

## **Nestle triumphs over the use of 'Yo!'**

'YO', a plain and informal expression used the world over to convey excitement, has been the subject of a trade mark war. The first salvo in this war was fired by Mood Hospitality Private Limited's (MHPL) by filing a trade mark infringement action against Nestle at the Delhi High Court. MHPL runs a chain of Chinese restaurants in India under the name 'Yo! China'. <http://www.yo-china.com/>. MHPL in its suit sought an interim injunction against the use of the expression 'Yo' by Nestlé for their recently-launched Maggi Cuppa Mania Instant Noodles in two flavours - 'Masala Yo!' and 'Chilly Chow Yo!' The single judge ruled in favour of MHPL and restrained Nestle from using the mark 'YO!'. Nestle appealed against this order to the Division bench.

In its Appeal Nestle argued that:

1. 'Yo!' is a popular expression commonly used by the trade as an expression of 'excitement and attention'. Thus it could not be considered distinctive or a well-known trade mark.
2. No evidence has been filed by MHPL to show that 'Yo!' had been used as a trade mark.
3. 'Yo!' was not used as a trade mark by Nestle. 'Yo!' was merely used as a flavour descriptor. To constitute infringement under the Trade Marks Act, 1999 the mark must be 'used as a trade mark'.
4. Use of 'Yo!' in conjunction with 'Masala' and 'Chilly Chow' could not cause confusion as Nestle's trade mark was distinguished by the presence of the MAGGI mark and its different packaging. Also, since the rival marks were different, passing off did not arise.
5. Where registration of a mark consisted of several elements, its registration conferred exclusive rights to the use of the trade mark taken as a whole. Thus, MHPL's registration for 'Yo! China' in class 30 did not mean that they had a registration for 'Yo!' alone in class 30.

MHPL while reiterating the arguments it advanced before the single judge submitted:

1. 'Yo!' and 'Yo! China' had become distinctive of MHPL and acquired secondary meaning. It had exclusive rights to use the marks 'Yo!' and 'Yo! China'. MHPL coined and adopted the expression 'Yo! China' in 2002.
2. Generic, common and descriptive words could be protected if they had acquired a secondary meaning. 'Yo!' and 'Yo! China' had acquired distinctiveness by extensive use.
3. No justification had been provided by Nestle as to how 'Yo!' could be regarded as a flavour descriptor.
4. It was not necessary for the offending mark to be used as a trade mark for infringement proceedings.
5. MHPL was the registered proprietor of the trade mark 'Yo! China' in class 30 and Nestle was using 'Masala Yo!' and 'Chilly Chow Yo!' for Noodles; there was similarity of goods with intent to cause confusion.

The Division Bench set aside the interim order of the single judge, holding that 'Yo!' was not used by Nestle as a trade mark. 'Yo!' had been used to invite attention of the customers. Further, 'Yo!' had not been used in isolation. 'Yo!' was used as part of the expression 'Masala Yo!' and 'Chilly Chow Yo!' by Nestle and it described the characteristics of the flavour. Thus infringement provisions were not attracted since

the first condition to sustain an infringement action, use as a trade mark, was not satisfied. The court was also of the view that no evidence to show that 'Yo!' had acquired distinctiveness had been filed. All the evidence related to use of the expression 'YO! China'. Further the court went on to hold that there was no evidence that the word YO! in Nestlé's use of the expression 'Masala Yo!' and 'Chilly Chow Yo!' created a connection with the MHPL's goods. The court was of the view that the prominent use of the trade mark MAGGI by Nestle on its products actually helped to retain the original meaning of YO!

The decision highlights the difficulty one can face in protecting marks that have a common meaning and usage.

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