

Date: 21-Aug-2020

To,
The Registrar of Trade Marks,
Hyderabad, Telangana, India.

Sub: Reply to Examination Report (No. TMR/HYD/EXM/2020) dated 16.08.2020,
08:30:52, in reference to Trade Mark Application No. NTMC2020031 in Class 14

(In case of hearing, preferred mode of attending hearing: Physical Mode)

Sir/Madam,

I am in receipt of your Examination Report (bearing no. TMR/HYD/EXM/2020) and I am hereby submitting my reply to the objections raised therein by the learned trade mark examiner.

The preliminary requirement of “authorisation of agent” (as prescribed by Section 145 of The Trade Marks Act, 1999 and Rule 19 of the Trade Mark Rules, 2017) has been completed at the time of filing of the trademark application by the simultaneous filing of form TM-M and the attaching of a duly signed power of attorney. Accordingly, I am filing this reply on behalf of the proprietor of “Wamishq Jewellers” as his duly authorised agent.

Therefore, in reference to the Trade Mark Application No. NTMC2020031, please find attached below our detailed response to objections raised in the Examination Report.

(Reply to Objections attached separately below.)

Regards,

NTMC2020031

(Advocate)

Date: 21-08-2020

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Sir/Madam,

We received the above Examination Report on 17th August, 2020 and *hereby submit the following reply* to the objections raised therein.

I. We humbly submit that **there exists no likelihood of confusion** on the part of the public because no similarity or identity is made out with the enclosed earlier trademark, **when our proposed mark is seen as a whole.**

The necessity to see marks as a whole when assessing similarity or confusion was first laid down in *Clarke v. Sharp [(1898) 15 RPC 141]* where the court held: “One must bear in mind the points of resemblance and the points of dissimilarity, attaching fair weight and importance to all, but remembering that *the ultimate solution is to be arrived at, not by adding up and comparing the results of such matters, but by judging the general effect of the respective wholes.*” This principle was affirmed by the Madras HC in *T.M. Abdul Rahim & Co. v. Ahmed Basha [AIR 1965 Mad 250]*.

In 1998, the European Court of Justice laid down what is now known as the well-recognised “global appreciation test” for measuring similarity between marks which was later affirmed in the landmark case of *Lloyd Schuhfabrik Meyer & Co. v Klijsen Handel [(2000) FSR 77]*. The Court agreed that trademark law and policy require that in order to assess deceptive similarity or likelihood of confusion, the proposed mark needs to be seen as a whole and not as a sum of its parts. The marks need to be compared in totality and not by breaking them up into different groups of letters or dissecting their constituents. In other words, the *likelihood of confusion should be assessed on the basis of an overall consideration of similarities and dissimilarities between the respective marks.*

Our proposed mark “Wamishq” only has a few letters in common with the earlier trade mark and when seen in totality, there is no similarity or likelihood of confusion either phonetically or orthographically (in terms of spelling). Focusing only on the similarity of a few letters without taking into account the differentiating ingredients or the overall impression is not correct.

In the oft-cited judgement of the Supreme Court of India in *Hoffmann-La Roche & Co. Ltd vs Geoffrey Manners & Co. Pvt. Ltd.* [1970 AIR 2062], the Supreme Court clearly observed that the mere existence of a common terminal syllable “vit” in the names of the two marks did not cause confusion as long as the letters preceding it did not give any sufficient cause for confusion. Similarly, in our present situation, the only common terminal syllable/suffix is “ishq” which has its own, well-known meaning in Urdu and Hindi (both of which are spoken in Telangana) and the letters preceding it are visually and phonetically very different.

II. We humbly submit that there exists no likelihood of confusion on the part of the public because the earlier trademark (“Tanishq”) and our proposed mark (“Wamishq”) operate through **completely separate and non-overlapping trade and distribution channels.**

In *Sony Kabushiki Kaisha v. Shamroa Maskar & Ors.* [AIR 1985 Bom 327], the Bombay High Court stated: “The trade channel through which goods will be sold is certainly a vital factor...” in determining the likelihood of confusion.

Though we seek registration of our proposed mark “Wamishq” in the same class of goods as the earlier trademark (Class 14, jewellery), the trade and distribution channels through which both these marks operate is different and detached. The products of “Tanishq” are sold *exclusively* through its authorised showrooms & stores and are neither sold nor displayed by any other trader or at any other commercial establishment. If a consumer wishes to purchase a “Tanishq” product, he/she can do so *only* at its authorised store and nowhere else. We at “Wamishq Jewellers” also sell our products only at our exclusive and privately-owned stores in Hyderabad and do not offer our products for sale on any other platform or forum. As a result of the above facts, the *consumer perception (which partly derives from the mode of purchase) of our respective products will be different*: “Tanishq” will continue to be perceived as a brand with national presence while “Wamishq” will be seen as the store of a local sole proprietorship.

The products of both enterprises can never be available for sale/purchase under the same roof nor do they intersect at any point in their journey from the goldsmith to the customer. Therefore, the trade channels through which the respective products will reach the consumer are entirely separate and do not overlap.

If the learned Registrar so requires, we are willing to state on oath that we will neither store nor offer for sale any “Tanishq” product in any of our commercial establishments and will neither do so at any time in the future.

