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Joy for Jio

Reliance's new brand 'Jio' has gained vast popularity in India due to its unconventional marketing strategy and within a span of 2 years it has amassed a wide consumer base. The trade mark 'Jio' has been filed for registration in India as well as various countries outside India. Recently, the trade mark 'JIO' was registered in the European Union when the proprietor of the trade mark 'Joi', LKN Communications Inc., filed invalidity proceedings against the registration of the mark 'Jio'.

The trade mark 'JOI' was registered in class 09 whereas the trade mark 'JIO' was registered in class 38, LKN Communications argued that the marks were registered in cognate classes. Furthermore, there existed a likelihood of confusion between the marks 'JOI' and 'JIO'. It was argued on behalf of Jio that telephone service providers did not sell any goods therefore there was no likelihood of confusion in this regard or with respect to any phonetic or visual similarity.

The Cancellation Division of the EUIPO heard the matter and ruled that while the word 'JOI' may be considered as a misspelling of the word 'JOY' the same could not be the case for 'JIO'. Furthermore, it was ruled that there was no conceptual or aural similarity between the marks. The Cancellation Division noted that there was no pleading from LKN Communications that the mark 'JOI' enjoyed enhanced degree of distinctiveness and therefore, ruled that there was low likelihood of confusion between the marks in question. LKN Communications was ordered to bear the cost of the proceedings i.e. € 450. Reliance Industries Ltd.'s trade mark applications in EUIPO were filed through R.K. Dewan & Co.

Not a sweet surprise

The get-up, packaging, representation of a product plays a key role in the marketing and sale of the product. An inherently distinctive packaging style or a packaging which has acquired distinctiveness by virtue of its continuous use is also capable of being protecting under the Indian Trade Marks law. In the recent case of *Ferrero Spa & Anr vs Piyush Devangan & Anr* at the centre of the controversy was the identical packaging of chocolates by an Indian proprietor.

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Ferrero Rochers are popular chocolates which are sold in a rectangular box with soft edges as corners, this box has 16 chocolates divided into two rows. The chocolates are wrapped in a golden wrapper with a white sticker on each of these chocolates' wrapper, the round chocolates are then placed on flute brown colored cupcake shaped wrappers. It was the case of Ferrero Rochers that the Defendants (Piyush Devangan & Anr.) were selling their chocolates under the brand 'D-lizie' but with identical packaging style. It was asserted by Ferrero Rocher that this action of the Defendants amounted to infringement of its statutory rights as well as passing off, of its goods as that originating from Ferrero Rocher. The following are the images of the two products:



Plaintiff's product



Defendant's product

(Image from: [HERE](#) and [HERE](#))

A perusal of the overall packaging and presentation of the products clearly shows that an ordinary purchaser may be deceived into purchasing the chocolates under the brand 'D-lizie' mistaking it to be similar to or the same as Ferrero Rocher chocolates and this is in contravention of the founding principles of Trade Marks Act, 1999. The judge perused the matter and observed that Ferrero Rocher had established a *prima-facie* case against the Respondent. The unique point of this case is that even though the traditional trademarks i.e. the brand name of the chocolates are dissimilar it still does not mitigate the possibility of being sued for trade mark infringement and passing off if the packaging is deceptively similar. In trademarks law, the visual test for determining similarity is as important as aural similarity between two trademarks. Therefore, this case is a good precedent against scrupulous traders who may adopt a different trade mark but identical packaging and presentation of a product to cause confusion in the minds of members of trade and public.

BCCI bowls out Junior Indian Premier League

India is a cricket loving nation, the sport has its fair share of aficionados in India and the organization basking in all this adulation is the Board of Control for Cricket in India (BCCI). The BCCI is the richest cricket boards and pursuant to launching the Indian Premier League (IPL) in 2008, the BCCI has prospered tremendously. Recently the BCCI filed a trade mark infringement suit against Grace India Sports Pvt. Ltd. for using the trade mark 'Indian Junior Players League Twenty 20' and the domain names WWW.IJPLT20.COM and WWW.JUNIORSIPL.COM.

