
THE COMPARATIVE STUDY OF TRADEMARK LAW: INDIA V. INTERNATIONAL STANDARDS

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ABSTRACT:

Trademarks have an important function to protect brand identity, consumer confidence and honest competition in a highly globalized world. This paper examines the comparative analysis of trademark law in India and global standards and how domestic legal systems interact with international commitments under agreements like the TRIPS Agreement, the Paris Convention, and the Madrid Protocol. The Indian Trade Marks Act, 1999 forms the basis of protection of marks but issues such as transborder reputation online infringement and counterfeiting still pose challenges to be resolved. Analyzing the seminal Indian decisions such as Cadila Healthcare Ltd. v. Caldila Pharmaceuticals Ltd. and comparing them with foreign jurisprudence the paper identifies both convergence and divergence of approaches. The paper also examines the extent of protection available to well-known marks, the treatment of non-conventional trademarks and the available mechanisms for enforcement in cross-border cases. Particular emphasis is placed on WIPO's role and harmonization initiatives that balance international trade with national interests. The paper concludes that although India has well aligned its trademark regime with international best practices, specific socio-economic realities necessitate a sensitive approach that retains local interests while promoting global competitiveness.

Keywords: *Trademark law, TRIPS agreement, trade mark act 1999, brand protection, Madrid protocol.*

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I. Introduction:

Trademarks now are not simply identifiers of brands they are vital tools of commerce and competition in the world economy. They confer business entities with identification, goodwill and exclusivity and at the same time protect consumers against deception and confusion. In India the law of trademarks is regulated mainly by the Trade Marks Act, 1999. Which harmonized Indian trademark jurisprudence with international obligations under the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement). Internationally trademark law is influenced by multilateral agreements like the Paris Convention for the Protection of Industrial Property (1883) and the TRIPS Agreement (1994) in addition to local legislation like the Lanham Act 15 U.S.C. 1051–1141n (1946) in the United States and the Trade Marks Directive in the European Union. The Indian Supreme Court in *Cadila Health Care Ltd. v. Cadila Pharms. Ltd.*, (2001) 5 S.C.C. 73 (India) reiterated the fact that trademark law does not aim just to protect the rights of traders but also consumer well-being. Likewise, the Supreme Court of the United States in *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995) granted protection to non-traditional marks like colors illustrating the expanding scope of protection under international standards of trademark. This paper makes a comparative analysis of trademark law in India in comparison with international practices looking into similarities differences challenges and the way forward.

II. Literature Review:

It is seen from scholarly contributions concerning trademark law that there exists a dynamic tension between national autonomy and global convergence. Some have provided an account of India's post-colonial transition toward its TRIPS-compliant law, while others note comparative aspects between Indian and international norms. P. Narayanan, in *Law of Trade Marks and Passing Off* (6th ed. 2017), offers a detailed doctrinal history of Indian trademark law, from its evolution in 1940 to 1999. He notes how English common law has had a dominant impact upon Indian case law, most famously in passing off law. Cornish and Llewelyn in *Intellectual Property: Patent, Copyright, Trade Mark and Allied Rights* (9th ed. 2019) adopt a comparative analysis, considering how globalization has eroded territorial boundaries, so that TRIPS' uniform minimum standard of protection is needed. Their text once again highlights how trademarks today are not just rights in law, but economic values in an era of knowledge economy. Shamnad Basheer, *India's Tryst with TRIPS: The Compliance Conundrum*, 10 J.

