

24, August, 2020

Chandigarh

To

The Registrar of Trademark,

Intellectual Property Bhavan,

Plot No. 32, Sector 14,

Chandigarh, 160014

**Sub:** Reply to the Examination Report for Application No. NTMC2020043 in Class: 28 in the name of M/s DARLENE ALDERSON.

Hon'ble Mx Registrar,

In furtherance to the Examination Report dated 16-08-2020 regarding the Trademark "NODY" which is subject matter of Application No. NTMC2020043 in Class: 28 in the name of M/s DARLENE ALDERSON, we would like to submit, humbly, the following response:

1. The trademark "**NODY**" is a distinct mark with user confined to niche and distinct product which shall cater to niche and distinct market thus creating an overall distinct brand and perception amongst the public which makes it unlikely to cause confusion or deception amongst the public at large. Hence, the trademark "**NODY**" merits a higher level of distinctiveness. The applicant disagrees with the Hon'ble Registrar on raising relative grounds of refusal under Section 11(1) of the Trademarks Act, 1999.
2. The Trademark "**NODY**" is proposed to be registered under Class 28 for single and specific type of articles, those being, "Artificially Intelligent Toy robots that sing, dance, read, write and learn from stimuli around them" or simply put "Smart Toy Robots" (hereinafter addressed).

3. The objection under S 11(1) of the Trade Marks Act, 1999, does not arise as the mark “NODY” is not identical with or similar to the mark objected by the examiner bearing application no. 757853 i.e. “NODDY” in respect of identical or similar description of goods or services and that on account of this, there exists no likelihood of confusion on the part of the public.

For your kind perusal, Section 11(1) is cited as follows:

Section 11. (1) “Save as provided in section 12, a trade mark shall not be registered if, because of-

(a) its identity with an earlier trade mark and similarity of goods or services covered by the trade mark; or

(b) its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

On bare reading, it is imperative that the combined effect of two factors constitute an occasion for probable confusion on the part of public, those factors being:

- a. The identification or similarity of the trade mark, along with
- b. The identification or similarity of goods/services traded

Hence, the law is clear that not only the marks are to be compared but equal weightage and consideration is to be given to the similarities/differences between description of goods traded under the mark.

4. In accord with the above, it is humbly submitted that the applicant’s mark NODY is not identical with or similar to mark NODDY so as to be likely to deceive or cause likelihood of confusion amongst the public at large. As it’s imperative, NODY is a four letter word as opposed to the five letters of the mark NODDY which gives it a clear difference in spellings thus making it significantly visually different. Owing to the fact of different spellings, there arises a difference in pronunciation where NODY is

pronounced with a different emphasis on the combination of NO (as in know) and DY (as in die) thus making it phonetically dissimilar, also.

5. Further, there is dissimilarity in the description of goods of the mark NODY and NODDY. The products of both trademarks, though falling in the same class, could be easily distinguished by the Consumers. The applicants mark is proposed to be used for a specific or niche and distinct kind of goods under class 28, those being “Artificially Intelligent Toy robots that sing, dance, read, write and learn from stimuli” or simply put “Smart Toy Robots” which is altogether different from the goods traded under mark NODDY, with the latter trading under broad classification of goods under class 28 with a range of traditional toys including figures, playsets, vehicles, games (called the preschool range) among others, which are simple in functioning.
6. Reliance is placed on *Nandhini Deluxe v. Karnataka Co-Operative Milk Producers Federation Ltd.*, AIR 2018 SC 3516, wherein the Hon’ble Court, in essence, held that the registration of a mark that is deceptively similar to a prior registered mark in the same class is permissible, provided that the condition is met that there is no overlap in the goods i.e. all the goods/articles of the marks are of dissimilar description and the manner in which the goods are traded is different..
7. For determining the similarity/dissimilarity of goods/services (namely whether the goods/services are of the same or different description) the UK Registry (UK being a common law country) follows the guidelines given in the *Jellinex* case (1946) 63 RPC 59 and the *Floridex* case (1974) RPC 583). For the goods to be of the same description, the following considerations may be taken into account.
  - I) **the nature of the goods**- Nature of the goods of both the marks is not same. NODY products are educational scientific toys which employ latest technology of artificial intelligence whereas NODDY products are a range of traditional toys which include static toys or games and playthings involving some basic mechanics.
  - II) **purpose of the goods**- purpose of the goods is not same as NODY products are to be used for educational purposes, that is, to teach High school children and young adults about the concept of artificial intelligence with practical, fun and easy learning method whereas no such purpose is served by the toy