It was stated by BCCI's counsel that, upon learning the Defendant's (Grace India Sports Pvt. Ltd.) use of the infringing trade mark and domain names, in December 2016 BCCI sent a Cease and Desist notice to the Defendants. The Defendant through its Executive Director replied to BCCI's notice informing that they had no intention of misleading people about their association with BCCI. The BCCI through its representative responded that since no approval had been obtained by the Defendant prior to launching its juniors' tournament, it could not use the deceptively similar trademarks and conduct such tournament. The Defendant's representative sought an appointment for amicable resolution of the dispute however; there was no further meeting between the two parties. In or around August 2017, BCCI learnt that the Defendant was planning to hold a cricket tournament in Dubai from 19th September, 2017 to 30th September, 2017. Furthermore, the Defendant was now carrying out its activities under the domain name WWW.IJPLTH.COM to promote its activities. The domain name WWW.JUNIORSIPL.COM was no longer active however the domain name WWW.JIPLT20.COM re-directed visitors to the website WWW.JIPLTH.COM. BCCI sent a second cease and desist notice to the Defendant in October, 2017. It was the case of BCCI that the Defendant's use of the trade mark 'Indian Junior Players League' and the domain name WWW.IJPLTH.COM amounted to infringement of its registered trademarks 'IPL' and 'IPLTwenty20' since the Defendant's trade mark contained all the elements of BCCI's registered marks.

The Bombay High Court perused the facts of the case, compared the trademarks and even referred to newspaper clippings where the Defendant's tournament was being referred to as 'Indian Junior Premier League'. It was ruled that a case of real and actual confusion was established by BCCI against the Defendant's use of the trade mark 'Indian Junior Players League' and therefore BCCI was entitled to relief for infringement and passing off against the Defendant; accordingly an order of injunction was passed against the Defendant and its representatives from using trademarks deceptively similar to BCCI's registered trademarks. This case throws light on the fact that use of abbreviations which are identical to an existing mark can also result in an action for trade mark infringement irrespective of the fact that such abbreviation may, otherwise have a different full form.

No 'MARQ' to Flipkart

The e-commerce transactions have increased phenomenally in India in the last few years, this movement has been spearheaded by Flipkart and Amazon in India. Recently, Flipkart in a bid to increase its influence in electronic goods market launched a new brand 'MARQ' however, this trade mark faced legal issues because of its similarity to a prior

registered trade mark 'Marc' also being used ofr electronic appliances. This case, *M/s Marc Enterprises Pvt. Ltd. v. Flipkart India Pvt. Ltd.* was filed before the District Court, Patiala House in New Delhi.

Marc Enterprises claimed that it was using the trade mark 'Marc' since 1981 and in respect of electronic goods the mark was being used since 1984. It was submitted that Flipkart had filed for registration of the trade mark 'MARQ' on a proposed to be used basis and has admitted to using the mark only from 2017 therefore, it should be enjoined from using the trade mark 'MARQ'. Flipkart submitted that though Marc Enterprises was aware of Flipkart's use of the trade mark 'MARQ' since 2017, yet no steps had been taken by it at that time to prevent Flipkart's use of the same.

The Judge heard the parties and ruled that here was phonetic similarity between the marks 'MARC' and 'MARQ' and since the trade mark 'MARC' was being used since 1981 the proprietor thereof had a better title. Therefore, Marc Enterprises was successful in establishing a prima-facie case and an order of injunction was passed against Flipkart. This is a reminder that prior to adopting a trade mark every company must ensure that a prior search is done in the database of the Trade Mark Registry to avoid any possibility of legal conflict in future.

