



INTELLECTUAL
PROPERTY INDIA
PATENTS/DESIGNS/
TRADE MARKS
GEOGRAPHICAL
INDICATIONS



भारत सरकार / GOVERNMENT OF INDIA
व्यापार चिन्ह रजिस्ट्री / TRADE MARKS REGISTRY
बौद्धिक संपदा भवन / IP BHAWAN
चाणक्यपुरी ओव्हरब्रीज के निकट / NEAR CHANKYAPURI OVERBRIDGE,
घाटलोडिया, अहमदाबाद / GHATLODIA, AHMEDABAD-380061

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NO. TMR/AHM/2022-2023/14031/14047

Date: 28/11/2022

To,

- ✓ 1. M/s. D. C. Dani & Associates., - फॉर् 2595341472N
908, Sukh Sagar Complex,
Nr. Hotel Fortune Land Mark,
Ashram Road, Usmanpura,
Ahmedabad-380 013. Gujarat.
- ✓ 2. M/s. Anand And Anand. - फॉर् 2595338752N
B-41, Nizamuddin East,
New Delhi - 110 013.

Sub: Opposition No. AMD – 722698 to Application No. 1470002 in class 06.

Sir,

With reference to the above subject, I am directed by the Registrar of Trade Marks to enclose herewith the order dated 04/11/2022 in the above subject matter.

Yours faithfully,

Examiner of Trade Marks.

Encl : a/a.

OK

THE TRADE MARKS ACT, 1999
(Before the Registrar of Trade Marks, Ahmedabad)

In the matter of Application No. 1470002 in class 5 in the name of Hareshkumar P. Zalawadia trading as Hero Plastic Industries, at 6, Jay Laxmi Industrial Estate, Plot No. 5/B, G.I.D.C., Odhav, Ahmedabad-382415, Gujarat (hereinafter referred to as 'the applicant').

AND

In the matter of Opposition thereto bearing no. 722698 by Volvo Trademark Holding AB, having its registered office at c/o AB Volvo 405 08 Goteborg, Sweden (hereinafter referred to as 'the opponent').

Present:

For Applicant: Adv. D.C. Dani of D.C. Dani & Associates.

For Opponent: Adv. Sandhya Singh of Anand & Anand.

Date of hearing: 11.10.2022

Date of order: 04.11.2022

ORDER

1. The applicant has filed the present application ("TM-1") on 14.07.2006 for registration of the label trade mark 'HOLVO' ("impugned trade mark") claiming use from 06.06.2006 for '*Door holder with catcher and hardware items being goods included in class 6*', which was advertised before acceptance under Proviso to Section 20(1) of the Trade Marks Act, 1999 ("the Act of 1999") in Trade Marks Journal No. 1377-0 on 01.10.2007 which was made available to the public on 16.11.2007. The impugned trade mark is reproduced hereinbelow:

HOLVO

2. A Notice of Opposition ("TM-5") to the registration of the impugned trade mark was filed by the opponent on 17.03.2008 under Section 21 of the Act of 1999 subsequent to filing of an application for extension of time on form TM-44 on 08.02.2008. The opponent has stated *inter alia* in the TM-5 that the trade mark 'VOLVO' is adopted by the opponent's predecessor in right, title and interest 'AB Volvo' on 05.05.1915. It is

A. Tendra

stated that later on 26.02.1999, AB Volvo assigned the trade mark 'VOLVO' to the opponent. The AB Volvo and Volvo Car Corporation are equal shareholders in the opponent. The opponent has given on license to AB Volvo and Volvo Car Corporation the right to use the trade mark 'VOLVO' within their respective business. The trade mark 'VOLVO' is a rare Latin word and it has no obvious meaning and is not found in any of the authoritative dictionaries of the English language. The word 'VOLVO' conveys nothing in its ordinary significance and it enjoys highest degree of inherent distinctiveness. The opponent is the proprietor of the trade mark 'VOLVO'. The trade mark 'VOLVO forms a key, essential and dominant part of the opponent's and its group companies' corporate name and trading style. The trade mark 'VOLVO' has been extensively and continuously used by the opponent through its licensees. The opponent further averred that the trade mark 'VOLVO' is registered in India in various classes including class 6 under registration no.763293.

