade Mark Rules, 2017"(para 1).

On merits, the Court examined the Registrar's decision and found that the rejection was unsustainable. The Court held that *"30.…The Appellant is given an opportunity to file a supporting affidavit…31… Thereafter, the Registrar shall afford a hearing to the*

[6] Kamdhenu Ltd. v. Registrar of Trade Marks, C.A.(COMM.IPD-TM) 66/2021, 2023 SCC OnLine Del 3446 (Delhi High Court, July 6, 2023).

Appellant and decide the said application in accordance with law" (paras 30–31). Accordingly, the decision of the Registrar was set aside, and the Court concluded that *"The present appeal is allowed and disposed of in the above terms." (para 32*), hence finding direct support herein.

This paper sets out that the above decision clearly illustrates that an order made by the Registrar under Rule 124 amounts to a "decision or order", as per Section 91. It follows that if an appeal can be filed against the denial of well-known status, it should equally apply when the same is recognized, rendering appeal a legally tenable remedy.

In **"*Dunlop International Limited v. Glorious Investment Limited*"[7],** the appeal directly contested the decision by the Deputy Registrar that the grant of well-known status to the supposed mark "DUNLOP", was coherent. The Calcutta High Court categorically observed that *"the mark 'Dunlop' is not a well-known trade mark within the meaning of Section 2(1)(zg) of the Act, nor is the mark on the list of well-known marks presently maintained under Rule 124 of the Trade Mark Rules, 2017" (para 18)*. The Court further held that the impugned orders were "unreasoned and unsubstantiated". In addition to the above, the Court found the impugned orders to be "unreasoned and unsubstantiated". For this reason, the Court quashed the impugned orders. Thus, regardless of whether it is an order for refusal or granting of the well-known status of the trademark, the appeal could be considered as maintainable.

3.3. <u>Writ Petition under Article 226 of The Indian Constitution</u>

Considering the limited statutory remedies available to challenge the grant of well-known trademark status by statute, it would seem that writ jurisdiction conferred by Article 226[8] emerges as a last expedient where the basis of such challenge is confined to the grant of such status and not to its registration itself. There appears to be no statutory scheme which would serve to create a constructive appellate route against the publication of a mark as well-known pursuant to Rule 124(5). While an appeal may lie against refusal, ambiguity persists in cases where the status has been granted. In such

[7] Dunlop International Ltd. v. Glorious Investment Ltd., MANU/WB/1330/2025, (2025) 2 CALLT 491 (HC) (Calcutta High Court, June 11, 2025).
[8] India Const. art. 226.

circumstances, writ jurisdiction becomes pertinent, especially when grievances are in connection with procedural unfairness or lack of an effective hearing.

The maintainability of a writ petition contesting against a well-known trademark status was precisely evaluated in ***"Kent Cables Pvt. Ltd. v. Union of India"***[9] where the petitioners filed a writ seeking *"(2)…to set aside the publication in Trade Mark Journal… whereby the Respondent No. 3's trade mark 'KENT' has been advertised as included in the list of well-known trademarks under Rule 124 (5)" (para 2)*. The respondents objected to maintainability, arguing that a writ petition would not lie against such an advertisement/publication… except before the High Court of Bombay and that *"the alternative remedy of filing an appeal under Section 91… exists".* However, the Court did not dismiss the petition on this ground but decided to confine its scrutiny to jurisdictional issues arising from the facts, particularly whether the cause of action arose in Delhi or Bombay. The question of writ maintainability per se was thus left open and yet to be decided.

Nevertheless, courts have ruled that a writ petition can be filed for any action taken by the Registrar in exercising the powers under any statute, provided there is some kind of a grievance concerning the use of such statutory power. This proposition of law was reiterated in "**J.L. Mehta v. Registrar of Trade Marks"**[10] **,** which ruled that writ intervention may be invoked in instances of procedural irregularity or jurisdictional error. Also, in the context of trademark law, it needs to be noted that availability of another remedy per se does not preclude writ jurisdiction. Upon analysing of all above sources, one can arrive at the conclusion that a writ petition contesting the grant of well-known trademark status is maintainable subject to the facts of every case, only upon exhaustion of other available remedies; which in this instance, are absent.

[9] Kent Cables Pvt. Ltd. v. Union of India, W.P.(C)-IPD 30/2023 (High Court of Delhi Aug. 11, 2023).
[10] J.L. Mehta v. Registrar of Trade Marks, MANU/MH/0144/1962, AIR 1962 Bom 82 (Bombay High Court, January 11, 1961).

CONCLUSION

The expiry of the objection period under Rule 124(4) does not confer a final right to a well-known trademark declaration. As demonstrated by this paper, failure to provide any post-limitation relief and remedy does not necessarily connote that no other legal recourse exists.

Three alternative courses of action are available for an aggrieved third-party. First, making a representation to the registrar under Rule 124(6). Although not explicitly allowed under the Rules, filing a representation is another course that is recognized by the judiciary as one that flows out of the powers of the registrar to correct his own erroneous inclusion. The appeal provided under Section 91 against the decision of the registrar under Rule 124 of the Rules in Kamdhenu and Dunlop International provides a proper remedy, and there is absolutely nothing in law preventing such a remedy from being extended to declarations as well. Failing both these remedies, the constitutional remedy of Article 226, as recognized even implicitly by Kent Cables, can be relied upon.

The aforementioned remedies clearly demonstrate that a well-known status may be modified and, hence, does not suggest an absolute nature. This fact is obvious both in respect of the statute as a whole and specifically from the perspective of Rule 124(6), which provides that the Registrar shall have the power to remove a trademark from the register if it was registered mistakenly or no longer requires registration.

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