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Filing date: **01/01/2024**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding no.	92083349
Party	Plaintiff FM WORLD SPOLKA Z OGRANICZONA ODPOWIEDZIALNOSCIA
Correspondence address	JAN TAMULEWICZ MYERS WOLIN, LLC 100 S. JEFFERSON ROAD, SUITE 202 WHIPPANY, NJ 07981-1009 UNITED STATES Primary email: jan.tamulewicz@myerswolin.com Secondary email(s): jan.tamulewicz@myerswolin.com, michael.sarney@myerswolin.com, tm@myerswolin.com 973-828-1284
Submission	Motion to Amend Pleading/Amended Pleading
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Signature	/Jan Tamulewicz/
Date	01/01/2024
Attachments	FMWO 14214 Amended Petition for Cancellation against YUTIKA.pdf(165515 bytes) YUTIKA EXHIBIT A.pdf(1708237 bytes) UTIQUE - AUSTRALIA - Opposition filed by YUTIKA.pdf(653524 bytes) UTIQUE - MALEZJA - OBSERVATION.pdf(2536526 bytes) Cambodia - petition for cancellation of UTIQUE.pdf(373860 bytes) UTIQUE - MALEZJA - OPPOSITION.pdf(962950 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Registration No. 7,026,718
Mark: YUTIKA
Registered: April 13, 2023

FM World Spolka z Ograniczona)	
Odpowiedzialnoscia,)	
)	
Petitioner,)	
)	Cancellation No. 92083349
– v –)	
)	U.S. Reg. No. 7,026,718
Jetharam Nemaram Gehlot)	
)	
Registrant.)	

AMENDED PETITION FOR CANCELLATION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

Commissioner:

FM World Spolka z Ograniczona Odpowiedzialnoscia, (“Petitioner”) a Polish corporation having its principal place of business at ul. Zmigrodzka 247, 51-129 Wroclaw, Poland, has been damaged, and will continue to be damaged by U.S. Trademark Registration No. 7,026,718 (“the ‘718 Registration”).

The ‘718 Registration was filed as U.S. Application No. 90/611,975 (“the ‘975 Application”) on March 30, 2021, under Section 1(b), by Jetharam Nemaram Gehlot

(“Registrant”) to register the mark YUTIKA (“Registrant’s Mark”) in connection with henna for cosmetic purposes; hair color; hair dye; mehndi preparations in the nature of henna for cosmetic purposes; hair bleach; cosmetics; laundry bleach; decalcifying and descaling preparations for cleaning household products; polishing preparations, namely, shoe polishing preparations, polishing wax, polishing cream; depilatory preparations, namely, hair removing cream, hair removing spray, body hair removing wax, body hair removing wax strips; scouring solutions; abrasives, namely, skin abrasive preparations; perfumery; essential oils; skincare preparations, namely, skin soap, body wash, face wash, facial moisturizer, non-mediated skin toner, cleansing milk, body lotion, cold cream, moisturizing cream, nourishing facial cream, facial cream, facial emulsions, beauty mask, anti-aging cream, fairness being skin lightening cream, anti dark skincare preparations being skin lighteners, sunscreen lotion, face powder; cosmetic creams; body lotions; cosmetic soaps; shampoos; hair oils; hair lotions; hair gels; bath oils other than for medical use; deodorants and antiperspirant for personal use; teeth cleaning products, namely, toothpaste, tooth powder, non-medicated mouthwash; mehndi and mehndi cone preparations in the nature of henna for cosmetic purposes; hand cleaning preparation, namely, hand wash being non-mediated hand soaps and hand cream; face cleaning preparation in the nature of facial cleansers; non-mediated hair treatment preparations for cosmetic purposes and hair conditioner; ammonia based hair color (“Registrant’s Goods”).

Because Petitioner believes it will be damaged by the continued registration of Registrant’s Mark Petitioner hereby requests cancellation of same.

The grounds for this cancellation are as follows:

1. Registrant is, to the best of Petitioner's knowledge, Jetharam Nemaram Gehlot an Indian individual residing at Saraswati nagar, Hirawadi Road 101, Shree White Heights Apartment, Nashik City, India. Registrant is the record owner of the '718 Registration.

2. Petitioner is the owner of the mark U.S. Registration No. 6932974 for the mark

UTIQUE



, filed September 28, 2020, with respect to "Aromatic oils; Lotions for cosmetic purposes; Non-medicated balms for use on skin; Cosmetics; Cosmetics for personal use; Skincare cosmetics; Cosmetic creams for skin care; Cosmetic creams; Non-medicated soaps; Perfumed soaps; Antiperspirant soap; Toilet soap; Cosmetic soaps; Non-medicated soaps and bath gels; Liquid bath soaps; Non-medicated soaps for body care; Conditioning preparations for the hair; Oils for hair conditioning; Oils for cosmetic purposes; Essential oils; Essential oils for personal use; Cosmetic preparations for bath and shower; Perfumed lotions for cosmetic and purposes; Non-medicated cosmetics and toiletry preparations; Perfumed body lotions; Perfumery; Perfumery, essential oils and Candles for lighting; Perfumed candles" ("Petitioner's Registration"). Petitioner's Registration was issued on December 27, 2022. Petitioner has used

UTIQUE



its mark in commerce in the United States in connection with "Cosmetics; Cosmetics for personal use; Skincare cosmetics; Cosmetic creams for skin care; Cosmetic

creams; Non-medicated soaps; Perfumed soaps; Antiperspirant soap; Toilet soap; Cosmetic soaps; Non-medicated soaps and bath gels; Liquid bath soaps; Non-medicated soaps for body care; Conditioning preparations for the hair; Oils for hair conditioning; Oils for cosmetic purposes; Essential oils; Essential oils for personal use; Cosmetic preparations for bath and shower; Perfumed lotions for cosmetic and purposes; Non-medicated cosmetics and toiletry preparations; Perfumed body lotions; Perfumery; Perfumery, essential oils and Candles for lighting; Perfumed candles, since at least 2016, and well prior to Registrant's filing date and claimed date of first use of March 30, 2021.

Count I: Fraud

A. Fraudulent Allegation Of Use In Commerce

3. In the Statement of Use filed by Registrant on February 10, 2023, Registrant stated that "[t]he mark is in use in commerce on or in connection with all of the goods/services," and that "the mark was first used in commerce at least as early as 12/23/2021." Such statements were material to the issue of the registration of the subject mark.

4. Upon information and belief, including upon Petitioner's review of Registrant's website and Registrant's product offerings on amazon.com, on or about the time that the Statement of Use for the '975 Application was filed, the aforesaid statements were false because Registrant had not used the mark YUTIKA in commerce in connection with all of the goods listed in the Statement of Use, either as of the date that Registrant filed the Statement of Use or prior to the expiration of the deadline for Registrant to file a Statement of Use. More specifically, at the time that Petitioner reviewed Registrant's website and its product listings on

amazon.com, the mark was not being used thereon in connection with the following goods listed in the Statement of Use filed by Registrant: laundry bleach; decalcifying and descaling preparations for cleaning household products; polishing preparations, namely, shoe polishing preparations, polishing wax, polishing cream; depilatory preparations, namely, hair removing cream, hair removing spray, body hair removing wax, body hair removing wax strips; scouring solutions; abrasives, namely, skin abrasive preparations; perfumery; non-mediated skin toner, cleansing milk; beauty mask; anti dark skincare preparations being skin lighteners; face powder; shampoos; deodorants and antiperspirant for personal use; teeth cleaning products, namely, toothpaste, tooth powder, and non-medicated mouthwash.

5. Upon information and belief, Registrant was aware of and knew the contents of his website and his product offerings on amazon.com at the time that he filed the Statement of Use and therefore knew that the aforesaid statements contained therein were false.

6. Upon information and belief, Registrant knowingly made the aforesaid false and material statements with the intent to deceive the USPTO and thereby procure a trademark registration that was greater in scope than that to which he was entitled.

B. Fraudulent Statement As To The Meaning Of YUTIKA

7. On information and belief, in a telephone communication with the examining attorney on or about November 16, 2021, Registrant stated that the word YUTIKA has no meaning in a foreign language, which statement was subsequently entered in the application by an Examiner's Amendment.

8. On information and belief, the word YUTIKA means “flower” in Hindu. See, e.g., Exhibit A hereto.

9. In fact, in his initial application, Registrant stated that the word YUTIKA means “flower” in Hindu.

10. Upon information and belief, at both the time that Registrant filed the subject application, and at the time of his aforesaid telephone communication with the examining attorney, Registrant knew that the word YUTIKA means “flower” in Hindu. Upon information and belief, Registrant therefore knew that his statement to the examining attorney that the word YUTIKA had no meaning in a foreign language was false. Such statement was material to the examination of Registrant’s trademark application, at least because such statement was relevant to whether or not the subject application may have conflicted with a prior registered mark and thereby been refused under Section 2(d) of the Trademark Act.

11. Upon information and belief, Registrant’s material and false statement that the word YUTIKA has no meaning in a foreign language was made with an intent to deceive the examining attorney and the USPTO, and thereby obtain a trademark registration to which he may not have been entitled.

12. The ‘718 Registration should therefore be cancelled on the grounds that the Registrant made material false statements during prosecution of the ‘975 application.

Count II: The 718 Registration is Invalid for Failure to Use the Mark in Commerce

13. Petitioner repeats and realleges paragraphs 1 through 12 above.

14. The '975 Application was approved for registration solely on Registrant's alleged actual use of Registrant's Mark in commerce. Upon information and belief, Registrant had not made such use in connection with all of the goods set forth in the Statement of Use at the time it was filed. The '718 Registration should therefore be found invalid, at least with respect to those goods in connection with which the mark was not used prior to the applicable deadline for filing a Statement of Use.

Count III: Likelihood Of Confusion

15. Petitioner repeats and realleges paragraphs 1 through 14 above.

16. Registrant's Mark YUTIKA is confusingly similar to Petitioner's Mark UTIQUE in appearance and sound.

17. Registrant's Mark in "718 Registration so resembles Petitioner's Mark, in which Petitioner has prior and superior rights, as to be likely, when applied to Registrant's Goods, to cause confusion, to cause mistake, or to deceive, by creating the erroneous impression that Registrant's Goods originate from or are associated with Petitioner, or that Registrant's Goods are authorized, endorsed, or sponsored by Petitioner.

18. The '718 Registration is without license, authorization or permission from Petitioner.

19. Registrant has filed an Opposition in Australia against Petitioner's International Registration No. 1618202 for the mark UTIQUE designating Australia. Registrant in his Opposition alleged a likelihood of confusion between Registrant's Mark and Petitioner's Mark. See Exhibit B hereto. Registrant has therefore admitted that there is a likelihood of confusion between the marks.

20. Registrant has also filed an Opposition in Malaysia against Petitioner's International Registration No. 1618202 for the mark UTIQUE designating Malaysia. Registrant in his Opposition alleged a likelihood of confusion between Registrant's Mark and Petitioner's Mark See Exhibit C hereto. Registrant has therefore admitted that there is a likelihood of confusion between the marks.

21. Registrant has filed a Cancellation action in Cambodia against Petitioner's International Registration No. 1618202 for the mark UTIQUE designating Cambodia. Registrant in his Cancellation alleged a likelihood of confusion between Registrant's Mark and Petitioner's Mark See Exhibit D hereto. Registrant has therefore admitted that there is a likelihood of confusion between the marks.

22. The '718 Registration should be cancelled because it consists of or comprises a mark that, by his own admission, so resembles Petitioner's previously used and registered trademark

UTIQUE



as to be likely, when used in connection with Registrant's goods, to cause confusion, mistake, or deception within the meaning of 15 U.S.C. § 1052(d), and to cause damage to Petitioner thereby.