3. The opponent further stated that it is extensively advertising and publicizing the trade mark 'VOLVO' in various magazines, journals, newspapers and through electronic media. The opponent has also sponsored several sports competitions. It is averred that the opponent's 'VOLVO' is a well-known trade mark in India as the same is instantly identifiable and recognizable by both the members of trade and public. Owing to its widespread trans-border businesses, promotional efforts and innate distinctiveness, the opponent's trade mark 'VOLVO' has acquired goodwill and reputation as the same stands for high standards and superior quality of goods manufactured by the opponent's licensees.
4. The opponent has further stated in the TM-5 regarding the impugned trade mark 'HOLVO' that the same is blatant imitation of and deceptively similar, visually as well as phonetically, to its well-known and prior registered trade mark 'VOLVO'. It is averred that the adoption of the impugned trade mark by the applicant is unjust and dishonest, therefore, the applicant cannot be the proprietor of the same. It is alleged that the applicant is falsely trying to represent a connection in the origin of the goods. It is further stated that the adoption of the impugned trade mark is obviously without due cause and apart from taking undue advantage of the reputation and goodwill subsisting in the opponent's trade mark and is also detrimental thereto. It is further alleged that the exclusivity of the opponent's trade mark will be diluted if third parties like applicant are allowed to register identical or deceptively similar marks. The opponent stated that it is

obvious that there is bad faith on the part of the applicant in claiming to be the proprietor of the impugned trade mark. Finally, it is submitted that the registration of the impugned trade mark would be contrary to the provisions of Sections 2(1), 11(1), 11(2)(a), 11 (3)(a), 11(4), 11(10), 12 & 18 of the Act of 1999. The opponent, thus, prayed to refuse registration of the impugned trade mark with costs awarded to the opponent.

5. In support of its case, an affidavit affirmed by Mrs. Monica Dempe, claiming to be the Managing Director in the opponent, has been filed on behalf of the opponent in support of opposition under Rule 50 of the erstwhile Trade Marks Rules, 2002 ("the Rules of 2002"). Along with the affidavit, the opponent produced on record copies of Product Catalogues (Annexure-A), list of companies related to the opponent (Annexure-B), copies of registration certificates for its trade mark 'VOLVO' in various classes in India and other jurisdictions (Annexure-C & Annexure-D), copies of Annual Reports from year 1997-2001 (Annexure-F), copies of newspaper articles, press reports, advertisement and promotional materials (Annexure-G & Annexure-H), *et cetera*.
6. The applicant filed his counter-statement ("TM-6") of the grounds on which he relies for the present application on 29.12.2008. It is averred in the TM-6 that the applicant is carrying on an established business of '*Door holder with catcher and hardware items*' under the trading style of M/s Hero Plastic Industries. The applicant averred that all of his trade marks start with the alphabet 'H' like 'HONCON', 'HENZER', 'HOZONE' and 'HOLVO'. He further stated that all of his trade marks including the impugned trade mark are invented marks as they are meaningless. He also averred that owing to long, continuous usage and wide publicity, the impugned trade mark has become distinctive of and exclusively identified with him. The applicant claimed to be the rightful owner and proprietor of the impugned trade mark 'HOLVO' in respect of his goods in class 6.
7. The applicant denied all the grounds set out by the opponent in the TM-5. It is stated in the TM-6 that the impugned trade mark is visually, phonetically and structurally different from the opponent's trade mark. It is also stated that the goods of the applicant are totally different compared to the goods of the opponent. The applicant denied that the opponent's trade mark is a 'well-known' trade mark. The applicant finally prayed to dismiss the notice of opposition and allow the present application to proceed for registration as the grounds set out in the TM-5 are frivolous, vexatious and false.

