

# FOREIGN WORDS AS TRADEMARKS

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# FOREIGN WORDS AS TRADE MARKS



- *DIMINISHING INTERNATIONAL BOUNDARIES*
- *THINK GLOBAL, ACT LOCAL*

# THE *LINGUA FRANCA*

*If you talk to a man in a language he understands, that goes to his head. If you talk to him in his language, that goes to his heart*

*-Nelson Mandela*

*“A global brand-building strategy is, in reality, a local plan for every market.”*

*-Martin Lindstrom , (Brand expert)*



LET'S SELL IN SAUDI ARABIA !!





A man lying in the hot dessert sand totally exhausted and fainting.



The Man is drinking Cola.

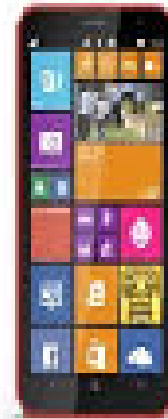


The Man is totally refreshed.

**DID WE REALLY MEAN IT?**

# LUMIA

**SPANISH SLANG FOR *PROSTITUTE***



**NOKIA  
LUMIA 1320**

# PAJERO



**TRANSLATED IN SPANISH AS ‘*WANKER*’**



# IRISH MIST

**LAUNCHED IN GERMANY - DID NOT  
GO WELL WITH THE MARKET**

**MIST MEANS *MANURE/DUNG/*  
*RUBBISH* IN GERMAN LANGUAGE**



# SIRI

**IN GEORGIAN LANGUAGE, SIRI IS A  
COMMON SLANG FOR *MALE GENITAL  
ORGAN***



***SHIRI* IN JAPANESE MEANS BUTT**

# FORD PINTO

Watching the sales of the car, the company realized that PINTO in Brazilian language means a slang used for denoting *genital area of a male*.

