
Bombay High Court holds you cannot 'LIVE IN Levi's'

Federal Brands Ltd (FBL) filed a suit for infringement and passing off against, Levi Strauss India Pvt. Ltd (LSIPL) makers of Levi's jeans. FBL's primary grievance was LSIPL's use of the mark "LIVE IN" in respect of jeans, apparel and clothing. The court passed a restraint order against LSIPL holding LIVE IN is neither descriptive nor a generic expression based on manner of use by FBL, and relying upon its reputation and goodwill.

Background and contention of parties

FBL in the suit contended:

- The mark LIVE IN was adopted in the year 1992 in respect of jeans, apparel and clothing by FBL's sister concern and they have been using the mark as a licensed/permitted user.
- The LIVE IN mark is registered in Class 25 since 2003 and FBL is the registered proprietor of the said mark by virtue of a deed of assignment executed by its sister concern.
- FBL has also registered the marks "LIVE-IN LITES", "LIVE-IN COMFIES", "LIVE-IN KHAKIS", "LIVE-IN CHINOS" and "LIVE-IN UNRUFFLED" collectively referred to as the "LIVE-IN" trademarks.
- FBL has made extensive sales of the LIVE IN branded products and also spent huge amounts on advertisements and brand promotion.
- In February, 2015, FBL noted that LSIPL had commenced its marketing campaign using the mark "LIVE IN LEVI'S" which created confusion in the market and the perception gathered that FBL's business had been taken over by LSIPL.
- LSIPL's intention is to ride piggyback on FBL's reputation in the LIVE IN trademarks which amounts to trademark infringement and passing off.

LSIPL relied on the following contentions:

- The words "Live in" or "Lived in" are generic and have been used world over to describe the products of apparel and shoe industries commonly known as comfortable wear and is therefore descriptive.
- The parent company of LSIPL, L&S Company, was one of the first clothing manufacturers to use the "Live in" concept with respect to its goods.

- L & S Company adopted the concept in 1970's in its advertising campaign by using "Live in LEVI'S" and is used as an advertising subtext and not as a trade mark. LSIPL has placed on record various print-outs of the advertisements of L&S Company in the 1970's and 80's. The campaign was dropped in the 1990's which was again revived in August, 2014, by LSIPL.
- LSIPL has spent substantial amounts on this campaign and has been using the term "Live in" as a description of goods in accordance with honest practices. Moreover, "Live in" is a non-distinctive term common to the trade and does not qualify as a trade mark.

Court's finding

1. LIVE IN is generic expression

With regard to the contention that the words "LIVE IN" being generic, the court observed that the documents produced by LSIPL do not indicate that the term is indeed generic or describes the nature or quality of goods. Moreover, the promotion and advertising campaigns referred to by LSIPL are international campaigns and not advertisements in India. The advertisements in India, which are referred by LSIPL are by themselves which have been circulated since August, 2013. Use of the terms "Live in" or "Lived in" by well known apparel companies internationally cannot suggest that the words are either generic or describe the nature or quality of the goods. Further, FBL is the registered proprietor of the mark "LIVE IN" in India and has established a substantial reputation and goodwill in respect of the trade mark "LIVE IN" over the last more than 20 years and is exclusively associated with them.

2. No confusion or deception

With regard to the argument that the term "LIVE IN" is always used by LSIPL in conjunction with its trade mark "LEVI'S" and not as a separate mark, the court held that the issue in the instant matter is not whether the words "LIVE IN" have a stand-alone existence. On the other hand the question is whether the mark "LIVE-IN" has come to be exclusively associated with FBL or its goods and whether the use of these words with or without LSIPL's mark "LEVI'S" is likely to cause confusion and deception in the market. The court was of the view that it has to be seen "whether the totality of the proposed trade mark is such that it is likely to cause deception or confusion or mistake in the minds of persons accustomed to the existing trade mark." The court applying this test was of the view that public are accustomed to FBL's existing registered trade mark, and its reputation and goodwill, the display of these two words, namely, "LIVE IN", even it be along with the LSIPL's own trade mark "LEVI'S", is clearly likely to cause confusion, if not deception. The purchasing public is very much likely to take the overall mark as a combination of the two marks, namely, "LIVE-IN" and "LEVI'S" and take it as indicative of a connection between the respective owners of the two marks.

3. "LIVE IN" merely forms a subtext of advertising campaign

The court was of the view that the materials on record indicate that whatever be the text of any particular campaign or advertisement, the words "LIVE IN" always appear only in conjunction with the mark "LEVI'S" and as separate and distinct from the other text of the campaign or advertisement. The words "LIVE IN" may not be shown in such advertisements or campaigns with greater prominence than the word "LEVI'S" but then they are almost always shown at least with equal prominence with the word "LEVI'S". What is more important is that the words "LIVE IN" also actually appear on some of the goods marketed by LSIPL.

The court concluded that comfort element of the quality of goods can always be brought out in a variety of ways by LSIPL, and no serious prejudice is likely to be suffered by it if it is not allowed to use the words "LIVE IN" or "Live in". The court held balance of convenience is in favour of FBL and irreparable injury also clearly weighs in their favour. Thus, proceeded to restraint LSIPL from using the words "LIVE IN" or "Live in".

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