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8. In support of the present application, Mr. Hareshkumar P. Zalavadia, applicant himself, filed his affidavit under Rule 51 of the Rules of 2002. The applicant produced on record the copies of sales invoices as Annexure-'A' indicating user of the impugned trade mark by him since the year 2006. The applicant also provided statement of 'sales figure' of his goods from 2006-07 to 2008-09 in the affidavit. The applicant again reiterated that the trade channels, markets and business of the applicant and the opponent are totally different from each other. He further said and submitted in his affidavit that since the rival goods as well as marks are distinct and different there is no chance of confusion. With regard to well-known recognition to the opponent's trade mark, the applicant submitted that since facts vary from case to case, thus, the orders and decrees passed by courts are irrelevant in the present case.
9. The opponent did not file evidence-in-reply under Rule 52 of the Rules of 2002 in response to the evidence affidavit filed by the applicant.
10. After closure of the evidence, the Registry fixed hearing in respect of main matter on 11.10.2022. When the matter came up before me for the hearing, Adv. D.C. Dani appeared for the applicant and Adv. Sandhya Singh appeared for the opponent and made their respective submissions. The matter was finally heard and the order was reserved.
11. At the time of arguments, Id. counsel appearing for the opponent argued that the opponent together with its licensees, namely AB Volvo and Volvo Car Corporation, and their subsidiaries provide a wide spectrum of transportation related products with high standards of safety and environmental care which are marketed and sold under the trade mark 'VOLVO'. She further submitted that apart from using the opponent's trade mark on its core products, the opponent have used the trade mark 'VOLVO' on several merchandise goods as well. The Id. counsel also submitted that the although the trade mark 'VOLVO' is a Latin word, however, the same is meaningless because it cannot be found in any of the authoritative dictionaries of English language. She submitted that in a sense 'VOLVO' is an invented mark. She further stated that the opponent's trade mark is registered in various classes including class 6 with registration no.763293 and the list of its national and international registrations together with certificates have been provided in TM-5 and affidavit in support of opposition. The Id. counsel for the opponent submitted that the trade mark 'VOLVO' has been recognized as a 'well-

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known' trade mark by Hon'ble Bombay High Court and the same is also mentioned in the list of well-known trade marks available on the website of the Registry. The ld. counsel further argued that the applicant has failed to provide any reasonable or due cause for adoption of the impugned trade mark 'HOLVO' which is deceptively similar to the opponent's trade mark. As per ld. counsel, the reason provided by the applicant for adoption of the impugned trade mark in the TM-6, that all of his trade marks commence from the alphabet 'H', is frivolous. The ld. counsel submitted that as per the provisions of the Act of 1999, the Registrar has to protect a well-known trade mark against identical or similar trade marks when their use would take unfair advantage or detrimental to the distinctive character or repute of such well-known trade mark.

12. The ld. counsel for the opponent brought my attention to the copies of the judgments/orders through which the opponent's trade mark was declared well-known which have already been produced on record. She submitted that the opponent's trade mark 'VOLVO' is an invented word and the same is not obvious, therefore, such uniqueness of the trade mark renders it distinctive. The trade mark 'VOLVO' has long and continuous history of extensive use by the opponent and its predecessor-in-title since the year 1915 across the globe when AB Volvo came into being. The opponent's predecessor-in-title started the business of assembling cars in year 1927 and of trucks in 1928. She further referred to the documentary evidence which is available on record to show open and extensive use of the opponent's trade mark.

