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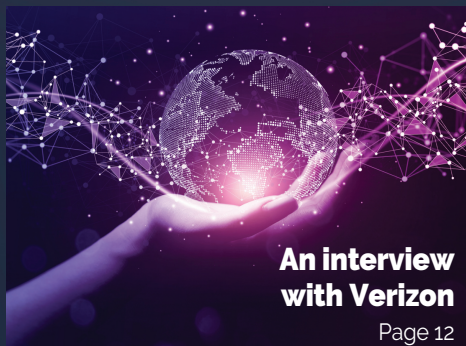
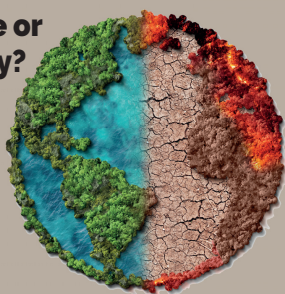
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Whose ARMOUR is stronger? A tussle between apparel moguls

Manisha Singh, Partner, and Anmol Bahuguna, Associate, of LexOrbis dissect the recent *Under Armour, Inc. v. Aditya Birla Fashion & Retail Ltd.* case to assess the claims of passing off and deceptive similarities with key takeaways for protecting fashion trademarks.

The global fashion industry is one of the most competitive arenas, and the difference between the success and collapse of a brand is contingent upon how robustly the business protects its identity. Trademark infringement is a common dispute that plagues this industry, and courts in India rely upon an array of factors to determine the intellectual property rights of the disputing parties. In the recent case *Under Armour, Inc. v. Aditya Birla Fashion & Retail Ltd. CS (COMM) 41/2023, I.As. 1349/2023 and 4142/2023*, the Delhi High Court was presented with a dispute over the adoption of the marks STREET ARMOUR, STRT ARMOR and SA by the defendant, which were alleged to be similar to the plaintiff's registered UNDER ARMOUR, UNDER ARMR, and UA marks.

Facts of the case

The plaintiff, UNDER ARMOUR, Inc. (UA India), is a US-based company. The plaintiff officially entered the Indian market in 2017 by selling its goods through Amazon. In 2018, the plaintiff incorporated its Indian subsidiary, Under Armour India Trading Pvt. Ltd., and the first physical store of the plaintiff was opened in India in 2019. The mark UNDER ARMOUR stands registered in the plaintiff's favor in Classes 18 (leather and imitations of leather, and goods made of these



Manisha Singh



Anmol Bahuguna

materials, etc.), 25 (clothing, footwear, headgear), and 28 (games and playthings, gymnastic and sporting articles, etc.) since 24 February 2009 and the mark UA stands registered in the plaintiff's favor in the same classes since 12 January 2011.

One of the contentions made by the plaintiff was about reputation; in a Google search of the word 'ARMOUR', the plaintiff's site was one of the first results to show. However, the court stated that the appearance of any brand's website in Google search results does not establish the brand's reputation or goodwill in the market and held a Google-based search argument insufficient.

The plaintiff operates the interactive websites www.underarmour.com and www.ua.com. According to the plaintiff, the defendant's use of the word 'ARMOUR' in its mark, notably the style and letters, is confusingly similar to the plaintiff's ARMOUR mark.

The defendant argued that since the plaintiff has only relied upon the fact that 'ARMOUR' was the dominant part of its marks and not the complete trademark to support its claims, the court ought to consider the entire trademarks UNDER ARMOUR, UA, UNDR ARMR as well as 'ARMOUR' in the distinctive font used by the plaintiff. The objective of the court is to determine whether, when viewed as a whole, the defendant's marks infringe the plaintiff's

Résumés

Manisha Singh, Partner

Manisha is known to be one of the most reputed lawyers in the intellectual property domain, with a decorated career of over 25 years. She has served as a vital advisor to corporations and research organizations in handling intellectual property matters and developing strong IP portfolios. She is ceaselessly engaged in endeavors to strengthen India's IP protection and enforcement system to align it with international standards and works closely with industry associations and the government.

Manisha has served as the leading counsel for a client base in over 138 countries in their IP management and litigation matters. She is identified by her clients as a seasoned and reliable counsel for the prosecution and enforcement of all forms of IP rights, and planning and management of global patents, trademarks, and designs portfolios. She has also led numerous negotiation deals on behalf of her clients for both IP and non-IP litigation and dispute resolution.

Anmol Bahuguna, Associate

Anmol Bahuguna, an Associate at LexOrbis, is a Post Graduate of L.L.M (Corporate & Commercial Laws) from IMS Unison University, Dehradun and has pursued his Graduation in B.B.A L.L. B from Lovely Professional University, Punjab. He regularly undertakes drafting and advisory work related to IP/ trademark prosecution and contentious matters. Over the course of his internships with various Law firms, he has acquired various legal and technical skills across various legal fields such as Company Law, Data Privacy Law, Arbitration Law, Consumer Law, and Intellectual Property laws, which he applies to his work at the firm.

marks or if the defendant may be accused of trying to pass off its goods as those of the plaintiff, on which the court agrees and holds. The court also addressed the "dominant part" argument, concluding that the probability of confusion must be assessed by taking into account the totality of the composite marks as an indivisible whole rather than by cutting or segmenting.