23. By virtue of the false and material claims made by Registrant regarding the meaning of Registrant's Mark, and his alleged use of Registrant's Mark in United States commerce in

connection with all the goods listed in the Notice of Allowance, the ‘718 Registration was invalidly obtained and should be cancelled.

24. Petitioner is being damaged by the continued registration of the mark YUTIKA and has standing to maintain this Petition for Cancellation.

25. By reason of the foregoing, Registrant’s Mark is subject to cancellation pursuant to 15 U.S.C. § 1052(d) as well as 15 U.S.C. §1064.

WHEREFORE, Petitioner requests that its Amended Petition for Cancellation be granted, and that Registration No. 7,026,718 for the mark YUTIKA be cancelled, and for such other relief as may be deemed just and proper.

January 1, 2024

Respectfully submitted,

MYERS WOLIN, LLC

/s/Jan Tamulewicz

Jan Tamulewicz

Michael Sarney

100 S. Jefferson Road Suite 202

Whippany NJ 07981

Phone: (973) 828-

Fax: (866) 864-3947

Email: tm@myerswolin.com

Attorneys for Petitioner

CERTIFICATE OF SERVICE

The foregoing Amended Petition for Cancellation was served on counsel of record below
on this 1st day of January 2024.

Jeff Goehring
NIXON & VANDERHYE P.C.
901 N. Glebe Road, 11th Floor
Arlington, VA 22203
jgoehring@nixonvan.com

EXHIBIT A

EXHIBIT B

EXHIBIT C

EXHIBIT D

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Baby Name : Yutika

Gender : girl

Origin : Indian, Bengali, Gujarati, Hindi, Hindu, Kannada, Malayalam, Marathi, Oriya, Tamil, Telugu

Yutika Meaning: Flower

Variant: Yutika

Number : 6

Moon Sign (Rashi) : Scorpio (Brischik)

Star (Nakshtra) : Jyeshtha

Name **Yutika** is combinations of , one occurrence of A , one occurrence of I , one occurrence of K , one occurrence of T , one occurrence of U and one occurrence of Y has a lots of significance in Astrology. In Moon sign based Vedic Astrology, person with name **Yutika** are straight forward nature. They like to tell everything to everyone at face. They do not like to entertain hesitation or delay. These people love to do any work in the shortest way possible. They like to keep everything easy and comfortable. However, their lazy nature is the main cause for this. Sleeping is what they enjoy mostly. A charming character is seen in these people. Here also we can find an imaginative mind in these people. Thus, people with this name, can hope to get a fruitful career in literature. A little gossip is like oxygen for these individuals. Otherwise, they can love, and long, and be lusty. Beside literature, these people can bring luck in their professional career with the help of their business strategy. As they have good luck in business matters. Y people have a lot of talent, but they need to



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utilize them properly to be successful. At times being a little selfish is good for these people. But they need to take care that they are not always selfish.

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Name **Yutika** or (Yutika) means Flower.

Person with name **Yutika** are the symbol of ecstasy. Person with this name as prevailing influence upon them, are born with luck. But this lucky charm does not work always for them. Some of factor always remains there to bar their happiness. These natives are largely peace-loving men, who can find their happiness in own way. Because of their jolly nature they are loved by everyone around them. But they cannot rely upon anyone. These people need to recognize the right person among the mass. Sometimes they may be extremely careless about their health. These men are advised to take their food on perfect time. Otherwise they may suffer from malnutrition or other problems related to their stomach or liver. These individuals are mostly concerned with their family members. They share everything with their spouses. No matter how bad things get, they do not hide anything from their life partner. They need to keep a patient mind at this time to resolve the trouble.

The natives with name **Yutika** have a protective nature for their near and dear ones. These people are mainly concerned with the ultimate outcome of any work. They have a confidence of the highest level. These people are responsible person. They can undertake any important duty and carry out with precise perfection. They have a high self-esteem. Those think themselves as very helpful to other people. They also think themselves as superior to others. **Yutika** named people likes independence. They do not rely upon anyone else and have a self-sufficient nature. They detest taking favour from others. However, when it comes to helping others, they are eager always. People of this name enjoy a rank of respect and superiority. They may be childish in their character but portrays a mature nature among people. Impatience is a word well defines these people. They are short tempered. These individuals are ruthless competitor. They would not let anyone outrun them. Sometimes they can be very seriously concerned about life. Sometimes these natives can be seen as spiritual people. Mainly introvert, these people have hidden emotions, repressed in their deeper self. This repression often ends up in sudden outbursts. They are interested in tantra and magical powers.

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Select Gender

Day

Month

Year

Hour

Mins

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Name by Number

Number 1

Number 2

Number 3

Number 4

Number 5

Number 6

Number 7

Number 8

Number 9

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Numerology by Name

First Name

Middle Name

Last Name

Day

Month

Year

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Names by Rashi

Mesh

Vrish

Mithun

Karkat

Simha

Kanya

Tula

Brischik

Dhanu

Makara

Kumbha

Meen

Name by Nakshatra

Ashwini

Bharani

Krittika

Rohini

Mrigashira

Aridra

Punarvasu

Pushya

Ashlesha

Magha

Purva Phalguni

Uttara Phalguni

Hasta

Chitra

Swati



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Name Yutika with the meaning for each letter (Y, U, T, I, K, A)

Y	You are focused to your dreams. You love travelling. You are intelligent. You are self centered.
U	You are good artist. You have short features. You are day dreamers. You are back packers.
T	You are patriotic by heart. You are born leader. You are dedicated. You are good human being. You are foody.
I	You have sharp features. Not so much dedicated towards your studies. You are good home maker. You have expertise at cooking.
K	You are lazy. You are born lovers. You have beautiful features. You are good human being.
A	You are born leader, over thinker, focused and dedicated. You can achieve your success with your hard work and passion.

The persons' name with **Yutika**, they are very cool and calm by nature. They want peace in their life. They are very caring and loving towards their dear and near ones. They are very artistic by heart. They love to spend their time through various types of creative works, like singing, dancing, writing, reading and many more. They love to do gardening as well. They are very much close to their relatives, family persons and even to their friends. They love to know how to balance harmony and sensitivity in their life. They are good representative of a team. They have diplomat quality. They are true preacher. They are born lover. They will have multiple life partners throughout their life. Their sensual and devotion towards their life is very appreciable. They know how to respect and treat people and for this nature they are very much close to their surrounding people. They have helping nature. They are pet lovers as well.

According to Vedic Astrology the persons' name start with **Yutika** are good and polite at heart. They are very sweet talker and they know how to make friends. They will have lots of friends in various age groups. They are very family person and they love to spend their time with their family members, relatives and near and dear ones. They are very much popular among their friends. They love to spend time with their friends as well. They will have beautiful face and attractive physical structure. They love to maintain themselves in terms of beauty and physic. There is a possibility that they may fall in love frequently and easily, but this may harm their emotional phases in multiple times. They are very creative person by nature. They love to do singing, dancing, painting, gardening, writing and many other creative works. They are also focused regarding their career. They love to do works which have challenges and they know how to achieve success in their career. They are very kind hearted. They love to do charity. So they are connected with different types of charitable organizations. They are dog lovers as well.

Vishaka	Anuradha	Jyeshtha	Mula
Purva Ashada	Uttara Ashada	Shravana	
Dhanistha	Satabishaka	Purva Bhadrapada	
Uttara Bhadrapada	Revati		

Boy Name by Alphabet

Boy A	Boy B	Boy C	Boy D	Boy E	Boy F
Boy G	Boy H	Boy I	Boy J	Boy K	Boy L
Boy M	Boy N	Boy O	Boy P	Boy Q	Boy R
Boy S	Boy T	Boy U	Boy V	Boy W	Boy X
Boy Y	Boy Z				

Girl Name by Alphabet

Boy A	Girl A	Girl B	Girl C	Girl D	Girl E
Girl F	Girl G	Girl H	Girl I	Girl J	Girl K
Girl L	Girl M	Girl N	Girl O	Girl P	Girl Q
Girl R	Girl S	Girl T	Girl U	Girl V	Girl W
Girl X	Girl Y	Girl Z			

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12 July 2023



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P.O. Box 18
1211 Geneva 20,
SWITZERLAND

Australian Trade mark number: 2218465
International registration number: 1618202
Your reference: -
Holder name: FM World Sp. z o.o.
Opponent name: Jetharam Nemaram GEHLOT
Dispute: Opposition to extension of protection

Madrid Agreement and Protocol

Notification of provisional refusal of protection based on an opposition

Rule 17(1) to 17(3)

We advise that following receipt of a Notice of Opposition to the above Trade Mark on 8 May 2023, it is necessary to issue this formal refusal letter. This refusal covers all of the goods and/or services of the International Registration (**Rule 17(2)(vi)**). Please find attached a copy of the Notice of Intention to Oppose and the Statement of Grounds and Particulars (**Rule 17(2)(iv)**).

We also attach:

- Copies of the trade mark(s) upon which the opposition is based, (if conflicting trade mark numbers have been provided in the notice of opposition) showing all relevant details (**Rule 17(2)(v)**, **Rule 17(3)**).
- A copy of subdivision C of Division 3 of Part 17A of the *Trade Marks Regulations 1995* (**Rule 17(2)(iv)**).

Subdivision C points to other relevant sections of the *Trade Marks Act 1995* (the Act) and the *Trade Marks Regulations 1995* (the Regulations). Both the Act and the Regulations may be accessed at the following website address:

<http://www.ipaustralia.gov.au/about-us/publications-listing/ip-legislation/>

The following information can also be accessed at:

http://www.ipaustralia.gov.au/pdfs/trademarkmanual/trade_marks_examiners_manual.htm

The Trade Marks Office Manual of Practice and Procedure.

IMPORTANT INFORMATION ABOUT NOTICE OF INTENTION TO DEFEND

The holder has ONE MONTH from the date of this notification to file a notice of intention to defend with IP Australia. The holder must provide an address for service in Australia or New Zealand. IP Australia will give a copy of the notice of intention to defend to the opponent.

If a notice of intention to defend is not filed, the opposition will be taken to be successful and the international registration designating Australia (IRDA) may not be protected in Australia.

The trade marks opposition process can be lengthy. 3 months is nominally allowed for evidence in support of the opposition and 3 months for evidence in answer. 2 months is nominally allowed for evidence in reply. These periods may be extended. The due date for filing evidence in answer to the opposition (unless an extension of time is requested) will be 3 months from the date on which the opponent files its evidence in support.

ADDRESS FOR SERVICE IN AUSTRALIA OR NEW ZEALAND: *important information for the holder of an opposed international registration designating Australia*

If the holder wishes to make written representations or to be heard in relation to the opposition, then the holder must notify the Registrar, in writing, of the holder's address for service in Australia or New Zealand.

Please also note that the Registrar is not required to take any action in response to a notice of intention to defend unless the holder has notified the Registrar, in writing, of the holder's address for service in Australia or New Zealand.

Yours sincerely,

IP Australia



12 July 2023



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SWITZERLAND

Australian Trade mark number: 2218465
International registration number: 1618202
Your reference: -
Holder name: FM World Sp. z o.o.
Opponent name: Jetharam Nemaram GEHLOT
Dispute: Opposition to extension of protection

**Madrid Agreement and Protocol
Information in accordance with Rule 16(1)(b)**

In compliance with Rule 16(1)(b) we now advise that the opposition period to the above trade mark began on 8 March 2023 and ended on 12 July 2023.

