

'Chaitime' is not descriptive, holds Bombay High Court India - RNA Intellectual Property Attorneys


Infringement

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The Bombay High Court has granted an injunction restraining Girnar Food and Beverages Pvt Ltd from using MY CHAI MY TIME in a suit for infringement filed by Sapat International Pvt Ltd (SIPL) on the basis of its registration for CHAITIME.

SIPL argued as follows:

SIPL is a part of the Sapat group of companies, founded in 1897, and has been producing tea since 1905.

- In 2004 SIPL adopted the trademark  (CHAITIME), a unique combination of the devanagari word 'chai' written in English script and the word 'time', both written together and in lower case; and registered as such in 2007 in Class 30 in relation to tea and similar goods.
- Due to extensive use, SIPL's trademark had acquired distinctiveness and secondary meaning and had come to be associated exclusively with it.
- In December 2014, SIPL learned that Girnar was using the deceptively similar mark



(MY CHAI MY TIME). It immediately sent a cease and desist letter to Girnar asking it to stop using the mark. As Girnar failed to comply with the request, SIPL filed a court action.

Girnar raised the following contentions in support of its case:

- SIPL had obtained registration for its mark CHAITIME fraudulently, as it stated the date of use differently in its application.
- The trade mark CHAITIME was a wholly descriptive word, 'as the word 'chai' is known in Hindi. Therefore, the combination was equivalent to the use of the words 'tea' and 'time', which many tea traders used.
- SIPL had not used the trademark CHAITIME for many years.
- Girnar had applied for rectification of SIPL's trademark CHAITIME in Class 30.
- The delay in filing the action disentitled SIPL from seeking a preliminary injunction.
- Girnar had adopted and used MY CHAI MY TIME honestly and the rival marks were different.

Decision

The court ruled in favour of SIPL, restraining Girnar from using the mark MY CHAI MY TIME or any other mark similar to CHAITIME or 'chai' and 'time' following each other or in close juxtaposition, for the following reasons:

- SIPL's registration of the mark CHAITIME was sufficient to enforce its rights in an infringement action; whether the mark was descriptive or SIPL had stopped using the trademark at any point was immaterial;
- The plea of invalidity of SIPL's registration cast a heavy burden on Girnar, which it failed to prove - at least at the interlocutory stage.
- Girnar's allegation that SIPL had stated different dates regarding use was irrelevant, as it related to different marks and not CHAITIME as registered in Class 30.
- The argument regarding invalidity of SIPL's mark on account of descriptiveness held little weight given that, due to its extensive use, the CHAITIME trademark had acquired distinctive character in relation to the goods or services for which it was registered.
- With regard to deceptive similarities of the rival marks, the court observed that Girnar was not using its trademark MY CHAI MY TIME written as a continuation of four words, in which case SIPL would be unable to claim a monopoly over the words 'chai' and 'time' separately. However, Girnar's use of

its trademark MY CHAI MY TIME with its specific presentation clearly invoked an association with SIPL's prior adopted, used and registered mark CHAITIME.

- Ginar's mark MY CHAI MY TIME, by reason of the juxtaposition of the structural element of the words 'chai' and 'time', would clearly cause confusion on the part of the public as to the origin of the goods.

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