

## **DILUTION OF TRADEMARKS AND PROTECTION IN INDIA**

This article fully pictures the present legal protection given to the well known trademarks in the territory of India. Well known trademarks are also a kind of intellectual property that needs protection beyond geographical limits. Normally trademarks are territorial in nature. But with internationalization of trade and commerce and with the shrinking global territory in area of trade has developed complex socio legal issues with regard to well known or famous trademarks.

A well known trademark is diluted when the use of similar or identical trademarks in other non-competing markets means that the trademark in and of itself will lose its capacity to signify a single source. In other words, unlike ordinary trademark law, dilution protection extends to trademark uses that do not confuse consumers regarding who has made a product. Instead, dilution protection law aims to protect sufficiently strong and well known trademarks from losing their singular association in the public mind with a particular product. (I.e. when we speak of Coca Cola we remember only the soft drink. Similarly when we speak of Rolls Royce, Benz we associate it with the car alone but when somebody else uses a similar mark like Rolls Royce or Benz for a chocolate, then the mark will remind two products in the minds of the consumer)

Dilution is sometimes divided into two related concepts: blurring, or essentially basic dilution which blurs a mark from association with only one product to signify other products in other markets (such as “Kodak Shoes”); and tarnishment, which is the weakening of a mark through unsavory or unflattering associations. Not all dilution protection laws recognize tarnishment as an included concept.

Dilution of well known or famous trademark is a wrong committed to the proprietor of the trade marks and also creates less awareness among the consumers who would associate the mark with two entirely different products when they think of a well known trademark.

The following concluding points are put forth after a clear analysis of the provisions of present Trademarks Act of 1999 and also the practicalities involved in the protection of well known trademarks in India.

- ❖ The definitions, the criteria for well known marks, registration of the well known marks are similar to that of the laws of other countries like Japan, USA, and UK

etc. The extent of protection varies under the Domestic laws of each country. Lack of effective protection from dilution under the national laws creates an ambiguity among the owners of the unregistered well known trademarks regarding the infringements of their marks and remedies for it.

- ❖ There is a imminent necessity to increase the protection given to the well known trademarks from dilution; as dilution eats away the value of the trademark than merely resulting in the likelihood of confusion. Separate registration of the well known trademark and separate registers need to be maintained. The considerations that need to be taken in to account by the Registrar while determining whether a mark is well known or not should be similar to the requirements for registration of the well known trademarks under other state laws. On line publication of the registered well known marks and easy access to it will create the much needed awareness among the consumers in our country about the type of goods traded by the proprietor of the famous mark and avoid the irrelevant association of products from the minds of the consumers. But still the chances of dilution of the unregistered famous marks exists leaving room for the habitual infringers to maneuver the investments and to take a free ride on the long built goodwill of the famous marks.
- ❖ Defensive marks is a kind of protection that is offered to well known trademarks that is associated by the people with particular good or service. Defensive marks registration will be necessary for well known marks that have not registered itself in the class of goods it is not trading with. When a well known mark brings a passing off suit in India and has been declared by the court as well known trademark it should be allowed to register itself in the class of goods it is not trading with. This would help the owners of the famous marks to initiate infringement suits in those classes even though he is not trading in those goods and also against dilution of the marks.
- ❖ Separate anti dilution statutes should be drafted with all legal clarifications that are ambiguous in the Trademarks Act of 1999. This necessity has been recognized earlier in the developed nations like USA, UK and Japan etc. USA in the year 1997 passed the Federal Anti dilution Act. This shows the concern and

importance of giving anti dilution protection to famous marks registered or unregistered.

- ❖ The conflict between the domain names and standard IP rights raises challenging policy questions. The growing number of cyber squatting (abusive registration of domain names that violate trademark rights) disputes reflects the premium business are placing the domain names and their potential for facilitating electronic commerce. There is always a threat to owners of the famous marks from cyber squatters who are readily exploiting them by registering well known trademarks as their domain names and demanding unreasonable price for returning the same to the legitimate owner. This type of practice has been condemned by the WIPO committee and suitable provisions have been incorporated in the treaty. The prevailing problem in the present Indian legislation on trademark is that it didn't contain any provisions relating to the infringement of the famous marks under the garb of domain names. The same should be incorporated to protect the interests of the owner and the consumers.
  
- ❖ If the marks similar to the famous trademarks are applied to goods of remote nature, people thinking of that mark would recall two different products to their mind. The individual association of the product with that of the well known trademark will be lost. This is called the dilution of the mark. It will lead to erosion of the good will and the investment in the business developed by the owner of the mark putting all his efforts in vain.

With this it can be concluded that concept of dilution of well known trademarks needs to be embedded in a legal enactment to create awareness among the traders and consumers and to decrease the number of infringements and guarantee quality goods to the consumers. The new Trademark Act 1999 is a step forward in prevention of dilution but still the contemporary Indian scenario necessitates for a separate legal enactment for prevention of dilution and to meet the standards of protection in the international level.

Article by

S.S.Karthikeyan., B.Sc.,B.L.,M.L.,

JURY BRAIN LAW OFFICES