Yours sincerely,
IP Australia

Trade mark details:

Trade mark: YUTIKA
Class(es): 3
Status: Registered
Filed on: 16 September 2020
Property type: Word
Entered on register: 27 April 2021
Registered from: 16 September 2020

Owner Details

Owner name: Jetharam Nemaram GEHLOT
Owner address: 101, Shree Whide Heights Apartments
Saraswati Nagar, Near Hirawadi Road
Panchavati
Nashik City Maharashtra 422 003
India

Representative details:

Representative name: Acumen Intellectual Property
Representative address: PO Box 140
NSW 2628
Australia

Goods and services:

Class: 3 Henna; henna powders; hair colours and dyes; detergents; bleaching preparations and other substances for laundry use; cosmetics and toiletries; cleaning preparations; cleaning products; cosmetics; polishing preparations; depilatory preparations; scouring preparations; abrasives; perfumery; essential oils; skin care preparations; creams; lotions; soaps; shampoos; hair oils; hair lotions; hair gels; bath oils other than for medical use; deodorants and antiperspirants for personal use; teeth cleaning products included in class 03

Subdivision C—Opposition to IRDA

17A.29 Definitions

In this Subdivision:

extension of protection means the extension of protection in Australia to the trade mark that is the subject of the IRDA.

notice of intention to defend means a notice filed under regulation 17A.34H.

notice of intention to oppose means a notice filed under regulation 17A.33.

notice of opposition means:

- (a) a notice of intention to oppose; and
- (b) a statement of grounds and particulars.

opponent means a person who files:

- (a) a notice of intention to oppose; and
- (b) a statement of grounds and particulars.

party means an IRDA holder or opponent.

statement of grounds and particulars means a statement by an opponent that sets out:

- (a) the grounds on which the opponent intends to rely; and
- (b) the facts and circumstances forming the basis for the grounds.

Note: The following terms are defined in section 6 of the Act:

- (a) applicant;
- (b) approved form;
- (c) employee;
- (d) file;
- (e) month;
- (f) person.

17A.31 Notification and opportunity to make representations

(1) This regulation applies if:

- (a) a party makes a request to the Registrar under this Subdivision; or
- (b) the Registrar proposes to make a decision on the Registrar's own initiative under this Subdivision.

(2) The Registrar must:

- (a) for paragraph (1)(a)—notify the other party of the request, including by giving the other party a copy of the request; or
- (b) for paragraph (1)(b)—notify the parties of the proposed decision.

(3) If the Registrar proposes to grant the request, the Registrar must give the parties an opportunity to make representations:

- (a) in writing; or
- (b) at a hearing; or

(c) by other means that the Registrar states in the notification.

(4) The Registrar must notify the parties of the Registrar's decision.

17A.32 Filing of notice of opposition

(1) A notice of opposition is taken to be filed when the notice of intention to oppose and the statement of grounds and particulars have been filed under regulations 17A.33 and 17A.34A.

(2) The Registrar must notify the International Bureau of the filing of the notice of opposition in accordance with rule 17, as applicable, of the Common Regulations.

17A.33 Filing of notice of intention to oppose

(1) If the Registrar advertises the acceptance of an IRDA in the *Official Journal*, a person may oppose the extension of protection by filing a notice of intention to oppose within 2 months from the advertisement of the acceptance.

(2) The notice must be in an approved form.

(3) The Registrar must give a copy of the notice to the holder of the IRDA.

17A.34 Grounds for opposing IRDA

(1) The extension of protection may be opposed on any of the grounds on which an IRDA may be rejected under Subdivision 2, except the ground that the trade mark cannot be represented graphically.

(2) The extension of protection may also be opposed on any of the grounds set out in sections 58 to 61 and 62A of the Act, as affected by subregulation (3).

(3) Sections 58 to 61 and 62A of the Act apply in relation to an IRDA as if:

(a) a reference in those sections:

(i) to an application for the registration of a trade mark were a reference to the IRDA; and

(ii) to an applicant were a reference to the holder of the IRDA; and

(iii) to the registration of a trade mark were a reference to the extension of protection in Australia to the trade mark that is the subject of the IRDA; and

(b) the reference in paragraph 60(a) of the Act to the priority date for the registration of the trade mark were a reference to the priority date for the trade mark that is the subject of the IRDA.

(4) The extension of protection may also be opposed on the grounds that:

(a) a document filed in support of the IRDA was amended contrary to the Act; or

(b) the Registrar accepted the IRDA on the basis of evidence provided, or a representation made, by the holder that was false in a material particular.

Note: Section 66 of the Act provides for the amendment of documents filed with the Registrar.

17A.34A Filing of statement of grounds and particulars

(1) A statement of grounds and particulars must be filed within one month from the day the notice of intention to oppose is filed.

(2) The statement must be in an approved form.

17A.34B Statement of grounds and particulars must be adequate

(1) The Registrar must assess the adequacy of a statement of grounds and particulars.

(2) If the Registrar decides that the statement is adequate, the Registrar must give a copy of the statement to the holder of the IRDA.

(3) If the Registrar decides that the statement is inadequate:

- (a) the Registrar may direct the opponent to rectify the inadequacy by filing more information on the basis for one or more of the grounds; or
 - (b) if all the grounds are inadequately particularised, the Registrar may dismiss the opposition; or
 - (c) if only some of the grounds are inadequately particularised, the Registrar may:
 - (i) delete from the statement some or all of the material that is inadequate; and
 - (ii) treat the result as the statement for the purposes of these Regulations; and
 - (iii) give a copy of the amended statement to the opponent.
- (4) If the Registrar decides that the statement is still inadequate after the information is filed under paragraph (3)(a):
- (a) the Registrar may dismiss the opposition; or
 - (b) the Registrar may:
 - (i) delete from the statement some or all of the material that is inadequate; and
 - (ii) treat the result as the statement for the purposes of these Regulations; and
 - (iii) give a copy of the amended statement to the opponent.
- (5) If the Registrar decides that the information filed under paragraph (3)(a) rectifies the inadequacy of the statement, the Registrar must give a copy of the statement and the information filed in relation to paragraph (3)(a) to the holder of the IRDA.
- (6) The opponent may apply to the Administrative Appeals Tribunal for review of a decision under this regulation to dismiss the opposition or delete material from the statement of grounds and particulars.
- (7) Regulation 17A.31 does not apply to this regulation.

17A.34C Extension of time for filing—application

- (1) A person who intends to oppose the extension of protection may request the Registrar to extend:
- (a) the period for filing a notice of intention to oppose under subregulation 17A.33(1); or
 - (b) the period for filing a statement of grounds and particulars under subregulation 17A.34A(1).
- (2) A request under paragraph (1)(a) or (b) may be made:
- (a) within the period for filing the document in question; or
 - (b) before the extension of protection of the IRDA is entered on the Record of International Registrations under paragraph 17A.37(1)(b).

Note: See subparagraph (3)(b)(ii) and subregulation 17A.34D(2) in relation to the consequences of making the request after the filing period has ended.

- (3) The request must:
- (a) be in an approved form; and
 - (b) be accompanied by a declaration stating:
 - (i) the facts and circumstances forming the basis for the grounds; and
 - (ii) if the period for filing the notice or the statement of grounds and particulars has ended—the reason why the request was not made within the period.

Note: Regulations 21.6 and 21.7 deal with making and filing declarations.

- (4) The request must be made only on either or both of the following grounds:
- (a) an error or omission by the person, the person's agent, the Registrar or an employee;
 - (b) circumstances beyond the control of the person, other than an error or omission by the person, the person's agent, the Registrar or an employee.

- (5) Subsection 52(5) of the Act applies to the request.
- (6) Regulation 17A.31 does not apply to this regulation.

17A.34D Extension of time for filing—grant

- (1) The Registrar may grant a request under subregulation 17A.34C(1) for an extension of time if the Registrar is satisfied that the grounds set out in the request justify the extension.
- (2) However, if the request is made after the period for filing the notice or statement of grounds and particulars has ended, the Registrar must not grant the extension unless the Registrar is satisfied that there is sufficient reason for the delay in making the request.
- (3) The Registrar must decide the length of the extended period having regard to what is reasonable in the circumstances.

17A.34E Opposition may proceed in name of other person

Section 53 of the Act applies to a notice of intention to oppose filed under this Subdivision.

17A.34F Amendment of notice of intention to oppose

- (1) An opponent may request the Registrar to amend a notice of intention to oppose to correct a clerical error or obvious mistake.
- (2) If an opposition proceeds in the name of another person under section 53 of the Act, the person may request the Registrar to amend the notice of intention to oppose to record the person's name.
- (3) The Registrar may grant a request under subregulation (1) or (2) on terms that the Registrar considers appropriate.
- (4) If the Registrar grants the request, the Registrar must give a copy of the notice of the amended intention to oppose to the IRDA holder.
- (5) Regulation 17A.31 does not apply to this regulation.

17A.34G Amendment of statement of grounds and particulars

- (1) An opponent may request the Registrar to amend the statement of grounds and particulars to:
 - (a) correct an error or omission in the grounds of opposition or the facts and circumstances forming the basis for the grounds; or
 - (b) amend a ground of opposition; or
 - (c) add a new ground of opposition; or
 - (d) to amend the facts and circumstances forming the basis for the grounds.
- (2) The Registrar may grant the request on terms that the Registrar considers appropriate.
- (3) However, the Registrar may grant a request to:
 - (a) amend a ground of opposition; or
 - (b) add a new ground of opposition;

only if the Registrar is satisfied that the amendment or addition relates to information of which the opponent could not reasonably have been aware at the time of filing the statement.

- (4) If the Registrar grants the request, the Registrar must give a copy of the amended statement to the IRDA holder.

17A.34H Filing of notice of intention to defend

- (1) The IRDA holder must file a notice of intention to defend within one month from the day the Registrar notifies the International Bureau under subregulation 17A.32(2).
- (2) The holder must file an Australian or New Zealand address for service with the notice.
- (3) The Registrar must give a copy of the notice to the opponent.

(4) If the holder does not file the notice within the period mentioned in subregulation (1), the Registrar may decide to:

- (a) take the opposition to have succeeded; and
- (b) refuse protection to the holder.

(5) The Registrar is not required to take any action in response to a notice of intention to defend filed under subregulation (1) unless the holder has notified the Registrar, in writing, of the holder's address for service in Australia or New Zealand.

(6) A requirement to:

- (a) give a document to a person; or
- (b) give a person an opportunity to make written representations or to be heard;

does not apply if no address for service of the person is recorded in the Record of International Registrations.

(7) The Registrar must notify the parties of the Registrar's decision.

17A.34HA Extension of time for filing—application

(1) A person may apply to the Registrar to extend the period for filing a notice of intention to defend.

(2) The application must be made before the end of the period of 2 months beginning on the day after the end of the period mentioned in subregulation 17A.34H(1).

(3) The application must:

- (a) be in the approved form; and
- (b) be accompanied by a declaration stating the facts and circumstances forming the basis for the grounds for making the application.

Note: Regulations 21.6 and 21.7 deal with making and filing declarations.

(4) The application may be made only on either or both of the following grounds:

- (a) an error or omission by the person, the person's agent, the Registrar or an employee;
- (b) circumstances beyond the control of the person, other than an error or omission by the person, the person's agent, the Registrar or an employee.

17A.34HB Extension of time for filing—grant

(1) The Registrar may grant an application under subregulation 17A.34HA(1) for an extension of time only if the Registrar is satisfied that the grounds set out in the application justify the extension.

(2) However, if the application is made after the period mentioned in subregulation 17A.34H(1) has ended, the Registrar must not grant the extension unless the Registrar is satisfied that there is sufficient reason for the delay in making the application.