13. The ld. counsel for the applicant also placed reliance on the following judgments other than those attached as Annexure-P with the evidence affidavit filed in support of opposition:
 - (a) Mahendra & Mahendra Paper Mills Ltd. Vs. Mahindra & Mahindra Ltd.
[AIR 2002 SC 117]
 - (a) Aktiebolaget Volvo and Ors. Vs. Kishore Purohit and Ors.
[Delhi High Court-CS(OS) No.1492/2005; Date:13.12.2010]
 - (b) Intel Corporation Vs. Maple Cybertech Informatics Pvt. Ltd.
[IPAB-O.A.24/2016/TM/MUM; Date:14.12.2020]

14. *Per contra*, the ld. counsel appearing for the applicant submitted that the impugned trade mark has been honestly conceived and adopted by the applicant and the same has

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been in use openly, continuously and extensively in respect of '*Door holder with catcher and hardware items being goods included in class 6*' since 06.06.2006. It is stated by the ld. counsel that the impugned trade mark is distinct and dissimilar from the opponent's trade mark by reason of it being a label trade mark. It is further contended by the ld. counsel that all the trade marks of the applicant like 'HONCON', 'HENZER', 'HOZONE' and its trading name 'Hero Plastic Industries' commence with the alphabet 'H'. It is further argued by the ld. counsel that the opponent has never used the trade mark 'VOLVO' for the goods for which the present application has been filed. As per the ld. counsel for the applicant, since both the parties are in altogether different businesses dealing in different goods, there exists no likelihood of confusion or deception. With regard to the judgments relied upon by the ld. counsel for the opponent, the ld. counsel appearing for the applicant submitted that the same are not applicable as the conflicting marks in all those cases were identical to the well-known or earlier trade mark whereas in the present case the impugned trade mark is distinct from the opponent's trade mark.

15. The ld. counsel for the applicant placed reliance on the following judgments to buttress his arguments:

- (a) Nandhini Deluxe Vs. Karnataka Co-operative Milk Producers Federation Ltd. [(2018) 9 SCC 183]
- (b) Vishnudas Vs. Vazir Sultan Tobacco. [1996 SCALE (5) 267]

16. I heard the arguments of ld. counsels appearing for the opponent and the applicant and have also carefully went through the material available on record including the Notice of Opposition, Counter-statement and Affidavits of evidence in support of opposition as well as application and the documentary evidence attached therewith. I have given my thoughtful consideration to the rival submissions with reference to the applicable law.

17. The case of the opponent is based almost entirely, as manifest from the pleadings and evidence produced, on the fact that its trade mark 'VOLVO' is not just registered in India in various classes including class 6 but also has been declared well-known trade mark by the Courts and recognized as such by this Registry. The opponent submitted that one of its earliest registrations for the trade mark 'VOLVO' for goods falling in class 7 is valid and subsisting since 10.09.1975 under registration no.308314. As per

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opponent, its trade mark is registered for goods falling in class 6 also under registration no.763293 since 20.06.1997. On verification, I found that the opponent's trade mark 'VOLVO' is indeed registered, valid and subsisting under registration nos.308314 and 763293. The opponent produced on record several orders/judgments passed by Hon'ble High Court of Bombay and Hon'ble High Court of Delhi through evidence-affidavit in support of opposition wherein the opponent's trade mark has been declared and recognized as well-known trade mark in actions initiated by the opponent against persons adopting trade marks identical or similar to the opponent's trade mark 'VOLVO' for even dissimilar goods.

18. In the matter of Aktiebolaget Volvo Vs. Volvo Steels Limited [1998 PTC (18) DB], the Division Bench of Hon'ble High Court of Bombay vide order dated 16.10.1997 recognized the opponent's trade mark as well-known and held that the 'VOLVO' brand name has acquired very large reputation and goodwill throughout the world. The Hon'ble High Court has further held, in view of the documents before it, that the predecessor-in-title of the opponent herein has presence in India and the brand name 'VOLVO' is an invented and fancy word. Resultantly, the Division Bench of the Hon'ble High Court set aside the order of the Single Bench and granted temporary injunction in favour of the opponent's predecessor-in-title and against the 'Volvo Steels Limited' for 'Steel Ingots'. Consequently, this Registry has also recognized the trade mark 'VOLVO' as well-known trade mark in the list maintained by it for the purpose.
19. The judgment/order passed by the Hon'ble High Court of Delhi in a case filed by the opponent's predecessor-in-title against '*Kishore Purohit (supra)*' is subsequent to the date of filing of the present application. However, Hon'ble High Court proceeded against the defendant therein restraining him to use the trade mark 'VOLVO' or any other mark similar to it for the purpose of selling, distributing and marketing his mixers, grinders and juicers.
20. The applicant has not seriously disputed the prior registration of the opponent's trade mark in India. It is pertinent to note that the opponent has proved through the documents produced on record by it that that it has presence in India as well as many countries through active business, advertisements, promotions and several registrations for its trade mark 'VOLVO'. The ld. counsel for the applicant, however, tendered his explanation in order to distinguish the facts of the present application from that of the