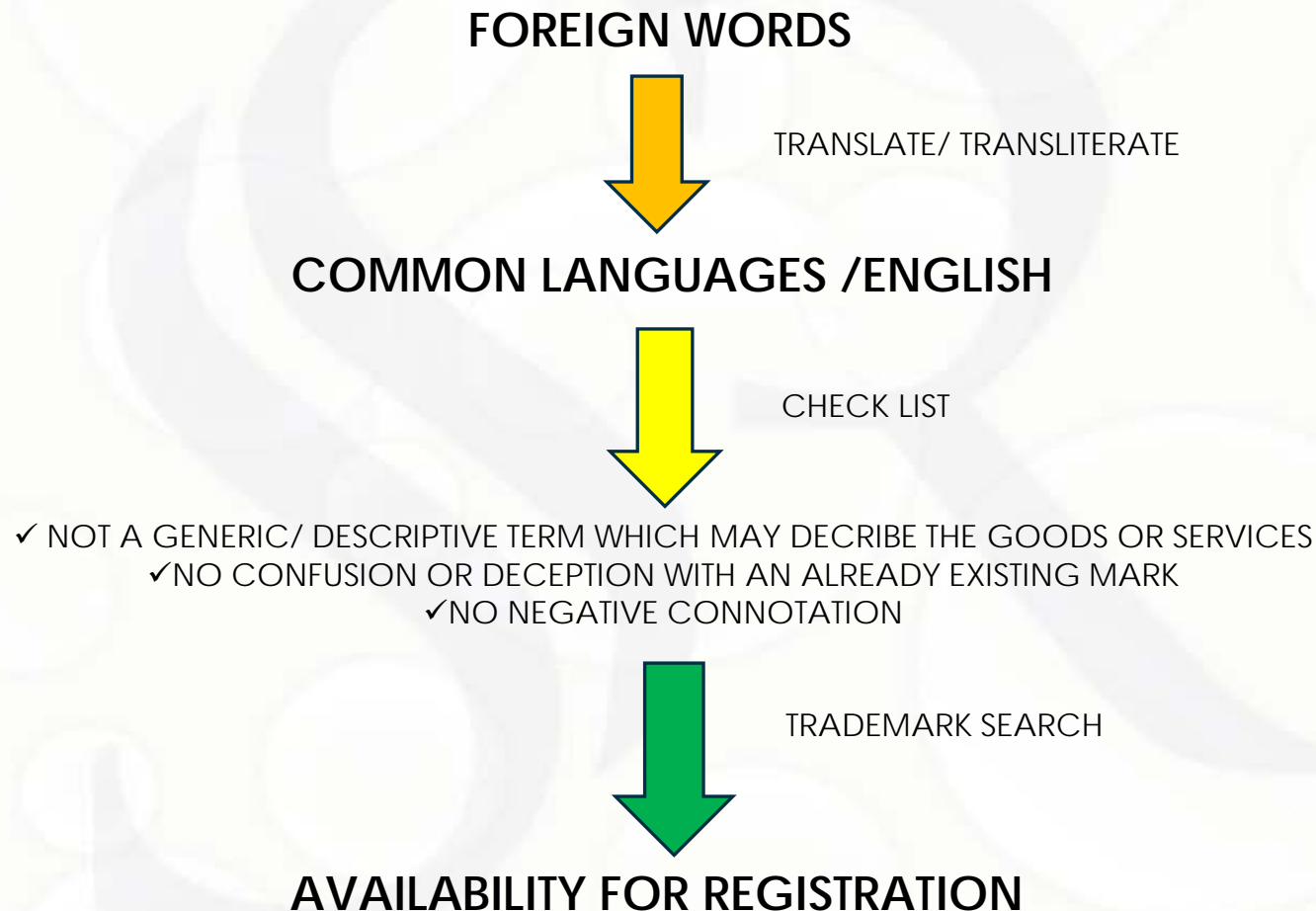


FORD PINTO

# FOREIGN WORDS AS TRADEMARKS

*“Those who know nothing of foreign languages know nothing of their own”  
- Johann Wolfgang von Goethe*

