



**IPAB** Intellectual Property Appellate Board  
International Intellectual Property

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**ORA/42/2019/TM/CHN**

**TUESDAY, THIS THE 19<sup>TH</sup> DAY OF JANUARY, 2021**

**HON'BLE SHRI JUSTICE MANMOHAN SINGH**                      **CHAIRMAN**  
**HON'BLE MS.LAKSHMIDEVI SOMANATH**                      **TECHNICAL MEMBER (TRADEMARKS)**  
**HON'BLE SHRI. MAKYAM VIJAY KUMAR**                      **TECHNICAL MEMBER (TRADEMARKS)**

DOTCOM RETAIL LIMITED OF  
LEVEL 12 NUMBER 5  
EXCHANGE QUAY, MANCHESTER  
ENGLAND, M53EF

: **APPLICANT**

(Represented by Ms. Suhrita M)

**Versus**

1. RNA INTELLECTUAL PROPERTY LIMITED  
A COMPANY OF AKARA BUILDING  
NO.24 DE CASTRO STREET, WICKHAMS CAY I  
ROAD TOWN, TORTOLA  
BRITISH VIRGIN ISLANDS

2. THE REGISTRAR OF TRADE MARKS  
TRADE MARKS REGISTRY  
BOUDHIK SAMPADA BHAVAN  
GST ROAD, GUINDY  
CHENNAI – 600032

: **RESPONDENTS**


(Represented by None)

**ORDER**

**Hon'ble Ms. Lakshmidevi Somanath, Technical Member (Trade Marks)**

1. The Rectification Application is filed under Section 47 and 57 of Trademark Act, 1999 for Removal of the Registration No. 2015388 for the mark “**beautybay**” in Class 35 in the name of Respondent No.1. The application for the impugned registration has been filed on 27/08/2010 on a proposed to be used basis and the sealing date for the registration certificate is 18/10/2011.
2. There is no representation on behalf of the Respondents at this and on the last few hearings.

3. The details of the Impugned registered Trade Mark are :

APPLICATION NO : 2015388  
TRADEMARK/LOGO : BEAUTY BAY (DEVICE MARK)  
represented as   
CLASS : 35  
DATE OF APPLICATION : 27/08/2010  
DATE OF ADVERTISEMENT : 30/05/2011 JOURNAL NO. 1486  
DETAILS OF REGISTRATION : CERTIFICATE NO. 1023489  
DATED 18/10/2011

### **FACTS OF THE CASE**

#### **About the Applicant**

4. The Applicant for Rectification (Dotcom Retail Limited) is the owner and proprietor of the widely known and popular trade mark BEAUTY BAY. The Applicant was incorporated in the year 2007 and is engaged in the business of online retailing of cosmetic and beauty products as well as manufacturing and selling of cosmetic products. The origin of the Applicant Company can be traced back to the year 1999, with the incorporation of the predecessor of the Applicant, namely the company Fragrancebay.com Limited. To diversify the business' product lines and to include a wider range of beauty products, Fragrancebay.com Limited adopted the trade mark Beauty Bay and acquired the domain beautybay.com in October 2002. In or around October/November 2007, Fragrancebay.com Limited underwent a corporate restructure and set up a new company, Dotcom Retail Limited, the Applicant herein, which became the owner of all Intellectual Properties of the erstwhile Fragrancebay.com Limited, including the trade mark Beauty Bay. A subsidiary company of the Applicant company, Beautybay.com Limited (now known as Beauty Bay Limited), was formed simultaneously. Fragrancebay.com Limited was dissolved in 2012. The trade mark BEAUTY BAY, adopted in 2002, has been used globally since 2005 and in India since 2008. The Applicant has been the registered proprietor of the trade mark BEAUTY BAY in the United Kingdom since 2006. The reputation and goodwill associated with the trade mark BEAUTY BAY is well established through global use, as well as direct use in India since 2008.

#### **About the Applicant's Trademarks**

5. The trade mark BEAUTY BAY was first adopted by the Applicant, through its predecessor, in the year 2002 and thereafter put to use by the said predecessor has been in use

since the year 2005, for goods and services in inter alia Classes 3 and 35. In December 2006, the afore mentioned Fragrancebay.com Limited (predecessor of the Applicant) filed applications to register the trade marks BEAUTYBAY and BEAUTYBAY.COM in the United Kingdom and since then the said predecessor and thereafter the Applicant Company, has filed applications for registration of the same in numerous countries around the world. The trade mark BEAUTY BAY is now particularly used by the Applicant's licensee and wholly owned subsidiary Beauty Bay Limited (formerly known as Beautybay.com Limited) and who also operate the website at [www.beautybay.com](http://www.beautybay.com).

