

PROVING PRIOR USE IN INDIAN TRADEMARK LAW: THE ROLE OF THE AFFIDAVIT OF USE

Introduction:

A **trademark** is a unique sign, logo, or design that represents the identity of a brand. It distinguishes the goods or services of one business from another. Its how you stop people from confusing your product with an imitation. In India, trademarks are governed by the [Trade Marks Act, 1999](#)¹, which outlines the rules and processes for trademark registration. For businesses, protecting their **reputation** and **goodwill** is crucial, and a trademark serves as the face of the brand. While unregistered trademarks can claim some level of protection due to prior use and reputation, the strongest protection against infringement is obtained through formal registration.

To register a trademark, businesses must follow a series of steps: preparing and filing the application, examination by the trademark office, publication in the journal, opposition proceedings (*if any*), and final registration. Trademark applications can be made either under the category of “**claiming user date**” (*for trademarks already in use*) or “**proposed to be used**” (*for trademarks intended for future use*).

In the case of claiming prior use, a crucial document called the **User Affidavit** must be submitted with the application. Made mandatory by the [Trade Marks Rules, 2017](#)², this affidavit serves as evidence that the trademark has been in **continuous use**, adding weight to the application and helping prove ownership, distinctiveness, and priority over competitors.

Let's Understand Affidavit of Use:

An Affidavit of use in trademark law is a sworn written statement, usually by a trademark owner or an authorized person, affirming the active use of a trademark with specific goods or services. This document typically details how long, in what manner, and where the trademark has been used, with a proof of evidence such as sales records, invoices and advertisements.

In Trademark disputes, an affidavit of use is essential for :-

- **Establishing prior use**, which helps challenge conflicting applications for similar marks.
- **Supporting well-known trademark claims** by demonstrating continuous use and consumer recognition, safeguarding the brand against imitation.
- **Strengthening infringement cases**, as affidavits serve as solid evidence of the trademark's market presence and historical use, adding in securing injunctions.
- **Demonstrating the owner's *bonafide* intent** to use the mark, which is a crucial factor in opposition cases to counter claims of non-use.

The Indian legal framework supports the use of affidavits in trademark proceedings. Section 129 of the *Trade Marks Act, 1999*, allows affidavits as admissible evidence. Section 18 (1) of the *Trade Marks Act, 1999*, enables affidavits for applicant opposing conflicting marks to prove their legitimate interest and exclusive rights to the mark. Lastly, Rule 124 of the *Trade Marks Rules, 2017* allows for affidavits in determining if a trademark qualifies as well-known enhancing its protection.

Essential Components of an Affidavit of Use in India

- Details of the Trademark: Description of the mark (wordmark, logo, etc.), Date of first use and evidence of continuous use.
- Nature of Goods/Services: Classification of goods/services under which the mark is used.
- Geographic Scope of Use: Areas of operation where the mark is used.
- Affirmation and Signature: Oath and declaration of truthfulness of the affidavit by the **director of a company** (or any authorized representative).
- Supporting Documents: Attachments like brochures, bills, advertisements, social media activity, etc.

Affidavits of Use in Opposition Proceedings: In opposition cases, affidavits significantly impact the hearing officer's decisions by providing evidence of the trademark's historical use and market presence. In *Anand Kumar v. Haldiram Bhujia Wala (80 (1999) DLT 26)*, during the prosecution of its application, the defendant filed an Affidavit of Use

supporting the application, claiming use of the mark only within the state of West Bengal. This persuaded the Delhi High Court to exclude the state of West Bengal from the purview of the injunction order against the defendant. The Affidavit of Use was sufficient to persuade the court that the defendant's rights were superior in that geographic area.

Affidavits in Cancellation/Rectification Proceedings: In rectification proceedings, affidavits may either support or weaken a case based on the strength of the evidence presented. In *Kamdhenu Ltd. v. Registrar of Trademarks (2021)*, the Delhi High Court clarified that documentary evidence alone could be sufficient to establish a mark's well known status without requiring an affidavit. This ruling emphasized that when extensive documentation supports a trademark's reputation, the absence of an affidavit may not be detrimental.

In *Tata SIA Airlines Ltd. v. Union of India (2023)*, the Court echoed this approach, clarifying that for a well-known trademark claim, strong documentation, such as sales data and advertising impact, can take precedence over an affidavit if it substantiates the mark's widespread recognition. This approach underscores a trend where robust evidence may sometimes replace affidavits if it is credible and well-documented.

However, in cases involving familial or legacy claims, affidavits can be instrumental, as seen in *Haldiram India Pvt Ltd. v. Haldiram Bhujawala Ltd. (2020)*. This case involved complex legacy claims over family-owned trademarks, where affidavits helped prove continuous use and ownership, demonstrating the affidavit's relevance in nuanced situations involving trademark ownership disputes.

Although the Indian Trademark Act does not mandate proof of use after filing an application on a "proposed to be used" basis, it is crucial to understand the potential implications of non-use. If a trademark remains unused after registration, it is vulnerable to cancellation under [Section 47](#) of the Trade Marks Act 1999 after five years. To prevent such a scenario, it is beneficial for applicants to demonstrate the mark's genuine use post-filing, either through an affidavit or other evidence, especially when challenges arise. This not only strengthens the validity of the registration but also safeguards the trademark from

being struck off the register due to non-use. Therefore, proactive steps in proving use are essential to maintaining the mark's protection and ensuring its long-term enforceability.

³[*Anand Kumar v. Haldiram Bhujia Wala \(80 \(1999\) DLT 26\)*](#)

⁴[*Kamdhenu Ltd. v. Registrar of Trademarks \(2021\)*](#)

⁵[*Tata SIA Airlines Ltd. v. Union of India \(2023\)*](#)

⁶[*Haldiram India Pvt Ltd. v. Haldiram Bhujawala Ltd. \(2020\)*](#)

About the Author:



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