Intell. Prop. Rts. 425 (2005), is a critical analysis of India's law reforms in TRIPS compliance. Basheer shows that India has legislated in TRIPS compliance, but there is poor enforcement as a result of delay by judges and lack of effective administrative infrastructure. Internationally, *The TRIPS Agreement: Drafting History and Analysis* by Daniel Gervais (4th ed. 2012), refers to how TRIPS brought about a paradigm shift in terms of including intellectual property rights in the international trade regime. He points out how developing countries are hard-pressed when trying to strike a balance between domestic policy interests and international commitments. Analysis of case law is also a significant component of the work. Indian cases like *Cadila Health Care Ltd. v. Cadila Pharms. Ltd.*, (2001) 5 S.C.C. 73 (India), and *Daimler Benz Aktiengesellschaft v. Hybo Hindustan*, A.I.R. 1994 Del. 239 (India), exemplify a tendency in the Courts to move towards protecting consumers. International judgments like *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995), and *Apple Inc. v. Samsung Elecs. Co.*, [2013] EWCA (Civ) 451 (U.K.), reflect a broadening of trademark protection beyond traditional marks and a contemporary role for trade dress in branding. The law as a whole shows that though India has considerably progressed in converging itself toward international standards, there are loopholes in enforcement, awareness, and registration of non-traditional marks. This opens the platform for a comparative study of trademark law's substantive provisions.

III. Historical Development of Trademark Law:

1. Evolution in India:

The earliest foundation of trademark law in India was based upon English common law rules of passing off. Under such a rule, a trader was able to institute injunctions against those who posed their goods as those of the claimant, in order to preserve goodwill. The rule was borrowed from cases such as *Perry v. Truefitt*, (1842) 6 Beav. 66, 49 Eng. Rep. 749 (Ch.), in which it was held by Lord Langdale M.R. that "a man is not to sell his own goods under the pretence that they are goods of another. It was introduced by means of the Trade Marks Act, 1940, as was the English Trade Marks Act, 1938. The 1940 act was, however, narrow in scope and failed to keep pace with modern commercial needs. The act was replaced by the Trade and Merchandise Marks Act, 1958, which harmonized legislation concerning trademarks, trade, and service marks. The 1958 act broadened registration sections, yet its effectiveness in addressing globalization and novel methods of marks was brought in doubt. The watershed was India's entry into the World Trade Organization (WTO) in 1995 and its consequent TRIPS

obligations that ensued from it. This led to the enactment of the law in the Trade Marks Act, 1999, No. 47 of 1999, India Code (1999). The 1999 Act ushered in a sequence of reforms:

- i. Expansion of definition of trademarks in § 2(1) (zb) to include shapes, packs, and colour combinations.
- ii. Recognition of service marks.
- iii. Introduction of collective marks and certification marks.
- iv. Provisions for well-known marks under § 11.
- v. Introduction of the Madrid Protocol for international registration.

Thus, our legislation in India progressed from a colonial emulation to a TRIPS-compatible modern act, although struggling in enforcement.

2. Evolution in International Law:

This internationalization of trademark law begins with the Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, 828 U.N.T.S. 305. This embedded core principles of:

National treatment giving foreign nationals an equivalent level of security as internal citizens.

Right of priority such that applicants will have their earliest filing date in a member country when filing in other member countries.

The Madrid Agreement for International Registration of Marks, Apr. 14, 1891, 828 U.N.T.S. 389, facilitated multinational registrations through a single registration. Nonetheless, it was not widely joined, and so, a successor, Madrid Protocol, June 27, 1989, 28 I.L.M. 1645, was adopted, providing wider flexibility and wider participation, including India in 2013. The most fundamentally transformative instrument has been the TRIPS Agreement, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299. Minimum levels of intellectual rights enforcement and protection, such as trademarks, have been embedded in the international trade regime for the very first time. TRIPS imposed:

- i. Protectable subject matter under Art. 15 (including signs that are able to distinguish

goods/services).

- ii. Prior rights of trademark owners under Art. 16.
- iii. Compulsory protection of well-known marks.
- iv. Effective enforcement procedures.

In the EU, national laws were aligned by means of the Trade Marks Directive 2015/2436, 2015 O.J. (L 336) 1, whereas EU-wide registration was regulated by EU Trade Mark Regulation 2017/1001, 2017 O.J. (L 154) 1, which is regulated by the European Union Intellectual Property Office (EUIPO). In the United States, the Lanham Act, 15 U.S.C. §§ 1051–1141n (1946), is still the foundation of trademark protection under federal law, interpreted broadly by courts, as in *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995).