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cases mentioned above. The explanation tendered on behalf of the applicants is not convincing inasmuch as there is no denial or dispute with regard to the factual position that the opponent's trade mark is a prior registered and an already determined well-known trade mark. The particular facts, as indicated by the ld. counsel for the applicant, pertains to the difference and dissimilarity in the impugned trade mark and its purported use for wholly dissimilar goods by the applicant in the present application does not make any difference with regards to the fact that the opponent's trade mark is no doubt an invented, fanciful and unique trade mark and has a great reputation and is well-known amongst the substantial segment of the public which uses the opponent's goods.

21. Furthermore, the applicant contended that the impugned trade mark 'HOLVO' is a distinctive label trade mark unlike the cases relied upon by the opponent wherein the parties have adopted the trade mark 'VOLVO' itself. The ld. counsel for the applicant further argued that 'HOLVO' is dissimilar from 'VOLVO'. In my opinion, the contention of the applicant is baseless as the font and style in which the impugned trade mark is written is identical to the opponent's trade mark as can be seen from Annexure-A (Product Catalogues), Annexure-F (Annual Reports) and Annexure-H (Advertisement and Promotional material) produced by the opponent on record. The applicant has merely replaced the first letter 'V' by 'H'. Moreover, while pronouncing the impugned trade mark in ordinary parlance, it will be slurred over to sound as the opponent's trade mark. The impugned trade mark is, in my opinion, visually, structurally and phonetically deceptively similar to the opponent's trade mark. In view of widespread and extensive goodwill and reputation acquired by the opponent's trade mark, as visible from the material available on record, the use of the word 'VOLVO' in relation to any other goods including '*Door holder with catcher and hardware items being goods included in class 6*' of the applicant would be likely to be taken as indicating connection in the course of trade between those goods and the opponent.
22. Even otherwise, Section 11(8) of the Act of 1999 mandates the Registrar to consider a trade mark as a well-known trade mark where such trade mark has been determined as such in at least one relevant section of the public in India by any Court or the Registrar himself. Thus, the opponent's trade mark is a well-known trade mark as defined in Section 2(1)(zg) of the Act of 1999 and as per Section 11(10)(i), the Registrar shall protect a well-known trade mark against the identical or similar trade marks.