6. While the services offered through the website Beautybay.com and under the trade mark Beauty Bay were initially provided only to customers in the United Kingdom, the services and shipment of products have been offered to customers outside the UK since the year 2007 and also customers in India since the year 2008. Currently, the Applicant ships its products to over 100 countries across the World based on orders placed on the website [www.beautybay.com](http://www.beautybay.com).

7. In India, the Applicant's business under the trade mark BEAUTY BAY has grown from sales of around GBP 2000 in the year 2008 to around GBP 150,000 in the year 2017. The trade mark BEAUTY BAY and the goods/ services under the same have been promoted extensively across the globe. The trade mark has been promoted primarily by way of 'Google Ad words'. The Applicant also promotes the trade mark BEAUTY BAY through several online social media platforms such as Facebook, Twitter and Instagram. The pages relating to BEAUTY BAY on such social media platforms have a huge number of followers which establishes the worldwide popularity and acclaim enjoyed by the trade mark BEAUTY BAY. Such pages are accessible to consumers across the World, including in India. The Applicant's global marketing budget is in excess of 6 Million GBP currently.

8. Through such extensive use, the trade mark BEAUTY BAY has for over one decade now been associated with the Applicant the world over owing to the global extensive use and the high quality of goods/ services rendered under the trade mark.

9. As far as trade mark application in India, are concerned, the Applicant filed applications for registration under nos. 3259215 in Class 35 and 3259214 in Class 3, claiming prior use in India. The applications are pending.

### **Applicant's Case against Respondent No.1**

10. During the prosecution of the Applicant's abovementioned trademark, an objection under Section 11, on the basis of the impugned mark was raised by the Registrar of Trade Marks. The registration of the Applicant's trade mark application for BEAUTY BAY in Class 35 stands obstructed by the impugned registration. The Applicant's cause of action against the registered proprietor arose therefrom from the date of issuance of the said examination report.

11. Prior to initiating the instant proceeding, Applicant with an intention to amicably resolve the potential dispute, sent a letter dated September 13, 2018, through its Advocates, M/s S. Majumdar & Co. to the Respondent No.1 as well as its Advocates in India. The Respondent No. 1 failed to respond to such letter. Therefore, the Applicant has filed the present Petition before us.


### **ARGUMENTS ADVANCED BY THE APPLICANT**

12. Learned Counsel for the Applicant argued that the impugned mark was applied for and the registration obtained by the Respondent No. 1 in bad faith, with full knowledge of the existence of the Applicant's prior adopted and extensively used reputed trade mark BEAUTY BAY. It is to be noted that the impugned mark was filed by Respondent No.1 in August 2010, on a proposed to be used basis, which is much later as compared to the use and adoption of the trade mark BEAUTY BAY by the Applicant. It can hardly be a matter of coincidence that Respondent No. 1 conceived and adopted a deceptively similar/ identical mark to one that was conceived and adopted by the Applicant many years ago, and has been popularly known across the World since the year 2005. Further, the trade mark BEAUTY BAY has been known to members of the public and trade since the year 2005 owing to accessibility of the website [www.beautybay.com](http://www.beautybay.com), globally. Even further, consumers and members of the trade in India have also availed of the services under the trade mark BEAUTY BAY since the year 2008, when the Applicant extended its services directly to India by allowing customers in India to place orders on the said website. The adoption and registration of the impugned mark is therefore devoid of good faith and in view of the prior adoption and use of the trade mark BEAUTY BAY, by the Applicant, the Respondent No.1 cannot claim to be the rightful proprietor of the impugned mark.

13. The Applicant argued that the impugned mark, which is a stylized representation of the

mark BEAUTY BAY, stands registered in respect of advertising, business management, business administration, display, retail business and office functions, in Class 35 of the NICE Classification of Goods and Services. Besides sharing an identical identifying verbal element namely, BEAUTY BAY, with the Applicant's trade mark, BEAUTY BAY, the services included under the impugned mark are identical/ overlapping with the services for which the Applicant is known for, worldwide.

