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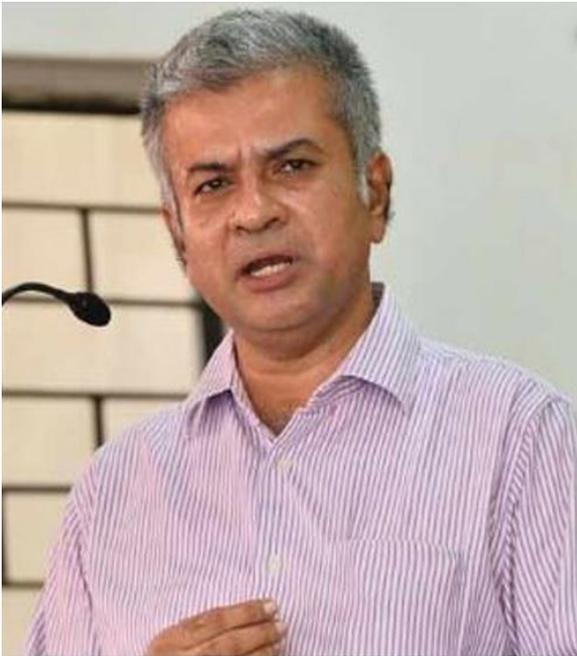
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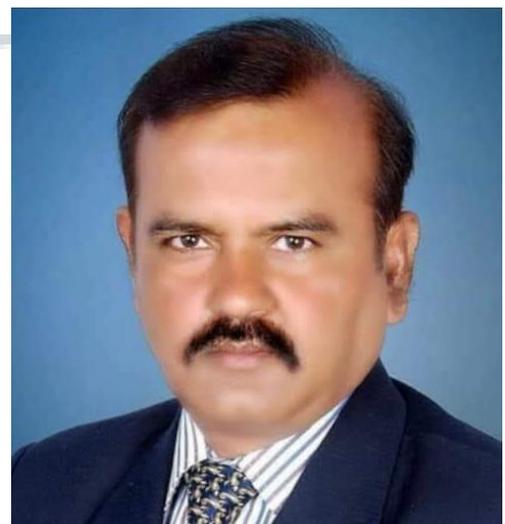


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With this thought, we hereby present to you

# **TRANS-BORDER TRADEMARK REPUTATION IN INDIA: EVOLVING EVIDENTIARY THRESHOLDS IN THE DIGITAL AGE**

AUTHORED BY - ADV. PRIYANKA KUMARI

## **Abstract**

Trans-border trademark reputation remains one of the most dynamic and debated areas within Indian trademark jurisprudence. As globalization and digital commerce dissolve traditional market boundaries, courts face the challenge of balancing territorial trademark principles with the realities of cross-border consumer awareness. This paper examines the conceptual trajectory of trans-border reputation in India—from early judicial endorsements of the universality principle to the more stringent territoriality-focused approach advanced in recent Supreme Court and High Court decisions. Special attention is given to the modern evidentiary requirements that foreign brand owners must satisfy to secure protection in India, drawing from landmark cases including *Whirlpool Corporation v. N.R. Dongre* (1996), *Toyota Jidosha Kabushiki Kaisha v. Prius Auto Industries* (2018), and recent 2024 decisions such as *Hind Rectifiers Ltd. v. Chrome21 India Pvt. Ltd.* and *Marvel Tea Estate India Ltd. v. Gurukirpa Traders*.

## **1. Introduction**

The doctrine of trans-border trademark reputation reflects a tension between the territorial nature of trademark rights and the increasingly globalized character of modern commerce. As foreign brands gain visibility in India through digital advertising, tourist exposure, and international media, the judiciary has been compelled to reconsider traditional territorial doctrines in intellectual property law.

The central inquiry is:

**How should Indian courts assess and protect the reputation of foreign trademarks that have not yet established substantial commercial presence in India?**

This paper explores how Indian courts have adapted evidentiary standards to ensure that trans-border reputation is recognized where genuinely warranted, while preventing unjustified

monopolies by foreign entities lacking real market impact in India.

## **2. Research Issue: Modern Evidentiary Thresholds for Trans-border Trademark Reputation in India**

The key research question is:

**How has the Indian judiciary's interpretation of trans-border reputation evolved with global commerce, and what evidentiary requirements must foreign brand owners meet to obtain protection against passing off or infringement in India today?**

Resolving this requires a doctrinal comparison between the **universality principle** and the **territoriality principle**, assessed in light of recent jurisprudence responding to digital globalization.