(3) The Registrar must decide the length of the extended period having regard to what is reasonable in the circumstances.

17A.34J Filing of evidence

(1) The Registrar must notify the parties that:

- (a) all the evidence for an evidentiary period mentioned in this regulation has been filed; or
- (b) no evidence was filed for the period.

(2) The Registrar must give a copy of any evidence filed by a party under this regulation to the other party:

- (a) before the end of the relevant evidentiary period, if the Registrar considers it appropriate to do so; or
- (b) after the evidentiary period ends.

Evidence in support

(3) An opponent must file any evidence in support of the opposition within 3 months from the day the opponent is given a copy of the notice of intention to defend.

Evidence in answer

(4) If the opponent files evidence in support of the opposition, the IRDA holder must file any evidence in answer to the evidence in support within 3 months from the day the Registrar:

- (a) gives the IRDA holder:
 - (i) all the evidence in support; or
 - (ii) if the opponent files the evidence in support in instalments—the final instalment of the evidence in support; and
- (b) notifies the IRDA holder that all the evidence in support has been filed.

(5) If the opponent does not file any evidence in support of the opposition, the IRDA holder must file any evidence in answer to the statement of grounds and particulars within 3 months from the day the Registrar notifies the IRDA holder that no evidence in support was filed.

Evidence in reply

(6) If the IRDA holder files evidence in answer under subregulation (4) or (5), the opponent must file any evidence in reply to the evidence in answer within 2 months from the day the Registrar:

- (a) gives the opponent:
 - (i) all the evidence in answer; or
 - (ii) if the IRDA holder files the evidence in answer in instalments—the final instalment of the evidence in answer; and
- (b) notifies the opponent that all the evidence in answer has been filed.

17A.34K Extension of time for filing

(1) A party may request the Registrar to extend a period for filing evidence mentioned in regulation 17A.34J.

(2) The Registrar may extend the period only if the Registrar is satisfied that:

- (a) the party:
 - (i) has made all reasonable efforts to comply with all relevant filing requirements of this Subdivision; and
 - (ii) despite acting promptly and diligently at all times to ensure the filing of the evidence within the period, is unable to do so; or
- (b) there are exceptional circumstances that justify the extension.

(3) The Registrar:

- (a) must decide the length of the extended period having regard to what is reasonable in the circumstances; and
- (b) may do so on terms that the Registrar considers appropriate.

(4) In this regulation:

exceptional circumstances includes the following:

- (a) a circumstance beyond the control of a party that prevents the party from complying with a filing requirement under this Subdivision;
- (b) an error or omission by the Registrar or an employee that prevents a party from complying with a filing requirement under this Subdivision;
- (c) an order of a court or a direction by the Registrar that the opposition be stayed.

17A.34L Registrar may allow cooling-off period

- (1) This regulation applies to an opposition if:
 - (a) the notice of opposition has been filed; and
 - (b) the Registrar has not made a decision on the opposition under regulation 17A.34N; and
 - (c) the opposition has not been dismissed under regulation 17A.34B.
- (2) If the Registrar is satisfied that the parties agree to a cooling-off period, the Registrar must allow a cooling-off period of 6 months.
- (3) The Registrar must extend the cooling-off period for 6 months if, before the end of the period, the Registrar is satisfied that the parties agree to the extension.
- (4) The Registrar must not:
 - (a) further extend the cooling-off period; or
 - (b) allow more than one cooling-off period for an opposition.
- (5) If a party files a notice in an approved form requesting the Registrar to discontinue the cooling-off period, the Registrar must do so.
- (6) The Registrar may direct the parties on steps they must take:
 - (a) if the cooling-off period is discontinued; or
 - (b) otherwise—when the cooling-off period ends.
- (7) The opposition resumes:
 - (a) if the cooling-off period is discontinued; or
 - (b) otherwise—when the cooling-off period ends.
- (8) If:
 - (a) the cooling-off period begins during the period mentioned in regulation 17A.34H or an evidentiary period mentioned in regulation 17A.34J; and
 - (b) the opposition resumes;

the period mentioned in regulation 17A.34H or 17A.34J restarts when the opposition resumes.

17A.34M Hearing

- (1) This regulation applies to an opposition if:
 - (a) the opposition has not been dismissed under regulation 17A.34B; or
 - (b) the opposition has not been decided under regulation 17A.34N; or
 - (c) the opposition is not taken to have succeeded under regulation 17A.34H.
- (2) The holder of an IRDA may request the Registrar to hold a hearing if:
 - (a) the evidentiary period mentioned in subregulation 17A.34J(3) has ended; and

(b) either:

- (i) all evidence for the opposition proceeding has been filed; or
- (ii) no evidence has been filed in that period.

(3) A party may request the Registrar to hold a hearing if:

(a) an evidentiary period mentioned in any of subregulations 17A.34J(4) to (6) has ended; and

(b) either:

- (i) all evidence for the opposition proceeding has been filed; or
- (ii) no evidence has been filed in that period.

(4) The Registrar:

(a) must hold a hearing of the opposition if requested by a party in writing; or

(b) may decide, on the Registrar's own initiative, to hold a hearing of the opposition.

(5) The hearing may, at the Registrar's discretion, be:

(a) an oral hearing; or

(b) by written submissions.

(6) If the Registrar decides on an oral hearing:

(a) the Registrar must notify the parties of the date, time and place of the hearing; and

(b) the opponent must file a summary of submissions at least 10 business days before the hearing; and

(c) the holder of the IRDA must file a summary of submissions at least 5 business days before the hearing.

(7) The Registrar may take into account a party's failure to file a summary of submissions under subregulation (6) in making an award of costs.

Note: Regulations 21.15 and 21.16 deal with hearings.

17A.34N Decision on opposition

- (1) Unless the opposition proceedings are discontinued or dismissed, the Registrar must decide:
 - (a) to refuse protection in respect of all of the goods or services listed in the IRDA; or
 - (b) to extend protection in respect of some or all of the goods or services listed in the IRDA (with or without conditions or limitations);having regard to the extent (if any) to which the grounds on which the IRDA was opposed have been established.
- (2) The Registrar must notify the International Bureau of the Registrar's decision.

17A.34P Appeal

- (1) Section 56 of the Act applies in relation to the Registrar's decision on the opposition as if a reference in that section:
 - (a) to an applicant were a reference to the holder of an IRDA; and
 - (b) to a decision under section 55 of the Act were a reference to a decision under regulation 17A.34N.
- (2) If an appeal is made, the Registrar must tell the International Bureau of the decision on the appeal.

17A.34Q Registrar may give direction

- (1) The Registrar may give a direction in relation to an opposition to which this Division applies:
 - (a) if requested by a party in writing; or
 - (b) on the Registrar's own initiative.
- (2) If the Registrar proposes to give a direction, the Registrar must give the parties an opportunity to make representations about the direction.
- (3) A direction must not be inconsistent with the Act or these Regulations.
- (4) The Registrar must notify the parties of the direction as soon as practicable.

17A.35 Registrar must notify parties of dismissal or discontinuance of opposition

If an opposition is dismissed under regulation 17A.34B or discontinued, the Registrar must notify the parties of the dismissal or discontinuance.



Australian Government

IP Australia

Trade Marks Act 1995
NOTICE OF INTENTION TO OPPOSE
Opposition to registration

Trade mark number

2218465

Applicant's name

FM World Sp. z o.o.

Opponent's name

Jetharam Nemaram GEHLOT

Opponent's address

101, Shree White Heights Apartments

Saraswati Nagar, Near Hirawadi Road

Panchavati

Nashik City, Maharashtra, 422003

India

Opponent's representative name

Acumen Intellectual Property

Opponent's representative address for service

PO Box 140

Berridale, New South Wales, 2628

Australia

Received date of the Notice of Intention to Oppose

2023-05-08



Australian Government

IP Australia

Trade Marks Act 1995
Statement of Grounds and Particulars
Opposition to registration

Trade mark number

2218465

Opponent's name

Jetharam Nemaram GEHLOT

Opponent's address

**101, Shree White Heights Apartments
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Panchavati
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India**

Opponent's representative name

Acumen Intellectual Property

Opponent's representative address for service

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Opponent's representative email address

policing@acumenip.com.au

Evidence email address

5552@acumenip.com.au

Opponent's representative telephone number

+61 2 6100 2405

Received date of the Statement of Grounds and Particulars

2023-06-08

Grounds and Particulars

Earlier similar trade mark(s) applied for with this office (s44/reg 4.15A)

2120353

Trade mark is similar to a trade mark that has a reputation in Australia (s60)

The trade mark/s have been used before the priority date of the trade mark being opposed

The Opponent owns a family of trade marks incorporating the word YUTIKA which include:

1. the mark the subject of the Trade Mark Registration No 2120353, YUTIKA;
2. the marks YUTIKA NATURAL, YUTIKA PHARMA, UTICA, YUTHICA, YUTHIKA, YUTIKA NATURE GREEN, YUTIKA NATURE LEAF, YUTIKA SELFCARE, YUTIKA SEVEN FOREST, and
3. variations thereof,
(collectively Opponent's YUTIKA Trade Marks).

The Opponent's YUTIKA Trade Marks are used in connection with cosmetics, beauty products, hair care products, skin care products and personal care products, including, but not limited to, Cosmetics, Henna, Henna Powder, Henna Cone, Henna Paste, Hair Color, Hair Dye, Hair Care and Skin Care Products, Cosmetics, Hair Oil, Depilatory Preparations, Medicated and Ayurvedic Preparations, Hand Care Preparations, Hand Wash, Hand Sanitizers, etc. The Opponent has used the Trade Mark 'Yutika' from 2006 (and subsequently other YUTIKA Trade Marks) in India

and many other countries. The yutika.com domain name was purchased in 2006 and has subsequently been used in connection with the Opponent's YUTIKA branded products.

The Opponent's YUTIKA branded products have been officially available in Australia since at least as early as February 2020 and there has been significant use of Opponent's YUTIKA Trade Marks in Australia since at least that date. The products sold under the Opponent's YUTIKA Trade Marks have been available for sale across Australia through various suppliers, including Amazon.com.au and have been available worldwide through traditional sales channels, major Indian and Global Online market places.

YUTIKA and variations thereof are being used by the Opponent and their licensees as a trade mark, a corporate name, a trade name, domain names (e.g. yutika.com & yutikanatural.com) and a house mark in respect of all of the products in the course of trade as well on other domains (e.g. www.premhenna.com) and third party social media platforms or similar (e.g. facebook.com, twitter.com, Google Plus, youtube.com, linkedin.com, pinterest.com).

The Opponent's YUTIKA branded products have also been promoted at numerous trade fairs worldwide.

Registration of the Opponent's YUTIKA Trade Mark has been sought in numerous countries and obtained in more than 60 jurisdictions around the world, including Afghanistan, Albania, Algeria, Andorra, Armenia, Australia, Benelux, Benelux (Belgium, Netherlands, Luxembourg), Bhutan, Bolivia, Bosnia and Herzegovina, Brunei Darussalam, Burundi, Caribbean Netherlands (BQ), Chile, China, Colombia, Costa Rica, Croatia, Czechia, Denmark, Ecuador, El Salvador, Estonia, Germany, Great Britain, Hong Kong, Hungary, Iceland, India, Israel, Italy, Kazakhstan, Kenya, Kyrgyzstan, Latvia, Lichtenstein, Lithuania, Madagascar, Malaysia, Maldives, Malta, Mauritius, Mexico, Moldova, Monaco, Mongolia, Morocco, Myanmar, Nepal, New Zealand, Nigeria, Palau, Paraguay, Peru, Philippines, Poland, Portugal, Romania, Samoa, San Marino, Singapore, Sint Maarten, South Korea, Spain, Sweden, Turkey, United States of America, Vietnam, which covers almost 75% of the world's population.