#### **COMPARISON OF THE MARKS**

14. We have examined the Impugned Trade Mark  and find that the impugned mark is deceptively similar to the Applicant's BEAUTYBAY trademarks, the letters used being identical. The impugned mark, therefore, cannot qualify for protection as a trademark under any circumstances as members of the trade and public would invariably associate the same with the Applicant. Thus the impugned mark is incapable of distinguishing the Respondent No.1's goods from those of the Applicant.

#### **INTENTION OF THE RESPONDENT**

15. It is seen that the behavior of the Respondent No-1 is having copied the key phonetic element BEAUTYBAY of the Applicant's mark, in a manner that evokes no contrast, phonetically or visually, evinces that they had deliberately and fraudulently adopted the impugned mark in respect of similar and allied goods and has applied for registration thereof, in order to establish a connection between the impugned marks and the Applicant's goodwill and reputation, and having full prior knowledge about Applicant's exclusive proprietorship over the BEAUTYBAY trademarks and the reputation and goodwill attached to the Applicant's marks. The impugned mark has been used on similar and allied goods in a manner so as to evince malafide on the part of the Respondent No.1.

16. The impugned registration was due for renewal on August 27, 2020 and the registered proprietor has failed to renew the registration in time.

#### **JUDGEMENTS RELIED UPON BY THE APPLICANT**

17. *M/s. Panacea Biotech vs. Neon Laboratories Pvt Ltd [2013] IPAB 148*, (Paragraph 9):  
*On the other hand, the undisputed fact remains that the Respondents have specifically mentioned in the application preferred by them, that they propose to use the trade mark CILLAMIN and till date, the Respondents are not using the said trade mark even as per the submission made by the Ld. Counsel for the*

*Respondents. Such being the position, the trade mark registered is liable to be removed on the ground of non-use as per the provision under Section 47 of the Trade Marks Act, 1999.*

In such matter the registered trade mark in question was not in use and further the Petitioners were prior users of the mark, as is also the case in the present proceeding.

18. ***Harry's Holdings Ltd. vs. Subhash Goel and Ors. 2018(76)PTC 625(IPAB)*** (paragraphs 17-20):

*"... 17. In the case of **Milmet Oftho Industries v. Allergen Inc. (Supreme Court 2004)**, the Supreme Court based its decision on the Cadila and Whirlpool judgment and was of the opinion that the ultimate test for passing off is who is first in the market. Here the applicants were an Indian company, which had applied for registration for their mark (1993). The respondents had filed a suit for passing off on the basis of their prior use (1992) of the mark OCUFLOX. They had attained registration in other countries.*

*18. In the present case, the marks were the same, and the mere fact that the respondents have not been using the mark in India would be irrelevant if they were first in the world market. On the basis of the material showing prima facie the respondents advertised before the appellants entered the field, was enough. The Hon'ble Court held that "It must also be remembered that nowadays goods are widely advertised in newspapers, periodicals, magazines and other media which is available in the country. This results in a product acquiring a worldwide reputation. Thus, if a mark in respect of a drug is associated with the Respondents worldwide it would lead to an anomalous situation if an identical mark in respect of a similar drug is allowed to be sold in India.*

*Further the Hon'ble Court held, that "Thus the ultimate test should be who is first in the market. In the present case, the marks are the same. They are in respect of pharmaceutical products. The mere fact that the Respondents have not been using the mark in India would be irrelevant if they were first in the world market. The Division Bench had relied upon material which prima-facie shows that the Respondents product was advertised before the Appellants entered the field. On the basis of that material the Division Bench has concluded that the Respondents were first to adopt the mark. If that be so then no fault can be found with the conclusion drawn by the Division Bench.*

*19. The Applicant in the present case has extensively advertised and done extensive media coverage through the international press and medial for their earlier trademark HARRY'S. This can be further evidenced by their website being [www.harrys.com.sg](http://www.harrys.com.sg). This website is dedicated to the HARRY'S brand and provides information on its services which is can be accessed from anywhere in the world including India.*

*20. The impugned mark was applied on a 'proposed to be used basis on May 6, 2005 and the Respondents has till date not taken any steps whatsoever to use the impugned mark, but simply registered the same with mala fide intentions to block the Register. The Respondents have obtained the registration of the impugned mark for the goods and service which are identical and/or deceptively similar to the goods and service of the Applicant's earlier trademark, which would lead to confusion and deception in the minds of the purchasing public.*

19. **Neon Laboratories vs Medical Technologies Ltd and ors. [(2016) 2 SCC 672]** wherein it has been held (paragraphs 8-9):

8. Section 47 of the Act is in the same vein and statutory strain inasmuch as it postulates the possibility of a registered mark being taken off the register on an application being made by any aggrieved person, inter alia, on the ground that for a continuous period of five years and three months from the date on which the trademark was registered, there was no bona fide use thereof. In the case in hand, prima facie, it appears that for over five years after a registration application was made by the Defendant-Appellant, the mark was not used. Facially, the Act does not permit the boarding of or appropriation without utilization of a trademark; nay the Defendant-Appellant has allowed or acquiesced in the user of the Plaintiff-Respondents for several years. The legislative intent behind this Section was to ordain that an applicant of a trademark does not have a permanent right by virtue of its application alone. Such a right is lost if it is not exercised within a reasonable time.

