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A Critical Analysis on Trademark Infringement in Digital Age

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ABSTRACT

This study examines the evolution and current structure of trademark protection within Indian and international legal contexts, emphasizing its increasing relevance in the digital economy. Trademarks, traditionally used to distinguish goods and services, have transformed into vital economic assets that influence consumer trust and brand equity, particularly in online commerce. The discussion traces the historical development of trademark law from ancient usage to the formal codification under colonial and post-independence Indian statutes, culminating in the Trademarks Act, 1999. The Act, aligned with global standards under the TRIPS Agreement, provides comprehensive mechanisms for registration, enforcement, and protection, including the safeguarding of well-known marks and remedies for infringement.

Special focus is given to how traditional statutory provisions—particularly Sections 27, 29, 134, and 135—have been judicially adapted to address emerging forms of digital infringement such as misuse in domain names, social media handles, metadata, and online advertising. The analysis further explores the role of international treaties including TRIPS, the Paris Convention, and the Madrid Protocol in facilitating cross-border protection and enforcement. However, it is noted that while these frameworks are broadly inclusive, they often lack explicit provisions for modern digital challenges. The study concludes by highlighting the pressing need for legislative reform and global cooperation to strengthen trademark protection in the face of evolving digital threats, thereby laying the groundwork for further discussion on contemporary online infringement in subsequent study.

KEYWORDS

Trademark Law, Digital Infringement, Trademarks Act, Passing Off, Well-Known Marks, Cross-Border Enforcement, TRIPS Agreement.

INTRODUCTION

Trademarks, as an essential branch of intellectual property law, play a pivotal role in the modern economy by safeguarding the distinctive identity and reputation of brands. They serve not only as legal tools for distinguishing goods and services in the marketplace but also as instruments of consumer trust, business goodwill, and commercial integrity¹. In an era where brand recognition can determine market dominance, the strategic value of trademarks has never been more significant².

The legal protection of trademarks ensures that businesses can secure exclusive rights over their identifiers, prevent unfair competition, and combat deceptive practices that could mislead consumers³. As economies have globalized and commerce has increasingly moved online, trademarks have expanded beyond their traditional function as mere trade symbols⁴. They have become intangible assets—often more valuable than the physical products they represent—shaping consumer behavior and brand loyalty across borders.

The evolution of trademark law reflects these growing commercial realities⁵. From early legal systems that recognized marks informally to contemporary statutes and international treaties that provide extensive protection, trademark jurisprudence has steadily adapted to socio-economic changes. However, the emergence of the digital age has presented an entirely new set of challenges. In this digital ecosystem, where goods and services are marketed, sold, and consumed online, trademarks are no longer confined to labels or packaging—they are embedded in URLs, hashtags, metadata, domain names, digital ads, and virtual identities⁶.

¹ Ibid., at 6

² McCarthy, J.T., *McCarthy on Trademarks and Unfair Competition* 3 (Thomson Reuters, 5th edn., 2020).

³ Narayanan, P., *Law of Trademarks and Passing Off* 4 (Eastern Law House, Kolkata, 6th edn., 2017).

⁴ Bainbridge, D., *Intellectual Property* 327 (Pearson Education, 10th edn., 2018).

⁵ Kur, A. & Dreier, T., *European Intellectual Property Law: Text, Cases and Materials* 209 (Edward Elgar, Cheltenham, 2013).

⁶ Sharma, V., “Trademark Disputes in E-commerce: Liability of Intermediaries in India”, (2021) 17(1) *Indian Journal of Law and Technology* 44.

This study explores the historical trajectory of trademark law and assesses the core statutory and international legal frameworks that underpin trademark protection in India and globally⁷. It begins by tracing the origins and development of trademark regulation, especially the influence of British law in shaping early Indian statutes⁸. It then critically examines the Trademarks Act, 1999, which is the principal legal instrument governing trademark rights in India, analyzing its scope, key provisions, and enforcement mechanisms.

Further, the study investigates the role of international conventions and treaties, including the TRIPS Agreement, the Paris Convention, and the Madrid Protocol, in harmonizing trademark law across jurisdictions⁹. These instruments not only facilitate cross-border brand protection but also impose obligations on member states to ensure effective enforcement, especially in transnational and digital contexts.

Finally, the study delves into the digital adaptation of these traditional frameworks. As new technologies disrupt conventional notions of trademark use, protection, and infringement, legal systems are under increasing pressure to evolve. The adaptability—and at times, the inadequacy—of current statutes and treaties in regulating online trademark abuse is critically assessed, laying the foundation for subsequent studies that deal with emerging forms of infringement and the judicial response to these novel challenges¹⁰.

By providing this multi-layered legal context, the study sets the stage for a deeper understanding of how trademark law is situated within a rapidly transforming digital economy—and how it must be reimagined to safeguard brand rights in the future.

HISTORICAL DEVELOPMENT OF TRADEMARK LAW

The concept of trademarks is not a modern innovation but has deep historical roots that reflect the economic and social significance of commercial identity¹¹. The earliest known instances of trademark use can be traced back to ancient civilizations such as Egypt, China, and Greece, where potters, builders, and artisans inscribed unique symbols, monograms, or signatures on their goods to indicate origin and ensure

⁷ Ibid., at 45.

⁸ Narayanan, P., *supra* note 4, at 7.

⁹ TRIPS Agreement, 1995; Paris Convention, 1883; Madrid Protocol, 1989.

¹⁰ Kur & Dreier, *supra* note 7, at 218.

¹¹ Cornish, W., Llewelyn, D., & Aplin, T., *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* 1 (Sweet & Maxwell, London, 9th edn., 2019).

recognition¹². These marks served a dual purpose: they signified craftsmanship and enabled the tracing of responsibility for defects or inferior quality.

In medieval Europe, the evolution of trade guilds led to a more structured use of marks¹³. Guild members were often required to use distinctive emblems or signs to identify their work, thus establishing rudimentary forms of brand differentiation and quality assurance¹⁴. These practices, though informal, laid the groundwork for the legal recognition of commercial symbols as proprietary interests.

