

To,

Date: 19/08/2020

The Registrar of Trademark,

Trademark Registry, DELHI

Sub: REPLY TO EXAMINATION REPORT(MIS-R) Dated on: 16/08/2020 08:29:35 Ref:
Application Number: NTMC2020054

In case of hearing, your preferred mode of attending the hearing is: VIRTUAL

Sir,

With reference to the above application, the point wise reply is as under.

Reply attached separately,

XYZ

Advocate (123456)

19TH August, 2020

Hyderabad

To

The Registrar of Trademark,
Intellectual Property Bhavan,
Plot No. 32, Sector 14,
Dwarka, New Delhi – 110078.

Sub: Reply to the Examination Report for Application No. NTMC2020054 in Class: 9 in the name of M/S. Mehul Tandaboina.

Dear Sir/Madam,

In furtherance to the Examination Report dated **16th August, 2020** regarding the Trademark “**JABUTICABA**” which is subject matter of **NTMC2020054** in **Class: 9** in the name of **M/S. Mehul Tandaboina**.

Upon perusal of the Examination report, we note that the learned Registrar has raised objections to the registration of the word mark, ‘JABUTICABA’. We submit our reply to the objections thus raised as follows:

1. *That the mark is devoid of distinctive character under Section 9(1)(a) of the Trade Mark, 1999 as the “mark is a non-distinctive and as such it is not capable of distinguishing the goods or services of one person from those of others.”*

We Respectfully DENY This Objection

- It is submitted that Jabuticaba is a word which is not used in day to day activities in India. Jabuticaba or Jaboticabeira is a Brazilian grapetree- which is unique tree where the fruit grows on the trunk of the tree. The Petitioner aims at providing ‘unique’ mobile phones to its consumers targeting working women. Therefore, the product and the proposed word mark can be distinguished from each other.

- It is submitted that, there are various types of trademarks. Initially four categories of trademarks i.e. (1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful were set out in *Abercrombie & Fitch Co. v. Hunting World, Inc.*¹
- It is submitted that JABUTICABA are arbitrary words which have no relation to the business of mobile phones and accordingly fall under the fourth category as cast out in the above mentioned case law.
- In *Two Pesos, Inc. v. Taco Cabana, Inc.*², it was held that there are five categories of trademarks. The relevant portion of the said judgment is reproduced herein below:— “... Marks are often classified in categories of generally increasing distinctiveness; following the classic formulation set out by Judge Friendly, they may be (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful. ...The latter three categories of marks, because their intrinsic nature serves to identify a particular source of a product, are deemed inherently distinctive and are entitled to protection. In contrast, generic marks—those that “refe[r] to the genus of which the particular product is a species”
- In *M/S Telecare Network India Pvt ... vs M/S Asus Technology Pvt Ltd & Ors*³ “The term ‘generic’ refers to the ‘genus’ to which a particular product or service is a species of. The term ‘descriptive’ refers to a word/mark which describes an article/service, its qualities, ingredients or characteristics. However, often the lines differentiating different categories of marks are blurred. Often, distinctions between suggestive, fanciful and arbitrary marks may seem artificial.....The term ‘fanciful’ refers to a mark which is an invented word solely for use as trademarks. When a common word is applied in an unfamiliar way, it is called an ‘arbitrary’ mark. For instance, “Ivory” would be generic when used to describe a product made from the tusks of elephants but would be arbitrary when applied to a soap..... Fanciful and arbitrary terms enjoy all rights accorded to suggestive marks and are also entitled to registration without proof of secondary meanings”
- That, the proposed trademark Jabuticaba doesn’t fall under the category of generic trademark as Jabuticaba isn’t a genus of the Mobile industry, ie, it isn’t a mark that is common to trade or customary in current language or in the established practice of trade are prohibited from registration in the Mobile Industry or Class 9.

¹ 537 F.2d 4, 9 (2nd Cir. 1976).

