

## **Kerala district court permanently restrains use of 'SEFRIDGES'**

In a suit for trade mark infringement and passing off, the District Court of Ernakulam, in Kerala State, granted a decree of prohibitory injunction against Selfridges Private Limited (Selfridges Private), permanently restraining it from using the mark 'SEFRIDGES' as its trade name and trade mark.

London-based retail giant Selfridges Retail Limited (Selfridges Retail) had filed a suit for trademark infringement and passing off in 2008 against Selfridges Private, an Ernakulam-based firm retailing consumer electronic products. The infringement had come to the knowledge of Selfridges Retail through publication of the mark SEFRIDGES in the name of Selfridges Private in Class 35, which it subsequently opposed. Selfridges Retail followed this with the suit for trade mark infringement and passing off when its efforts to settle the issue amicably failed.

In the suit, Selfridges Retail alleged that as the nature of the services of the two entities was similar, the purchasing public was likely to associate the two businesses. This likelihood was augmented as Selfridges Private had attempted to position its retail store as close as possible to that of Selfridges Retail. Selfridges Retail relied on its various international registrations, the oldest of which dates back to 1935, and extensive global use and goodwill, including in India where it had previously organized high-profile exhibitions and festivals.

Selfridges Private on its part argued that it adopted the mark on the basis of its business which was initially confined to 'selling fridges'. Relying on registration with various government authorities since 1991 and incorporation under the Indian Companies Act in this name, Selfridges Private claimed prior use in India. It elaborated that the mark was not affixed to retailed goods, their packing, labels or brochures and, therefore, there was no violation attributable to its adoption of the mark/ name 'SEFRIDGES' as a trading name.

The court examined witnesses from both sides and after going through evidence, noted that:

- Both parties had admittedly used the mark/name 'SEFRIDGES' in the course of trade.
- Selfridges Retail had used the mark 'SEFRIDGES' in connection with electronic consumer goods in addition to other goods, whereas Selfridges Private had only used it in relation to electronic consumer goods.
- While Selfridges Retail conducted business in London, Selfridges Private conducted business in different parts of India.
- Selfridges Retail enjoyed a valid and subsisting trade mark registration in India for the mark 'SEFRIDGES' under No. 669991, whereas Selfridges Private had no such trademark registration.
- Selfridges Retail had filed an opposition to registration of Selfridges Private's trade mark application for an identical mark in Class 35.

Based on these facts, the court made the following principal observations:

- Selfridges Retail was an internationally well-known establishment and also enjoyed a trade mark registration. Thus, it was not proper to compare the variety of goods sold through the outlets of the parties.

- The name and fame of Selfridges Retail had spread to India and all disparities apart, there was a possibility of emerging confusion in the minds of consumers as to an association between the two parties. In cases of passing off, the main consideration is *likelihood* of confusion or deception, deliberate or otherwise.
- The contention of Selfridges Private that it sold fridges and, hence, the mark 'SEFRIDGES', was without merit as it sold other electronic items too. In effect, the name 'SEFRIDGES' had no particular relevance to the business of Selfridges Private.

Observing that the quality of the consumable items sold from an outlet has a direct nexus with the confidence that the consumers repose in that institution, the court held that Selfridges Retail had the exclusive right to use the mark/name 'SEFRIDGES' and Selfridges Private had no such right. In light of this finding, Selfridges Retail was granted an injunction restraining Selfridges Private from using the mark/name 'SEFRIDGES'.

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