The modern legal framework for trademark protection began to take shape in the 19th century, primarily in response to the industrial revolution, which facilitated mass production and interstate commerce¹⁵. As goods began to travel far beyond their place of origin, there emerged a need to regulate the use of identifiers to protect both consumers from deception and producers from unfair competition. One of the earliest statutory landmarks was the British Trademarks Registration Act of 1875, which introduced a formal system of registration and provided for statutory remedies in cases of infringement.

The British legal influence was subsequently transplanted into colonial territories, including India¹⁶. The Indian Merchandise Marks Act, 1889 was one of the first legislative efforts to prohibit the falsification of marks and to criminalize the use of deceptive labels¹⁷. However, this legislation was primarily punitive and did not provide a detailed procedure for registration or civil enforcement. Recognizing the growing importance of commercial identity, the Trademarks Act of 1940 was enacted to align Indian law more closely with the British model, offering a more systematic approach to trademark registration and infringement redressal.

Following independence, the need for an indigenous and comprehensive legal framework led to the enactment of the Trademarks Act, 1958. This Act consolidated existing laws and provided mechanisms for registration, opposition, rectification, and enforcement of trademark rights. It marked a significant shift towards civil enforcement, allowing rights holders to seek remedies through civil courts rather than relying solely on

¹² Ibid., at 2.

¹³ Bainbridge, D., *Intellectual Property* 317 (Pearson Education, London, 10th edn., 2018).

¹⁴ Ibid., at 319.

¹⁵ Ibid., at 199.

¹⁶ Narayanan, P., *supra* note 3, at 7.

¹⁷ Ibid., at 8.

criminal proceedings¹⁸. However, even this Act was limited in its international scope and lacked provisions that addressed the challenges posed by transnational commerce and emerging technologies¹⁹.

The late 20th century witnessed a dramatic transformation in the global economic landscape, characterized by liberalization, globalization, and digitization. These developments necessitated a more robust, globally aligned legal regime. India's accession to the World Trade Organization (WTO) and its obligations under the TRIPS Agreement (1995) catalyzed a complete overhaul of its trademark legislation²⁰. Consequently, the Trademarks Act, 1999 was introduced to:

- Comply with international standards,
- Broaden the definition of trademarks to include service marks, shapes, packaging, and color combinations,
- Introduce well-known marks protection,
- Strengthen enforcement mechanisms, and
- Enable international registration via the Madrid Protocol (which India joined in 2013).

The 1999 Act also recognized the growing complexities of brand protection in an increasingly digital and borderless economy, although it did not specifically legislate for internet-based infringement²¹. The responsibility to address such issues has since fallen to the judiciary, which has interpreted existing provisions to apply them to digital platforms, e-commerce, and online advertising²².

Thus, the historical development of trademark law in India is a reflection of both colonial legacy and post-independence modernization, culminating in a legal structure that seeks to balance domestic commercial needs with international obligations²³. As the next section explores, this framework—though comprehensive on paper—faces significant challenges in

¹⁸ Narayanan, P., *supra* note 3, at 10.

¹⁹ Ibid., at 11

²⁰ TRIPS Agreement, 1995; Marrakesh Agreement Establishing the World Trade Organization.

²¹ Sharma, V., "Trademark Disputes in E-commerce: Liability of Intermediaries in India", (2021) 17(1) *Indian Journal of Law and Technology* 45.

²² *Yahoo! Inc. v. Akash Arora*, 1999 PTC (19) 201 (Delhi High Court); *Christian Louboutin SAS v. Nakul Bajaj*, CS(COMM) 344/2018 (Delhi High Court).

²³ Cornish, W. et al., *supra* note 1, at 13.

responding effectively to digital infringement, necessitating both judicial innovation and legislative reform.

STATUTORY PROVISIONS IN INDIA – THE TRADEMARKS ACT, 1999

The Trademarks Act, 1999 serves as the principal legislation governing trademark law in India, offering a comprehensive statutory framework for the registration, protection, and enforcement of trademark rights. The Act was enacted to consolidate and modernize trademark law in India in line with international standards, particularly those prescribed by the TRIPS Agreement under the World Trade Organization (WTO). It replaced the Trademarks Act of 1958 and significantly expanded the scope of legal protection to include new forms of marks, broadened the concept of infringement, and streamlined procedural rules for enforcement.

At the core of the Act is the definition of a trademark under Section 2(1)(zb), which describes it as:

“A mark capable of being represented graphically and which is capable of distinguishing the goods or services of one person from those of others...”

This definition encompasses a wide range of identifiers, including words, names, symbols, numerals, shapes of goods, packaging, and combinations of colors. It also explicitly covers service marks, a crucial inclusion in the era of digital services and online businesses.

KEY PROVISIONS RELEVANT TO DIGITAL INFRINGEMENT

While the Act was not drafted specifically with the digital environment in mind, several provisions are broad enough to be interpreted and applied to online contexts. The following sections are particularly relevant:

Section 29 – Infringement of Registered Trademarks

Section 29 of the Trademarks Act, 1999 forms the statutory backbone for the protection of registered trademarks in India. It provides a comprehensive and layered definition of what constitutes *infringement*, thereby offering trademark owners enforceable rights when their mark is used without authorization. Unlike common law remedies, Section 29 provides statutory relief and specific grounds under which infringement can be established in civil proceedings.

The section recognizes that infringement can occur through not

only direct imitation but also indirect association, dilution of goodwill, and misuse in unrelated industries, especially in the case of well-known marks. The provision is designed to balance consumer protection with fair market practices, and its interpretation has evolved in light of digital commerce and online branding dynamics.

Core Elements of Infringement under Section 29

Under this section, a person infringes a registered trademark if they use, in the course of trade, a mark that:

- Is identical or deceptively similar to the registered trademark;
- Is used in respect of goods or services for which the trademark is registered or for similar goods/services;
- Is likely to cause confusion or deceive consumers regarding the source or origin of the goods/services;
- Takes unfair advantage of the mark's distinctiveness or reputation.

