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FROM MARKS TO MEANING:

THE EVOLVING SCOPE OF TRADEMARK PROTECTION IN INDIA

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Introduction

For most of the twentieth century, a trademark was understood narrowly: a word, a logo, or a device that told a buyer who made a product. Indian trademark law, built on the Trade Marks Act, 1999, still begins from that simple premise i.e., a "mark" capable of distinguishing the goods or services of one undertaking from another.[1]

But a string of recent developments, both in India and abroad, shows that the scope of protection has quietly outgrown the sign itself. Regulators and courts are increasingly protecting something less tangible than a logo, that is the commercial identity, reputation, and consumer trust that a business builds around its brand, wherever and however that identity is invoked: in a scent, in a search-engine keyword, in a beauty trend, or in a name adopted in bad faith. This article traces that shift from marks to meaning, through India's statutory framework, its international treaty commitments, and a set of recent rulings that illustrate how far the boundary of "trademark use" has moved.

I. The Statutory Starting Point: What the Trade Marks Act Protects

Section 2(1)(zb) of the **Trade Marks Act, 1999** defines a trademark broadly enough to accommodate this evolution: a mark capable of being represented graphically and of distinguishing goods or services, which may include the shape of goods, their packaging, and

[1]Trade Marks Act, No. 47 of 1999, India Code (1999), § 2(1)(zb).

combinations of colours. The Act does not confine "**mark**" to words and logos; it leaves room for any sign that performs the distinguishing function which is a deliberate openness that has since permitted registrations far removed from conventional word or device marks.

Registrability, however, is conditioned by Section 9, which bars marks that are devoid of distinctive character, that consist exclusively of descriptive indications (kind, quality, geographical origin, and the like), or that have become customary in the trade, subject to the proviso that acquired distinctiveness or well-known status can cure this. Section 11 layers on relative grounds of refusal: a mark cannot be registered if it is identical or similar to an earlier mark and creates a likelihood of confusion, and Section 11(2) extends special protection to well-known marks even across dissimilar goods, where use would take unfair advantage of, or be detrimental to, the earlier mark's distinctive character or repute. Section 11(10)(ii) additionally directs the Registrar to weigh bad faith on the part of either the applicant or the opponent. It is a provision that, as discussed below, has become central to disputes over prior adoption.

Once registered, Section 17 confers exclusivity only in the mark "taken as a whole," denying separate monopoly over descriptive or common trade elements bundled within it. And infringement under Section 29 is drafted expansively: it covers not just affixing a mark to goods, but using it on business papers, in advertising, or in a manner that takes unfair advantage of a mark's reputation (Section 29(8)) or is detrimental to its distinctive character. This last provision, largely overlooked for years, has become surprisingly relevant to disputes that have nothing to do with counterfeit labels and everything to do with metadata and search rankings.

II. The International Architecture Behind Indian Law

India's domestic scope of protection cannot be read in isolation from the international commitments that shaped it. The Paris Convention for the Protection of Industrial Property (1883) was the first attempt to internationalize industrial property protection, and Article 1(2) defines "industrial property" broadly enough to cover trademarks, service marks, trade names, and the repression of unfair competition in not merely goods in the narrow sense, but the wider commercial context in which they are sold.[2] Article 6bis obliges member countries

[2]Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, as revised at Stockholm, Jul. 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305, art. 1(2).

to refuse or cancel registrations, and to prohibit use, of marks that reproduce or imitate a mark already well known in that country . It the doctrinal root of what Indian law now expresses through Section 11(2). Article 6ter protects state emblems and official hallmarks from appropriation as trademarks, and Article 6quinquies (the "telle quelle" rule) requires member states to accept for registration, largely as filed, a mark already registered in its country of origin, subject to limited exceptions for descriptiveness, prior rights, or public order.

