



(T)OP(TM) No.398 of 2023
(ORA/114/2020/TM/CHN)

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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 07.03.2024

CORAM

MR.JUSTICE N.SESHASAYEE

(T)OP(TM) No.398 of 2023
(ORA/114/2020/TM/CHN)

Intercontinental Great Brands LLC
100 Deforest Avenue, East Hanover
NJ, 07936, United States of America

... Petitioner

Vs

1.Hemalatha Sharma
Trading as M/s.Oreo Besin
Plot No.338, Singareni Colony
Behind Singareni Colony Welfare Office
Saidabad, Hyderabad,
Andhra Pradesh.

2.Rao & Rao

3.Deputy Registrar of Trade Marks
Trade Marks Registry
Boudhik Sampada Bhawan
G.S.T. Road, Guindy, Chennai - 600 032

... Respondents



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Prayer: Original Petition filed under Section 57 of the Trade Marks Act, to expunge the registration of the impugned mark OREO BESIN bearing Registration No.1835147 by its removal from the register and for costs.

For Appellants : Ms.Antara Balaji
for Mr.Rajesh Ramanathan
for M/s.Lall and Sethi

For Respondent : Mr.Rajesh Vivekanandan
Dy. Solicitor General for R3

ORDER

This petition is filed for rectification of Register of the third respondent where the petitioner seeks cancellation of first respondent's mark off the Register of the third respondent. [The second respondent herein is irrelevant party to the proceedings]

2. The petitioner is a U.S. based company and they are in the field of manufacture and one of the market leaders in the field of confectionery. They trade their products under the trade name 'OREO'. They have registered the word 'OREO' under Class 30 for multiple products covered under Class 30.



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This apart, they also have registered the word 'OREO' with a catchy font style and colour scheme. This apart, they also have both device and label marks with the word OREO prominently printed. The details are as below:

<u>Trade Mark</u>	<u>Number</u>	<u>Date</u>	<u>Cl.</u>	<u>Goods</u>
OREO (word)	551287	17-05-1991	30	Biscuits, cookies and crackers
OREO (word)	2858293	08-12-2014	30	Biscuits, cookies, crackers, ice-cream, frozen and chilled confectionery
	1960090	03-05-2010	30	Biscuits, cookies and crackers



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	1208713	24-06-2003	30	Coffee, tea, cocoa, sugar, rice tapioca, sago, artificial coffee, flour and preparations made from cereals, bread pastry, biscuits, cookies, crackers and confectionery, teas, honey, treacle, yeast, baking powder, salt, mustard, vinegar, sauces (condiments), spices ice.
ONLY OREO (word)	1956742	27-04-2010	30	Biscuits, cookies and crackers
OREO O'S (word)	1443815	10-04-2006	30	Breakfast cereal
	1987314	30-06-2010	30	Biscuits, cookies and crackers
	2292915	01-03-2012	30	Biscuits, cookies and crackers
				



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3. Be that as it may, the first respondent herein has registered her word mark 'OREO BESIN' in Class 35 for marketing her pharmaceutical preparations. She applied for registration on 01.07.2009 with the user status for barely a month from 01.06.2009 and it came to be registered on 19.03.2021 and has since been renewed periodically. Even if the word OREO is searched for its meaning, Google only shows petitioner's biscuit.

4. Inasmuch as the petitioner had registered its word mark OREO at least for four different products in the same Class, it is very evident that in the same class, it has exclusive ownership over that. The first respondent, therefore does not have any right *per se* to use the word OREO as its trade name and does not have any right to have it registered.

5. Notice was served on the first respondent but she chose not to appear. Heard the counsel on record for the petitioner and the Deputy Solicitor General for the third respondent.



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6. Ms.Anthra Balaji, the learned counsel for the petitioner submitted that petitioner's word mark 'OREO', is an invented word, which implies that it is entitled to optimum protection in the Trade Mark regime. Therefore, notwithstanding the fact that the first respondent had registered its mark only as a trade name in Class 35, yet inasmuch as petitioner's word mark 'OREO' is an invented word, it has a direct impact on the petitioner's mark.

7. This court, carefully considered the submissions of the learned counsel and also perused the records. This court also verified with the dictionary and finds itself satisfied that it is an invented mark. Necessarily, the first respondent does not have any right to rob somebody's invented property for its commercial use.

8. The issue now is whether the entire word mark of the first respondent shall be struck off from the register of the third respondent. On perusal, this court finds the first respondent's mark is based on two independent words they are: OREO and BESIN. While the petitioner has every right to seek cancellation of the word, 'OREO BESIN' of the first respondent, so far as the word



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BESIN is concerned, this word is not part of any petitioner's word mark or label mark. However, the mark has been registered as one single mark. Hence this court is constrained to direct that the said mark be struck off from the register of the third respondent.

9. Accordingly, this petition is allowed and the third respondent is directed to strike off the first respondent's mark 'OREO BESIN' from the Register forthwith. No costs.

07.03.2024

Asr
Index: Yes/No
Speaking Order / Non-Speaking Order
Neutral Citation: Yes / No

To
The Deputy Registrar of Trade Marks
Trade Marks Registry
Boudhik Sampada Bhawan
G.S.T. Road, Guindy, Chennai - 600 032



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N. SESHASAYEE, J.

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