The concept of "deceptively similar" is critical and has been judicially interpreted as a close resemblance that may confuse a person of average intelligence and imperfect recollection (*Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.*, AIR 2001 SC 1952).

This broad phrasing enables the courts to include **non-traditional uses** such as:

- Online advertisements that mimic or reference the trademark;
- Invisible uses such as metatags and backend coding;
- Hashtags incorporating the brand name;
- Embedded trademarks in digital product displays or app names.

Section 29(4) – Protection for Well-Known Marks Beyond Similar Goods

A significant advancement in Indian trademark law is encapsulated in Section 29(4), which addresses infringement even where the goods or services are dissimilar. This is particularly crucial in protecting the reputation and distinctiveness of well-

known marks.

The clause applies when:

- The registered trademark has a reputation in India;
- The infringing use, although for dissimilar goods or services, is without due cause;
- Such use takes unfair advantage of, or is detrimental to, the distinctive character or repute of the registered trademark.

This provision is extremely relevant in the digital domain, where trademark use often transcends product categories. For instance:

- A well-known fashion brand's name used as a domain name or Instagram handle by an unrelated business;
- A trademarked brand referenced as a keyword for online advertising by a competitor in a different industry;
- Use of a popular trademark in viral hashtags or memes, thereby diluting its serious brand image.

The phrase "without due cause" has also been broadly interpreted by courts to prevent opportunistic behavior—where infringers seek to ride on the reputation of a famous mark to attract attention or legitimacy.

APPLICABILITY TO DIGITAL INFRINGEMENT SCENARIOS

According to section 29, though drafted before the explosion of digital platforms, has been effectively interpreted by Indian courts to encompass a wide array of online infringement activities. Some notable applications include:

- **Search Engine Marketing (SEM):** Using a registered trademark as a keyword in pay-per-click (PPC) campaigns without the trademark owner's consent can mislead consumers, especially when the ad copy also imitates brand characteristics. This has been addressed in cases involving Google Ads, where courts have acknowledged the likelihood of initial interest confusion.
- **Domain Name Conflicts:** Courts have held that registering a deceptively similar domain name to divert web traffic from the legitimate brand constitutes infringement, as the domain name functions as a source identifier in the digital world (*Tata Sons Ltd. v. Manu Kishori*, 2001).

- **Social Media & Hashtag Misuse:** Use of trademarks in usernames, page titles, or promotional posts without authorization—especially for profit or competitive advantage—has been construed as “use in the course of trade.” Even hashtags that are embedded with brand names can be viewed as infringing if they mislead audiences or capitalize on a brand’s fame.
- **E-commerce Listings:** Unauthorized use of a registered trademark in product descriptions, titles, or seller names on e-commerce platforms like Amazon or Flipkart can mislead consumers into believing that they are purchasing from the original brand, constituting a clear case of infringement under this section.

JUDICIAL INTERPRETATION AND EVOLVING TRENDS

Indian courts have increasingly demonstrated a progressive and technology-aware approach in applying Section 29 to digital disputes²⁴. The judiciary has:

- Recognized non-physical use (e.g., in metadata and online search results) as “use in the course of trade”;
- Treated domain names and social media handles as trademark equivalents for enforcement purposes;
- Issued injunctions against online platforms and advertisers for allowing the misuse of trademarks;
- Addressed intermediary liability, particularly in cases where digital platforms continue to host infringing listings despite being notified.

These interpretations affirm that while the statute may not expressly refer to online uses, Section 29 is sufficiently broad to accommodate modern forms of digital brand misuse—provided courts adopt a purposive and consumer-oriented reading.²⁵

Section 29 of the Trademarks Act, 1999 is the most significant statutory tool available to trademark holders in India.²⁶ Its structured approach to defining and penalizing infringement—especially through its expansive language and special protection for well-known marks under sub-section (4)—makes it highly

²⁴ Sharma, V., “Trademark Disputes in E-commerce: Liability of Intermediaries in India”, (2021) 17(1) *Indian Journal of Law and Technology* 42.

²⁵ Narayanan, P., *Law of Trademarks and Passing Off* 122 (Eastern Law House, Kolkata, 6th edn., 2017).

²⁶ The Trademarks Act, 1999 (Act No. 47 of 1999), India, s. 29.

adaptable to the evolving digital context.²⁷

Nonetheless, the lack of explicit statutory guidance on online platforms, digital advertising, and algorithmic misuse leaves certain gray areas that can lead to inconsistent application.²⁸ There remains a pressing need for legislative updates and clearer regulatory directives to ensure that Section 29 continues to serve as a robust legal safeguard in an increasingly virtual and interconnected commercial environment.

Section 27 – Passing Off

While the Trademarks Act, 1999 primarily centers around the protection of registered trademarks, it notably preserves the common law remedy of passing off through Section 27, thereby ensuring that prior user rights and unregistered trademarks continue to enjoy legal protection.²⁹ This provision is a critical safeguard in Indian trademark jurisprudence, particularly in the context of the digital economy, where numerous businesses operate without formally registering their marks, yet develop substantial goodwill and consumer recognition.

STATUTORY TEXT AND PRINCIPLE

Section 27(2) of the Act explicitly states:

“Nothing in this Act shall affect rights of action against any person for passing off goods or services as the goods of another person or the remedies in respect thereof.”³⁰

This clause affirms that even in the absence of trademark registration, an aggrieved party can seek relief if they can demonstrate that another entity has misrepresented their goods or services as being associated with them, thereby causing damage to their goodwill or deceiving consumers.³¹

Passing off is rooted in the principle of equity and unfair competition, where the primary aim is to prevent a trader from riding on the reputation and brand image of another.³² Traditionally, the law has required the claimant to establish three

²⁷ Ibid., s. 29(4).

²⁸ Kur, A., & Dreier, T., *European Intellectual Property Law: Text, Cases and Materials* 242 (Edward Elgar Publishing, 2013).

²⁹ The Trademarks Act, 1999, s. 27(2).

³⁰ Section 27(2), The Trademarks Act, 1999.

³¹ Cornish, W., Llewelyn, D., & Aplin, T., *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* 139 (Sweet & Maxwell, 9th edn., 2019).