3. Substantive Provisions: A Comparative Study:

1. Definition and Coverage of Trademarks:

In India, the Trade Marks Act, 1999, defines a trademark broadly in § 2(1) (zb) as "a mark capable of being represented graphically and capable of distinguishing the goods or services of one person from those of others." This not only encompasses classical marks such as words and logos, shapes of products, packages, colour combinations, etc., but anything that may distinguish goods or services of a person from goods or services of others. The Supreme Court in *Cadila Health Care Ltd. v. Cadila Pharms. Ltd.*, (2001) 5 S.C.C. 73 (India), upheld that the very essence of a trademark is to avoid confusion in consumers' minds. Globally, TRIPS Art. 15 takes a similar definition, where any sign capable of distinguishing goods/services may serve as a trademark, if it is able to be depicted in registers. The Lanham Act, 15 U.S.C. § 1127, broadens such scope in the U.S., where courts have embraced non-traditional marks such as sounds (*In re General Electric Broadcasting Co.*, 199 U.S.P.Q. 560 (T.T.A.B. 1978)) and colours (*Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995)). The EU Trade Mark Regulation 2017/1001, art. 4, similarly welcomes such non-traditional signs, subject to distinctiveness. Thus, India's definition is akin to TRIPS but still experiences practical challenges in accepting non-traditional marks due to evidentiary as well as administrative constraints.

2. Registration and Acquisition of Rights:

India has a registration system, where sole rights are derived by registration under the 1999 Act. However, passing off actions in the nature of common law are available regardless of registration, as was affirmed in *S. Syed Mohideen v. P. Sulochana Bai*, (2016) 2 S.C.C. 683 (India). It is not permitted under TRIPS Art. 15(3), to refuse registration where a mark is not distinctive per se, if there is a likelihood of acquiring distinctiveness through use. Use-based rights as well as registration-based rights, in a federal system, are granted in U.S. Lanham Act. EU has registration as a predominant factor, whereas acquired distinctiveness is a determining criterion for accepting descriptive or unconventional marks. India's strict reliance on registration makes its system more rigid compared to the U.S., where use-based rights are deeply entrenched.

3. Rights Granted to Proprietors:

Under § 28 of the Indian Trade Marks Act, registration secures exclusive right to the proprietor to use the mark in respect of goods/services and to remedy infringement. The Act is also receptive to collective and certification marks under §§ 61–68, reinforcing consumer confidence in standards of quality. Internationally, TRIPS Art. 16 prescribes that trademark proprietors will have exclusive right to restrain third parties from adopting similar or identical marks where such use would result in a confusion among consumers. The Lanham Act, 15 U.S.C. § 1114, grants similarly broad rights, e.g., against dilution (§ 1125(c)) irrespective of confusion. EU law is a step beyond, as it grants such protection against unfair advantage or prejudice to distinctive character/reputation, as enshrined in Directive 2015/2436, art. 10(2). Indian law has lagged in accepting anti-dilution protection, though there have been judgments accepting it in *Daimler Benz Aktiengesellschaft v. Hybo Hindustan*, A.I.R. 1994 Del. 239 (India), where it was held that "Benz" was so well-established it must have protection against confusion.

4. Infringement and Passing Off:

In India, infringement is defined in §§ 29–30 of the 1999 Act. The cases involve use of identical/similar marks likely to cause confusion. Nevertheless, passing off continues as a separate remedy for unregistered marks. The *Cadila Health Care* (2001) cases emphasized a wider consumer-oriented confusion test, particularly in cases relating to pharmacy. TRIPS Art.

16 requires members to give protection against likelihood of confusion, whereas the Lanham Act makes a distinction between infringement (§ 1114) and unfair competition (§ 1125(a)), and includes passing off as well. The EU system also gives title protection against identical/similar marks under art. 10 of Directive 2015/2436. Notable comparative observation: while India is yet left with dual remedies (statutory infringement and passing off at common law), transnational regimes increasingly concentrate these in well-integrated unfair competition regimes.