Legal issues considered by the Delhi High Court

1. Whether the second element 'ARMOUR' is a dominant feature of the plaintiff's mark UNDER ARMOUR. Whether the plaintiff's marks, seen as whole marks, are, or are not, infringed by the defendants.
2. Whether the 'ARMOUR' part of the plaintiff's marks would be descriptive.

The court commented on the identification of a "dominant mark", which refers to a specific element within a composite mark that is given greater prominence compared to the other constituent elements. In other words, it is an element that stands out and is more noticeable than the other elements in the composite mark. In this present case, plaintiff's mark UNDER ARMOUR and the defendant's mark STREET ARMOR, there is no reason for the court to consider ARMOUR/ARMOR as the dominant part of both the marks respectively. The primary way to determine whether an element of a trademark is dominant is to test whether it makes a stronger impression on the customer's mind than the other elements when viewed by an average customer with imperfect memory. The court further observed that in the absence of any material or evidence to indicate that 'UNDER' or 'STREET' is less dominant in UNDER ARMOUR or STREET ARMOR respectively than 'ARMOUR' or 'ARMOR', thus the plaintiff's argument that 'ARMOUR' is the most dominant part of the UNDER ARMOUR mark is not valid.

While addressing the second issue, the court held that if a purchaser with average intelligence buys sportswear bearing the plaintiff's brand name UNDER ARMOUR or UNDR ARMOR, and later comes across sportswear bearing the defendant's brand name STREET ARMOUR or STRT ARMOR, the purchaser may think that they had purchased a similar piece of sportswear previously with a similar name and there is every possible chance that the purchaser may presume a connection between the defendant's mark and the plaintiff's earlier trademark which they came across earlier.

Keeping the abovementioned observations in mind, the court determined that under Section 29(2)(b) of the Trade Marks Act, 1999, the plaintiff's registered mark UNDER ARMOUR was violated since the use of the marks STREET ARMOUR and ARMOUR in connection with athletic equipment was likely to lead to confusion or association between the marks. Lastly, while determining whether there was trademark infringement, the court looked at the marks as a whole and did not consider 'ARMOUR' to be the plaintiff's mark's dominant component.



Credit: PRImageFactory

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The defendant argued that the 'ARMOUR' part of the plaintiff's mark was descriptive and hence could not be protected. The court rejected this argument and held that 'ARMOUR' was not descriptive of the goods of either the plaintiff or the defendants. The court observed that sportswear is not armorial, and even if the clothing in question was protective, the mark could at best be suggestive, which can be registered, unlike descriptive marks. The court also noted that the plaintiff's use of the mark was not protective, and 'ARMOUR' was arbitrary when used for such apparel. The court further dismissed the defendant's argument that it had applied for registration of the STREET ARMOUR mark, contending that it was estopped from claiming that 'ARMOUR' was descriptive.

The defendant further argued that the word 'ARMOUR' was common to trade as the plaintiff was operating in a "crowded marketplace"; however, the court rejected this argument by stating that the Trade Marks Act does not recognize any such concept called "crowded marketplace". Even if 'ARMOUR' was common, it would only apply if the plaintiff claimed exclusivity over that part of the mark, which they were not doing. The court found the defendant's marks were deceptively similar to the plaintiff's marks, and the argument of whether 'ARMOUR' was common to the trade was insignificant.

It is important to note that the defendant contended that the plaintiff purposely suppressed material facts by not disclosing their response to the First Examination Report (FER) while obtaining registration for the mark UNDER ARMOUR. The defendants contended that in the response to FER, the plaintiff submitted that other marks

which had 'ARMOUR' as a part thereof were already registered, and the plaintiff's mark had to be seen as a whole, whereas in the present plaint, the plaintiff is being sought to claim exclusivity on the word 'ARMOUR' itself. The defendant contended that the stance taken by the plaintiff in this present case is different from the stance taken in the response to the FERs and the plaintiff is bound to disclose the replies filed to the FERs with the present plaint.

The court held that if the defendant's mark is cited in the FER as a similar mark to the plaintiff's proposed mark under Section 11(1)(b), then the plaintiff's response to the FER would be relevant as the plaintiff cannot take a different stance and oppose the same mark of the defendant in the infringement suit. Doing so would be considered inconsistent and unfair. Hence in the present case, this principle has no application as the defendant's mark was never put up as a similar mark in the FER while objecting to the application of the plaintiff for registration of the UNDER ARMOUR mark.

Lastly, the court observed that if any material fact which would have an impact on the outcome of the proceedings is suppressed, the suppression of fact could disentitle such party to seek relief and the plaintiff is not guilty of any such material

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suppression of fact as would disentitle it to release in the present case.

Order of the Delhi High Court

The court made a ruling based on the facts and legal issue presented and held that defendant is restrained from dealing in or using the impugned marks STREET ARMOR, STRT ARMR, ARMR, ARMOR, SA, ARMR DEPT, SA DEPT, STREET ARMOR CO, STRT ARMR LAB or any other trademarks/labels that are identical with and/or deceptively similar to the plaintiff's registered UNDER ARMOUR, UNDR ARMR or UA word marks or device marks, or any other mark that is confusingly or deceptively similar to the said marks of the plaintiff, in respect of apparel or any other goods or services which may be regarded as similar or allied to the goods in respect of which the plaintiff uses its marks.

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