9. We must hasten to clarify that had the Defendant-Appellant commenced user of its trademark ROFOL prior to or even simultaneous with or even shortly after the Plaintiff- Respondents' marketing of their products under the trademark PROFOL, on the Defendant-Appellant being accorded registration in respect of ROFOL which registration would retrospectively have efficacy from 19.10.1992, the situation would have been unassailably favourable to it. What has actually transpired is that after applying for registration of its trademark ROFOL in 1992, the Defendant-Appellant took no steps whatsoever in placing its product in the market till 2004. It also was legally lethargic in not seeking a curial restraint against the Plaintiff-Respondents. This reluctance to protect its mark could well be interpreted as an indication that the Defendant-Appellant had abandoned its mark at some point during the twelve-year interregnum between its application and the commencement of its user, and that in 2004 it sought to exercise its rights afresh. It would not be unfair or fanciful to favour the view that the Defendant-Appellant's delayed user was to exploit the niche already created and built up by the Plaintiff-Respondents for themselves in the market. The 'first in the market' test has always enjoyed pre-eminence. We shall not burden this judgment by referring to the several precedents that can be found apposite to the subject. In the interest of prolixity we may mention only N.R. Dongre v. Whirlpool Corporation and Milmet Oftbo Industries v. Allergan Inc. In Whirlpool, the worldwide prior user was given preference any predominance over the registered trademark in India of the Defendant. In Milmet, the marks of pharmaceutical preparation were similar but the prior user worldwide had not registered its mark in India whereas its adversary had done so. This Court approved the grant of an injunction in favour of the prior user. Additionally, in the recent decision in S. Syed Mobiden v. P. Sulochana Bai this Court has pitbily underscored that the rights in a passing-off action emanate from common law and not from statutory provisions, nevertheless the prior user's rights will override those of a subsequent user even though it had been accorded registration of its trademark. Learned Counsel for the Defendant-Appellant has endeavoured to minimise the relevance of Whirlpool as well as Milmet by drawing the distinction that those trademarks had attained worldwide reputation. However, we think that as world shrinks almost to global village, the relevance of the transnational nature of a trademark will progressively diminish into insignificance. In other words, the attainment of valuable goodwill will have ever increasing importance. At the present stage, the argument in favour of the Defendant- Appellant that we find holds more water is that in both Milmet and Whirlpool, as distinct from the case before us, the prior user of the successful party predated the date of application for registration of the competing party.....

## FINDINGS

20. We find that the impugned mark is deceptively similar to the Applicant's prior used and registered BEAUTYBAY trademark and the same is devoid of any distinctive character and is not capable of distinguishing the goods of the Respondent No.1. The Applicant is the prior adopter and prior user of the trademark BEAUTYBAY.

21. As was observed by **Parker, J., in *Re Pianotist Co.'s Application*, (1906) 23 RPC 774**, and further expanded on in a plethora of subsequent cases including ***Roche & Co. v. Manners & Co. (P) Ltd.*, AIR 1970 SC 2062**, ***Parle Products v. J P & Co.* AIR 1972 SC 1359**, and ***Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.* [2001 CLC 564** the Apex Court has observed that it must be seen whether there was an overall similarity between the two names in respect of the same description of goods, both visually as well as phonetically. In the present case, both marks are the same phonetically and visually. In this regard, the reliance is placed on ***Ruston and Hornsby Ltd. Vs. Zamindara Engineering Co.*, 1970 AIR(SC) 1649**, wherein the Defendant was using the mark 'RUSTAM INDIA' and the Hon'ble Supreme Court of India observed that- "8..... If the respondent's trade mark is deceptively similar to that of the appellant the fact that the word 'INDIA' is added to the respondent's trade mark is of no consequence and the appellant is entitled to succeed in its action for infringement of its trade mark." This was also relied on in ***Greaves Cotton Limited V. Mohammad Rafi &ors*, 2011 (46) PTC 466 (Del.)**