³² Bainbridge, D., *Intellectual Property* 305 (Pearson Education, 10th edn., 2018)

critical elements—commonly referred to as the “classical trinity”:

1. **Goodwill** or reputation attached to the goods or services;
2. **Misrepresentation** by the defendant, likely to deceive or confuse the public;
3. **Damage** or likelihood of damage to the claimant’s goodwill or business.

These principles have been judicially reaffirmed in landmark cases such as *Perry v. Truefitt (1842)*³³ and, in the Indian context, *Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.*,³⁴ where the Supreme Court emphasized the need to protect consumers from deception, even in the absence of formal registration.

RELEVANCE IN THE DIGITAL ENVIRONMENT

In the digital age, passing off has taken on renewed significance, particularly due to the proliferation of businesses that establish their brands entirely online—often without registering trademarks in the early stages of their operations. In such cases, common law protection becomes the only legal recourse when third parties attempt to exploit or imitate an existing brand’s identity in the digital sphere.

Passing off is especially vital in the following digital scenarios:

- **Unregistered Digital Brands:** Many startups and content creators rely on digital branding (e.g., unique names, logos, or taglines used on websites or social media) to build market recognition. If a competitor or malicious actor imitates these elements, the aggrieved party can initiate a passing off action by demonstrating that they had established reputation and consumer association before the imitation occurred.
- **Domain Name Disputes:** Courts have increasingly recognized that domain names function as digital identifiers of businesses, equivalent to trademarks. In *Yahoo! Inc. v. Akash Arora & Anr.* (1999), the Delhi High Court held that using a domain name deceptively similar to that of a well-known business could amount to passing off, even in the absence of trademark registration. The court further observed that internet users are particularly prone to confusion due to the nature of digital navigation.

³³ *Perry v. Truefitt*, (1842) 6 Beav. 66.

³⁴ *Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.*, AIR 2001 SC 1952.

- **Look-Alike Websites and Apps:** Some infringers create confusingly similar websites or mobile applications, replicating the visual layout, colors, and branding elements of a legitimate business. Even without copying a registered trademark, such mimicry may mislead users into believing they are interacting with the original entity—thereby satisfying the test of misrepresentation and damage in a passing off claim.
- **Social Media Impersonation:** The rise of brand impersonation on platforms like Instagram, Twitter (X), and Facebook has introduced new dimensions to passing off. Fake profiles that use similar names, bios, or branding can deceive followers and erode the goodwill of the real brand. Although social media platforms have internal takedown procedures, legal action for passing off remains a crucial remedy when impersonation causes commercial harm or reputational damage.
- **Influencer and Affiliate Misrepresentation:** In some cases, digital influencers or affiliates may falsely present themselves as being officially associated with a brand. Even if the trademark is not used verbatim, such behavior can constitute passing off if it causes confusion about endorsement or origin.³⁵

JUDICIAL ENDORSEMENT AND FLEXIBILITY

Indian courts have demonstrated a progressive approach in extending the principles of passing off to the digital context. The Delhi High Court in several cases, including *Satyam Infoway Ltd. v. Sifynet Solutions Pvt. Ltd.* (2004), reaffirmed that domain names and other digital assets could be protected under the doctrine of passing off.

Moreover, the courts have emphasized that actual deception need not be proven; it is sufficient to show that there is a likelihood of confusion among the relevant consumer base. This is especially pertinent in online transactions, where attention spans are short, and consumers are more prone to being misled.

Section 27 of the Trademarks Act, 1999 is a vital legal tool for brand protection in the digital age, as it upholds the rights of prior users and unregistered trademark holders through the equitable remedy of passing off. Its flexibility allows it to adapt to a wide range of digital infringement scenarios, including domain name

³⁵ Kur, A. & Dreier, T., *European Intellectual Property Law: Text, Cases and Materials* 237 (Edward Elgar Publishing, 2013).

hijacking, brand impersonation, and deceptive online advertising.

In an era where branding is often born digitally, and businesses gain prominence through online engagement before seeking formal registration, the doctrine of passing off remains a foundational principle in ensuring fair competition and consumer protection. However, given the pace at which digital platforms evolve, there is a growing need for statutory clarity and technological understanding in how passing off is interpreted and enforced in India's rapidly digitizing marketplace.³⁶

Section 134 – Jurisdiction for Legal Proceedings

Section 134 of the Trademarks Act, 1999 is a critical procedural provision that provides territorial jurisdiction for filing civil suits in cases of trademark infringement or passing off. It offers a significant departure from the general rule under the Code of Civil Procedure (CPC), 1908, which typically requires that a suit be instituted either where the defendant resides or where the cause of action arises.³⁷ Instead, Section 134 empowers the trademark owner to initiate legal proceedings in the court where they carry on business, providing greater convenience and legal agility.³⁸

STATUTORY LANGUAGE AND PURPOSE

Specifically, **Section 134(2)** states:

“For the purpose of clauses (a) and (c) of sub-section (1), a ‘District Court having jurisdiction’ shall, notwithstanding anything contained in the Code of Civil Procedure, 1908, or any other law for the time being in force, include a District Court within the local limits of whose jurisdiction, at the time of the institution of the suit or other proceeding, the person instituting the suit or proceeding, actually and voluntarily resides or carries on business or personally works for gain.”

The intent behind this provision is to reduce the procedural burden on trademark proprietors, who may otherwise be forced to file suits in far-off jurisdictions—especially in cases where infringing acts occur in remote or multiple locations. It recognizes the commercial realities of brand protection and gives legal standing to businesses to act swiftly and decisively from their own

³⁶ McCarthy, J.T., *McCarthy on Trademarks and Unfair Competition* 481 (Thomson Reuters, 5th edn., 2020).

³⁷ Code of Civil Procedure, 1908, s. 20.