# FOREIGN WORDS AS TRADEMARKS



# DOCTRINE COMES INTO ACTION

PEOPLE KNOW/ ARE FAMILIAR WITH THE FOREIGN LANGUAGE



STOP AND TRANSLATE



LIKELIHOOD OF CONFUSION ARISES / DESCRIPTIVENESS



# FACTORS IMPACTING THE DOCTRINE

## WHETHER LANGUAGE IS WELL-KNOWN IN THE FILING COUNTRY

RISTORANTE  
Meaning café in  
Italian

- ORDINARY CONSUMERS  
WOULD BE AWARE

CRUSTUM  
Meaning café in  
Latin

- ORDINARY CONSUMERS  
WOULD NOT BE AWARE

## WORDS ORIGINATING FROM DEAD/ EXTINCT LANGUAGE

# WHY TRADEMARK SEARCH IN INDIA?

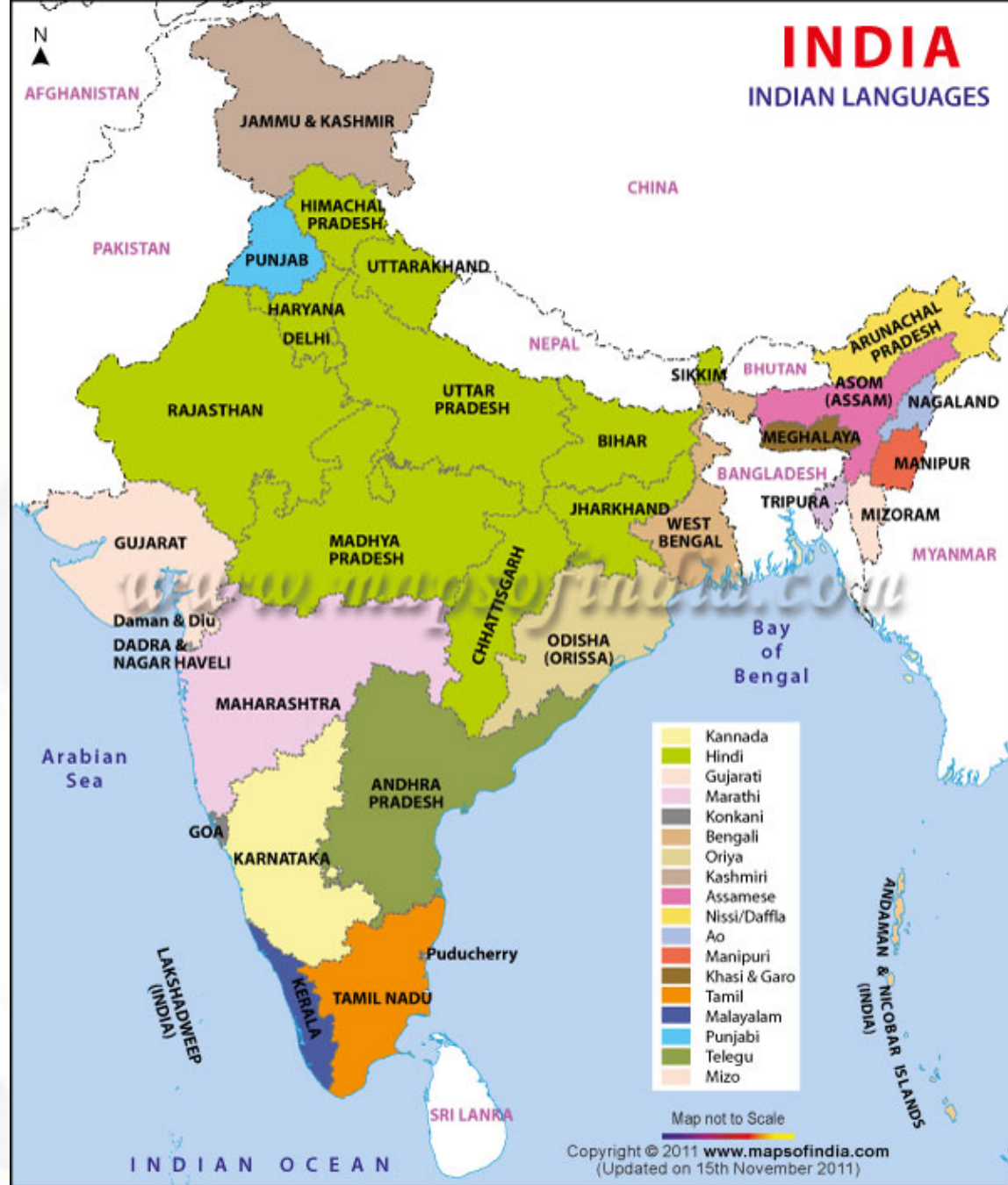
**India has a very rich linguistic culture: \***

- 780 Different Languages**
- 122 Languages have been declared by the census as spoken by a population exceeding 10,000**
- 86 Different Scripts**
- 22 Scheduled Indian languages**

**\* The People's Linguistic Survey of India, 2013**







# INDIAN PERSPECTIVE

## THE TRADEMARK ACT

- **ABSOLUTE GROUNDS OF REFUSAL** [Section 9]- (Basis of Descriptiveness)

- **RELATIVE GROUNDS OF REFUSAL** [Section 11] – (Basis of Cited marks)

❖ **NO NEGATIVE CONNOTATION IN INDIA**

❖ **RULE 33 OF THE TRADEMARK RULES: PROVIDES FOR  
TRANSLITERATION AND TRANSLATION FOR A WORD IN SCRIPTS  
OTHER THAN ENGLISH OR HINDI**

# INDIAN REGISTRY

## WATER WATER IN THE TM REGISTER !!

- **WASSER** IN GERMAN (#1096245)
- **EAU** IN FRENCH (#1650609)
- **ACQUA** IN ITALIAN IS (#1826594)



**ALL REGISTERED IN CLASS 32**

# INDIAN REGISTRY

➤ **MIZU** IN JAPANESE IS WATER



(#2476737) IN CLASS 32

**OBJECTED ON GROUNDS OF DESCRIPTIVENESS**

# INDIAN REGISTRY

## SERVING CHOCOLATE IN SEVERAL LANGUAGES !!

### ➤ SCHOKOLADE IN GERMAN

SCHOKO-BONS (#1769225)- REGISTERED IN CLASS 30

SCHOKOLAADE (#2212443)- OBJECTED ON THE GROUNDS OF DESCRIPTIVENESS

### ➤ CHOCOLAT IN FRENCH

BON CHOCOLAT (#1319214)

REGISTERED IN CLASS 30



# INDIAN REGISTRY

NOODLES..YUMMY IN EVERY LANGUAGE!!!

