

# IPR Newsletter



## INDEX

- *S. Sudhakar v. M/s GRB Dairy Food Pvt. Ltd. & Others*
- *Asos v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*
- *The Coca Cola Company & Anr v. K. M. Salim*

*“The greatness of a man is not in how much wealth he acquires, but in his integrity and his ability to affect those around him positively.”*

**-Bob Marley**

*S. Sudhakar*

*....Applicant*

v.

*M/s GRB Dairy Food Pvt. Ltd & Others*

*....Respondent*

**Applicant:**

S. Sudhakar on behalf of Shri Lakshmi Agro Foods Pvt. Ltd.

**Respondent:**

1. M/s Grb Dairy Food Pvt. Ltd.
2. The Assistant Registrar of Trademarks, Trademarks Registry, Chennai

**FACTS OF THE CASE:**

**Brief of the applicant:**

The applicant is engaged in the business of manufacturing and/or marketing of food and allied products such as dhall, atta, rawa, maida, salt, rice, spices, fried gram appalam, idli batter, etc. through M/s Shri Lakshmi Agro Foods Private Limited and is the registered joint proprietor of the trademark/ label "Udhaiyam" in class 30 vide 595393 for dhall and food products.

**Brief of the respondent**

The respondent is engaged in the business of "ghee" under the brand name "Udhayam" and is the registered owner of the trademark "Udhayam Ghee" vide application no. 785124 and "GRB Udhayam" vide application no. 1077180- both in class 29.

**BACKGROUND OF THE CASE:**

The applicant is the joint proprietor of the trademark / label "Udhaiyam" and is carrying on business through Shri Lakshmi

Agro Foods Pvt. Ltd. The said company is engaged in the business of marketing food and allied products under the said trademark "Udhaiyam". The applicant's goods are sold under the trademark "Udhaiyam" in the state of Tamil Nadu and in other states of India. The trademark "Udhaiyam" was honestly conceived and adopted by the applicant's predecessors in the year 1940. In order to cater to the increasing retail demand, another partnership under the name of Shri Lakshmi Agro Foods was constituted in the year 1993. The entire dhall was sold to Shri Lakshmi Agro Foods which in turn sold Dhall under the trademark "Udhaiyam" in retail quantities. M/s Karupiah Nadar & Sons and M/s Shri Lakshmi Agro Foods function like a single group.

The applicant came to know that the respondents are the registered proprietors of the trademark "Udhayam" and are selling goods i.e. ghee for which the applicant has even filed a civil suit before the Hon'ble High Court of Madras for infringement and passing off.

**MATTER OF DISPUTE:**

Whether applicant is a person aggrieved and has a locus to file an application for rectification as alleged by the respondents?

The trademark adopted by the respondent's is fraudulent and dishonest as it is identical and/or deceptively similar to that of the applicants trademark and there is likelihood of confusion and deception among the public as the goods are purchased by both literate and illiterate consumers as alleged by the applicant.

**OBSERVATIONS OF THE IPAB:**

**With regard to first point of matter to dispute:**

On this matter, IPAB stated that the applicant as a person is affected and aggrieved by the respondent's use of the impugned trademark for which it has filed a suit. Further, the respondents themselves have also, filed the suit against M/s Shri Lakshmi Agro Foods Pvt. Ltd. represented by its Director Mr. S. Sudhakar. Therefore, there remains on reason to accept the respondent's objection and hence the applicant is a person aggrieved and has a locus standi to file and maintain an application for rectification.

**With regard to second point of matter to dispute:**

IPAB observed the following:

Application No.785124 for the trade mark Udhayam Ghee:

The said application was filed on 06/01/1998 claiming user since 01/04/1993 and trading style at least since 30/04/1993 of which 1<sup>st</sup> invoice is dated 21/12/2001, which prove their use as claimed in the application. Further, the issuance of Agmark Certificate issued by the concerned authorities which is dated 05/06/1998 i.e. subsequent to the date of user claimed. Also, respondents have shown various advertisement as evidence to demonstrate their use but these evidence will not prove the use, as use means actual use/commercial use. Hence, advertisement cannot be taken as evidence for the respondent's use.

Application No.1077180 for the trade mark "GRB's Udhayam":

The said application was filed under class 29, which is a label mark with the device of cow. The application was made on 31/01/2002 claiming user since 01/04/1993 of which few advertisement receipts issued by the marketing companies which is of the year 2004 were available. The receipt does not prove use of the mark as

they are only of the year 2004 and not earlier i.e. 1993 for which usage is claimed in the application for registration. Therefore, there is no proof of their use since 01/04/1993 as claimed.

