



Favorable order granted against the use of the mark 'CUSTARD'

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In *Lotte Confectionary Co. Ltd., v. Orion Corporation*, the mark in question was CUSTARD in class 30 against which we had filed a rectification petition under No. ORA/317/2013/TM/DEL. The impugned goods were "chocolates, biscuits, cookies, crackers, wafers, confectionery, corn chips, bread pastries, cakes, pies, puddings, sherbets, ice creams, candy, caramels, chewing gum (not for medical purpose)." We filed a rectification petition against this mark on the ground of it being descriptive in nature and not capable of distinguishing the Registrant's goods from those of third parties. We argued the matter and made the following submissions:

1. The mark is descriptive in nature of the goods in class 30
2. It is not capable of distinctiveness and providing any identity to its origin solely with the opposite party
3. A similar opinion was taken by courts of other jurisdictions against the same parties wherein the term CUSTARD was disclaimed
4. There is a presence of various third party CUSTARD formative marks in the Register of Trade Marks in India
5. The presence of CUSTARD *per se* in the Register of Trade Marks would not only harm us but also other third parties who are genuinely using the mark along with other formative variants
6. We also denied use of the mark CUSTARD *per se* by the opposite party and submitted that even otherwise, the mark being descriptive for the goods in the class cannot be registered as a trademark.

After hearing our submissions, the Hon'ble Board has passed the order considering the mark "CUSTARD" as being incapable of acquiring a distinctive character and being wrongfully registered in the name of the opposite party. The impugned registration under no. 1444980 in class 30 was held to be contrary to the provision of Sections 2(a), 9(1)(b) 9(1)(c) and section 18 of the Trade Marks Act, 1999.