As a result of the significant use of the Opponent's YUTIKA Trade Marks over a considerable period both in Australia and globally, the Opponent's YUTIKA Trade Marks had acquired a substantial reputation in Australia, and globally, as at 2 March 2021.

In view of:

1. the substantial reputation in the Opponent's YUTIKA Trade Marks before the Priority Date;
 2. the similarity of the Opposed Trade Mark to the Opponent's YUTIKA Trade Marks; and
 3. the same or similar goods for which the Opposed Trade Mark is sought to be registered to the Opponent's goods;
- the use of the Opposed Trade Mark is likely to cause consumers to wrongly assume that such goods and services are provided by or with the authorisation or approval of the Opponent.

By reason of the reputation in the Opponent's YUTIKA Trade Marks, the use of the Opposed Trade Mark would be likely to deceive or cause confusion.

Use of the trade mark would be contrary to law (s42(b))

Competition and Consumer Act 2010; Tort of passing off

Trade mark likely to deceive or cause confusion (s43)

The Opponent repeats the particulars provided in connection with Section 60 (above).

Use of the Opposed Trade Mark by the Applicant is likely to convey to consumers the connotation that the Applicant and/or the Applicant's goods and services have the licence or approval of the Opponent when in fact they have no such licence or approval.

The application was filed with no intention to use the trade mark (s59)

Based on online investigations, the Applicant appears to only provide perfumes, hair oil and face oil.

There is no indication that the Applicant offers under the Opposed Trade Mark the remaining goods listed in class 3 or any of the goods listed in class 4 under the Opposed Application.

Registration of the Opposed Trade Mark should therefore be refused on the ground that as at 2 March 2021, the priority date of the Opposed Application, the Applicant did not intend:

1. to use, or authorise the use of, the Opposed Trade Mark in Australia; or
2. to assign the Opposed Trade Mark to a body corporate for use by the body corporate in Australia;
3. in relation to the goods specified in the Opposed Application, other than perfume and hair oils.

Award of costs

The opponent applies for an award of costs.

TRADEMARKS ACT 2019
TRADEMARKS REGULATIONS 2019

NOTARY
NOTED & REGISTERED
Serial No. 1698/2023
E 2512/2023
This Document Contains
Total 23 Pages

IN THE MATTER of Trademark Application

No.: TM2021028509 for in
Class 3, in the name of FM WORLD SP. Z
O.O.

...Applicant

AND

IN THE MATTER of an Opposition against
the same by JETHARAM NEMARAM
GEHLOT

...Opponent

STATUTORY DECLARATION

I, **Ambuj Kumar**, residing at Flat No. B-4, Sheetal Paradise Apartment, Govind Nagar,
Nashik, Maharashtra 422009, India, do hereby solemnly and sincerely state as follows:

- 1) I am the holder of the Power of Attorney by the Opponent, and I am duly authorized to declare this Statutory Declaration on behalf of the Opponent in this proceedings. The facts deposed to herein are within my personal knowledge or from the records and documents to which I have full access at all times, save where the contrary appears. A copy of the abovementioned Power of Attorney by the Opponent is attached and marked as **Exhibit A**.
- 2) The Opponent have been shown and have read a copy of the Counter Statement filed by the Applicant dated 1st June 2023. This Statutory Declaration is affirmed in support of the contentions set out in the Notice of Opposition and in reply to the Applicant's contentions in its Counter Statement.

AK

- 3) The Opponent is one of the owners of the world-renowned company **PREM HENNA PVT LTD**, an innovative and diversified global supplier of quality Henna, Henna products, hair color, hair dyes, cosmetic dyes, hair care products, soap, shampoos, lotions, hand sanitizer, hand wash, cosmetics and cleansing agents for hands.
- 4) The Opponent along with his family members is engaged in the family business of manufacturing and marketing various products in 1998 and they have established a manufacturing unit of henna powder, henna paste, hair dye, hair color, skin care preparations, hair care preparations, hair oils, cosmetics, depilatory preparations, ayurvedic and medicated preparations, pharmaceutical preparations, and then, in the year 2005 to distinguish its products and its identity from others, the Opponent's brother, Mr. Chutraram Nemaram Gehlot, had adopted various trademarks for various products and businesses including the trademark "**YUTIKA**" and had been continuously and uninterruptedly using the well-known mark "**YUTIKA**" which has been adopted since the year 2009.
- 5) Due to the extraordinary efforts, hard work and dedication, their business has multiplied. With excellent quality products and expanded organization, they have established "**Prem Henna Ltd**" in 2012. In 2018, due to the significant growth in business, another company was incorporated by the name of "**Yutika Natural Pvt Ltd**" in which the Opponent acts as the Promoter, Director and the Shareholder. The said company manages and uses the said trademark belonging to the Opponent in the worldwide continuously and openly in the market.
- 6) The Opponent is the sole proprietor of the mark "**YUTIKA**" by virtue of the Deed of Assignment executed in his favour by his brother Mr. Chutararam Nemaram Gehlot (the predecessor). The Opponent is the proprietor of the mark "**YUTIKA**", which has been adopted since the year 2009 by the predecessor. The adoption of the predecessor is to be construed as adoption by the Opponent. Attached and marked under **Exhibit B** is the Company Registration Certificate, and other documents related to the companies above.
- 7) The Opponent has built up a large international distribution network for its goods, placing the Opponent among the top manufacturers and marketers of his goods worldwide.

AK

- 8) In Malaysia, the Opponent is the common law owner and registered proprietor of "YUTIKA" under trademark registration no.: TM2020027980 in Class 3 since the year 2020. Further, as a result of long, extensive and continuous use of the mark "YUTIKA" in Malaysia, the mark "YUTIKA" has acquired well-known mark protection and therefore the Opponent is entitled to the exclusive use of the same to the exclusion of all others.
- 9) The mark "YUTIKA" has been registered with the Indian Trademark Office since the year 2009, and its concurrent use for the past 14 years has resulted in the mark "YUTIKA" being well-known and rooted in the minds of consumers in India and countries all over the world including Malaysia. These registrations are valid and subsisting at all material times to date. The copies of the Trademark Certificates are attached and marked as **Exhibit C**.

The Opponent is also the registered proprietor of the mark "YUTIKA", among others, in various countries worldwide as shown in the table below with respect to Hair colourants; dyes (cosmetic); hair dyes; henna for cosmetic purposes, Skin care preparations, Hair care preparations, Hair oils, Cosmetics, Depilatory Preparations, Ayurvedic and Medicated Preparations etc., worldwide all included in class 3. The ownership of all these registered marks is subsisting and beyond dispute. Copies of the international trademark registration certificates of "YUTIKA" are attached and marked as **Exhibit D**.

NO.	COUNTRY	MARK	APPLICATION/ REGISTRATION NO.CLASS	CLASS	DATE OF REGISTRATION
1	Afghanistan	YUTIKA	18121	3	02/05/2021
2	Afghanistan	YUTIKA Selfcare	24803	3	17/10/2021
3	Albania	YUTIKA	22599	3	27/04/2021
4	Algeria	YUTIKA	121095	3	20/04/2021
5	Andorra	YUTIKA	42453	3	23/04/2021
6	Armenia	YUTIKA	20211133	3	20/05/2021
7	Australia	YUTIKA	2120353	3	16/09/2020
8	BENELUX	YUTIKA	1443702	3	27/05/2021
9	Bhutan	YUTHIKA	BT/T/2015/8526	3	14/07/2016
10	Bhutan	YUTHIKA	BT/T/2015/8527	5	14/07/2016

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11	Bhutan	YUTIKA Selfcare	BT/T/2021/9993	3	29/10/2021
12	Bolivia	YUTIKA	199078-C	3	14/04/2022
13	Brunei Darussalam	YUTIKA	51714	3	19/10/2020
14	Bulgaria	YUTIKA	2021162770N	3	18/05/2021
15	Burundi	YUTIKA	97081BI	3	07/07/2021
16	Cambodia	YUTIKA	KH/2021/84272	3	11/01/2021
17	Chile	YUTIKA	1358712	3	16/11/2021
18	China	YUTIKA	40901650	3	07/06/2021
19	Colombia	YUTIKA	688557	3	17/08/2021
20	Costa Rica	YUTIKA	302807	3	21/04/2021
21	Croatia	YUTIKA	Z20210588	3	19/04/2021
22	Czechia	YUTIKA	388500	3, 5	03/11/2021
23	Denmark	YUTIKA	VR 2021 00947	3	18/01/2021
24	Ecuador	YUTIKA	SENADI_2022_TI_2424	3	19/01/2022
25	El Salvador	YUTIKA	155845	3	12/10/2021
26	Estonia	YUTIKA	60435	3	06/12/2021
27	Germany	YUTIKA	30 2021 106 799	3	06/07/2021
28	Hong Kong	YUTIKA	305462604	3	13/04/2021
29	Hungary	YUTIKA	236 634	3	13/12/2021
30	Iceland	YUTIKA	V0121787	3	31/05/2021
31	Indonesia	YUTIKA	IDM000943573	3	07/01/2021
32	Italy	YUTIKA	302020000086638	3	12/10/2020
33	Kazakhstan	YUTIKA	102056	3	22/04/2021
34	Kenya	YUTIKA	115308	3	22/12/2020
35	Latvia	YUTIKA	M 77 217	3	20/12/2021
36	Liechtenstein	YUTIKA	19615	3	22/09/2021
37	Lithuania	YUTIKA	84333	3	13/07/2021
38	Malaysia	YUTIKA	TM2020027980	3	24/11/2020
39	Mauritius	YUTIKA	30491/2021	3	18/11/2020



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40	Mexico	YUTIKA	2279044	3	26/07/2021
41	Moldova	YUTIKA	35604	3	18/09/2021
42	Mongolia	YUTIKA	40-0023991	3	03/11/2020
43	Morocco	YUTIKA	224972	3	02/03/2021
44	Nepal	YUTHIKA	2015/059128	5	23/02/2018
45	Nepal	YUTHIKA	2015/059129	3	23/02/2018
46	Paraguay	YUTIKA	2021-531197	3	25/10/2021
47	Peru	YUTIKA	312128	3	20/07/2021
48	Philippines	YUTIKA	4/2021/0050154 6	3	21/01/2021
49	Poland	YUTIKA	349440	3, 5	10/06/2021
50	Romania	YUTIKA	179225	3	16/02/2022
51	Singapore	YUTIKA	40202104239W	3	22/02/2021
52	Spain	YUTIKA	4.119.450	3	26/04/2021
53	Sweden	YUTIKA	2021/04760	3, 5	11/11/2021
54	Turkey	YUTIKA	2021 034087	3	02/03/2021
55	UK	YUTIKA	UK00003560792	3	26/11/2020
56	Vietnam	YUTHIKA	292985	5	21/12/2017



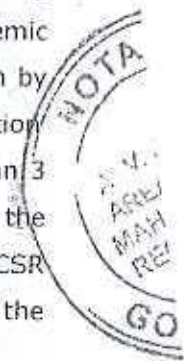
- 11) In addition to the trademark registration, the Opponent also owns the copyrights of the artwork on the mark "YUTIKA" as regulated under the Indian Copyright Act. Copies of the abovementioned Copyright Certificates are attached and marked as **Exhibit E**.
- 12) In the past several years, the sales of the products bearing the mark "YUTIKA" have grown rapidly and the Opponent has built an enviable reputation in the market. The sales turnover of the products in the past few years and has reached an immense reputation. The purchase order, sales and export invoices related to the mark "YUTIKA" internationally are attached and marked as **Exhibit F**.
- 13) The Opponent has and still continues to expend large sums of money to promote and advertise "YUTIKA" through various digital and media platforms, aside from actively participating in well-known exhibitions globally. The social media channels that have been used to promote the goods bearing the mark "YUTIKA" are attached and marked as **Exhibit G**.

