

World Trademark Review Daily

Automobile giant cannot monopolize letter 'T'
India - Nishith Desai Associates - Legal & Tax Counselling Worldwide

Examination/opposition
National procedures

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In *Super Cassettes Industries Ltd v Union of India* (WP (C) 1263/2005, April 22 2010), the Delhi High Court has set aside an order of the **Intellectual Property Appellate Board** (IPAB) and affirmed an order of the deputy registrar, holding that there was no likelihood of confusion between the parties' trademarks.

Super Cassettes Industries Ltd sells electronics goods, CDs and DVDs, among other things, and is engaged in film production. In 1986 it applied for the registration of the device mark T-SERIES in Class 9 of the **Nice Classification**. The mark was advertised in the *Trademarks Journal* in 1991. Super Cassettes' mark was opposed by **Tata Engineering & Locomotive Company Ltd** (Telco), the Indian automobile giant, on the grounds that the letter 'T' in a circle was its house mark and, therefore, there would be a likelihood of confusion and deception among the public if Super Cassettes' mark was registered.

The deputy registrar, having considered the evidence filed by both parties, allowed the registration of the mark on the grounds that:

- there was no likelihood of confusion and deception among the public; and
- the letter 'T' could not be monopolized by Telco.

Telco appealed to the IPAB. The IPAB amended the deputy registrar's order and requested that Super Cassettes remove the circle surrounding the letter 'T' in the T-SERIES mark. Super Cassettes appealed to the Delhi High Court.

Super Cassettes submitted that:

- it had been using the T-SERIES mark since 1979 for audio cassettes and, subsequently, for electronic goods;
- it had acquired extensive reputation, goodwill and distinctiveness in the market for the goods at issue;
- Telco could not claim a monopoly over the letter 'T', since the letter is not distinctive *per se*;
- the registration granted to Telco in Class 9 was not for the letter 'T' on its own, but in combination with the words 'Tata Engineering' and a wing device; and
- the T-SERIES mark was not similar to Telco's mark.

The court considered whether:

- the marks of the parties were so similar so as to cause confusion and deception among the public;
- Super Cassettes had used the T-SERIES mark in an honest or continuous manner; and
- the relief granted by the IPAB was beyond what was requested by Telco.

Based on the arguments of the parties, and relying on well-established case law, the court held as follows:

- The T-SERIES mark was structurally, stylistically and substantially different from Telco's mark. Therefore, there was no likelihood of confusion among the public, especially in light of the fact that the marks were used primarily for different categories of goods.
- The issue of honest prior use or continuous use is relevant only in cases where it is established that the marks at issue are identical or deceptively similar. As this was not the case here, the IPAB had erred in assuming that the adoption of the T-SERIES mark by Super Cassettes had not been in good faith.
- Telco initially opposed the registration of Super Cassettes' mark on the grounds that the dominant feature of the T-SERIES mark was the letter 'T' and, therefore, the mark should not be registered. However, on appeal before the IPAB, Telco contended that it would be satisfied if the circle surrounding the 'T' in the T-SERIES mark was removed. The IPAB had failed to notice that the nature of the relief claimed had changed.
- On appeal before the court, Telco again changed its position and contended that the dominant feature of its mark was the letter 'T' in a circle. Telco's arguments could not be maintained for the following reasons:
 - The dominant feature of Telco's mark was the letter 'T', and not the letter 'T' in a circle.
 - In order to oppose the registration of the T-SERIES mark under Sections 11(1) and 11(2) of

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the [Trademark Act 1999](#), Telco had to show that the two marks were similar. However, Telco had failed to do so.

- The argument that the letter 'T' in a circle was the dominant feature of Telco's mark was not legally tenable under Section 17 of the act, which provides that the registration of a composite mark confers on its proprietor the exclusive right to use the mark as a whole.

Consequently, Super Cassettes' writ petition was allowed. The order of the deputy registrar was affirmed and costs of Rs10,000 were awarded to Super Cassettes.

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