The respondents had been carrying on business under the name Udhayam Dairy Farm between the period 1991 – 1993. Thereafter, it has been under the name G.R. Balasubramaniam and Brothers, G.R. Balasubramaniam and Co., G.R. Balasubramaniam, GRB Dairy Foods, GRB Dairy Foods Pvt. Ltd. Hence, respondent's contention that they have adopted the trade mark "Udhayam" from the trading style cannot be accepted.

The Respondent's claim that the goods are different or not cannot be upheld as the trade channels are the same. In such a case, the class of customers is to be considered. The customers who purchase the goods of the applicants and the respondents belong to all class i.e. literate and illiterate. Therefore, there is every possibility that there may be confusion among the public.

### **JUDGMENT:**

The mark deserves to be removed for wrong date of user as the respondent's have not satisfied the Registrar as regard to the date of use. Therefore, the application for the rectification is allowed with a direction to the registrar to cancel the trademarks registered under No. 785124 and 1077180 in class 29. Further, there shall be order as to costs.

*Asos*

v.

*Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*

**May 05, 2014**

### **Applicant:**

ASOS plc established in London (United Kingdom)

### **Defendant:**

Office for Harmonization in the Internal Market (OHIM)

### **Intervener:**

Mr. Roger Maier, for and behalf of "ASSOS", the mark for which application was filed on 9 September, 2005 under Classes 3, 12 and 25, registered on 11 September, 2006 under no. 4580767 accompanied by a priority claim in respect of a Swiss trade mark application filed on 14 June, 2005

### **BACKGROUND OF THE CASE**

**June 30, 2005:** Applicant Asos plc, filed an application for registration of the word mark "ASOS" under classes 3, 18, 25 and 35

**February 6, 2006:** The trade mark application was published in Community Trade Marks Bulletin No 6/2006

**April 27, 2006:** The intervener, Mr. Roger Maier, filed a notice of opposition for the registration of the mark "Asos"

**November 9, 2010:** The opposition upheld by the Opposition Division for all the goods and services under classes 3, 25 and 35 and partially for goods under class 18

**November 11, 2010:** The applicant filed an appeal with OHIM, against the decision of the Opposition Division.

**October 17, 2011:** The Fourth Board of Appeal of OHIM upheld the appeal in part, stating as follows:

a) The goods and services in Classes 3, 25 and 35 covered by the mark applied for and the goods

covered by the earlier mark were identical or similar.

b) The goods in Class 18 with regard to 'articles of leather and imitations of leather; bags; handbags; shoulder bags; belts; parts and fittings for all the aforesaid goods', were similar to the goods covered by the earlier mark.

### **With regard to comparison of the signs at issue:**

The mark shared the letters 'a', 's', 'o' and 's' and differed only by an additional letter 's' in the earlier mark. The additional letter 's' is hardly audible in many of the languages of the European Union, hence, the signs at issue are very similar both visually and phonetically.

### **With regard to the overall assessment of the likelihood of confusion:**

There is high degree of visual and phonetic similarity between the signs, there is a likelihood of confusion in respect of the identical and similar goods. Further, the applicant had not succeeded in proving that the marks at issue coexisted peacefully within the territory of the European Union.

**December 19, 2011:** Application lodged with the General Court

### **CLAIMS IN THE SUIT:**

#### **Applicant's Claim:**

Annul the contested decision in so far as it refuses registration of the mark applied for

Allow the registration of the mark

Order OHIM to pay the costs

#### **OHIM Claim:**

Dismiss the action

Order the applicant to pay the costs

**Intervener Claim:**

Dismiss the action

Amend the contested decision in so far as it finds no likelihood of confusion in regard to “bumbags, sports bags, casual bags, briefcase, attaché cases, satchels, beauty cases, credit card cases and holders, wallets, purses in Class 18. It dismissed the appeal as to the remainder.

**OBSERVATIONS OF THE GENERAL COURT:**

**Claims of the Applicants:**

- a) **To allow the registration of the mark applied for in respect of goods and services at issue:**

The General Court stated that, when an action is brought before the Courts of the European Union against the decision of a Board of Appeal of OHIM, OHIM is required to take the measures necessary to comply with the judgments of those Courts. Accordingly, it is not for the General Court to issue directions to OHIM. It is for the latter to draw the appropriate inferences from the operative part and grounds of the Courts’ judgments. Hence, the applicant’s claim is for that reason inadmissible.

- b) **Annul the contested decision in so far as it refuses registration of the mark applied for:**

The General Court stated that for the majority of the relevant public, neither of the signs at issue has a meaning and the conceptual comparison is neutral. Further, with regard to the applicant’s claim that there is a peaceful coexistence of the marks at issue in 18 Member States of the European Union, it

held that a declaration originating from the applicant itself cannot be attributed probative value unless it is corroborated by other items of evidence. Also, the intervener opposed the registration of the applicant trade mark ASOS in the United Kingdom and the applicant subsequently withdrew its application for registration. Hence, the Board of Appeal correctly took the view that “this cast doubt upon the peaceful coexistence of the marks at issue.”