### **3. Evolution of Judicial Doctrine**

#### **3.1 Early Approach: Universality of Reputation**

The Supreme Court first articulated a broad doctrine of trans-border reputation in *Whirlpool Corporation v. N.R. Dongre*. In this case, the Court held that:

- International advertising and global circulation of magazines were sufficient to prove reputation in India,
- No local sales, registrations, or physical presence were necessary to assert passing-off rights.

This marked judicial recognition of the international mobility of goodwill.

#### **3.2 Shift Toward Territoriality: *Toyota Prius* (2018)**

A major doctrinal shift occurred in *Toyota Jidosha Kabushiki Kaisha v. Prius Auto Industries Ltd.* The Supreme Court held that:

- Foreign trademark owners must prove **actual spill-over** of reputation into India as of the date of the defendant's adoption;
- Global fame alone is insufficient;
- Evidence must demonstrate **real consumer recognition in India**, not speculative goodwill.

This ruling restored the centrality of territoriality in Indian trademark law and raised the evidentiary threshold significantly.

## **4. Recent Judicial Developments (2023–2024)**

### **4.1 *Hind Rectifiers Ltd. v. Chrome21 India Pvt. Ltd.* (Bombay High Court, 2024)**

In 2024, the Bombay High Court granted interim relief to the plaintiff based on:

- Demonstrated customer recognition in India,
- Market presence in specialized industrial sectors,
- Likelihood of confusion.

The Court reaffirmed that **localized goodwill**—not international renown—is essential to securing protection.

### **4.2 *Marvel Tea Estate India Ltd. v. Gurukirpa Traders* (Delhi High Court, 2024)**

In a matter concerning dilution and unrelated goods, the Delhi High Court held that:

- Digital visibility and online reach could support a claim,
- But reputation must show **tangible impact on Indian consumers**,
- Extensive local evidence justified the injunction.

This illustrates a modernized but stricter evaluation of trans-border reputation within the digital ecosystem.

## **5. Current Judicial Principles**

### **5.1 Dominance of the Territoriality Principle**

Contemporary decisions uniformly emphasize:

- Primacy of Indian consumer perception,
- Inapplicability of the “first in the world” doctrine (except limited contexts),
- Necessity of **hard evidence** demonstrating spill-over reputation into India.

### **5.2 Limited Exception: Pharmaceutical Trademarks**

Courts exhibit greater flexibility in pharmaceutical cases due to:

- International scientific exchange,
- Public health implications,
- Likelihood of cross-border recognition among medical professionals.

Thus, pharmaceuticals enjoy a modified universality principle, though still anchored in consumer protection.

## **6. Evidentiary Standards in the Modern Context**

Indian courts now expect robust, India-specific proof of reputation, including:

### **A. Primary Evidence**

- Sales figures and invoices showing Indian market activity,
- India-specific market surveys,
- Distribution agreements and business correspondence.

### **B. Secondary / Digital Evidence**

- Social media engagement among Indian users,
- Website analytics tied to Indian IP addresses,
- Evidence of actual consumer confusion or inquiries.

### **C. Insufficient Evidence**

Courts generally discount:

- Global advertisements not shown to reach Indian audiences,
- International press coverage without India-specific relevance.

This marks a clear departure from the more permissive standards in *Whirlpool*.

## **7. Comparative Doctrinal Analysis**

<b>Case</b>	<b>Principle</b>	<b>Present Relevance</b>
<i>Whirlpool v. Dongre</i> (1996)	Universality; international advertising sufficient	Broad early protection; persuasive but not controlling
<i>Toyota Prius</i> (2018)	Territoriality; must prove spill-over into India	Governing standard; heightened scrutiny
<i>Hind Rectifiers</i> (2024)	Local goodwill + reputation	Confirms <i>Toyota</i> ; demands India-specific evidence
<i>Marvel Tea Estate</i> (2024)	Dilution + digital reputation	Digital presence relevant but must show Indian impact

## **8. Analysis: Theoretical and Practical Implications**

### **8.1 Need for Territorial Evidence**

Courts remain cautious to:

- Prevent “trademark squatting” by foreign entities lacking Indian presence,
- Avoid unfair monopolies based solely on global renown.