HAKKA IS ONE OF THE MAJOR CHINESE LANGUAGES

- CHANG (HAKKA NODLES) (#1072677 )
- HAKKA Noodles (#1765836)
- TIKKA VS HAKKA (#1742445 & 1742447)



AFORESAID MARKS ARE REGISTERED IN CLASS 30

- HAKKA & TIKKA (#2067474)



OBJECTED ON THE GROUNDS OF DESCRIPTIVENESS



# INDIAN REGISTRY

**RAMEN IS JAPANESE NOODLE SOUP DISH**

- **NISSIN TOP RAMEN (#554876)**
- **TOP RAMEN MUG NOODLES (#758247)**
- **TOP RAMEN CHOW CHAMP (#1200542 & 1200543)**



**AFORESAID MARKS ARE REGISTERED IN CLASS 30**

# INDIAN REGISTRY

➤ **SAVON** IN FRENCH IS SOAP

#1901529



➤ **PARFUM** IN FRENCH IS PERFUME

#1033033



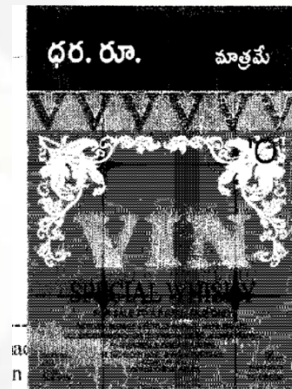
AFORESAID MARKS ARE REGISTERED IN CLASS 3



# INDIAN REGISTRY

➤ **VINO** IN SPANISH IS WINE  
# 1404139

➤ **VIN** IN FRENCH IS WINE  
**VIN** (# 1250570)  
**VIN** (# 401387)



AFORESAID MARKS ARE REGISTERED IN CLASS 33



# INDIAN REGISTRY

- **SENORITA** IN SPANISH IS MISS  
#996344
- **MADAME** IN FRENCH IS MRS.  
#1066711
- **MADAME**  
#1569616



AFORESAID MARKS ARE REGISTERED IN CLASS 25

# INDIAN REGISTRY

*- Not always so sweet !!*

**DOLCE VITA IN ITALIAN MEANS THE SWEET LIFE**

➤ **DOLCE VITA** (#2143860 in class 29)  
**OBJECTED ON THE GROUNDS OF DESCRIPTIVENESS**



➤ **DOLCE VITA** (#2151401 in class 29)  
**OBJECTED ON THE GROUNDS OF DESCRIPTIVENESS**



# INDIAN REGISTRY

**YAKISOBA** IS A JAPANESE DISH AND IS TECHNICALLY A DERIVATIVE OF CHINESE CHOW MEIN

#2449481IN CLASS 30- **OBJECTED BY THE REGISTRY ON THE GROUND OF DESCRIPTIVENESS**



# INDIAN REGISTRY

GELATO IN ITALIAN MEANS ICE- CREAM

- JUST GELATO (#1776506) IN CLASS 30



OBJECTED ALONG WITH THE COMMENT – *“THE MARK INDICATES THE CHARACTER OF GOODS”*

- GELATO ROMA (#2383217) IN CLASS 30
- CIAO GELATO (#2522288) IN CLASS 30 (CIAO IN ITALIAN MEANS HELLO)



