

Legal Opinion

To,
Sanika Surve
103/1 Star Apartments,
Planet Lane,
Dadar (East), Mumbai 400028

Date – 12th August 2020

Sir,

This legal opinion (“Opinion”) is furnished to you pursuant to your request for my opinion in connection with your registrability of the mark ‘**TOPAZE**’ (“the mark”) as a trademark. As the mark is not currently in use and will be used in future, it shall be termed as ‘proposed to be used’. Since, the mark is pertaining to goods related to automobiles, the mark shall fall into Class 12.

I have conducted the public search for the mark. The search was conducted for phonetically similar and wordmarks similar to the concerned mark. The Trademark Registry objects on the applied mark when the mark is deceptively or phonetically similar and can tend to create confusion in the minds of the public in comparison to the already registered mark.

I have attached the entire search report consisting of the results obtained based on Phonetic and Wordmark search for **TOPAZE**. However, I have shortlisted certain marks from class 12 which can bring objection from the Registry on receiving the trademark application.

Following are the observations –

Sr.no	Mark	Description	Status and User date
1	TOPAZ (289203)	Part of motor vehicles and fittings therefore included in Class 12.	Registered. Proposed to be used.
2	TOPAZ (1299262)	Bicycles, parts and fittings included in Class 12.	Registered. User Date– 01/04/2001

3	TOPAZ (1380058)	Parts and fitting included in class 12 for Motor land vehicles in Class 12.	Registered. User Date – 05/07/1980
4	TOPAZ (2055869)	All types of automobile bodies, chains, boats, parts and vehicle sets and goods.	Refused. User Date – 15/09/2010
5	TOPAJ (3111306)	Automobile parts, fitting and accessories, fitting, vehicles, apparatus for locomotion by land, air or water included in Class 12.	Refused. User Date –10/11/2015
6	TOPEX (DEVICE MARK) (537054)	Parts included in Class 12 for motor land vehicles.	Abandoned Proposed to be used
7	TOPEX (455748)	Parts and Fittings included in class 12 for use in Bicycles. Duggal	Removed User Date – 30/05/1986
8	TOPEX (2958281)	Parts and Fittings included in Class 12 for motor land vehicles.	Registered User Date – 10/03/1985
9	SPAZE (2222613)	Vehicles, Apparatus for locomotion by land, air and water.	Registered Proposed to be used

I would like to specify that there is no mark already registered for the word ‘TOPAZE’.

Hence there is a room for us to register the mark.

However, the abovementioned marks are conflicting and similar to the mark and can be objected by the Registry on the basis of being Deceptively and Phonetically similar since they are registered in Class 12 as well.

For your kind perusal, Class 12 includes in particular:

- motors and engines for land vehicles;

- couplings and transmission components for land vehicles;
- air cushion vehicles;
- remote control vehicles, other than toys;
- parts of vehicles, for example, bumpers, windscreens, steering wheels, tyres for vehicle wheels, as well as treads for vehicles.

The trademarks under Sr.no. **1,2,3,4** are confusingly similar to the mark. As you can see, the word '**TOPAZ**' and '**TOPAZE**' are visually similar with a difference of a single letter 'E'. Also the presence of this one letter does not change the pronunciation of the mark, making it Phonetically similar.

Hence it can create a sense of confusion and deceptive similarity amongst the public and can invite objection from the Registry.

With reference to '**TOPAZ**', none of the marks are registered for all the inclusions of class 12. Further, all these marks are not registered by the same Proprietor despite being identical and hence there is a scope for registration for '**TOPAZE**' as a trademark.

With reference to '**TOPAJ**', the mark is similar to '**TOPAZE**' since the first 4 alphabets are the same and the pronunciation is not very distinct. TOPAJ and TOPAZE sound almost similar and can lead to phonetic confusion. The trademark application for this mark is 'refused' but that does not mean it cannot be granted a registration. The mark has a user date from 2015 which makes it highly likeable to get a trademark. And hence, this mark can bring objection to the proposed to be used '**TOPAZE**'.

The mark '**TOPEX**' is visually similar to '**TOPAZE**' because of the first 3 common alphabets. The marks are not so phonetically distinct since they sound similar when pronounced simultaneously or in fast speech. More than phonetic similarity, the common alphabets are likely to create confusion in the minds of the public and hence can be pointed out as a conflicting mark by the Registry.

With reference to Sr.no. **6**, the mark '**TOPEX**' is a device mark and has no user date since it is a proposed to be used mark. This mark is Abandoned, which means its currently not registered as a trademark. Also since the device mark was not in use by its Proprietor, there is a less chance of it forming the part of conflicting marks by the Registry. However, this is

subject to unless the Proprietor of TOPEX applies for the registration of this mark again during the course of the application process of **'TOPAZE'**.

With reference to Sr.no.7, the mark **'TOPEX'** is removed from the Register of Trademarks but has a user date since 1986. Hence, although the mark is currently not registered, the proprietor of this mark can ask for renewal and to restore the mark by paying the requisite fees or also apply for new registration on the basis of long use of the mark and prior registration of the same.

With reference to Sr.no. 8, the mark **'TOPEX'**, is a registered mark since 2016. This mark has a user detail since 1985 and can form a part of conflicting mark to be pointed out by the Registry.

With reference to Sr.no. 9, device mark **'SPAZE'** has common alphabets with the word mark **'TOPAZE'** since the last 4 alphabets **'PAZE'** are identically placed in both words making it phonetically similar. Both marks when pronounced bring out similarity and can leave a chance of confusion.

At the outset, these are the marks which can conflict with the mark **'TOPAZE'**. However, as already mentioned the most similar mark **'TOPAZ'** has been registered by different proprietors and hence **'TOPAZE'** has a chance of registration. The same goes to **'TOPEX'** which is a slightly less similar mark in comparison to **'TOPAZ'** and is registered by different proprietors in different territories. The other marks **'TOPAJ'** and **'SPAZE'** find their similarities with the mark but do not create substantial hindrance in going for the registration for the trademark.

In my opinion, we can go ahead with the trademark application process for the wordmark **'TOPAZE'** and apply for the protection of the mark in all the descriptions of goods given in class 12. This way it shall give a broader protection of the mark in all the inclusions under the concerned class and provide for higher chances of getting the registration since the possible conflicting marks have protection under class 12 for limited descriptions.

If you agree with this opinion, we can go ahead with the filing of the trademark application without any further delay. Kindly revert with your take on the same.

It was a pleasure researching and drafting this opinion for you.

Thank you.

XYZ

Participation ID - NTMC2020017