³⁸ Cornish, W., Llewelyn, D., & Aplin, T., *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* 147 (Sweet & Maxwell, 9th edn., 2019).

base of operations.³⁹

RELEVANCE IN THE DIGITAL CONTEXT

In the era of digital commerce and online marketing, territorial boundaries have become increasingly blurred, creating complexities in determining where a cause of action arises. Infringements committed over the internet—whether through unauthorized use of a domain name, digital advertisement, or social media impersonation—can theoretically occur anywhere in the country (or even globally), depending on where the content is accessed.⁴⁰

Section 134 thus becomes especially relevant in digital trademark infringement cases, as it allows trademark owners to anchor their litigation in a forum that is most accessible to them, rather than chasing infringers across various jurisdictions. This territorial flexibility proves beneficial in situations where:⁴¹

- The infringing act is committed online, making it difficult to pinpoint a singular territorial origin;
- The defendant's physical location is unknown, as is often the case with anonymous or pseudonymous domain name registrants, e-commerce sellers, or social media impersonators;
- The infringer operates across multiple states, or has no formal place of business in India (e.g., foreign online sellers or hosting platforms);
- The infringement is dispersed over digital platforms such as Google Ads, YouTube, Amazon, or Instagram, where acts of infringement may appear simultaneously in several geographic locations.

By permitting litigation at the plaintiff's place of business, Section 134 provides a practical remedy in these scenarios and acts as a procedural enabler for enforcement in cyberspace.⁴²

³⁹ Narayanan, P., *Law of Trademarks and Passing Off* 206 (Eastern Law House, 6th edn., 2017).

⁴⁰ Sharma, V., "Trademark Disputes in E-commerce: Liability of Intermediaries in India", (2021) 17(1) *Indian Journal of Law and Technology* 45.

⁴¹ Kur, A., & Dreier, T., *European Intellectual Property Law: Text, Cases and Materials* 233 (Edward Elgar, 2013).

⁴² Bainbridge, D., *Intellectual Property* 344 (Pearson Education, 10th edn., 2018).

JUDICIAL ENDORSEMENT AND APPLICATION

Indian courts have upheld and applied Section 134 expansively to accommodate the changing nature of commerce. In *Indian Performing Rights Society Ltd. v. Sanjay Dalia & Ors.* (2015), the Supreme Court interpreted Section 134 in conjunction with Section 20 of the CPC, reaffirming that the provision exists to ease the hardship of plaintiffs. However, the Court cautioned against abuse by parties with multiple offices, noting that the choice of jurisdiction should not be arbitrary or *mala fide*, especially when the cause of action has no connection to the chosen venue.

In digital infringement cases, courts have often taken a technology-sensitive approach. For example:

- In *Banyan Tree Holding (P) Ltd. v. A. Murali Krishna Reddy* (2008), the Delhi High Court analyzed jurisdiction in online disputes, noting that mere accessibility of a website in a particular jurisdiction does not automatically confer jurisdiction—there must be purposeful targeting of that jurisdiction.
- Similarly, in *Impresario Entertainment & Hospitality Pvt. Ltd. v. S&D Hospitality* (2021), the Bombay High Court held that online visibility combined with business operations at the plaintiff's base could justify jurisdiction under Section 134.⁴³

PRACTICAL UTILITY FOR BRAND OWNERS

The utility of Section 134 for trademark owners—particularly startups, small enterprises, and digital-first brands—cannot be overstated. Given the cost and complexity of cross-jurisdictional litigation, the ability to litigate from one's own base empowers rights holders to respond quickly and efficiently to infringement threats.⁴⁴

Moreover, in the absence of a centralized national IP court, Section 134 offers a pragmatic solution to jurisdictional uncertainty in India's vast judicial system. It ensures that enforcement is not undermined by procedural roadblocks, especially when infringing acts are carried out by elusive digital actors or foreign entities.⁴⁵

⁴³ *Impresario Entertainment & Hospitality Pvt. Ltd. v. S&D Hospitality*, 2021 SCC OnLine Bom 1531.

⁴⁴ Sen, A., "The Role of Intermediaries in Online Trademark Infringement", (2018) 23(6) *JIPR* 270.

⁴⁵ WIPO, *Territorial Challenges in IP Jurisdiction*, <https://www.wipo.int> (last

Section 134 of the Trademarks Act, 1999 plays a crucial enabling role in the effective enforcement of trademark rights, especially in an environment where digital platforms allow infringement to occur across borders and jurisdictions simultaneously. By empowering trademark holders to file suits in courts where they conduct business, the provision aligns legal procedure with commercial convenience and technological realities.

However, as digital disputes continue to evolve, there may be a need for greater judicial guidance or legislative clarity on how jurisdictional principles apply to new-age challenges such as blockchain-based commerce, NFTs, and AI-driven infringement, all of which are capable of further complicating the territoriality doctrine in IP law.⁴⁶

Section 135 – Civil Remedies

Section 135 of the Trademarks Act, 1999 provides the statutory foundation for civil remedies available to trademark proprietors in cases of infringement or passing off.⁴⁷ This section empowers the courts to grant both preventive and compensatory relief, ensuring that the rights of trademark holders are effectively enforced not only after infringement has occurred but also preemptively to prevent further harm. While rooted in traditional legal doctrine, these remedies have been adapted over time to address emerging challenges posed by digital commerce and online brand exploitation.⁴⁸

STATUTORY FRAMEWORK OF SECTION 135

The provision authorizes the following key civil remedies:

1. *Injunctions (Temporary and Permanent)*

Injunctions are the most frequently granted remedy in trademark infringement cases. They serve to:

- Prevent the continuation or repetition of infringing acts;
- Restrain infringers from further misuse of the mark;

visited Apr. 12, 2025).

⁴⁶ McCarthy, J.T., *McCarthy on Trademarks and Unfair Competition* 498 (Thomson Reuters, 5th edn., 2020).

⁴⁷ The Trademarks Act, 1999, s. 135.

⁴⁸ Cornish, W., Llewelyn, D., & Aplin, T., *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* 151 (Sweet & Maxwell, 9th edn., 2019).

- Protect the goodwill and commercial reputation of the trademark holder.

Courts may issue:

- Interim injunctions (temporary) during the pendency of litigation to prevent irreparable harm;
- Permanent injunctions as a final remedy, barring future use of the infringing mark or representation.

