

Interim injunction bars Blu Frog from piggybacking on reputation of celebrated venue India - Nishith Desai Associates

July 29 2016

The first plaintiff in *Frog Company Private Limited v M/S Blu Frog Kitchen* owns and manages Blue Frog, a bar and restaurant that also hosts concerts and live performances. Together with the second plaintiff, a holding company, it owns several BLUE FROG trademarks in various classes. The plaintiffs have used the marks since 2007 and they also form part of the corporate name of the second plaintiff. The plaintiffs' establishment has been widely advertised online, in newspapers and on advertising billboards; has featured in television shows; has been written about in international journals; and has won several awards. Thanks to its success, it has a large customer base and a high turnover.

In May 2015 the first plaintiff learned that the first defendant, M/s Blu Frog Kitchen & Lounge, was operating a restaurant/lounge in a mall in Belagum, Karnataka under the confusingly similar mark BLU FROG (the device mark also contained a representation of a frog). Mr Akash Desai, the proprietor of the first defendant (collectively, 'the defendants'), had also applied to register the conflicting mark on July 1 2015 (Application 2999257) in Class 43, for confusingly similar services to those of the first plaintiff. In order to protect its rights, the first plaintiff served a cease and desist notice on the first defendant; it sent a reminder in December 2015 and also sought execution of an undertaking. However, the first defendant neither responded to the two notices nor ceased using the conflicting mark, thereby continuing to infringe the plaintiffs' marks. As a consequence, the plaintiffs filed suit in the Bombay High Court.

The Bombay High Court agreed with the plaintiffs' submissions and granted an interim injunction in their favour.

The court held that there was a more than sufficient *prima facie* case in favour of the plaintiffs for both infringement and passing off. The court further held that it was neither coincidence nor accident that the defendants had chanced upon an expression such as 'Blu Frog' in connection with services that were similar to those of the plaintiffs. Simply removing the vowel 'e' from the word 'Blue' did not constitute meaningful or legally tenable distinctiveness. The court also held that it was impossible that the defendants were unaware of the plaintiffs' establishment in light of its reputation.

As regards the trademark application filed by the first defendant, the court held that it was unclear whether the first defendant had conducted a trademark search before filing the application; however, both a trademark and a market (including internet) search should have been conducted. The court stated that nonetheless, in light of the plaintiffs' reputation, such a search was not necessary in this case.

The court agreed that the conflicting mark was phonetically, structurally, visually and in every other way that mattered indistinguishable from the plaintiffs' marks. In addition, people visiting Blu Frog would mistakenly believe that it was a branch or franchisee of the plaintiffs' establishment, thus leading to dilution of the plaintiffs' brand. In the court's opinion, denying protection to the plaintiffs would allow the defendants to 'piggyback' on the plaintiffs' success through the illicit use of their marks.

Accordingly, an ad interim injunction was granted which, among other things, restrained the defendants from infringing the plaintiffs' marks and from passing off their goods and services as those of the plaintiffs.

The matter is listed for hearing and final disposal of notice of motion on July 25 2016.

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