5. Remedies

India provides civil relief (injunctions, damages, account of profits, delivery up of infringing goods) under §§ 134–135 and criminal relief under §§ 103–105, including imprisonment and penalties against counterfeiting. Nonetheless, criminal enforcement in India has been widely condemned as ineffective against poor conviction rates. Effective enforcement by members is mandated in TRIPS Part III in the form of injunctions, damages, and border measures. Treble damages and statutory damages for counterfeiting are in 15 U.S.C. § 1117 in the United States. The EU has effective civil remedy, which is harmonized in Directive 2004/48/EC (Enforcement Directive). Compared to India, its solutions are great in theory but deficient in enforcement in practice. The international frameworks, specifically the U.S., have stronger deterrent solutions, for instance, high statutory damages.

IV. Non-Traditional Trademarks:

1. Concept and Global Recognition:

In the past, trademarks were limited to words, symbols, and logos. The globalisation and innovations in marketing have, however, broadened the trademark jurisprudence to non-traditional marks such as colours, smells, sounds, shapes, movements, and smells. International law recognizes such protection. TRIPS Art. 15(1) states that "any sign... capable of distinguishing" goods or services can be a trademark. The open-ended description has enabled courts like those in the United States and European Union to recognize non-traditional marks. In the United States, the Lanham Act, 15 U.S.C. § 1127, neither limit trademarks to traditional designs. Courts have held:

Colours: (Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159 (1995)) – green-gold for press

pads.

Sounds: (In re General Electric Broadcasting Co., 199 U.S.P.Q. 560 (T.T.A.B. 1978)) – NBC chimes.

Scents: (In re Clarke, 17 U.S.P.Q.2d 1238 (T.T.A.B. 1990)) – plumeria-scented sewing thread.

At the European Union, the EU Trade Mark Regulation 2017/1001, art. 4, specifically covers sounds, movements, multimedia, and holograms. Registration mandates that the mark must be feasible to be depicted in a clear and precise manner, keeping in line with guidelines in *Sieckmann v. Deutsches Patent- und Markenamt*, Case C-273/00, 2002 E.C.R. I-11737 (ECJ), which disallowed smell marks for lack of precision.

2. Indian Position on Non-Traditional Marks

The Trade Marks Act, 1999, broadened the definition of trademarks in § 2(1) (zb) to encompass shapes of goods, packaging, and colour combinations. This extension of legislative provision brought India into compliance with TRIPS requirements. Practical acceptance, though, continues to be modest.

Colours: Indian courts have also exercised restraint. While standalone colours struggle with registration for insufficient distinctiveness, combinations can be registered insofar as they can identify goods.

Shapes: Covered under § 2(1) (zb), but restricted under § 9(3), which bars shapes that are a consequence of the nature of goods or conferring substantial value to goods.

Sounds: India has begun to permit sound marks since 2010 (Rule 26(5), Trade Marks Rules 2002, amended 2017). The initial registered sound mark was Yahoo!'s yodel in 2008 (*Yahoo! Inc. v. Akash Arora*, 78 D.L.T. 285 (Del. 1999), although the case itself was on domain name passing off).

Smells and Taste: Not yet known, primarily because they cannot be represented graphically.

Judicial interpretation is limited. In *Gorbatschow Wodka KG v. John Distilleries Ltd.*, 2011 (47) P.T.C. 100 (Bom.) (India), the Bombay High Court extended protection to the bottle shape of the distinctive vodka, demonstrating guarded receptivity to trade dress protection.

3. Comparative Analysis:

Breadth of Recognition: U.S. and EU have extended recognition to colour, sounds, and in certain instances, smells. India is confined largely to shapes, colours (with effort), and sounds (few cases only).

Graphical Representation Requirement: Indian law continues to insist on graphical representation, limiting smells/tastes. EU dropped this requirement in 2017, opting for a more lenient standard ("clear, precise, and accessible representation").

Judicial Attitude: Indian courts continue to be conservative, reluctant to grant protection to abstract marks. U.S./EU courts positively enlarge the scope to keep pace with changing business practices.