In digital contexts, injunctions have been extended to cover:

- Take-down orders against infringing websites, e-commerce listings, and social media pages;
- Disabling URLs or hyperlinks that lead to infringing content;
- Injunctions against intermediaries, such as web hosts, search engines, or marketplace operators, to prevent further dissemination of infringing material.

In *World Wrestling Entertainment, Inc. v. Reshma Collection*, the Delhi High Court issued dynamic injunctions to restrain continued online sales of counterfeit goods and to ensure effective enforcement across digital platforms.

2. Damages or Account of Profits

Section 135 allows courts to award monetary compensation in two primary forms:

- **Compensatory damages:** To compensate for actual loss suffered by the plaintiff;
- **Account of profits:** To disgorge the profits made by the infringer through unauthorized use of the trademark.

In practice, Indian courts often prefer awarding nominal or exemplary damages in clear cases of bad faith, especially in ex parte matters where calculating actual damages may not be feasible. This is particularly relevant in online infringement cases, where infringers may operate anonymously, and their financial gains are difficult to quantify.

For instance, in *Microsoft Corporation v. Yogesh Papat*, the court awarded punitive damages for unauthorized online distribution of software bearing Microsoft's trademark, recognizing the need to

deter digital piracy and infringement.⁴⁹

3. Destruction, Erasure, or Removal of Infringing Goods and Materials

To ensure comprehensive enforcement, Section 135 empowers courts to order the destruction or erasure of infringing materials. Traditionally, this has applied to:

- Counterfeit goods,
- Fake labels,
- Packaging and promotional materials.

In digital environments, courts have expanded this to include:

- Erasure of infringing data, logos, banners, or promotional content from websites;
- Deletion of infringing digital files or metadata used to mislead consumers;
- Orders to remove infringing mobile applications from digital app stores.

This digital adaptation ensures that infringing content is not merely rendered inactive but is completely removed or destroyed, minimizing residual consumer confusion or brand dilution.

4. Delivery Up of Counterfeit Goods

Courts may also direct the seizure and surrender of infringing goods, allowing the trademark owner to take custody of products bearing unauthorized marks. In e-commerce and online sales, this remedy is applied through:

- Seizure of warehouse inventories of counterfeit sellers operating through digital platforms;
- Tracking and freezing of inventory and delivery logistics, especially when tied to infringing listings on platforms like Amazon or Flipkart.

In *Christian Louboutin SAS v. Nakul Bajaj & Ors.*, the Delhi High Court emphasized the importance of cooperation from intermediaries and marketplaces in executing such orders, highlighting the role of e-commerce in either enabling or curbing

⁴⁹ *Microsoft Corporation v. Yogesh Papat*, 2005 SCC OnLine Del 849.

online trademark violations.⁵⁰

RELEVANCE TO DIGITAL INFRINGEMENT

The remedies under Section 135 have proven to be sufficiently flexible to adapt to digital realities. Indian courts have recognized that infringement in the digital space can be just as damaging—if not more so—than physical misuse, given the instantaneous and far-reaching impact of online platforms.

Key digital scenarios where Section 135 remedies have been invoked include:

- Fake social media accounts misrepresenting a brand or service;
- Misuse of brand names in Google Ads or sponsored content;
- Counterfeit listings on e-commerce sites with manipulated product descriptions;
- Look-alike websites or spoofed domains mimicking original brand identity.

By issuing injunctions, awarding damages, and ordering the removal or de-indexing of digital content, courts have creatively extended traditional remedies to the virtual space—often incorporating principles of dynamic injunctions, proactive enforcement, and real-time compliance.

CHALLENGES IN EXECUTION

Despite the effectiveness of Section 135 on paper, its implementation in digital contexts presents certain challenges:⁵¹

- Identifying anonymous infringers behind domain names or online handles can be difficult without strong data-sharing frameworks between platforms and law enforcement.
- Jurisdictional barriers arise when infringing websites or sellers are hosted or operated from foreign countries.
- Delay in enforcement can render the remedy moot, especially in viral or time-sensitive campaigns where brand damage occurs rapidly.

⁵⁰ *Christian Louboutin SAS v. Nakul Bajaj & Ors.*, CS(COMM) 344/2018 (Delhi HC).

⁵¹ Sen, A., “The Role of Intermediaries in Online Trademark Infringement”, (2018) 23(6) *Journal of Intellectual Property Rights* 271.

To address these issues, courts have started embracing technologically forward remedies, such as:

- John Doe orders against unknown defendants in digital cases;
- Dynamic injunctions, allowing plaintiffs to extend protection to future infringing URLs without returning to court;
- Directives to digital intermediaries for immediate compliance and content removal.⁵²

Section 135 of the Trademarks Act, 1999 provides a broad, effective, and evolving toolkit for civil enforcement of trademark rights. Its flexibility allows courts to deliver justice not only in traditional commercial settings but also in the rapidly expanding digital environment, where infringement can be subtle, widespread, and highly disruptive.

As India continues to digitize its economy, and as brands increasingly operate online-first models, the robust and proactive use of Section 135 remedies—coupled with judicial innovation—will be essential in maintaining the integrity of trademarks, ensuring consumer trust, and upholding fair competition.

INTERPRETATION OF “USE IN THE COURSE OF TRADE” IN THE DIGITAL ERA

One of the most critical interpretative challenges posed by the Act is its lack of explicit reference to digital or online trademark use. Terms like “use in the course of trade” were historically understood to refer to physical use—on goods, shop signage, packaging, and printed materials. However, with the advent of the internet, e-commerce, and digital advertising, courts have had to expand the meaning of this phrase.

Judicial precedents have interpreted digital usage to include:

- Use of trademarks in domain names (*Tata Sons Ltd. v. Manu Kishori*),⁵³
- Bidding on competitor’s trademarks in keyword advertising,
- Unauthorized use on e-commerce platforms, including fake listings,

⁵² Sharma, V., “Trademark Disputes in E-commerce: Liability of Intermediaries in India”, (2021) 17(1) Indian Journal of Law and Technology 46.