**Claims of the Intervener:**

**With regard to second head of claim:**

The General Court stated that while assessing the similarity of the goods or services concerned, all the relevant features relating to the relationship between those goods or services should be taken into account. Those factors include, in particular, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary. Other factors may also be taken into account, such as the distribution channels of the goods concerned. Goods or services are complementary where there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that consumers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking.

Therefore, the Courts held that “The Board of Appeal consequently held correctly that the goods, coming within Class 18, were not complementary to ‘clothing, footwear, headgear’ in Class 25 as contemplated by the applicant.” It further added that “The Board of Appeal acted correctly in holding that the ‘bumbags; sports bags; casual bags; briefcases; attaché cases;

satchels; beauty cases; credit card cases and holders; wallets; purses’ in Class 18 and referred to in the application for the mark sought and the goods in Class 25, covered by the earlier mark, were not similar.”

**JUDGMENT:**

The applicant’s action must be dismissed in its entirety and the intervener’s second head of claim, seeking partial annulment must be rejected.

Asos plc to bear its own cost and to pay the costs incurred by the OHIM.

Mr. Maier to bear his own cost.

*The Coca Cola Company & Anr*

*....Plaintiff*

*v.*

*K. M. Salim*

*....Defendant*

**Marks at issue:**



**Brief of the Plaintiff:**

The plaintiff founded in 1886, is a corporation organized and existing under the laws of the state of the Delaware, United States of America and is the world’s leading manufacturer, marketer and distributor of non-alcoholic beverage, concentrates and syrups used to produce nearly 400 beverage brands and is the registered proprietor of the well known trade



marks Sprite, Thums Up, Fanta, Coca-Cola, Coke, Diet Coke, Minute Maid, Limca, Mr. Pibb, Kinley, Mazza, Powerade, Sunfill, etc.,

### **Brief of the Defendant:**

The defendant is the registered proprietor of the trade marks Funs Up bearing number 973780, Bright bearing number 956526 which is abandoned and Bright with label bearing number 1789464 having the status of abandoned.

### **MATTER OF DISPUTE:**

Misuse of the trade marks Sprite, Sprite (label), Fanta (label) and Thums Up as well as the copyright that subsists in the Sprite and Fanta label by the defendant through their registered trade marks in the name and style of Bright and Funs Up. Also, the defendants had copied the distinctive elements of the Plaintiff product Fanta which comprise of unique colour combinations and the distinctive style of writing amounting to infringement of the registered trade marks Sprite and Thums Up, passing off and the copyrights in the Sprite and Fanta labels.

### **Date-wise Events in the case:**

**December 2008:** Plaintiff came to know about the activities of the defendant

**02.01.2009:** The attorney of the plaintiff wrote a letter to the defendant to cease and desist from manufacturing, selling or offering for sale any goods under the offending label and/or trade dress and/or any other mark or name identical/virtually identical or deceptively or confusingly similar to the trade marks of the plaintiff No.1 or in any other manner whatsoever infringing the registered trade marks Sprite and Thums Up and/or the copyright in the Sprite and Fanta label.

**28.01.2009:** Attorney of the plaintiff sent a reminder letter to the defendant.

**12.02.2009:** Defendant's filed a response to the letter dated 28.01.2009 denying the contentions of the plaintiff.

**14.04.2009:** Attorney replied to the letter of the defendants denying their contentions and reiterating the plaintiff rights.

**04.06.2009:** Reminder letter sent to the defendant when no response from them was received on the plaintiff's letter dated 14.04.2009.

**22.06.2009:** Defendant called the counsel of the plaintiff asking about the specific changes in the impugned marks and label to amicably settle the matter.

**08.07.2009:** Plaintiff counsel wrote a letter specifically stating the changes required to be made by the defendant.

**17.01.2012:** The plaintiff counsel wrote a RTI to ascertain the renewal status of the defendant's registration for the mark 'Funs Up' and if the registration has not been renewed, why the status had not been updated to "Removed"

**13.02.2012:** Response received against the RTI filed by the Plaintiff, confirming the registration of the mark Funs up not renewed till date and status will be updated.

**07.06.2012:** Letter to the defendant's counsel informing them that they are still using the impugned marks and label Bright and Funs Up and the plaintiff will file a suit.

### **Pleas of the Plaintiff:**

#### **1. Infringement of trade mark:**

The defendant violated the statutory rights and infringement of plaintiff

well known trademarks under Section 29 of the Trade Marks Act, 1999, causing confusion and deception in the minds of the consumers and to dilute the distinctiveness of the plaintiff's trademarks resulting in misappropriation of plaintiffs' goodwill and reputation.