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- 14) The Opponent has expended significant efforts marketing the goods bearing the mark "**YUTIKA**" through advertisements and promotional undertakings which results in the public and traders easily identifying the goods, marks, and its origin. The copies of advertisement invoices related to the mark "**YUTIKA**" are marked and attached as **Exhibit H**.
- 15) Further, I take pride in stating that the Opponent is a philanthropist and seeks welfare for the society and the environment. The Opponent has performed various CSR (Corporate Social Responsibility) activities in India wherein the Opponent has donated for the betterment of the environment through the Opponent Company 'Yutika Welfare Foundation'. I further take the liberty to state that the Opponent's Company 'Yutika Welfare Foundation' has been granted with various Awards and Certifications time and again for its noble acts. The Opponent's Company 'Yutika Welfare Foundation' has been certified for rendering highest degree of services in favour of the common people during the pandemic of Covid-19 by Rajasthan Government. The Certificate of Appreciation given by the Rajasthan Government, the Opponent's Company 'Yutika Welfare Foundation' is indulged in donation of saplings and have donated and planted more than 3 lacs saplings in Rajasthan for the contribution in the greener environment, the Newspaper Cutting of the Donation, the award of the 'Navbharat-Navrashtra CSR Award 2023', and the Newspaper Cuttings of CSR Award granted to the Opponent's Company 'Yutika Welfare Foundation' under **Exhibit I**.
- 16) In light of the details and evidence provided in paragraphs 6 to 15, the Opponent has been advised by the Opponent's trademark agent, and which the Opponent believes to be true, that the mark "**YUTIKA**" is distinctive to the Opponent's company, to the exclusion of all other parties. The Opponent has therefore acquired goodwill, fame and reputation in its trade and business such that mark "**YUTIKA**" acts as an instant indicator of origin and refers exclusively to the Opponent. Due to the continuous and extensive use of the mark "**YUTIKA**", it signifies the Opponent's company and goods internationally and in particular among the trade and public in Malaysia.
- 17) The Opponent has created a product catalogue that is specially created for marketing collateral that lists essential product details that helps buyers make a purchase decision. The Opponent has spent, incurred and invested a sufficient amount of money, labour, skill, time, energy and expertise in establishing

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products under the said trademark in the market and now enjoys exclusivity. The products bearing the mark "YUTIKA" are also been sold via online shopping websites which makes the said trademark more accessible and known to the Indian and Global public. Copy of the product catalogue bearing the mark "YUTIKA" is attached and marked as **Exhibit J**.

- 18) It has come to the attention of the Opponent that the Applicant's mark, TM Application No.: TM2021028509, was applied for by the Applicant on 2nd March

2021 for in Class 3 with respect to "*aloe vera preparations for cosmetic purposes; antiperspirants [toiletries]; anti-perspirants in the form of sprays; deodorants and antiperspirants; antiperspirants for personal use; aromatics; aromatic oils; lotions for cosmetic purposes; balms, other than for medical purposes; flower perfumes (bases for -); lip gloss; nail glitter; amber [perfume]; tissues impregnated with cosmetic lotions; tissues impregnated with cosmetics; facial wipes impregnated with cosmetics; moist wipes impregnated with a cosmetic lotion; wipes impregnated with a skin cleanser; tissues impregnated with make-up removing preparations; tissues impregnated with essential oils, for cosmetic use; essential oils of lemon; deodorants for human beings; deodorants for human beings or for animals; air fragrance reed diffusers; extracts of flowers [perfumes]; herbal extracts for cosmetic purposes; sunscreen preparations; hair dye; incense; joss sticks; cosmetics; make-up preparations; natural cosmetics; cosmetics for eyelashes; eyebrow cosmetics; make-up preparations; cosmetics for children; cosmetics for personal use; skincare cosmetics; skin care creams [cosmetic]; cosmetic creams; skin whitening creams; hair spray; nail polish; cosmetic masks; potpourris [fragrances]; mint for perfumery; almond milk for cosmetic purposes; facial cleansing milk; cleansing milk for toilet purposes; soaps; perfumed soaps; perfumed soaps; antiperspirant soap; toilet soap; cosmetic soaps; soaps and gels; liquid bath soaps; soaps for body care; soap for foot perspiration; deodorant soap; shaving soap; almond soap; nail art stickers; hair nourishers; conditioning preparations for the hair; hair conditioners for babies; jasmine oil; lavender oil; gaultheria oil; almond oil; bergamot oil; rose oil; oils for hair conditioning; peppermint oil [perfumery]; cuticle oil; hair fixing oil; oils for cosmetic purposes; oils for perfumes and scents; oils for perfumes and scents; essential oils; essential oils*

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for personal use; oils for cosmetic purposes; cedarwood (essential oils of -); oils for toilet purposes; cosmetic pencils; breath freshening strips; teeth whitening strips; shoe polish; musk [perfumery]; eye-washes, not for medical purposes; liquid latex body paint for cosmetic purposes; hair lotion; mouthwashes, not for medical purposes; mouthwashes, not for medical purposes; vaginal washes for personal sanitary or deodorant purposes; after-shave preparations; lipstick; pomades for cosmetic purposes; dentures (preparations for cleaning -); make-up removing preparations; eye make-up remover; depilatory preparations; hair removal and shaving preparations; douching preparations for personal sanitary or deodorant purposes [toiletries]; bath preparations; baths (cosmetic preparations for -); bath preparations, not for medical purposes; hair waving preparations; shining preparations [polish]; fumigation preparations [perfumes]; nail care preparations; skin, eye and nail care preparations; refurbishing preparations; denture polishes; hair straightening preparations; sun blocking preparations [cosmetics]; tanning preparations; phytocosmetic preparations; collagen preparations for cosmetic purposes; cosmetic preparations for bath and shower; cosmetic preparations for slimming purposes; breath freshening preparations for personal hygiene; astringents for cosmetic purposes; toiletries, perfumed lotions [toilet preparations]; non-medicated cosmetics and toiletry preparations; perfumed body lotions [toilet preparations]; perfumery; perfumery, essential oils; face powder; eyelashes (false -); bath salts, not for medical purposes; shampoo; dry shampoos; body shampoos; shampoos for pets [non-medicated grooming preparations]; baby shampoo; shampoo bars; shampoos for personal use; false nails; artificial nails for cosmetic purposes; cleansers for intimate personal hygiene purposes, non-medicated; dentifrices; dentifrices and mouthwashes; air fragrancing preparations; massage candles for cosmetic purposes; talcum powder, for toilet use; mascara; long lash mascaras; petroleum jelly for cosmetic purposes; toilet water; cologne impregnated disposable wipes; lavender water; perfume water; toilet water; floral water; micellar water; javelle water; hydrogen peroxide for cosmetic purposes; moustache wax; cosmetic kits; nail varnish removers; nail varnish remover [cosmetics]; nail polish remover pens; hair gel; shaving gel; make-up removing gels; styling gels; dental bleaching gels; gels for cosmetic use; gels for fixing hair; massage gels, other than for medical purposes and gel eye patches for cosmetic purposes". It is immediately apparent that the goods specified under the application of the Applicant's mark are similar to the goods covered under the Malaysian registration of the mark "YUTIKA", as well as the goods that the Opponent undertakes.

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- 19) The Opponent believes that the Applicant's mark is substantially similar and/or so closely resembles the mark **"YUTIKA"** and that any use of the Applicant's mark is likely to deceive or cause confusion amongst the public and is furthermore calculated to deceive and/or cause confusion amongst the public.
- 20) The Opponent further believes that by comparing the features of the get-up of the Applicant's mark and the features of the get-up of the mark **"YUTIKA"**, it is evident that features of the get-up of the Applicant's mark are identical and/or confusingly similar. Specifically, the use of the word **"UTIQUE"**, appears to be taken, borrowed, and derived from the mark **"YUTIKA"**. The part **"QUE"** could be mispronounced as **"KA"** (**UTIKA**) making it phonetically very similar to the Opponent's mark **"YUTIKA"**. Further, the Opponent is advised that the trademarks are deceptively similar and the Applicant's mark is to be registered for goods that are identical or similar to those registered under the mark **"YUTIKA"**. The similarities are shown as below:

Feature	YUTIKA	UTIQUE	Explanation
Visual Similarity	YU-TI-KA	U-TI-QUE	Both marks presented in three syllables. The sequence of the letters "UTI" is presented in both marks.
Shared Syllable 'UTI'	UTI-KA	UTI-QUE	Both marks contain the syllable "UTI".
Sequence of the mark	YUTIKA	UTIQUE	Same sequence.
Phonetic Identical	YU	U	Same pronunciation as /you/.
	TI	TI	Same pronunciation as /ti/.
	KA	QUE	The ending sounds of the two marks is identical due to the pronunciation of "Q" as /k/ in malay pronunciation which makes "QUE" sounds like /KA/.

- 21) Further, the Opponent is advised that the Applicant's mark is closely similar to the registered mark **"YUTIKA"** in Malaysia. Given the fame and repute demonstrated in this Statutory Declaration, it is verily believed that the Applicant

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has adopted the mark "**YUTIKA**" to exploit its existing fame and reputation. The Applicant, after being fully aware of the significant brand reputation associated with "**YUTIKA**" on a global scale, including in Malaysia, has in bad faith dishonestly adopted the closely similar mark "**UTIQUE**" for toiletries, personal care and cosmetic products, strategically aiming to benefit from the established market reputation of the registered and prior used mark "**YUTIKA**". The deliberate selection of the impugned trademark by the Applicant is regarded as a calculated decision, intended to exploit the hard-earned reputation that the opponent has diligently built over time.

- 22) The trades and public would be confused into believing that the goods of the Applicant originate from "**YUTIKA**", or that the Applicant is in some way associated with "**YUTIKA**", or that the Applicant has been granted proper licenses to use the mark "**YUTIKA**". The Opponent had been advised by his trademark agent, which the Opponent verily believe to be true, that the registration of the Applicant's mark would offend section 24(2)(b) of the Trademarks Act 2019, which entitles the Opponent to oppose its registration under section 34(2)(a) of the Trademark Act 2019.
- 23) The Opponent has been further advised that the Opponent has exclusive rights for the copyright in "**YUTIKA**" under the Indian Copyrights Act and the Berne Convention. Thus, the registration of the Applicant's mark would offend Section 24(4)(b) of the TA 2019, which compels the Registrar to refuse the registration of the Applicant's mark by virtue of an earlier right under the law of copyright. In this regard, it is verily believed that the Applicant's mark ought to be refused registration under section 24(4)(b) of the TA 2019, which entitles the Opponent to oppose its registration under section 34(2)(a) of the TA 2019.
- 24) The Opponent further believes that based on the facts and evidence set forth above, the Applicant's mark can never be capable of distinguishing the goods of the mark "**YUTIKA**". Hence, the Opponent is advised that due to the well-known status of the mark "**YUTIKA**", the Opponent is entitled to oppose the registration of the Applicant's mark under section 34(2)(c) of the TA 2019.
- 25) By reason of the above it is verily believed to be true, the Applicant's mark ought to be refused registration under the grounds for a refusal of registration as prescribed by the Trademark Act 2019 and the Regulations thereunder.