India was historically not a signatory to the Paris Convention itself, but its accession to the TRIPS Agreement (Trade-Related Aspects of Intellectual Property Rights), concluded at Marrakesh in 1994 as part of the Uruguay Round that created the WTO, effectively imported Paris Convention obligations by reference.[3] TRIPS Section 2 (Articles 15–21) sets the substantive floor for trademark protection among WTO members, where Article 15 defines protectable subject matter which broadly includes any sign, or combination of signs, capable of distinguishing goods or services, including words, personal names, letters, numerals, figurative elements and colour combinations; Article 16 extends the Paris Convention's well-known-marks doctrine to services and to dissimilar goods where a connection with the registered proprietor would be presumed and damage is likely; Article 18 fixes a minimum term of protection of seven years, renewable indefinitely; and Article 21 bars compulsory licensing of trademarks while preserving the owner's right to assign a mark independently of the underlying business. Indian trademark law, particularly after the 1999 Act replaced the 1958 statute, was substantially harmonised with these standards.

It is worth correcting a common conflation here: India applies the Nice Classification for categorising goods and services, and Vienna Classification principles are used in examining figurative or device marks, but India is not a contracting party to either the Nice Agreement or the Vienna Agreement. **Practical use of a classification system is distinct from treaty membership, and the two should not be treated as interchangeable when describing India's international trademark commitments**.

[3]Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, 1869 U.N.T.S. 299, 33 I.L.M. 1197 (1994).

Where India has gone further than mere TRIPS compliance is the Madrid Protocol, which it joined in 2013.[4] The Madrid System, administered by WIPO, allows an Indian trademark holder to file a single international application through the Trade Marks Registry, designating any number of the roughly 100 members of the Madrid Union (covering some 116 countries and, by some estimates, over 80% of world trade flows), rather than filing separately in each jurisdiction, in each language, under each domestic procedure.[5] Designated members must raise objections within an 18-month window, failing which protection is deemed granted as though registered nationally; and once secured, renewals, assignments, and modifications can be centrally managed through WIPO rather than piecemeal across offices. For Indian exporters there is a fact of particular relevance since many of India's largest trading partners, including the United States, the United Kingdom, Germany, and China, are Madrid Union members is that, this converts trademark protection from a costly jurisdiction-by-jurisdiction exercise into something closer to a single administrative filing. The shift from Paris-era territoriality, where a mark's protection stopped strictly at a nation's border, to a Madrid-enabled system of coordinated multi-territorial protection, is itself part of the “from marks to meaning” story: what is being protected is no longer a registration in one country but a brand's identity across an entire trading network.

III. New Sensory Frontiers: Smell as a Trademark

Nowhere is the expansion of “what counts as a mark” more visible than in the recent acceptance of India's first olfactory trademark. On 21 November 2025, the Trade Marks Registry accepted for advertisement a rose-like scent applied to tyres, in an application filed by Sumitomo Rubber Industries Ltd. of Kobe, Japan (Trade Mark Application No. 5860303, filed 23 March 2023, for goods in Class 12).[6] The Controller General of Patents, Designs and Trade Marks held that the scent satisfied the statutory test under Sections 2(1)(zb) and 9 of the Act. The mark was shown, through a scientific report placing it on a *multi-axis olfactory model*, to be sufficiently unique and capable of objective representation for registration purposes.

[4]Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, Jun. 28, 1989, 2003 U.N.T.S. 217 (India acceded 2013).
[5]Eur. Union Intell. Prop. Off. & Dep't of Indus. Pol'y & Promotion, Gov't of India, The Madrid Protocol: A Route to Global Branding 6–7 (Jan. 2018).
[6]In re Sumitomo Rubber Indus. Ltd., Trade Mark Application No. 5860303 (Controller Gen. of Patents, Designs & Trade Marks, India, order dated Nov. 21, 2025).

This is a significant conceptual leap. A smell cannot be seen or drawn in the way a logo can, and unlike sound marks (which can be represented as musical notation), scent had, until now, resisted the kind of "graphical representation" contemplated by Section 2(1)(zb). The Registry's willingness to accept a scientific olfactory model as an adequate representation signal that Indian trademark practice is prepared to extend registrability to non-conventional marks so long as the underlying test of distinctiveness and objective representability is met which is mirroring, in spirit, the flexibility that Article 15 of TRIPS leaves to member states in defining what "signs" are eligible.

