IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION

COMMERCIAL MISCELLANEOUS PETITION NO. 10 OF 2024

TikTok Limited Faheem Ahmad Constituted Attorney of TikTok Limited ... Petitioner

Versus

The Registrar of Trade Marks Mumbai & Anr. ... Respondents

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Ms. Swati Mittal (through V.C.) a/w Ms. Manisha Singh, Mr. Abhai Pandey, Ms. Anju Agrawal, Mr. Gautam Kumar, Ms. Ritika Agrawal, Ms. Paulome Metha, Mr. Shubhankar Sharma and Mr. Ishvendra Tiwari i/by Sonal Doshi & Co. for the Petitioner.

Mr. Yashodeep Deshmukh (through V.C.) a/w Ms. Leena Patil and Ms. V. Deshmukh for Respondents.

Mr. Pranjal Sharma and Ankit Sharma, Examiner of Trade Marks- present.

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CORAM: MANISH PITALE, J.

RESERVED ON : 2nd MAY 2025

PRONOUNCED ON : 10th JUNE 2025

ORDER :

. By this petition, the petitioner has challenged order dated 31st October 2023 passed by the respondent-Assistant Registrar of Trade Marks, refusing an application filed on behalf of the petitioner for inclusion of its registered trade mark/*TikTok* in the list of well known marks under Rule 124 of the Trade Mark Rules 2017. It is the case of the petitioner that the statutory provisions of the Trade Marks Act, 1999 and Rules framed thereunder, were not taken into consideration in a proper perspective by the said respondent while passing the impugned order.

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2. Before referring to the rival submissions, it would be appropriate to briefly refer to the relevant facts.

3. The petitioner is a technology company operating a range of content platforms, including a platform/mobile application bearing the mark *TikTok*. It is undisputed that *TikTok* is a registered trade mark. It is stated that *TikTok* is a social media video application for creating and sharing short talent videos. The videos are allowed to be created by the users of the application on short music and lip-syncing videos for uploading on the application.

4. The application was launched worldwide in the year 2017 and it employs Artificial Intelligence to analyze interests and preferences of users through their interaction with the content and it displays a personalized content feed to each user. By the year 2019, the aforesaid application *TikTok* was available in 155 markets and in 75 languages. It gained immense popularity and at a point in time, its downloads surpassed those of *FaceBook, YouTube* and *Instagram*. It is stated that while the petitioner has already obtained registration for its mark *TikTok* in India, some other applications for registration are pending before the respondent. In the statement of case placed before the respondent, the petitioner staked its claim for inclusion in the list of well known marks in terms of the provisions of the Trade Marks Act. Accordingly, the proceeding under Rule 124 of the Trade Mark Rules for inclusion of the mark *TikTok* in the list of well known trade marks was initiated. The said respondent kept the matter for

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hearing and after hearing, by the impugned order, the application filed by the petitioner was refused. The main reason recorded in the impugned order was that the application *TikTok* was found to be controversial by the Government of India and it stood banned in India, as the Government of India found the said application to be prejudicial to the sovereignty and integrity of India and for other such reasons.

5. Ms. Swati Mittal, learned counsel appearing for the petitioner, submitted that the impugned order can be said to be an order passed without reasons as certain press releases of the Government of India were quoted and without any application of mind, the impugned order was passed resulting in refusal of the application filed on behalf of the petitioner for inclusion of the mark *TikTok* in the list of well known marks. It was submitted that the non-application of mind was further evident from the fact that the said respondent made reference to Section 9 of the Trade Marks Act, which had no concern with the application filed by the petitioner. Only Section 11 of the Trade Marks Act was relevant, which was not even referred to and therefore, the impugned order deserves to be set aside.

6. It was further submitted that elaborate material was placed before the said respondent to justify the prayer for inclusion of the mark *TikTok* in the list of well known marks, but no reference was made to the same in the impugned order for refusing the application.

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7. It was submitted that therefore, the only reason discernible from the impugned order is the ban on the application *TikTok* issued by the Government of India by referring to a news item published in the magazine India Today. The learned counsel for the petitioner submitted that the ban imposed on some of the applications, along with the application of the petitioner, was lifted and therefore, mere banning of an application, which is necessarily a transient situation, cannot be the basis for refusing such an application for inclusion in the list of well known marks. It was submitted that there was no discussion on the factors to be taken into consideration by the said respondent under Section 11(6) of the Trade Marks Act, for determining the question as to whether the trade mark of the petitioner deserves to be included in the list of well known trade marks and hence, the impugned order deserves to be set aside. It was indicated that this Court may consider remanding the matter back to the said respondent for consideration afresh in the light of the requirements under the Trade Marks Act and Rules.