No copyright protection for film titles

The title of a work plays a key role in grabbing the attention of the target base, an interesting title of a book or movie may get more takers than a work with a mundane title. It is for this reason that various authors, movie producers tend to seek protection for such titles under copyright Act, 1957 or through Film and Television Producers Guild etc. The Indian Copyright act, 1957 *per se* does not protect titles or films, books or songs this is particularly so because the title to a work is too short and incapable of being an independent work protectable under the Act. This was reiterated by the Madras High Court in its recent division bench decision in the case of *M/s Lyca Productions & Anr. vs. J. Manimaran* .

The case was an appeal from a single judge decision, the Plaintiff (J. Manimaran) claimed that he was producing a film bearing the title 'Karu' which is a Tamil word for 'Foetus'. The Plaintiff claimed that he had also registered the title of his work with the Film and Television Producers Guild of South India in 2011. The Plaintiff submitted that simultaneously the Defendant (Lyca Production) was also producing a film titled 'Lyca's Karu'. The Defendant submitted that its title was registered with the Tamil Film tProducer Council from 2017. The Plaintiff submitted that it was standard industry practice to obtain registration for titles of work from such Producers guild and since it was the prior registrant of the title 'Karu' the Defendant should be enjoined from using a similar title. The single judge had ruled in favor of the Plaintiff. In the appeal the division bench perused section 13 and 16 of the Copyright Act, 1957 and ruled that the Copyright Act did not grant protection to title of a cinematographic work; it protected the work contained therein. Furthermore the decision of the apex court in *Krishika Lulla v Shyam Vithalrao Devkatta & Anr* was also referred to. The Division Bench held that the registration of title of works with film guilds/councils, which were not recognized copyright societies, cannot result in preventing a third party which is not a member of such council, from using the title, since such third party is not bound by the internal rules and regulation of such guild. Furthermore, such

guilds were incompetent to administer rights in cinematographic works because they are not registered as copyright societies under the Act.

This decision will have a crucial impact on the film industry because a lot of media houses/producers secure registration in title of their works through registration with such producers guild. Pursuant to this decision it is evident that film titles may be protectable only if producers that are member of the same guild have a conflict over the title, otherwise a third party is free to select a similar title as an earlier movie without legal consequences for such similar work title.

Shedding crocodile tears

Crocs Inc. is a popular U.S. brand known for its unusual clog like footwear which may have a perforated or a non-perforated surface design. It is for this reason that Croc Inc obtained design registration for both its usual designs. This was followed by Croc Inc. filing multiple suits against its competitors such as Liberty, Relaxo, Action Shoes, Bata etc. to injunct them from selling footwear which were identical/imitation of Croc's registered design. Initially, Croc succeeded in obtaining an interim injunction in these cases however, the injunction orders were later vacated. These matters were heard together and recently, the Delhi High Court passed its judgment.

The Plaintiff (Crocs) claimed that the defendants (Liberty, Bata, Action Shoes etc.) were infringing on its statutory rights under Section 11 of the Designs Act, 2000 and therefore, it ought to be protected under Section 22 of the Act. The defendants argued that the Plaintiff's design was liable to be cancelled under Section 19 of the Act on the grounds that the design had been disclosed prior to Plaintiffs application for design registration; the design lacked novelty and therefore was not registerable under the Designs Act, 2000. The Defendants filed as evidence a publication of Holey Shoes dated 2002 which showed designs which were similar to that of the Plaintiff's and was created prior to the Plaintiff's application for design registration. The Defendants were successful in proving that the design applied by the Plaintiff was not new or original, in fact it was a trade variant which was not capable of protection under the Act as it did not satisfy the novelty threshold.

The High Court heard the parties and concluded that the Plaintiff's designs were variants of previously existing designs therefore no injunction could be granted in favor of the Plaintiff. Furthermore, since the Plaintiff had refused the possibility of amicable resolution with the Defendants, it was now liable under Section 35 of the Commercial Courts Act, 2016 to pay costs to each Defendant in the proceedings. This is an interesting case because the Delhi High Court took a strict interpretation for payment of costs under the Commercial Courts Act, 2015 and set a precedent against Plaintiffs filing commercial suits which lack merit.