

“NANDINI” versus “NANDHINI” – ‘NOT’ deceptively similar trademarks

The use of deceptively similar trademarks was allowable for goods or services falling under different classes and it never became a major issue of concern. For instance, the trademark MARUTI for cars also exists for tissue papers, hosiery products and also hardware items. Such independent existence of the same or similar trademark was acceptable and has been in use for products falling under different classes and do not pose any conflict or overlap between the relevant consumers. However, the courts maintained a consistent view that existence of deceptively similar trademarks were not permissible for goods or services falling under the same class.

But now, post the recent judgment of *Nandhini Deluxe v. Karnataka Co-Operative Milk Producers Federation Ltd.* Civil Appeal No. 2943-2944 of 2018; same or deceptively similar trademark can be used even for goods falling under the same class if they are visually distinct when compared. Supreme Court held that the use of similar trademarks for different goods or services, even though they might be falling under the same class, cannot be termed as infringement.

Karnataka Co-Operative Milk Producers Federation has been producing and selling milk and milk products since years and had obtained registrations for their trademark “**NANDINI**” along with its variants in class 29 for milk and milk products, in English as well as several other languages, with a user date of 1985. Nandhini Deluxe, a restaurant chain, which is in the market since the year 1989, applied for registration of their trademark “**NANDHINI**”, in class 29 for meat, fish, poultry, meat extracts, preserves, dried and cooked fruits and vegetables, jellies, jams, eggs, milk and milk products, edible oils and fats, salad dressings etc. This trademark application was allowed by the Registrar of trademarks post the completion of the opposition proceedings, whereas it was declined by the IPAB (Intellectual Property Appellate Board) as it disapproved of the registration of trademark “**NANDHINI**” as being deceptively similar to another trademark “**NANDINI**”, already in use prior to the adoption of the trademark “**NANDHINI**”, for having a similar pronunciation and only a basic difference of a single alphabet ‘**H**’ between the two marks. The IPAB held that the Karnataka Co-Operative Milk Producers Federation was in “regular and consistent use of the trademark



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“NANDINI” and it had become entrenched in the minds of the consumers and it would not be in the interest of the public to allow the restaurant chain to use the trademark **“NANDHINI”**. Thereafter, based on this, the High Court concurred with the above mentioned reasons as given by the IPAB and affirmed both marks to be deceptively similar, thereby disallowing the registration of the trademark **“NANDHINI”**. Additionally, the HC noted that Karnataka Co-Operative Milk Producers Federation was using the trademark **“NANDINI”** for goods like milk and milk products since 1985, whereas Nandhini Deluxe adopted the trademark **“NANDHINI”** for their restaurants since 1989 which proved the fact that Karnataka Co-Operative Milk Producers Federation was a prior user and adopter of the trademark **“NANDINI”**.

With the IPAB and the HC restraining Nandhini Deluxe, the restaurant chain, from using the **“NANDHINI”** trademark and considering its use to be an infringement of the well-known trademark **“NANDINI”**, Nandhini Deluxe further appealed against before the Supreme Court.

The Supreme Court put together a detailed comparison on the trademarks in dispute and observed that the marks in question, **“NANDHINI”/“NANDINI”** of Nandhini Deluxe (Appellant) and Karnataka Co-Operative Milk Producers Federation (Respondent), respectively, cannot be claimed to be deceptively similar, and not amounting to any confusion among the general public. The Court held as follows: *“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”** in totally different font as compared to the style adopted by the respondent for its trademark **“NANDINI”**. Further, the Appellant has used and added the suffix **‘Deluxe’** and, thus, its trademark is **“NANDHINI DELUXE”**. It is followed by the words **‘the real spice of life’**. There is device of lamp with the word **“NANDHINI”**. In contrast, the Respondent has used only one word, namely, **“NANDINI”** which is not prefixed or suffixed by any word. In its trademark, **“NANDINI”** encircled by an egg shaped circle has been placed below the **‘Cow’** logo. A bare perusal of the two trademarks would show that there is hardly any similarity of the appellant’s trademark with that of the respondent when these trademarks are seen in totality.”*

The Court held, *“**“NANDHINI”/“NANDINI”** is a generic name, representing a goddess and a cow in Hindu mythology, and it is not an invented or coined word by anyone to the dispute.”*

Further the Court concluded that there is no provision of law which expressly prohibits registration of a trademark which is similar to an existing trademark and used for dissimilar goods, even when they fall under the same class. It was held that no person can have exclusive right or monopoly over the entire class of goods, especially when the trademark is not being used with respect to all the goods falling under the said class. Supreme Court’s decision clearly construes that two visually distinct and different marks cannot be called deceptively similar especially when they are being used for different goods.

This in turn would be a huge relief to the trademark owners having trademarks similar to already existing trademarks for dissimilar goods falling under same class.

The complete judgment can be accessed at:

https://www.supremecourt.gov.in/supremecourt/2015/18014/18014_2015_Judgement_26-Jul-2018.pdf