8. On the other hand, Mr. Yashodeep Deshmukh, learned counsel appearing for the respondent, submitted that the impugned order did take into consideration the relevant material while refusing the application of the petitioner for inclusion of its mark in the list of well known marks. It was submitted that merely because the said respondent referred to the wrong provision, in itself cannot be a ground for setting aside the order. It was further

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submitted that the factors indicated in Section 11(6) of the Trade Marks Act are not exhaustive in nature and that therefore, the said respondent was justified in taking into consideration banning of the application *TikTok,* while refusing to grant the application for inclusion of the said mark in the list of well known marks.

9. It was further submitted that the said respondent correctly referred to the relevant provisions in the Constitution of India and in that context, the relevance of the banning of the application *TikTok* by the Government of India, while passing the impugned order. On this basis, it was submitted that the petition deserved to be dismissed.

10. Before considering the rival submissions, it would be appropriate to first refer to the relevant provisions under the Trade Marks Act and Rules. Rule 124 of the Trade Mark Rules, concerning the determination of well known trade mark by the Registrar, specifies in sub-Rule (2) that while determining the trade mark as well known, the Registrar shall take into account the provisions of sub-Sections (6) to (9) of Section 11 of the Trade Marks Act. Thus, it becomes clear that while considering such an application as filed by the petitioner, the Registrar is required to keep in focus the requirements of Section 11(6) to (9) of the Trade Marks Act. It would be appropriate to refer to the said provisions, which read as follows :

"Section 11 – ***Relative grounds for refusal of registration.***

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(6) The Registrar shall, while determining whether a trade mark is a well-known trade mark, take into account any fact which he considers relevant for determining a trade mark as a well-known trade mark including—

(i) the knowledge or recognition of that trade mark in the relevant section of the public including knowledge in India obtained as a result of promotion of the trade mark;

(ii) the duration, extent and geographical area of any use of that trade mark;

(iii) the duration, extent and geographical area of any promotion of the trade mark, including advertising or publicity and presentation, at fairs or exhibition of the goods or services to which the trade mark applies;

(iv) the duration and geographical area of any registration of or any application for registration of that trade mark under this Act to the extent that they reflect the use or recognition of the trade mark;

(v) the record of successful enforcement of the rights in that trade mark, in particular the extent to which the trade mark has been recognised as a well-known trade mark by any court or Registrar under that record.

(7) The Registrar shall, while determining as to whether a trade mark is known or recognised in a relevant section of the public for the purposes of sub-section (6), take into account—

(i) the number of actual or potential consumers of the goods or services;

(ii) the number of persons involved in the channels of distribution of the goods or services;

(iii) the business circles dealing with the goods or services, to which that trade mark applies.

(8) Where a trade mark has been determined to be well known in at least one relevant section of the public in India by any court or Registrar, the Registrar shall consider that trade mark as a well-known trade mark for registration under this

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Act.

(9) The Registrar shall not require as a condition, for determining whether a trade mark is a well-known trade mark, any of the following, namely:—

(i) that the trade mark has been used in India;

(ii) that the trade mark has been registered;

(iii) that the application for registration of the trade mark has been filed in India;

(iv) that the trade mark—

(a) is well-known in; or

(b) has been registered in; or

(c) in respect of which an application for registration has been filed in, any jurisdiction other than India, or

(v) that the trade mark is well-known to the public at large in India."

11. Section 11(6) of the Trade Marks Act provides that a Registrar shall take into account any fact that he considers relevant for determining a trade mark as a well known trade mark, including facts specified in clauses (i) to (v) of the said sub-Section. A bare perusal of the said provision shows that it is not exhaustive in nature.

12. Section 11(7) of the Trade Marks Act elaborates the circumstances to be taken into consideration by the Registrar while applying Section 11(6) thereof.

13. Section 11(8) of the Trade Marks Act lays down that when a

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trade mark is already determined to be a well known mark by any Court or Registrar, it shall be considered as a well known trade mark under the Trade Marks Act.

14. Section 11(9) of the Trade Marks Act specifies that the Registrar shall not require as a pre-condition satisfaction of clauses (i) to (v) of the said sub-Section for determining whether a trade mark is a well known trade mark. The learned counsel for the petitioner has placed much emphasis on Clause (i) of Section 11(9) of the Trade Marks Act, which specifies that the aspect as to whether the trade mark has been used in India or not, shall not be taken as a condition by the Registrar while determining whether such a trade mark is a well known trade mark. It was submitted that even if, consequent upon ban imposed by the Government of India on the said application bearing trade mark *TikTok* of the petitioner, the trade mark is not being used in India, that in itself cannot be a ground to hold against the petitioner.

15. This Court is of the opinion that the impugned order indeed does not refer to Section 11(6) to (9) of the Trade Marks Act. In fact, it refers to Section 9 thereof, which is obviously not relevant for considering the application filed by the petitioner. But, that in itself cannot be a ground to set aside the impugned order.