² 505 US 763

³ (2019) 262 DLT 101

- It is therefore submitted that the proposed trademark, Jabuticaba does not fall under a descriptive trademark, as it does not merely describe any article/service, its qualities, ingredients or characteristics which are common in the proposed class, ie, class 9 or in the Mobile Phone Industry.
- That Jabuticaba is not a coined word and therefore, does not fall in the category of Fanciful Mark, though the meaning of the term is not commonly known in India. Further, Jabuticaba is the name of a grape tree and therefore it does not fall under the category of Suggestive trademark though like the growth of Jabuticaba fruits, the company aims to manufacture unique mobile phones.
- That the above mentioned categorisation of trademarks (Two Pesos, Inc. v. Taco Cabana, Inc) has been accepted by a Coordinate Bench of the Hon'ble Delhi High Court in Evergreen Sweet House v. Ever Green⁴, (paragraph 14), 'wherein it was held that the mark 'Evergreen' in its application to sweets and confections is an arbitrary one and accordingly is entitled to protection'.
- It is further submitted that the petitioner had conducted study on focus groups with a sample size of 1000 people. This study was conducted in four parts divided into 250 people each, on 06th June, 2020, 15th June, 2020, 27th June, 2020 & 06th July, 2020. The subjects for the study were chosen randomly. In total 800 people (i.e. 80%) of the people responded that they had never heard the term 'Jabuticaba' and that 50 people (5%) may have heard the term but did not know its meaning. The summary report of the focus group study has been attached below.
- That the trademark has not acquired any secondary meaning as it is 'Proposed to be used', as it is an Arbitrary Word Mark it is entitled to be registered without proof of secondary meaning, in view of the above-mentioned judgement of Delhi High Court (M/S Telecare Network India Pvt ... vs M/S Asus Technology Pvt Ltd & Ors).
- That a similar view was given by the Intellectual Property Appellate Board in Syed Ghaziuddin v/s Pepsico INC & Ors.⁵ "According to the well-recognized classics of trade mark law, "Suggestive Mark" are in the same position as arbitrary marks and are entitled to protection without proof of secondary meaning. The courts in India in very many cases have protected common words as Trademarks."

⁴ 2008 (38) PTC 325 (Del)

⁵ [2005] IPAB 1

- Therefore, it is submitted that in view of the above-mentioned judgments and study on focus groups it can be understood that Jabuticaba is an arbitrary Mark which does not have nexus with class 9 or mobile phones.

Therefore, the Applicant prays that the Hon'ble Registrar may be pleased to accept the above given explanations and allow the application and direct it to be advertised in the trademarks journal & thus render justice.

Thank You,

XYZ

Summary of Focus Goup Research conducted by M/s Tandaboina Technologies for determination of brand name

Total No. of Subjects: 1000

(I) Characteristic of the study population			
1	Gender		
	Female	700	70%
	Male	300	30%
	Age Group		
	18-30	600	60%
	30-65	300	30%
	above 65	100	10%
2	Education		
	Uneducated	50	5%
	High School	150	15%
	Graduation	500	50%
	Post Graduation	300	30%
3	Marriage		
	Married or domestic partnership	600	60%
	Widowed, divorced, or separated	100	10%
	Single, never married	300	30%
4	Employment		
	Retired	50	5%
	Employed full-time	500	50%
	Employed part-time	100	10%
	A homemaker	200	20%
	A student/unemployed	150	15%

(II) Mobile technology familiarity.			
1	Have used a Smart Phone		
	Yes	910	91%
	No	90	9%
2	Are available on Whatsapp Messenger		
	Yes	850	85%
	No	150	15%
3	Download apps for playing games		
	Yes	700	70%
	No	300	30%

(III)	Questions Related to the brand		
1	What is the size of phone they prefer?		
	Small Phones	50	5%
	Flip phones	150	15%
	Large Phones	300	30%
	Medium- Pocket sized phones	500	50%
2	Which of the following do you find the most important feature you want in your phone?		
	Look	250	25%
	Build	150	15%
	Unique Work Friendly	600	60%
3	Which of the following colours do you prefer?		
	Purple	400	40%
	Black	350	35%
	Blue	150	15%
	Violet	100	10%
4	Which of the following brand names do you prefer?		
	Jabuticaba	800	80%
	Tandaboina Technologies	80	8%
	Kabuti	100	10%
	Jeticab	20	2%
5	Whether they heard the term jabuticaba before?		
	Yes	150	15%
	No	800	80%
	Yes, but don't know its meaning	50	5%
6	After using the mobile phone for a week will you buy it for 45,000?		
	Yes		
	No		
	Maybe		