Jitendra

23. The explanation given by the applicant as to the adoption of the impugned trade mark for his goods that he had honestly and bonafidely adopted the same is flimsy and unsatisfactory. Such explanation cannot be accepted as proof of honesty of adoption especially when the opponent's trade mark 'VOLVO' is not a dictionary word or a general name. The opponent's trade mark has no meaning at all and is a unique, fanciful coined and invented word. The only reason for adoption of the impugned trade mark by the applicant, as it appears to me, is to ride upon extensive goodwill and reputation accrued to the opponent's trade mark. Therefore, not just use but the adoption itself of the impugned trade mark by the applicant for his goods is dishonest. The applicant is not the proprietor of the impugned trade mark. The principle of unfairness as enunciated by the courts, that where a distinctive trade mark is used for long and with much expenses a substantial goodwill is thereby created for it and the use by another of that mark even on non-competitive goods will surely affect the valuable goodwill built up for it and will injure it and dilute the quality of that trade mark, is squarely applicable in the present case as well. The use of the impugned trade mark by the applicant even for '*Door holder with catcher and hardware items being goods included in class 6*' is without due cause and would be detrimental to the distinctive character or repute of the opponent's trade mark. In my opinion, the ingredients of Section 11(2) of the Act of 1999 are duly satisfied in the present case in view of the facts discussed hereinabove. Moreover, the Registrar is mandated under Section 11(10)(ii) of the Act of 1999 to take into consideration the bad faith of the applicant or the opponent which affects the right relating to a trade mark. The application is, in view of above facts, liable to be refused.
24. The applicant has also contended that owing to use of the impugned trade mark made by him in the course of trade, the same has become distinctive. In support of the same, the Id. counsel for the applicant invited my attention to the sales invoices produced on behalf of the applicant on record. After perusal, in my opinion, the sales invoices of the applicant starting from 08.04.2006 do not help the case of the applicant. The applicant actually claimed the use of the impugned trade mark from 06.06.2006, and not from April, 2006, while filing the present application on 14.07.2006. The date of earliest sales invoice available on record appears to be contradictory to the claim of user made by the applicant. Nonetheless, the user claimed by the applicant is only a little more than a month on the date of filing the present application. Therefore, it cannot be said that the impugned trade mark has acquired distinctiveness owing to extensive use by the

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applicant. In any case, I have already held hereinabove that the present application is liable to be refused under Section 11(2) of the Act of 1999.

25. Now, I shall discuss the judgments relied upon by the Id. counsel appearing on behalf of the applicants:

(i) Nandhini Deluxe Vs. Karnataka Co-operative Milk Producers Federation Ltd. [(2018) 9 SCC 183]

The facts of the present case are different as the Supreme Court observed in the case before it that the word 'NANDINI / NANDHINI DELUXE' are generic as it represents the name of goddess and a cow in Hindu mythology; the mark in dispute in that case was not an invented or coined word whereas the opponent's trade mark 'VOLVO' is an invented, unique, fanciful and coined word. Most importantly, the opponent's trade mark herein is already recognized a well-known trade mark. Therefore, in my humble opinion, the judgment is not applicable in the facts of the present case.

(ii) Vishnudas Vs. Vazir Sultan Tobacco. [1996 SCALE (5) 267]

In this case, as observed in the judgment itself, Hon'ble Supreme Court was dealing with the validity of the order of rectification of the registration of trade mark and did not address the questions of infringement and passing off of trade marks. It was also observed that the expression 'charminar' is not an invented word. However, in the present case, this Tribunal has to decide whether the impugned trade mark 'HOLVO' is registrable in view of the earlier valid and subsisting registration in respect to the well-known trade mark 'VOLVO' in favour of the opponent. The parameters, for protection of earlier well-known trade marks, are stricter in the law. Therefore, in my humble opinion, this judgment is also not applicable in the facts of the present case.

26. The view taken by me is also fortified by the judgment rendered by the Hon'ble Supreme Court in the case of Laxmikant V. Patel Vs. Chetanbhat Shah and another [(2002) 3 SCC 65]:

"...The law does not permit any one to carry on his business in such a way as would persuade the customers or clients in believing that his goods or services belonging to

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someone else are his or are associated therewith... honesty and fair play are, and ought to be, the basic policies in the world of business..."

27. Finally, I do not find any reason, in view of the findings made by me, to exercise the discretion vested in me under Section 18(4) of the Act of 1999 in favour of the applicant as he has acted dishonestly in adopting the impugned trade mark.
28. In view of the overall facts and circumstances, I allow the opposition no. 722698 in above terms and consequently the application no. 1470002 in class 6 is refused. There shall be no order as to costs.

Signed and sealed at Ahmedabad on 04/11/2022.

Jitendra

JITENDRA BOHRA

(Hearing Officer)