III. We humbly submit that there exists no likelihood of confusion on the part of the public because *the nature of the goods in question* (jewellery, precious & semi-precious stones) *is such as would logically involve more vigilant and discerning customers.*

It is a well-accepted and common-sense based principle in trademark law that expensive goods or services are bought less frequently and are more carefully selected, with consequent greater attention being paid to the trademark used on those goods or services. In contrast, customers are likely to pay much less attention to marks that are used on everyday products such as groceries, detergent, etc. and these are more likely to be purchased in a hurry and without any caution, vigilance and/or discretion.

In *Lloyd Schuhfabrik Meyer & Co. v Klijsen Handel [(2000) FSR 77]*, the European Court of Justice observed: “It should be borne in mind that the average consumer’s level of attention is likely to vary according to the category of the good/service in question.”

Needless to say, the goods in question (jewellery, precious & semi-precious stones) are quite expensive and are *infrequent purchases* for a customer. Before finally purchasing any such product, customers survey & deliberate the various options in the market in terms of pricing, quality, availability, trustworthiness and shop/brand reputation. It is highly unlikely that a customer will suddenly decide that he/she needs jewellery and will go out and purchase it from the nearest store without any pre-planning. In fact, for purchases as expensive as jewellery, most customers will probably do a background check for each seller/shop/brand and then decide his/her preference.

Due to these reasons it is highly unlikely that the public will be confused as to what is “Tanishq” and what is “Wamishq Jewellers”. A simple internet search will be sufficient to dispel any iota of confusion, if at all there is any.

IV. We humbly submit that **a mere far-fetched likelihood of association with the earlier trademark should not be seen as a guarantee of confusion** on the part of the public.

Though S.11 (1) of the Trade Marks Act, 1999 includes ‘likelihood of association’ within the meaning of ‘likelihood of confusion’, this cannot be interpreted to mean that the former will alone suffice to prove the existence of the latter.

In *Ramdev Food Products Pvt. Ltd v. Arvind Bhai Rambhai Patel & Ors* [Supreme Court of India, Civil Appeal 8815-8816 of 2003], the Supreme Court agreed with the view taken by the European Court of Justice in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.* [(1999) RPC 177] that “*mere association which the public might make between two trademarks as a result of their analogous, semantic content is not in itself a sufficient ground for concluding that there is a likelihood of confusion*”.

In *Sabel BV v. Puma AG* [(1998) RPC 199], the court observed that a mere ‘likelihood of association’ cannot serve to prove a ‘likelihood of confusion’ and that if the public merely makes an association between two marks this would not in itself be sufficient for concluding that there is a likelihood of confusion.

Also, in *Marca Mode CV v. Adidas AG* [(2000) ETMR 723, ECJ], the famous ‘Adidas 3 stripes case’, the European Court of Justice stated that the reputation of a trademark does not automatically give grounds for presuming a likelihood of confusion in the strict sense.

V. The allegation of ‘**likelihood of confusion**’, as raised against us in the examination report, **does not hold in light of the ratio of the following landmark judgements too**

- In *De Cordova & Ors. v. Vick Chemical Co.* [(1951) 68 RPC 103], the Privy Council spelled out the ‘essential feature test’ whereby a passing-off suit could succeed only if an essential feature of the mark had been copied. In our present case, we humbly submit that no essential feature of the earlier mark “Tanishq” has been copied and hence there exists no likelihood of confusion on the part of the public.
- In the seminal case of *Amritdhara Pharmacy vs Satyadeo Gupta* [1963 AIR 449], the Supreme Court of India took the view that in considering the matter of likelihood of confusion between two marks, ‘all the circumstances of the case must be considered’.

Accordingly, we humbly submit that the learned Registrar take into account all the circumstances and arguments raised above in this reply before arriving at a decision.

- In the recent judgement of *M/s Nandhini Deluxe vs. M/s Karnataka Co-operative Milk Producers' Federation* [2018 (9) SCALE 202], the Supreme Court of India refused to declare 'Nandhini Deluxe' and 'Nandini' as deceptively or confusingly similar within the same class of goods. The court held: "Though there is a phonetic similarity insofar as the words "Nandhini" & "Nandini" are concerned, the trademark with logo adopted by the two parties are altogether different. The manner in which the Appellant has written 'Nandhini' is in totally different font as compared to the style adopted by the respondent for its trademark 'Nandini'." In our present case, if the learned Registrar so requires, we can affirm that we will not adopt a similar font or styling for "Wamishq" as that of "Tanishq" and will also ensure that the logo is clearly distinguishable from that of the earlier mark.

On the basis of the above arguments it is finally humbly submitted that there exists no likelihood of confusion on the part of the public as regards our proposed mark "Wamishq" and the earlier trademark mentioned in the search report annexed to the examination report. Hence, the objection raised under Section 11(1) of the Trade Marks Act, 1999 is not maintainable.

Having regard to the above facts and there being no other objection in the examination report, we request you to take the above submissions on record and accept the mark to be advertised in the Trademark Journal at the earliest. In case, the learned Registrar still maintains any of the objections raised in the examination report, we request you to kindly provide us with an opportunity of hearing before passing an adverse order in relation to this application.

Your Sincerely,

NTMC2020031