**ALL AFORESAID MARKS ARE OBJECTED BY THE REGISTRY ON THE GROUND OF DESCRIPTIVENESS**

# REGISTRY'S STANCE

- AUGMENTATION IN THE FILING OF FOREIGN MARKS IN INDIA
- OBSERVATION INDICATES THAT EARLIER THE REGISTRY HARDLY USED TO RAISE ANY OBJECTION ON ACCOUNT OF DOCTRINE OF FOREIGN EQUIVALENT
- HOWEVER, IN RECENT TIMES THE REGISTRY HAS BEEN MORE FREQUENTLY RAISING OBJECTION BASED ON THE DOCTRINE

# JUDICIAL PRONOUNCEMENT

*Aktiebolaget Volvo & Ors. vs Mr. Vinod Kumar & Ors. (Delhi High Court on March 7, 2011)*

**ISSUE - VOLVO in Latin means ?**

- **Test**
- **Absolute rule or merely a guideline**
- **Foreign words from dead and extinct languages**



# JUDICIAL PRONOUNCEMENT

*C. Kamani Oil Industries Pvt. Ltd. vs Bhuvaneshwar Refineries Pvt. Ltd.* (Bombay High Court on May 9, 2014)

ISSUE – RISO in Italian

- Whether RISO can be held to be descriptive in India?

RISO - LITE



# JUDICIAL PRONOUNCEMENT

*Bhatia Plastics v. Peacock Industries Ltd. (Delhi High Court on July 4, 1994)*

ISSUE: IS PEACOCK DECEPTIVELY SIMILAR TO MAYUR?

PLAINTIFFS: REGISTERED PROPRIETOR FOR “MAYUR” IN CLASS 21- HAD ACQUIRED SIGNIFICANCE

DEFENDANTS: STARTED USING THE MARK “PEACOCK” FOR SIMILAR GOODS



CONVEYS THE SAME IDEA IN A DIFFERENT LANGUAGE

# FOREIGN TRADEMARKS IMPLYING INDIAN CONNECT

## ■ VOLKSWAGEN DAS AUTO

- DAS AUTO IN GERMAN MEANS "THE CAR"

- NISSAN'S SUNNY XL 'THE CARR'



**DAS IS A COMMON INDIAN SURNAME**

# CONTINUED...



- BOSE CORPORATION IS AN AMERICAN COMPANY
- OFTEN CONFUSED BY INDIAN CONSUMERS AS AN INDIAN COMPANY

**"BOSE" IS AN INDIAN SURNAME**

# CONTINUED...

➤ SONY CORPORATION- SONY (SONI)

The Sony logo, consisting of the word "SONY" in a bold, black, sans-serif typeface.

• BEAUTIFUL GIRL IN INDIA

➤ RAND WORLDWIDE- LEADING PROVIDER OF TECHNOLOGY SOLUTIONS

The Rand Worldwide logo, featuring the word "RAND" in a stylized, black, serif font with a large, decorative "R", and the word "WORLDWIDE" in a smaller, black, sans-serif font below it.

# BRAND EVALUATION

- General interpretation
- All possible meanings
- Negative connotations
- Existing names with a similar meaning
- Pronunciation issues
- Phonetic similarities



Ask the LOCALS!!!



“

A brand is worthless if it doesn't **connect**  
with the right audiences in a relevant way.

”

*“A BRAND IS NOT JUST A  
LOGO, A WEBSITE, OR YOUR  
BUSINESS CARDS...*

*IT'S AN EXPERIENCE.”*

“We are no longer in  
the era of the “copy  
cat” brand. Consumers  
just don't buy it.”

“

Your brand  
is the single  
most important  
investment  
you can make  
in your business.”

– Steve Forbes

# TRADEMARKS IN INDIAN LANGUAGES

## FILING OF TRADEMARKS BY FOREIGN BRAND OWNERS IN INDIAN LANGUAGE

- Comprehensive Protection- Additional or Necessary
- If Yes, the factors to be considered
  - Target audience for goods/services
  - Target geographical area
  - Classification of industry
  - Size of the industry
  - Risk factors involved
- Major Indian Languages – Hindi, Bengali, Tamil, Telugu, Kannada, Marathi, Punjabi, Malayalam etc.



नेटफिलक्स

अक्यु-गेक

एक्यु-चेक

एक्यु-डेक

आकु-ठक

श्री नमो



# THANK YOU.....