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Advocate & Notary

REPLY TO THE APPLICANT'S COUNTER STATEMENT

- 26) The Opponent has been shown and read the Applicant's Counter Statement dated 1st June 2023. The Opponent would address the Applicant's contentions by reference to the issues raised by the Applicant, and otherwise in the order it is raised in the Counter Statement.
- 27) Para 1 to 5 is denied and the Applicant is put to strict proof. Furthermore, the Opponent has been advised that in today's fast-paced society, the internet plays a crucial role in promoting and establishing brand recognition. Both marks "YUTIKA" and the mark "UTIQUE" have a significant online presence through popular search engines like Google and various social media platforms. The Applicant's counterstatement that their products are exclusively sold within their franchise system does not negate the fact that the mark "UTIQUE" is extensively used and visible online. This online exposure actually worsens the confusion as online shoppers often make quick decisions without closely examining the product or its brand name. They may rely on a quick glance at the product image and brand name, remembering only the general look or sound of a brand, rather than its exact spelling or design. Additionally, it is important to highlight that the list of goods claimed for both marks overlaps, as they both relate to toiletries, personal care, and cosmetics products, further increasing the likelihood of confusion. It is evident that the Applicant is selling goods in a clandestine manner in order to escape from the legal action by the Opponent.
- 28) In reply to para 6, the Opponent denies the contents and the Applicant is put to strict proof. Despite the Applicant's assertion, the phonetic and visual similarities between "YUTIKA" and "UTIQUE" are significant and could lead to confusion among the public. The creation of the mark, whether independent or not, does not eliminate the potential for this confusion.
- 29) In reply to para 7, the Opponent has been advised that that there are significant phonetic and visual similarities between the Opponent's mark "YUTIKA" and the Applicant's mark "UTIQUE". Despite the Applicant's creative efforts, these significant similarities have the potential to cause confusion among the public. The principle of general recollection suggests that the public tends to remember the overall impression of a trademark rather than its specific details. Therefore, the unique design of the logo or the use of gold colour in the Applicant's mark "UTIQUE" is not sufficient to differentiate it from the opponent's mark "YUTIKA"

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in the minds of the public. Furthermore, it's important to note that according to section 20 (3) of the Trademarks Act 2019, a trademark registered without colour limitations is considered registered for all colours. This means that the Applicant's use of colour in their mark does not necessarily provide a distinct difference, as the Opponent's mark **"YUTIKA"** could also be presented in any colour, including gold.

30) In reply to para 8, the Opponent denies the Applicant's claim that **"UTIQUE"** is a Latin adverb meaning "certainly, by all means" or "at any rate", and its Latin pronunciation as "oo-tee-qey". In fact it is an afterthought of the Applicant to overcome the opposition; in fact the mark can also be pronounced as "u-tee-que/k". However, the Opponent is advised that this does not eliminate the potential confusion among the general public. Particularly in regions like Malaysia, where Latin is not the common language, people may not be aware with this Latin pronunciation. Instead, they are more likely to rely on their general recollection and phonetic interpretation of the mark. Given the similarities between the opponent's mark **"YUTIKA"** and the Applicant's mark **"UTIQUE"**, which phonetically resembles **"YUTIKA"**, confusion could easily ensue. Moreover, it's crucial to consider that the national language of Malaysia is Malay. In this language, the 'Q' in the Applicant's mark **"UTIQUE"** is pronounced as /k/, akin to the pronunciation in words like Qatar or kiss. Furthermore, the 'QUE' in **"UTIQUE"** is pronounced as /kuay/. Evidence supporting this Malay pronunciation is provided under **Exhibit L**.

31) At the outset, it is submitted that the impugned trade mark **"UTIQUE"** is almost identical and/or deceptively similar to the prior used and registered trade mark of the Opponent. A comparative analysis of the rival trademarks shows that the Applicant has blindly copied the Opponent's registered trade mark **"YUTIKA"** and with dishonest and mala fide intention, cosmetically changed the same in a clandestine manner by merely deleting the last letter 'A' from the Opponent's trademark without rupturing its phonetic, visual and structural equilibrium as the last letters 'QUE' is always pronounced as a sharp sound of 'K'. In view thereof, the impugned trade mark when pronounced speedily and/or casually and/or commonly as 'YOU-TI-K'. Hence, there is every possibility of confusion, deception, passing off etc. between the rival trademarks. The Opponent further say and submit that the Opponent's trademark has acquired so much distinctiveness that the use of any trademark identical with and/or similar or mere reference and/or integral / dominant part of the same in respect of any kinds of

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goods / service can cause confusion, deception and/or association with the Opponent.

- 32) In reply to para 9 and 10, the Opponent has no knowledge of the contents and the Applicant is put to strict proof of the contents and the claim that the co-existence of the marks in other countries eliminated the likelihood of confusion in Malaysia. Furthermore, it is important to highlight that any coexistence of these marks in certain countries is not due to any agreement or understanding between the Opponent and the Applicant. Rather, it is because the Opponent has not yet initiated trademark cancellation proceedings in those jurisdictions. The fact that the Opponent has filed Opposition proceedings in Malaysia clearly shows that the Opponent does not intend to coexist with the Applicant's mark "**UTIQUE**". Additionally, the Opponent has been advised that the Applicant's overseas registrations were only recently obtained in 2021, whereas the Opponent's registrations predate theirs. This information is crucial in reinforcing the claim of the opponent of prior use and ownership of the mark "**YUTIKA**". By establishing that the Opponent's registrations were obtained before the Applicant's, I am demonstrating that the Opponent has a longer and extensive history of using the mark. Regardless of the coexistence of these marks in other countries, it holds no relevance to the case in Malaysia, as trademark law is territorial in nature. As such, proof of coexistence in foreign countries cannot be construed as coexistence in Malaysia.

It is stated that the Opponent's website www.yutika.natural.com are available and accessible worldwide since 2006 which was also accessible to the applicant. It is further noted that the entire range of the Opponent's product bearing trademark "**YUTIKA**" is reflected on the website and from there the applicant has copied the opponent's mark with malicious intention by making minor variation to take marketing benefit. The web capture of the Opponent's website is attached under **Exhibit G**.

- 34) In reply to para 11, the Opponent has no knowledge of the efforts taken by the Applicant to promote and market their goods within the Multi-Level system globally and also unaware of the amount of money the Applicant has invested in advertising the mark "**UTIQUE**" across different channels and platform. The Applicant is put to strict proof.

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35) In reply to para 12, the Opponent's company details are attached under **Exhibit B.**

36) In reply to para 13, the Opponent has acknowledge the Applicant's partial admission of para 6 of the Grounds of Opposition. However, the Opponent vehemently dispute the Applicant's denial of the well-known mark protection status of "YUTIKA" in Malaysia. It is submitted that the Opponent's mark "YUTIKA", has been registered with the Indian Trademark Office since 10th June 2009, and its concurrent use for the past 14 years in India has resulted in the Opponent's mark "YUTIKA" being well-known and rooted in the minds of consumers in India and countries all over the world including Malaysia. The details of the registered marks in various countries, including Malaysia are shown in **Exhibit C.** The Opponent has expended significant effort marketing the goods of "YUTIKA" through advertisements and promotional undertakings which result in the public and traders easily identifying the goods, marks, and its origin. In the past several years, the sales of the goods bearing the mark "YUTIKA" have grown rapidly and has built an enviable reputation in the market. The immense sales turnover and uptrend over the last 3 years is shown in **Exhibit F.** The Opponent has been advised that the facts and evidence presented herein as a whole prove that the Opponent's mark "YUTIKA" has met the definition of a well-known mark, over and above. The Opponent has been further advised that Regulation 5 of the Trademarks Regulations 2019 outlined the criteria of well-known marks. The Opponent's mark "YUTIKA" has fulfilled all the criteria set forth in the abovementioned provision as shown below: -



Regulation 5: Criteria of a well-known trademark

- a) the extent of knowledge or recognition of the trademark in the relevant sector of the public;
- b) the duration and extent, and geographical area of any use of the trademark;
- c) the duration and extent of any promotion of the goods or services where the trademark applies and the geographical area where the promotion is carried out.
- d) the duration and place of registration, or duration and place of application for registration, of the trademark, to the extent that they reflect use or recognition of the trademark;
- e) the record of successful enforcement of rights in the trademark, in particular, the extent to which the trademark was recognized as well-known by competent authorities; and

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f) the value associated with the trademark.

37) Para 14 is denied as false in fact and in law upon the advice of the Opponent's trademark agent in which the Applicant allegedly claim that the concurrent use in India does not necessarily build a reputation in Malaysia. The Opponent's has been advised by the Opponent's trademark agent that the Opponent's mark "YUTIKA" has indeed been registered in India since 2009 under the name "YUTIKA PHARMA", and subsequent registrations of the mark "YUTIKA" in various classes have been made since then. It is common sense that the word Pharma is a generic term and therefore the mark to be considered is "YUTIKA" only. The "YUTIKA" component of the "YUTIKA PHARMA" mark was distinct and prominently used, which could have established a reputation and recognition among the public since 2009. While it is true that trademark protection is territorial in nature, the reputation of a well-known mark can transcend geographical boundaries. The Opponent's mark "YUTIKA" has been used extensively and continuously in various countries, including Malaysia, and as such, has acquired a well-known status. The mark "YUTIKA" is a well-known mark under Article 6 bis of the Paris Convention, Article 16 of the TRIPS Agreement, and, Regulations 5 of the Trademarks Regulations 2019, and therefore it is protected under Section 76 of the Trademarks Act 2019. The use of the Applicant's mark in relation to the Applicant's goods would indicate a connection between the Applicant's goods and the goods of the mark "YUTIKA" which may appear to have come from the same source hence the public will be fooled and misguided due to the close similarity between the two marks.

38) Further, the Opponent's has been advised given the fame and repute that the Opponent has demonstrated from para 9 to 15 herein, it is obvious that the mark "YUTIKA" qualifies as a well-known mark in accordance with the criteria set forth in said provision, and the Opponent verily believe that Applicant has adopted the Applicant's mark to take undue advantage of the Opponent's mark "YUTIKA". This is particularly in light of the fact that the mark "YUTIKA" is registered under Class 3 of the Nice Classification and is associated with toiletries, personal care and cosmetic products. On the other hand, the Applicant's mark "YUTIQUE", which is being sought for registration, includes a range of goods that are notably similar to the Opponent's goods of the mark "YUTIKA". This overlap of goods between the Opponent's mark "YUTIKA" and the Applicant's mark "YUTIQUE" increases the likelihood of confusion among consumers. Consequently, the proximity in relation to the nature of service, the shared trade channels, and the similar

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business activities of the Applicant and the mark "YUTIKA" would make confusion and deception unavoidable and inevitable. Both the Opponent's mark "YUTIKA" and the Applicant's mark claim toiletries, personal care and cosmetic products, resulting in confusion and deception to the public due to the same trading and marketing channel.

