
RELATION BACK AS A PRINCIPLE, NOT A FICTION: REVISITING SECTION 34 OF THE TRADE MARKS ACT, 1999

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ABSTRACT

When it comes to disputes under Section 34 of the Trade Marks Act, 1999, the doctrine of relation back should be applied, but with some limitations. This doctrine is basically a rule that fixes the legal date of registration, and it shouldn't be used to harm someone who was using a trademark in good faith before the registration. There are several things to consider here:- Section 23 of the Act which uses this deeming fiction, similar uses of this doctrine in other areas of law, like civil procedure, property succession, and Hindu adoption, where things can be made to apply retroactively as long as they don't override anyone's pre-existing rights. Additionally, the case of *Neon Laboratories* gives importance to prior use. Section 23(1) of the Act is relevant when it comes to delays in prosecution, opposition, and renewal. However, a cautious approach appreciated because if we use the relation back doctrine too strictly, it could lead to problems like trademark trafficking, blocking, hoarding. The case of *American Home Products v Mac Laboratories* is an example of this. This is a complex problem with lots of moving parts, and we need to consider all of them carefully.

Keywords: relation back principle, prior use, trademark trafficking, Trade Marks Act, 1999, Section 34, vested rights

Introduction

The relation back doctrine is a legal fiction which advocates that an act carried out at a later point in time is, by operation of law, regarded as having effect from an earlier date. It is often given effect to prevent injustice caused by delay or procedural failure. Section 34 of the Indian Trade Mark Act, 1999 (herein referred as “Act”) acknowledges the vested rights arising from the use of the trademark. The language of the provision refers to the “date of registration” of the registered mark. This is where the question arises whether the doctrine of relating back of a trademark registration to the date of its application should be applied to cases involving the prior use defense under section 34 of the Act. If the doctrine is applied in its purest form, the registered proprietor’s rights are treated as existing from the date of its application. This means a prior user will have to prove its use prior to that earlier filing date, not the later date of registration, raising the evidentiary threshold. Hence, it will narrow the scope of the prior use defence. On the other hand, if the doctrine is not applied under section 34, the rights of the applicant will only arise from the date of registration. This may create some issue. The purpose of filing an application under the Act is to claim priority over the mark. If the relation back doctrine is not applied, the claimant may not be able to claim rights over the mark until the date of registration, which may give third parties the opportunity to adopt similar mark during the pendency period. This may allow a later user of the mark to take advantages of the delay in the registration process. This weakens the position of a diligent applicant who has taken timely steps to secure protection of his mark, in relation to someone who entered later but starts using the mark before the registration is granted to the earlier user. Hence, this article maintains a balanced approach while adopting relating back doctrine under section 34 of the Act.

Applying The Doctrine of Relating Back

Now let us discuss the applicability of this doctrine by the legislature itself. Section 23 of the Act is one such example where doctrine of relation back is applied under the Act. This deeming fiction exists to avoid the delay in trademark prosecution. If the law treated the date of grant of certification as decisive, the applicant would be prejudiced by Registry delay, and priority would ultimately depend on administrative speed rather than legal order. Courts have therefore treated the application date as the legal date of registration. The Bombay High Court again in *Drums Food*¹ clarified that the expression “date of registration” under section 34(b) of the Act must mean date of application for registration. It clearly stated that “...*The date on which a*

¹ *Drums Food International Pvt. Ltd v. Euro Ice Cream and Anr*, (2012) 49 PTC 224.

mark is considered to be registered must be the same for infringement or for a passing off action. It would otherwise lead to conflicting orders in actions for infringement on the one hand and passing off actions on the other, which could never have been the intention of the Legislature...” In my view, court rightly interpreted the provision to prevent harm to the registered proprietor.²

Further, this article examines the use of relation back doctrine in other branches of law as well. In CPC, an amendment under Order VI Rule 17 may relate back to the date of filing of the plaint. The purpose is to avoid multiplicity of proceedings and to ensure that technical defects do not defeat the substantial justice. The doctrine is applied under the Hindu Succession Act, 1956 to trace back the inheritance rights of legal heirs of a person from the date of the death of a person. In Property law, under section 47 of the Transfer of property Act, 1882, a registered document operates from the date of execution and not from the date of registration. This is done to protect parties from delays in registration process. In Hindu Adoption law, relation back doctrine is applied to treat an adopted child to be the child of the adoptive parents from the date of adoption.³ The proviso limits this doctrine to protect vested rights. It is to be noted, that the doctrine is never applied absolutely, without any limitations. Thus, the common principle is that relation back is permissible so long it does not take away any pre-existing rights. In light of this, the deeming fiction under section 23 of the Act should be used to fix priority in time, not take away the independent protection granted by section 34 of the Act to a bona fide prior user.