## 8.2 Digital Commerce Challenges

Digital commerce complicates territoriality because:

- Global ads reach Indian audiences incidentally,
- Consumers are exposed to foreign marks without deliberate targeting.

Courts therefore require proof that Indian consumers specifically associate the mark with the foreign owner.

## 8.3 Balancing Competing Interests

Courts strive to balance:

- Protection of genuine foreign brand owners,
- Encouragement of domestic enterprise,
- Prevention of opportunistic copying.

Modern standards ensure protection only where foreign reputation is **real and substantial** within India.

## 9. Conclusion

Indian jurisprudence on trans-border trademark reputation has evolved from the broad universality doctrine in *Whirlpool* to the more nuanced, territorially grounded approach in *Toyota Prius*. The evidentiary threshold for foreign brand owners is significantly more demanding today.

To secure protection, claimants must show:

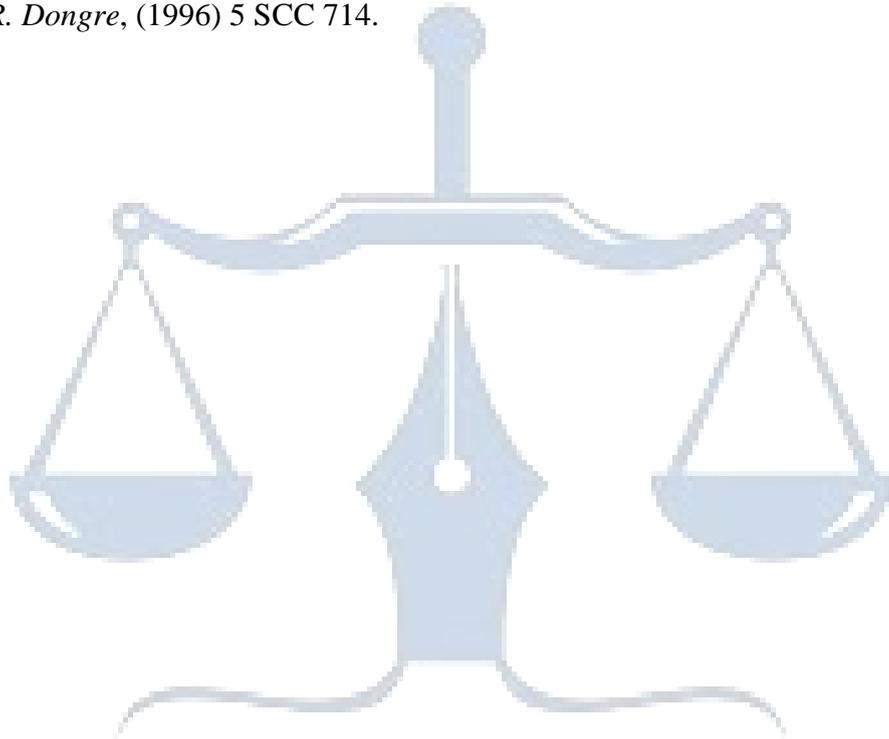
- Demonstrable consumer recognition in India,
- Tangible market spill-over,
- Real likelihood of confusion.

Recent 2024 decisions reinforce that digital presence or global fame alone is insufficient. Courts prioritize evidence showing genuine impact on Indian consumers. This balanced approach protects legitimate foreign interests while safeguarding domestic commercial activity, ensuring that trademark law remains aligned with both global realities and territorial principles.

## References:

1. *Whirlpool Corp. v. N.R. Dongre*, (1996) 5 SCC 714.
2. *Toyota Jidosha Kabushiki Kaisha v. Prius Auto Indus. Ltd.*, (2018) 2 SCC 1.

3. *Hind Rectifiers Ltd. v. Chrome21 India Pvt. Ltd.*, 2024 SCC OnLine Bom \_\_\_\_ (Bombay High Court).
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5. See *Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.*, (2001) 5 SCC 73.
6. *Toyota Prius*, (2018) 2 SCC 1.
7. *Prius Auto*, id.
8. *Milmet Oftho Indus. v. Allergan Inc.*, (2004) 12 SCC 624.
9. *N.R. Dongre*, (1996) 5 SCC 714.



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