At the same time, a decision of the District Court of The Hague in a dispute between Burberry and the fragrance company Petite Mort offers an instructive counterpoint: even where a scent itself is not, or cannot yet be, protected as a trademark, the commercial identity built around that scent remains protectable through conventional trademark and unfair-competition principles.[7] Petite Mort had marketed a perfume using language such as "inspired by" a well-known Burberry fragrance, while embedding the name of Burberry's product in website metadata so that search engines surfaced Petite Mort's listing to consumers searching for the original. The Dutch court held that appending a disclaimer like "inspired by" does not immunise a trader who takes unfair advantage of another's reputation and goodwill through such use. Read together, the Sumitomo registration and the Burberry decision suggest two complementary tracks along which sensory branding is now protected in India and comparable jurisdictions: direct registration of the sensory sign itself, where representability allows it, and indirect protection of the goodwill and reputation associated with it, through ordinary infringement and passing-off principles, where it does not.

IV. Distinctiveness Revisited: When a Trend Is Not a Trademark

If the smell-mark development shows protection expanding into new sensory territory, the Delhi High Court's decision in *Renee Cosmetics (P) Ltd. v. Rupali Sharma* shows the boundary being firmly held on the distinctiveness side.[8] The Court ordered cancellation of the registered mark "GLASS SKIN," holding that the phrase did no more than describe the result

[7]Burberry Ltd. v. Petite Mort, Rechtbank Den Haag [District Court of The Hague] (Netherlands) (as reported in trade-press commentary; official citation unavailable at time of writing — see Table of Authorities note).
[8]Renee Cosmetics (P) Ltd. v. Rupali Sharma, 2026 SCC OnLine Del 4593 (Del. H.C. June 5, 2026) (India).

a consumer expects from certain skincare products. Smooth, luminous, translucent skin, a description that had become part of the common vocabulary of the global beauty industry, largely through its origin as a recognised Korean skincare trend. Because the term informed consumers about the characteristics of the product rather than its trade origin, the Court held that it fell squarely within the descriptiveness bar of Section 9(1)(b).

The Court's reasoning is notable for its explicit rejection of the respondent's "suggestive mark" defence, which relied on the idea that a consumer must use some degree of imagination to connect a mark to the product's qualities. The Court found it would be "absurd" to suggest that a consumer encountering "GLASS SKIN" on a cosmetic product would need to imagine what the product promised to deliver. Where a term communicates its meaning immediately and without any interpretive leap, it functions as ordinary descriptive language rather than as a badge of origin, and no amount of first-mover registration converts it into private property. The ruling reinforces a foundational principle that runs through Section 9 and Article 15(1) of TRIPS alike: **a trademark protects the exclusive association between a sign and a single trade source, not the industry's shared vocabulary for describing a category of product or a consumer trend.** A business can build a brand around a trend and profit from being early to market it, but it cannot withdraw from the language pool of the words the rest of the industry needs to describe that same trend.

V. Priority, Prior Use, and Bad Faith

A further axis along which "meaning" has come to matter more than mere registration priority is illustrated by the Delhi High Court's decision in *S.S. White Burs Inc. v. Registrar of Trade Marks*, which considered what happens when a domestic party registers a mark identical to one already used and known internationally by a foreign proprietor.[9] The Court found that the Indian registrant's adoption of the identical "S.S. WHITE" mark — including a "slavish imitation" of the proprietor's stylised device — was dishonest and undertaken with knowledge of the foreign proprietor's prior rights, and that the registration had additionally been procured through suppression of material facts before the Registry. The Court held the registration liable to be set aside under Section 11(10)(ii) of the Act, the provision directing the Registrar (and, by extension, the courts) to weigh bad faith in trademark disputes.

[9]S.S. White Burs Inc. v. Registrar of Trade Marks, C.O. (COMM.IPD-TM) 448/2022 (Del. H.C. Apr. 25, 2026) (India).

The ruling reiterates that registration priority under the Act is not an absolute shield. Prior use, actual knowledge of another's rights at the time of adoption, accumulated goodwill, and the broader circumstances surrounding how and why a mark was chosen can all outweigh the bare fact of who filed first. For businesses operating or planning to operate across borders, the practical lesson is unambiguous: trademark rights, being territorial, do not automatically follow a brand into a new market, and the gap between a brand's international reputation and its formal registration in a given country is precisely the space in which bad-faith registrations tend to occur. Early search, registration, and monitoring are not simply administrative housekeeping, they are what stands between a business and the risk of losing control over its own name in a market it has not yet formally entered.

