

## **ROCA and ROKA to co-exist rules Delhi High court**

The Delhi High Court recently decided an interim injunction application filed by Roca Sanitario S.A. (Roca) against Naresh Kumar Gupta (of Roma International (Roma)) and a counter-claim filed by Roma against Roca (CS (OS) 626/2006 and CS (OS), 2223/2006, 15 March, 2010). In its decision, the Delhi High Court dismissed the interim injunction applications of both parties and in effect allowed Roma to continue using the mark ROKA.

Roca in support of its case argued that:

1. It owned registrations for the mark ROCA in respect of bathroom tiles, fittings and sanitary-ware products in over 90 countries.
2. In India, it had owned registrations since 28 March 1979. It owned numerous domain name registrations comprising of the word ROCA, since 1995. In India, it claimed that it was using the mark ROCA before 1998.
3. Roma's prior use claim was unfounded. The earliest evidence produced by Roma dated from September 1999. Invoices produced by Roma for use since 1996 were not credible as they were internal.
4. Roca relied on its sales figures, worldwide to establish 'spill-over' reputation in India.
5. The explanation for the abrupt adoption and use of the mark ROKA since 1996 by Roma was unconvincing and false. ROKA was adopted without conducting a trade mark search.
6. Roma had adopted the similar mark ROKA for identical goods: 'ceramic and sanitary ware'. Confusion and deception were inevitable. Its stylised depiction and use of a similar font established its dishonest intentions in relation to the subject matter of the registration owned by Roca. Roma's attempt to establish prior use by reliance upon affidavits of its dealers was irrelevant as they did not demonstrate sales.
7. Before the opening of the Indian economy, Roca could not import the goods into India due to trade barriers.

Roma argued that:

1. It had owned a registration for ROKA in respect of sanitation goods, fittings, bath tubs since 1996. It had imported goods from China and marketed them under the mark ROKA since its adoption. It filed affidavits of several dealers having sold the ROKA brand for the last 10 years. Invoices from 1996 onwards were also filed.
2. ROKA was a coined term and has been derived from its proprietor's children names, Romika and Kanishk.
3. Roca had not used the mark in India. It had not filed any advertisement in trade journals/magazines with circulation in India. All magazines were in Spanish/ French.
4. Mere assertion of trans-border reputation was not sufficient. There should be documentary evidence.
5. ROCA had failed to show why it did not conduct business for 23 years (1979-2002) i.e. after securing registration of the mark.

The court was of the view that Roca had not shown that its international reputation had come to the knowledge of Indian consumers. The court specifically referred to the magazines relied on by Roca which were in Spanish and French and questioned whether they had any circulation among Indian consumers. The court took the view that Roca was exporting products to India for specific customers only, usually hotels on demand. It was therefore difficult to say Roca had presence in the Indian ceramic tiles market. In view of this it was not entitled to an injunction.

The court also refused to grant an injunction to Roma stating that the reason for coining the term ROKA was unconvincing. Roma had not adduced any evidence to assist the court as to their clientele. Further, the court concluded that the materials produced by Roma were insufficient to establish any kind of brand awareness or distinctiveness.

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