Section 34 of the Act serves as a carve out for prior users. It starts with expression “nothing in this Act” shall entitle the registered proprietor to interfere with the rights of a prior user. The Supreme Court in *S. Syed Mohideen v Sulochana Bai*⁴ held that the rights of prior user are superior to that of registered owner. Thus, rights of a prior user will override subsequent user, even when the subsequent user is registered proprietor. The *Neon Laboratory*⁵ case stressed on the “first in the market” principle. It does not abolish relation back doctrine, rather it prevents relation back from operating against an earlier bona fide continuous user. This position was followed in the recent Delhi High Court decision of 2025.⁶ Further, the 2026 Bombay High

² Merck KagA v Natco Pharma 2012 SCC OnLine Bom 2331 followed the same proposition.

³ The Hindu Adoption and Maintenance Act, 1956, § 12, No. 78, Acts of Parliament, 1956 (India).

⁴ 2015 SCC OnLine 1084.

⁵ Neon Laboratories Ltd v. Medical Technologies Ltd & Ors 2015 SCC OnLine 905

⁶ The Trustees of the Princeton University v The Vagdevi Educational Society & Ors, FAO(OS) (COMM) 239/2023

Court order also provided that the defendant must show continuous and bona fide prior commercial use by supporting evidence.⁷

The Challenges Faced

It is important to also discuss the issues which might arise if the doctrine of relation back is applied in too strict sense. The major issue which may arise is trafficking of trademarks, which means the act of buying, selling or dealing in trademarks as a tradable asset, without treating it as source identifier of the goods or services it is registered for. Another problem which may arise is of trademark hoarding which essentially refers to the practice of registering multiple trademarks without any bona-fide intent of using them. It is often done to block others from using the mark or gain commercial benefit from it. If the relation back principle is applied too rigidly, the filing trademark becomes important than actually using it, which encourages the practice of hoarding. This allows the applicants to block market entry for genuine users of the mark, simply by filing first. The decision in *American Home*⁸ concerned with trademark trafficking and bona fide intention to use the mark. The Court observed that the intention to use the trademark must exist at the date of filing application and such intention must be genuine and bona-fide. The ratio drew on section 46(1) of the Trade Marks Act, 1940, (now section 47 of the Act) which meant to prevent trademark trafficking and held that a person cannot be permitted to use the trademark when he is not intending to use it with relation to such goods and services. If doctrine of relation back were strictly followed in section 34, it would allow a party to file application without bona fide commercial purpose, sit on the mark, and then use the filing date as a shield against a later honest adopter of the mark.

Hence, relation back must only be used to protect genuine applicants from delay, not allow for trademark hoarding or blocking. Therefore, there might arise two circumstances: (a) first, if relation back is altogether rejected, registry delay would grant protection to an intervening adopter; and (b) second, if it is applied absolutely, mala fide user would defeat genuine prior users. The scheme of the statute rejects both the extremes. Accordingly, a balanced approach needs to be adopted, which recognises the value of relation back for priority and certainty, but also protect genuine prior users. If it is applied too strictly, the right becomes paper-based right; if it is not applied at all, the filing system loses value. So, the law should use relation back for certainty, but also keep section 34 strong to ensure fairness to genuine users.

⁷ Ms Siyaram Silk Mills Ltd v Ms Stanford Siyaram Fashion Private Ltd & Ors, 2026:BHC-OS:1037.

⁸ American Home Products v Mac Laboratories, MANU/SC/0204/1985.

Conclusion

In light of the aforesaid discussion, the correct preposition would be that relation should be recognised in section 34, but only in limitation. The purpose should be to fix the date of registration and not defeat a genuine prior user. So, the correct position should be that if the defendant is found to be using the mark earlier and continuously, then it must be granted protection under section 34, even against a registered proprietor. But if the defendant has been found to commence the use only after the application of the plaintiff was filed, then registered proprietor can afford the benefit of relation back and claim priority from date of filing application.