⁵³ *Tata Sons Ltd. v. Manu Kishori & Ors.*, 2001 PTC 432 (Del).

- Misuse of brand names in social media handles or posts.

This interpretative flexibility has enabled the judiciary to bridge the gap between traditional statutes and modern realities, but the absence of explicit statutory language on digital use continues to create uncertainty, especially in cross-border enforcement and intermediary liability.

GAPS AND THE NEED FOR REFORM

While the Trademarks Act, 1999 is largely in conformity with international standards, its static definitions and analog-era orientation create challenges in the context of:

- Cross-border online infringement;
- Anonymity and automation in digital platforms;
- Intermediary responsibilities, where platforms may host or facilitate infringing content.

Unlike some jurisdictions (e.g., the U.S. Lanham Act or the EU Trademark Regulation), the Indian statute does not directly address digital aspects such as metatagging, digital advertising, influencer marketing, or tokenized use of trademarks (e.g., in NFTs or the metaverse).⁵⁴

This necessitates either judicial expansion of existing principles or legislative reform to modernize the statutory framework in line with technological advancements and global best practices.

The Trademarks Act, 1999 offers a robust legal foundation for the protection of brand identity in India. While its broad provisions have allowed for judicial creativity, the lack of digital-specific language and guidance presents a challenge in today's fast-evolving technological landscape. As the nature of trade continues to shift from physical to virtual realms, there is a pressing need to ensure that the statutory framework remains dynamic, forward-looking, and responsive to the unique realities of digital trademark infringement. This sets the stage for the next section, which will examine the international frameworks that shape and influence digital trademark regulation.

INTERNATIONAL CONVENTIONS ON TRADEMARK LAW

In an era defined by globalization and digital interconnectivity, the protection of trademarks can no longer be confined within the

⁵⁴ Lanham Act, 15 U.S.C. §§ 1051 et seq.; Regulation (EU) 2017/1001 on the European Union Trademark.

territorial boundaries of a single jurisdiction.⁵⁵ Infringements—especially in the online environment—often transcend national borders, with websites, domain names, digital advertisements, and e-commerce operations functioning simultaneously across multiple countries.⁵⁶

Recognizing the need for harmonization of trademark standards and cross-border cooperation, India has acceded to several international treaties and conventions.⁵⁷ These instruments shape the contours of Indian trademark law, influence legislative drafting, and serve as a guide for judicial interpretation, especially in matters involving foreign entities, global brands, and international online platforms.

Among these, the TRIPS Agreement, the Paris Convention, and the Madrid Protocol hold primary relevance to this study.

a) TRIPS Agreement (1995)

Trade-Related Aspects of Intellectual Property Rights

The TRIPS Agreement, enforced under the aegis of the World Trade Organization (WTO), is the most comprehensive and binding international instrument governing intellectual property rights, including trademark protection. It establishes minimum standards of protection and enforcement that all member states, including India, are required to incorporate into their domestic legal frameworks.

Key Provisions Relevant to Trademark Law:

- **Article 15-21:** Lay down the substantive rules on trademark protection, including what constitutes a trademark, the rights conferred, and grounds for refusal or invalidation.
- **Article 16:** Provides enhanced protection for well-known trademarks, including protection against dilution and unfair advantage even in unrelated goods or services—a principle directly reflected in Section 29(4) of India's Trademarks Act.⁵⁸

⁵⁵ Kur, A. & Dreier, T., *European Intellectual Property Law: Text, Cases and Materials* 198 (Edward Elgar, 2013).

⁵⁶ WIPO, *Intellectual Property and the Internet: A Guide for Trademark Owners*, <https://www.wipo.int> (last visited Apr. 12, 2025).

⁵⁷ Narayanan, P., *Law of Trademarks and Passing Off* 364 (Eastern Law House, 6th edn., 2017).

⁵⁸ Ibid., art. 16.

- **Article 41–61:** Focus on enforcement mechanisms, mandating that member countries provide:⁵⁹
 - Effective legal procedures to prevent infringement;
 - Expeditious remedies, including injunctions and damages;
 - Criminal penalties in cases of wilful counterfeiting;
 - Border measures to intercept infringing goods in transit.

TRIPS played a transformative role in shaping India's Trademarks Act, 1999, aligning it with global best practices. Its relevance to digital infringement lies in its principle of technological neutrality—it does not restrict enforcement to any specific medium, thus enabling courts to interpret digital misuses (e.g., in e-commerce, metadata, or digital ads) within its broad framework.⁶⁰

Furthermore, TRIPS underscores the importance of cross-border cooperation, which is vital in online trademark infringement cases involving foreign registrants, international platforms, or offshore hosting services.⁶¹

b) Paris Convention (1883)

Convention for the Protection of Industrial Property

Administered by the World Intellectual Property Organization (WIPO), the Paris Convention is one of the oldest and most influential international treaties on intellectual property. India is a signatory to this treaty, and its provisions are reflected both directly and indirectly in Indian IP jurisprudence.

Key Provisions:

- **National Treatment (Article 2):** Ensures that each member country grants equal legal protection to foreign nationals and local applicants. In practical terms, this guarantees that a U.S. or European trademark owner can initiate legal proceedings against digital infringement in India, just as an Indian entity could.

⁵⁹ Ibid., arts. 41–61.

⁶⁰ The Trademarks Act, 1999, Preamble and Statement of Objects and Reasons.

⁶¹ Gervais, D.J., *The TRIPS Agreement: Drafting History and Analysis* 422 (Sweet & Maxwell, 4th edn., 2012).

- **Right of Priority (Article 4):** Allows applicants to file for trademark registration in other member countries within six months of the initial filing date and retain the original priority. This is highly useful for online startups and cross-border e-commerce platforms seeking to establish a global brand footprint.⁶²
- **Protection Against Unfair Competition (Article 10bis):** This is a particularly relevant provision in the digital context. It obligates member states to protect businesses against:⁶³
 - Acts likely to cause confusion;
 - False allegations that may damage a competitor's reputation;
 - Misleading indications that create false commercial association.