products of NODDY as these are mostly used for playful engagement of toddlers and young children.

III) **channels of trade** for the goods same or coincide at some stage- this is also not true for this case as the section of market which is captured by the NODY products is altogether different from that of NODDY products. The NODDY toy products are targeted towards market comprising of toddlers and young children. The applicants goods cater to a completely different market from that of NODDY which consists of educational institutions, school going children aged 14 years and above including young adults. Moreover, The Smart Toy robots of NODY fall at a higher price range than an average product of NODDY, with the former starting from 15k and upwards and are categorised as luxury goods which shall be sold only at exclusive retail outlets. Thus, further diverging the channels of trade for the goods.

8. Further, reliance is placed on the case of **Vishnudas Trading as Vishnudas Kushandas** wherein it was held that when a person trades or manufactures one good under the broad classification having no bona fide intention to trade in all other goods falling under that broad classification, they cannot be permitted to enjoy monopoly in articles falling under such classification. Evidently, NODDY has not registered itself for goods 'smart toys' nor has traded or expressed intention to trade goods under this category of smart toys under class 28, therefore it can not enjoy monopoly over all the articles under broad classification of toys/playthings and preclude the applicant from registering for these articles.
9. It is further submitted that the law is clear that the global appreciation of the likelihood of confusion must be made through the eyes and the ears of the "average consumer". The average consumer will depend upon the type of goods or services in question, so that this may include members of the trade as well as of the general public. He/she is "deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind" (Lloyd). The consumer's level of attention is likely to vary according to the category of goods or services. Since, applicants product being a sophisticated product which is marketed to

educational institutions, school going teens and young adults, it is clear that the consumers consists of educated and knowledge public with greater attention to detail. Thus, further reducing the likelihood of confusion.

10. Drawing inspiration from *Cadila Healthcare Limited vs. Cadila Pharmaceutical Limited*(AIR 2001) SC 1952, it is humbly submitted that legislative intent behind the provision of section 11(1) is to be given due respect and consideration. The legislative intent does not warrant refusal on mere technically or computationally correct similarities between two marks. It proposes a well rounded consideration of all the factors at play while comparing the trademarks. Conflicting marks have to be compared in a holistic manner giving equal weight to the tangible and intangible factors related to identity of the goods of the mark which constitute the brand and perception of the trademark among the consumers.
11. The degree of visual and phonetic dissimilarity of mark “NODY” coupled with the level of distinctiveness attributed to it because of its user confined to niche type of toys those being Smart Toy Robots which capture a distinct section of market thus the remoteness of the description of goods and the sophistication of the buyers, the applicant’s bona fide intention in adopting the mark and the quality of applicant’s product combined, merit a higher level of distinctiveness and would not cause likelihood of confusion as to the origin or source of the good among public at large and thus would not warrant invocation of objection under section 11(1) of the act.
12. Therefore, the refusal raised under Section 11(1) of the Trade Marks Act 1999, should be withdrawn and the application should be accepted for registration and should be published immediately in the Trademark Journal. In the event this applicant is still required to pursue the application for the subject mark and for any submission of arguments and production of evidence in support of the applicant’s contentions and defence, it is humbly submitted that we would like to be heard at the office of the Trademarks Registry, Chandigarh.

Thank you,

Jashan and Associates