22. Respondent No.1 has never used nor has had any bona fide intention to use the impugned mark. The impugned mark was granted registration on October 18, 2011 and therefore more than 7 years have passed since the impugned mark was actually granted registration. The Applicant owns common law rights in connection with the trade mark Beauty Bay and therefore is entitled to a registration. Further the Applicant is the bona fide prior adopter of the trade mark BEAUTY BAY which was adopted by the Applicant as far back as in the year 2002. It is a matter of record that Applicant has been the registered proprietor of the trade mark BEAUTY BAY in the United Kingdom since the year 2006, which, is well prior to the application/ adoption of the impugned mark by the Respondent No.1. The trade mark BEAUTY BAY has even been used in India prior to the application of the impugned registration.

23. The impugned mark was filed by the Respondent No.1 only in the year 2010, on a *proposed to be used* basis, evidently with full knowledge of the existence of the trade mark BEAUTY BAY in the name



of the Applicant. It is obvious that the Respondent No.1 obtained the impugned registration by misdirecting and misleading the Respondent No.2, as to the ownership of the trade mark BEAUTY BAY. The impugned mark, in view of the Applicant's rights as aforesaid, is of such nature as to be capable of deceiving/causing confusion among the public and members of the trade/ public, and is therefore in contravention of Section 9 (2) of the Act. The impugned mark is also violative of Section 11 of the Act

The Respondents have failed to file any counter statement in the present proceedings, therefore the malafide of the Respondent No.1 is evident. The Hon'ble Supreme Court in ***Mahendra & Mahendra Paper Mills Ltd. v. Mahindra & Mahindra***, [2002 2 SCC 147] laid out certain guidelines on deceptive similarity resulting in infringement by capitalizing on the goodwill and reputation of the original trader. This was relied on in a plethora of decisions including ***Standard Electricals Limited vs Rocket Electricals And Anr. 2004 (28) PTC 26 Del.***

24. We note that the goods covered under the impugned marks are similar to the Applicant's goods covered under various registrations. Hence, any use of the impugned mark in respect of the abovementioned goods in CLASS 35 tends to mislead the public to believe that the Respondent No. 1's business and goods are that of the Applicant. Such user by the Respondent No. 1 will also dilute and debase the goodwill and reputation of the Applicant in its BEAUTYBAY mark.

25. Given the long and extensive use and promotional initiatives undertaken by the Applicant worldwide, it is incomprehensible that the Respondent No.1 was unaware of the prior use, registrations, goodwill and reputation of the Applicant's BEAUTYBAY trademarks. Thus the adoption of the impugned mark by the Respondent No.1 for conflicting goods is dishonest, fraudulent and solely motivated to encash upon the goodwill attached to the above trademarks of the Applicant. Considering that the use of the impugned mark, if any, was illegitimate, there is no acquired distinctiveness which has accrued in favour of the respondent No.1 and hence, no protection is available to the said registration under the provision of Section 32 of the Act. The impugned registered trade mark is therefore, liable to be cancelled under the provisions of Section 11 & 18 of the Act. It also offends under Section 57 of the Act. The existence of the identical/nearly identical impugned registration which was wrongly granted is prejudicial to the Applicant's interests.

26. In view of facts and material placed on record, it is evident that the registration of the impugned trade mark has been wrongly granted by the Respondent No. 2 and should be removed from the register as it is in breach of provisions of 9(1)(a), 9(2)(a), 11(1), 11(2), 11(3), 11(10), 12, 18(1) and 32 of the Trade Marks Act and therefore is liable to be removed and cancelled from the Register under Section 47 and 57 (2) of the Trade Marks Act, 1999.

27. In the light of above the Petition is allowed and Respondent No.2 is directed to delete the entry of registered Trade mark No. 2015388 for the mark “**beautybay**” in Class 35 in the name of Respondent No.1 from the Register under the provisions of Section 47(1)(a) and (b) and Section 57 of the Trade Marks Act, 1999. Copy of order be sent to the parties as well as Respondent No.2 who is directed to remove the said mark from the Register forthwith

28. No costs.

- Sd/-

-Sd/-

-Sd/-

(Ms. Lakshmidevi Somanath)  
Technical Member (Trademarks)

(Shri. Makyam Vijay Kumar)  
Technical Member (Trademarks)

(Shri Justice Manmohan Singh)  
Chairman

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