These provisions support legal actions against deceptive digital practices such as keyword advertising on search engines, spoofed brand impersonation, and unauthorized use in social media marketing.

Although the Paris Convention does not contain strong enforcement mechanisms like TRIPS, it establishes core legal principles that courts often use in interpreting unfair trade practices and in extending passing off remedies to foreign mark holders.

c) Madrid Protocol (India acceded in 2013)

International System for Trademark Registration

The Madrid Protocol, also administered by WIPO, facilitates the international registration of trademarks through a centralized, simplified application process. Rather than filing separate trademark applications in each country, a brand owner can file one application through the home trademark office (e.g., India's Controller General of Patents, Designs and Trademarks), designating multiple countries of interest.⁶⁴

India became a party to the Madrid Protocol in 2013, which was a major step toward internationalizing its trademark regime and

⁶² Ibid., arts. 2 & 4.

⁶³ Ibid., art. 10bis.

⁶⁴ Madrid Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, 1989.

making it easier for Indian businesses to secure rights globally.

Key Benefits in the Digital Context:

- **Global Brand Consistency:** Digital-first businesses (e.g., SaaS companies, e-commerce platforms, app developers) can register trademarks internationally in a single filing, ensuring consistent branding across platforms and jurisdictions.
- **Efficient Cross-Border Enforcement:** Trademark owners can initiate legal proceedings or take down infringing listings across multiple countries where they hold rights under the Madrid registration.
- **Simplified Maintenance:** Renewals, amendments, and ownership changes can be managed centrally, which is critical for rapidly scaling online businesses operating across global digital markets.⁶⁵

While the Madrid Protocol itself is administrative rather than substantive, it plays a key role in preventing digital infringement across jurisdictions by offering a practical solution for managing and protecting trademarks globally—especially important in the borderless nature of internet-based commerce.⁶⁶

The international conventions discussed above—TRIPS, the Paris Convention, and the Madrid Protocol—form the global scaffolding upon which India's trademark regime is constructed. They collectively promote harmonization of legal standards, ensure reciprocal protection for domestic and foreign brand owners, and facilitate the cross-border enforcement of trademark rights.

In the digital age, where trademark infringement may originate in one country, be hosted in another, and affect consumers globally, these instruments provide both legal clarity and procedural mechanisms for resolving disputes and asserting rights. However, their effectiveness ultimately depends on national implementation and judicial interpretation, especially when confronting technologically complex, multi-jurisdictional online infringements.⁶⁷

As trademark enforcement moves into digital domains such as

⁶⁵ WIPO, *The Madrid System for the International Registration of Marks*, <https://www.wipo.int/madrid/en/> (last visited Apr. 12, 2025).

⁶⁶ Bainbridge, D., *Intellectual Property* 367 (Pearson Education, 10th edn., 2018).

⁶⁷ McCarthy, J.T., *McCarthy on Trademarks and Unfair Competition* 493 (Thomson Reuters, 5th edn., 2020).

metaverses, NFTs, and AI-driven branding, it is likely that these treaties will need to be supplemented or updated to ensure they remain relevant and responsive to emerging threats.

DIGITAL ADAPTATION OF THESE FRAMEWORKS

Despite these robust legal foundations, existing trademark laws and treaties were not originally designed to handle the nuances of the digital age.⁶⁸ The digital environment introduces new forms of infringement that are instantaneous, anonymized, and transnational.⁶⁹ Key challenges in digital adaptation include:

- **Absence of Digital-Specific Language:** Neither the Indian Act nor most international instruments explicitly reference domain names, social media handles, or digital advertising.⁷⁰ Courts must interpret outdated terminology in modern contexts.
- **Ambiguity in Intermediary Liability:** Current frameworks do not clearly define the responsibility of digital intermediaries like e-commerce platforms (e.g., Amazon, Flipkart), social media networks (e.g., Facebook, Instagram), or search engines (e.g., Google) in facilitating or failing to prevent trademark misuse.
- **Domain Name Disputes:** While UDRP (Uniform Domain Name Dispute Resolution Policy) under ICANN offers some redress, it operates outside formal judicial systems and lacks uniform enforceability.
- **Cross-Border Jurisdiction:** The decentralized nature of the internet raises jurisdictional dilemmas. Trademark law, by nature, is territorial; however, digital infringement is global. This creates difficulties in pursuing remedies across borders without mutual legal frameworks or enforcement treaties.
- **Adaptation by Judiciary:** Indian courts have taken a proactive role in expanding traditional legal concepts to address digital realities. For example, in cases such as *Tata Sons Ltd. v. Manu Kishori*, the Delhi High Court treated

⁶⁸ Cornish, W., Llewelyn, D., & Aplin, T., *Intellectual Property: Patents, Copyright, Trade Marks and Allied Rights* 311 (Sweet & Maxwell, 9th edn., 2019).

⁶⁹ WIPO, *Understanding Trademark Law in the Digital Age*, <https://www.wipo.int> (last visited Apr. 12, 2025).

⁷⁰ Narayanan, P., *Law of Trademarks and Passing Off* 379 (Eastern Law House, 6th edn., 2017).

domain names as equivalent to trademarks, thereby protecting brand identity in cyberspace.

CONCLUSION

The legal framework for trademark protection, both in India and internationally, provides a strong foundation for safeguarding brand identity.⁷¹ However, the unprecedented shift toward digital platforms has outpaced the evolution of these laws. While statutes like the Trademarks Act, 1999 and treaties like TRIPS offer broad protections, they are not equipped to address the specific mechanisms, scale, and complexity of digital trademark infringement.

The law's reliance on judicial interpretation has filled some of these gaps, but there remains an urgent need for legislative modernization, clearer definitions, and globally harmonized enforcement models that reflect the realities of the digital age.⁷² The next study will delve into how these emerging forms of infringement operate and highlight the growing sophistication of trademark abuse in the online world.

⁷¹ The Trademarks Act, 1999, Preamble and s. 29.

⁷² Bainbridge, D., *Intellectual Property* 324 (Pearson Education, 10th edn., 2018).