16. A perusal of the impugned order shows that the respondent has take into account the basis of the claim made by the petitioner for inclusion of its trade mark *TikTok* in the list of well known

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marks. Thereafter, the respondent has referred to the controversy regarding the application *TikTok* of the petitioner, specifically referring to press release issued by the Government of India banning the application *TikTok* along with other applications. The Government of India exercised power under the provisions of the Information Technology Act and the Rules framed thereunder to ban the said application of the petitioner bearing the trade mark *TikTok*. There is also no dispute about the fact that the said application remains banned in India.

17. The respondent has then referred to some other material in the public domain, indicating the reasons as to why the application *TikTok* has been banned in India. Thereupon, the respondent has referred to the Constitution of India, including its preamble and eventually concluded that the said trade mark of the petitioner does not deserve to be included in the list of well known marks.

18. The reasoning adopted in the impugned order does not show reference to the factors indicated in Section 11(6) and (7) of the Trade Marks Act. But, as noted hereinabove, the factors included in Section 11(6) are not exhaustive in nature and it is crucial that the aforesaid provision specifies that the Registrar can take into account "any fact which he considers relevant for determining a trade mark as a well known trade mark". The factors included in Clauses (i) to (v) in Section 11(6) are obviously illustrative in nature and the said factors are not exhaustive.

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19. Therefore, the respondent is entitled to take into account a fact which is not mentioned in Clauses (i) to (v) of Section 11(6) of the Trade Marks Act, while considering the application filed under Rule 124 of the Trade Mark Rules, for inclusion of the trade mark in the list of well known marks.

20. As noted hereinabove, the fact taken into consideration by the respondent is the ban imposed by the Government of India on the application bearing the trade mark *TikTok*. The material taken into consideration by the said respondent in the impugned order shows that it refers to the aforesaid application of the petitioner bearing trade mark *TikTok* being found to be prejudicial to the sovereignty and integrity of India, Defence of India, Security of State and Public Order. The Government of India exercised power under the Information Technology Act and the Rules framed thereunder, for imposing such a ban. The said respondent also found that there was material indicating that the ban imposed on *TikTok* was also in the backdrop of concerns regarding data privacy of the users and the fact that the servers of the said application *TikTok* are located in China. The said respondent also referred to certain instances indicating that pictures of some women and girls downloaded from *TikTok* were found to be morphed and that there were cases of cyber bullying and sexually explicit context.

21. In this backdrop, the said respondent referred to the Constitution of India while passing the impugned order and

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thereupon, refused inclusion of the trade mark *TikTok* in the list of well known marks.

22. This Court is of the opinion that the aforesaid material taken into consideration by the said respondent can be said to be a relevant factor and it is covered under the aforesaid expression under Section 11(6) of the Trade Marks Act, highlighted hereinabove, which specifies that the Registrar (in this case, the said respondent) can take into account any fact that he considers as relevant. This Court is of the opinion that the banning of the application of the petitioner i.e. *TikTok* by the Government of India, while exercising power under the Information Technology Act and Rules, is indeed a relevant fact taken into consideration by the Registrar. It was admitted on behalf of the petitioner that the ban still operates. Merely because the ban on certain other applications has been lifted cannot be a ground for the petitioner to claim that the impugned order is rendered erroneous.

23. The statutory provisions of the Trade Marks Act and Rules are relevant and as noted hereinabove, Section 11(6) of the Trade Marks Act itself gives power to the Registrar to take into consideration any fact that he considers relevant for determining a trade mark as a well known trade mark. Apart from this, the Constitution of India would require all concerned Authorities to apply the law within the broad framework, indicated in the Constitution of India. The reasons why the application of the petitioner bearing the trade mark *TikTok* has been banned pertain

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to the sovereignty and integrity of India, its Defence and Public Order. These are serious matters, which cannot be ignored and therefore, it is found that the respondent did take into consideration relevant factors while passing the impugned order.

24. It is obvious that due to the ban imposed by the Government of India, the aforesaid application bearing the trade mark *TikTok* cannot be used in India. This would be irrelevant for determining the question of inclusion of the trade mark in the list of well known marks, but, since the said mark is already a registered trade mark in India, it does enjoy all statutory protection available under the Trade Marks Act. Inclusion in the list of well known marks obviously gives added protection to a mark, but in the light of the fact that the application *TikTok* itself has been banned in India, which till date admittedly has not been set aside by any Competent Court or Authority, this Court finds that no error can be attributed to the said respondent in passing the impugned order while refusing the application of the petitioner for inclusion of its trade mark *TikTok* in the list of well known marks.

25. In view of the above, the petition is dismissed.

MANISH PITALE, J.

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