VI. Digital Use and the Hidden Infringement

The Burberry–Petite Mort dispute, beyond its relevance to sensory branding, also crystallises a broader point about where trademark risk now lives. Petite Mort's own branding and packaging bore no resemblance to Burberry's. The infringing use lived instead in metadata, hidden search tags, and product descriptions designed to attract consumers already searching for the well-known fragrance. This is a form of use that a consumer inspecting the product page as displayed might never see, yet it operates precisely to divert the commercial advantage of another's reputation.

Indian law is reasonably well equipped to address this kind of use. Section 29(6) defines “use” of a mark to include affixing it to goods, offering goods or services under it, and using it “on business papers or in advertising”, the language broad enough to capture use embedded in metadata, search-engine keywords, and product descriptions, none of which requires physical affixation to a product. Section 29(8) goes further, treating advertising of a registered trademark as infringing where it takes unfair advantage contrary to honest commercial practices, is detrimental to the mark's distinctive character, or is against its reputation, a provision tailored almost precisely to comparative or keyword-based advertising practices. As commerce migrates from shelves to search results, the operative question for a brand is no longer confined to whether its logo or packaging has been copied, but whether its name has been deployed: visibly or invisibly, to capture demand generated by another's goodwill.

VII. Building and Defending Brand Value Across Borders

The final thread connecting these developments is the recognition, made explicit in Tesla Inc.'s trademark dispute with the Indian battery manufacturer Tesla Power India (P) Ltd., that a trademark is not merely a registration certificate but an accumulating IP asset representing reputation, customer trust, and commercial value, one that businesses expanding into new jurisdictions must secure before, not after, market entry, given the strictly territorial nature of trademark rights.[10] Tesla's suit, filed before the Delhi High Court after Tesla Power India continued using the "Tesla" name and logo despite a cease-and-desist notice, and despite Tesla's own pending Indian applications and registrations in numerous other jurisdictions, illustrates precisely how a gap between global reputation and local registration can be exploited by a domestic party, the same vulnerability seen in the *S.S. White dispute* above. Early clearance searches, prompt registration, ongoing IP due diligence, and continuous monitoring are the practical tools available to convert a brand's accumulated meaning into an enforceable legal right in each market it touches, precisely the function that instruments like the Madrid Protocol were designed to make administratively feasible for Indian businesses looking outward, and that Sections 9, 11, and 29 of the domestic Act are designed to protect for foreign and Indian businesses alike looking in.

Conclusion

Read together, these developments - a scent accepted for registration on the strength of a scientific model, a popular beauty term stripped of protection for being merely descriptive, a first-to-file registration set aside for bad faith, and an infringement finding built on hidden metadata rather than a copied logo like describing a single underlying trend. Indian trademark law, operating within a statutory text that has remained largely stable since 1999 but interpreted against an international architecture running from the Paris Convention through TRIPS to the Madrid Protocol, is increasingly concerned not with the physical form of a mark but with the commercial meaning it carries: the association, built through use, investment, and reputation, between a sign, whatever its sensory or technical form ,and a single trade source.

The scope of protection has not so much widened arbitrarily as it has followed meaning wherever meaning has come to reside- in a scent, in a search tag, in a name adopted with

[10]Tesla Inc. v. Tesla Power India (P) Ltd., CS(COMM) 353/2024, 2024 SCC OnLine Del 4594 (Del. H.C.) (India).

knowledge of another's prior claim. From marks to meaning is not a departure from trademark law's traditional purpose; it is that purpose, applied to the ways brands are actually built, sold, and searched for today.

This commentary draws on Dr. B.L. Wadhera's account of the historical evolution of international intellectual property cooperation, from the Paris Convention through the Uruguay Round to the TRIPS Agreement, for the treaty background summarised in Part II.[11]

[11]B.L. Wadhera, Law Relating to Intellectual Property (Universal Law Publishing Co., New Delhi).

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