#### **2. Infringement of copyright:**

To grant perpetual order of injunction restraining the defendant by himself, its servants, dealers and agents from infringing the plaintiffs' copyrights in its artistic works by reproducing it or any substantial part thereof in any material form and/or by using its impugned work in any manner, whatsoever. Apart from being a civil violation, the impugned use, imitation and reproduction also constituted a cognizable criminal offence under the provisions of Sections 63 and 64 of the Copyright Act, 1957, which is punishable with imprisonment up to three years and penalty up to Rs.2 lac.

**3.** To declare defendant act of copying several distinct elements of the plaintiffs' SPRITE and FANTA labels as passing off and act of unfair competition.

### **OBSERVATIONS OF THE HIGH COURT:**

**1.** All the three trademarks of plaintiff i.e. Sprite, Thums Up and Sprite (label) under which it offer its products are famous and well known throughout the globe and comes under the purview Section 2 (1) (zg) of the Trade Mark Act, 1999, which has defined "well-known trade mark". They are, therefore, liable to the protection accorded to well-known marks by the Act.

**2.** As per settled law, it appears to the court that the

defendant's mark Bright and Funs Up are phonetically, confusingly and deceptively similar to plaintiff registered and well-known trade mark Sprite and Thums up. The defendant is guilty of infringement of registered trade mark.

3. The colour combination of the plaintiff Sprite label has been copied by the defendant i.e. the Blue colour on the top half of the label merging into the colour Green on the bottom half of the label and the mark Bright written in white with a blue outline. The plaintiffs' style of representing the trade mark Sprite diagonally across the label written in white block letters has also been copied by the defendant. The label of the defendant also has representation of bubbles which has also been copied from the plaintiff's Sprite label. The defendant is also bottling soft drink bearing the impugned mark Funs Up. Additionally the label being used by the defendant for the impugned mark Funs Up was confusingly and deceptively similar to the label used by the plaintiff for their product Fanta. The orange colour with the mark written in a dark blue colour. The defendant has also copied the distinctive style in which the plaintiffs' represent Fanta. Additionally even the placement of the word Fanta which is diagonal has been copied by the defendant by placing their mark Funs Up diagonally on the label. The defendant has also placed a leaf device on their label above the word Funs Up in a similar fashion as the plaintiffs' place a leaf device above the mark Fanta. The defendant further has used an orange circular background on which it inscribes Funs Up which is similar to orange circular background on which the plaintiff's inscribe Fanta.

**DECREE OF THE HIGH COURT:**

1. The defendant, its servants, partners, employees, agents, distributors, franchisees, representatives and assigns are restrained from manufacturing or authorizing the manufacture, selling or offering for sale, marketing, advertising, promoting, displaying or in any other manner whatsoever using the impugned marks "Bright" and/or "Bright (label)" and/or "Funs Up" and/or "Funs Up (label) " and/or any other mark which is deceptively or confusingly similar to the registered trade marks "Sprite", "Thums Up" and "Fanta (stylized)" of Plaintiff, as a trade mark or part of a trade mark, trade name or part of trade name or as a domain name or part of a domain name or in any other manner whatsoever so as to infringe the Plaintiff's registered trademarks and also using any label which is a substantial reproduction of the artistic work in and to the Sprite and Fanta label of the plaintiff or any other manner infringing the copyright in the artistic work which vests with the Plaintiff.

2. They are also restrained from passing off their goods as and for the goods of the plaintiff by use of the marks "Bright" and/or "Bright (label) " and/or "Funs Up" and/or "Funs Up (label) " and/or any other trade mark or name similar to the Plaintiffs' trade marks "Sprite" and "Thums Up" as a trade mark or part of a trade mark, trade name or part of trade name or as a domain name or part of a domain name or in any other manner whatsoever.

3. The Defendant is directed to hand over to the Plaintiffs or their nominated representative all goods, bottles, bottle caps, labels, packaging and promotional material, catalogues, stationery and any other material whatsoever bearing the "Bright" and/or "Bright (label) " and/or "Funs Up" and/or "Funs Up (label) " and/or any other trade mark deceptively or confusingly similar to the trade

marks "Sprite" and "Thums Up" and/or any labels which is a substantial reproduction of the artistic work which vest in the Sprite and Fanta labels of the Plaintiff No. 1 within one month from today.

4. The plaintiffs are also entitled to costs.

5. As the suit has already been decreed, the application being I.A. No.932/2013 under Order 39 Rule 1 and 2 CPC is also disposed off.

**DISCLAIMER:**

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