4. Implications for India

The restricted grant of non-traditional marks in India is an indication of legislative intent/administration/judicial implementation discrepancy. In order to compete in the international market, Indian trade needs to see the evolution of the law consistent with global trends by Embracing adaptable standards of representation (something other than graphical). Improving examination techniques at the Trade Marks Registry. Spreading awareness among entrepreneurs regarding non-traditional brand assets.

V. International Treaties and India's Compliance:

1. Paris Convention (1883)

The Paris Convention for the Protection of Industrial Property, 1883, was the first comprehensive international instrument acknowledging trademarks as intellectual property. It brought in fundamental principles:

National Treatment: Every member state has to accord the same protection to foreign applicants that it accords to domestic applicants (Art. 2).

Right of Priority: A claimant in one member state can assert priority elsewhere if applications are made within six months (Art. 4).

Independence of Protection: Registrations in one country are independent of others (Art. 6).

India's Position: India became a member of the Paris Convention in 1998. India's Trade Marks Act, 1999, incorporated these tenets under §§ 154–157, with a view to reciprocity and foreign applicants' priority rights.

2. TRIPS Agreement (1994)

Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), within the WTO system, is the most far-reaching IP treaty.

Applicable provisions for trademarks:

Art. 15: Any symbol capable of distinguishing goods/services can be a trademark (wide scope).

Art. 16: Exclusive rights to avoid third parties' use of identical or confusingly similar signs without authorization.

Art. 18: Minimum registration period = 7 years, renewable in perpetuity.

Art. 20: No unjustifiable encumbrances on the use of trademarks.

India's Compliance:

The 1999 Act was passed primarily to fulfil India's obligations under TRIPS. Enlarged the definition of trademarks (§ 2(1) (zb)) to cover shapes, packaging, colour combinations. Established well-known trademark protection (§ 11(6)–11(9)). Strengthened enforcement remedies: civil remedies (§ 135), criminal sanctions (§§ 103–105). However, India departs on scope of non-traditional marks (narrower recognition) and enforcement (slower judicial procedures).

3. Madrid Protocol (1989)

The Madrid Protocol facilitates international trademark registration centrally via WIPO. The applicant can make application in their home office and mention several member states. Position of India: India acceded in 2013. Trade Marks (Amendment) Act, 2010, and Trade Marks Rules, 2013 incorporated Madrid provisions.

Indian applicants can apply via the Indian Trademark Registry, which will relay to WIPO.

Foreign applicants may indicate India for protection.

Impact: Strong growth in international filings identifying India, a measure of international business interest. But Indian Registry delay in examination and opposition proceedings has been criticized.

4. Other Treaties and Developments:

Nice Agreement (1957) India adopted the Nice Classification of goods and services (45 classes).

Vienna Agreement (1973) India adheres to Vienna Classification of figurative elements of marks.

Singapore Treaty on the Law of Trademarks (2006) India not ratified, although partial harmonization in reforms under Trade Marks Rules, 2017.

VI. Conclusion:

The development of Indian law of trademarks shows a gradual process of harmonization with global norms while holding on to distinctive local nuances. From its origins in colonial law through to the Trade Marks Act, 1999, India has incorporated provisions compliant with TRIPS, acknowledged well-known marks, and adhered to the Madrid Protocol for international registration. Case law such as Cadila Health Care and Daimler Benz demonstrates a consumer-centric approach, although delay in enforcement and restricted acknowledgment of non-traditional marks continue to be ongoing issues. Internationally, such as in the Paris Convention, TRIPS, and EU laws, broad and flexible protection is stressed across the board, particularly for non-traditional trademarks, whereas in the United States, doctrines such as dilution and strong remedies are developed. In contrast, Indian policy is conservative and is marked by a conflict between international convergence and internal socio-economic realities. As a whole, India has made great strides toward conformity with global best practices, but strong enforcement, efficient administration, and broader use of new branding techniques are essential in the future. By improving institutions and responding to international innovations,

India can manage local interests while ensuring global competitiveness and establishing itself as a leading player in the changing terrain of trademark law.

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