- 39) In reply to para 15, the evidence the international trademark registration certificates of the Opponent's mark "YUTIKA" is attached under **Exhibit C** and the purchase order, sales and export invoices related to the Opponent's mark "YUTIKA" internationally and in Malaysia is attached under **Exhibit F**.
- 40) Para 16 is denied in fact and in law as outlined in the para 22 in this Statutory Declaration and the evidence of the Copyright Certificates is attached under **Exhibit E**. The Applicant's assertion that copyright laws do not provide protection for words used as trademarks is a misrepresentation of the law. It is crucial to clarify that copyright protection does, in fact, extend to original works of authorship. This encompasses the use of the word "YUTIKA" as a distinctive and recognizable mark. Additionally, Malaysia has been a member of the Berne Convention since 1990. As a member, Malaysia recognizes and respects artistic works created within its jurisdiction or any other country that is a party to the Berne Convention, including India.
- 41) In response to paragraph 17, the evidence to support the claims regarding the marketing and promotion of goods under the Opponent's mark "YUTIKA" are attached under the **Exhibit F to K**:
- i) Evidence of the sales turnover is attached under **Exhibit F**.
 - ii) Evidence demonstrating the use of social media channels for promoting the goods is attached and marked as **Exhibit G**.
 - iii) Evidence of substantial expenditure on the promotion and advertisement of the Opponent's mark "YUTIKA" is attached and marked as **Exhibit H**.
 - iv) The product catalog, specifically created as marketing collateral that includes essential details about the goods of "YUTIKA", is attached under **Exhibit J**.
 - v) Evidence of participation in exhibitions promoting "YUTIKA" is attached under **Exhibit K**.



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Advocate & Solicitor

Pursuant to the above evidence (i) to (v), the extensive use and advertising of the Opponent's mark "**YUTIKA**" and its variants suggest that the Opponent's mark has gained significant goodwill and reputation for the goods. Furthermore, the Opponent assert that when the trading and purchasing public encounters the Opponent's mark, they associate it exclusively with the Opponent and not any other trader.

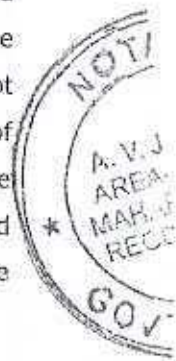
42) Para 18 is denied as false in fact and in law upon the advice of the trademark agent in which the Applicant alleged that the Opponent's mark "**YUTIKA**" is a well-known mark in Malaysia is a presumptuous claim. It is submitted that the long, extensive and continuous use of mark "**YUTIKA**" has acquired well-known mark protection and is therefore entitled to the exclusive use of the same to the exclusion of all others. This is further amplified by the fact that the mark "**YUTIKA**" is so widely known among the members of trade and the public all around the world including Malaysia.

43) In reply to Para 19, the Opponent acknowledge the admission of the Applicant to the contents of the statement.

44) Para 20 (a) is denied as false in fact and in law. The Opponent is advised that by comparing the features as stated in para 20 in this Statutory Declaration, it is evident that there are substantial similarities between the Applicant's mark "**UTIQUE**" and the Opponent's mark "**YUTIKA**", which are sufficient to cause confusion among the public. The Opponent states that it is denied that the Applicant's logo design is unique and creative, it is in fact not unique and creative and is very common in India and such designs are used in ancient architecture. Thereby, the applicant has depicted the common Indian original architectural design with the word **UTIQUE** with malicious intension to resemble the mark "**YUTIKA**" of the Opponent which will deceive the Registry as well as to confuse the consumers at large. The fact that the dominant part of their mark, namely the word "**UTIQUE**", bears significant phonetic and visual resemblance to the mark "**YUTIKA**". The Applicant contends that their logo design is a prominent feature of the "**UTIQUE**" mark. However, it is important to note that this design element cannot be verbally articulated by consumers. While the logo and the word "**UTIQUE**" are presented in equal size in the Applicant's mark, the critical feature is undeniably the word "**UTIQUE**". The logo does not play a significant role in verbal representations of the mark, thereby potentially leading to confusion with the Opponent's mark "**YUTIKA**".

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- 45) Para 20 (b) is denied as false in fact and in law. The Opponent is advised by the Opponent's trademark agent that while the Applicant asserts that the marks are visually dissimilar, this claim overlooks the significant similarities between both of the marks. Both marks share the same sequence of the word as in "YU-TI-KA" and "U-TI-QUE" and the sequence of letters "UTI", which is a prominent feature in both. This similarity could lead to visual confusion among consumers, they will be guided and influenced by a general recollection or impression of the mark which they have seen. Furthermore, the Opponent is advised, which the Opponent verily believe to be true that the pronunciation and speech of the consumer, particularly in non-Latin speaking regions such as Malaysia, is not going to be aware of the Latin pronunciation of "oo-tee-qéy" and its meaning. The public are more likely to rely on their general recollection and phonetic interpretation of the mark as "you-ti-ka" where the alphabet 'U' and 'Q' in "**UTIQUE**" is often pronounced as "you" and 'k', which is identical to the pronunciation of the Opponent's mark "**YUTIKA**".
- 46) Para 20 (c) is denied as false in fact and in law. The Applicant is put to strict proof of the origins of the word "**UTIQUE**". Furthermore, the Opponent has been advised that the counterstatement that it is illogical for "**UTIQUE**" to be derived from "**YUTIKA**" because "**UTIQUE**" is an older term does not negate the likelihood of confusion. The crux of the matter in trademark infringement is not about the chronological order of word creation, but about the likelihood of confusion among the public due to the similarities between the marks. The identical phonetic and visual similarities between the mark "**UTIQUE**" and "**YUTIKA**" are undeniable, and these similarities, rather than the age of the words, are what could lead to confusion among consumers.
- 47) Para 20 (d) is denied as false in fact and law. The Opponent is advised by the Opponent's trademark agent that, it is true that to consider the marks as a whole, however, it is equally crucial not to overlook the potential confusion arising from similar visual representation of the word "**UTIQUE**" and the identical phonetic pronunciation of both marks. Dissecting and comparing components is not an incorrect approach, but rather a vital part of a comprehensive analysis aimed at assessing potential consumer confusion.
- 48) Para 20 (e) is denied as false in fact and law. The Opponent has been advised that the Applicant's argument oversimplifies the test. The unique design of the



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logo or the use of gold color in the Applicant's mark "**UTIQUE**" does not sufficiently differentiate it from the Opponent's mark "**YUTIKA**" in the minds of the public. It's important to note that according to section 20 (3) of the Trademarks Act 2019, a trademark registered without color limitations is considered registered for all colors. This implies that the Applicant's use of color in their mark does not necessarily provide a distinct difference, as the Opponent's mark "**YUTIKA**" could also be presented in any color, including gold. Furthermore, the principle of imperfect recollection takes into account all aspects, and thus cannot ignore the visual and phonetic similarities as outlined in paragraph 20 of this Statutory Declaration.

- 49) In reply to para 21, the Applicant's denial is devoid of merit. The exclusive rights held by the Opponent over the mark "**YUTIKA**" as dictated by the Indian Copyrights Act 1957 and the Berne Convention, unequivocally encompass the word itself, and are not confined solely to artistic works, designs, images, content of labels, or product packaging associated therewith. The Applicant's claim that copyright laws only protect artistic and literary works, while the word used as a trademark per se remains unprotected, is a misrepresentation of the law. Notably, copyright protection extends to original works of authorship, which includes the creation and usage of the word "**YUTIKA**" as a distinctive and identifiable mark. Furthermore, it is critical to clarify that a mark does not need to be identical to infringe upon an earlier right; substantial similarities may suffice. The disputed mark "**UTIQUE**" exhibits substantial similarities to the Opponent's mark "**YUTIKA**" potentially leading to consumer confusion, and therefore infringes upon the Opponent's copyright under the Indian Copyrights Act and the Berne Convention. The contention that the Applicant's mark does not resemble any of the artistic and literary works is inconsequential and deviates from the core issue at hand. Thus, Section 24(4)(b) of the Trademarks Act 2019 is indeed relevant and directly applicable to this Opposition proceeding. The Section mandates the refusal of a mark's registration if it offends an earlier right under copyright law. Therefore, the registration of the Applicant's mark "**UTIQUE**" should be refused as per Section 24(4)(b) of the Trademarks Act 2019, and the Opponent retains the right to oppose its registration under Section 34(2)(a) of the Trademarks Act 2019. The demand for 'strict proof' in this case does not negate the necessity for the Registrar to consider the potential violation of copyright and the impact on the earlier rights of the Opponent.

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Advocate & Notary

- 50) Para 22 is denied as false in fact and in law upon the advice of the Opponent's trademark agent. The Opponent has been advised that the burden of proof that the Applicant's mark fulfils all the registrability requirements falls squarely on the Applicant. In this regard, the Applicant can never discharge the burden of proof, and the onus is on the Applicant to eliminate the doubts that have been raised in this Opposition including but not limited to the claim that the Applicant has intended to usurp the goodwill and reputation of a well-known mark, as it is evident in the wordings of the Applicant's mark "**UTIQUE**" which pronounced as "**YUTIKA**" compared to the Opponent's mark "**YUTIKA**". The Applicant's attempt to negate the contentions raised in this regard by putting the Opponent to strict proof instead is absurd. The Applicant must go beyond a mere denial that its mark is not derived from "**YUTIKA**", and prove that they are bona-fide, instead of requesting the Opponent to prove otherwise and in effect wrongly discharging the Applicant of its duty to justify its own registration.
- 51) In reply to para 23, the Opponent has been advised that the Applicant's mark "**UTIQUE**" is not an original creation but a modification of the mark "**YUTIKA**", with the removal of letter 'Y' and 'K' and the addition of letters 'QUE' at the end. This modification does not negate the fact that the phonetic components of both marks are identical, leading to confusion among consumers. The emphasis on the pronunciation of "YUTIK" in the Grounds of Opposition is not an inconsistency but rather a demonstration of the phonetic similarity between 'YUTIK' and 'UTIQUE'. It is the Applicant's mark that has introduced this confusion, not the actions of the Opponent. It is crucial to highlight that the Applicant's attempt to downplay the similarities between both marks and shift the blame for any potential confusion onto the Opponent is unfounded. The comparison of the marks in para 20 in this Statutory Declaration and the similarities of goods claimed clearly shows that the Applicant's mark "**UTIQUE**" is likely to deceive or cause confusion amongst the public. Thus, the Opponent verily believe that the Applicant's mark "**UTIQUE**" is intentionally camouflaged, as it directly stems from the mark "**YUTIKA**" and serves as a condensed version of it.
- 52) In reply to Para 24, the Opponent denies any contents and the Applicant is put to strict proof. The Opponent has been further advised that the Applicant's argument that consumers in the beauty industry are discerning and would not confuse the marks is fundamentally flawed. The mere fact that the products of both marks may not be found in the same physical location does not eliminate the likelihood of confusion, particularly in the digital age where online shopping



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is prevalent and consumers often rely on brand names when making purchases. The visual and phonetic similarities between the Applicant's mark "**UTIQUE**" and the mark "**YUTIKA**" are striking and cannot be overlooked. Even the most discerning consumer can be misled by such similarities, especially given the imperfect recollection that is typical of the average consumer. The fact that both marks are used for similar goods under Class 3, such as toiletries, personal care, and cosmetics products, only amplifies the potential for confusion. The Applicant's argument that their products are sold through different trade channels and target different customers is a red herring. The crux of the matter is the confusing similarity between the marks and the goods they represent, which poses a significant risk of confusion among consumers. Thus, the Opponent firmly maintain that the registration of the Applicant's mark "**UTIQUE**" should be refused to prevent the public from being deceived and confused.

- 53) In reply to para 25, the Guidelines for Control of Cosmetic Products in Malaysia evidence is attached under **Exhibit M**. The Opponent has been advised and verily believe that the proximity in relation to the nature of goods of interest and similar business activities of the Applicant and of the Opponent would thus create confusion and deception unavoidable and inevitable, particularly against the Opponent's mark and the Applicant's mark claim for cosmetics, personal care, skin care preparation and personal hygiene products will overlap resulting in confusion and deception to the public.

54) Para 26 is denied. The Opponent has been advised which the Opponent verily believe to be true that, given the fact that the Applicant's mark is almost identical with the Opponent's mark "**YUTIKA**", there remains a likelihood of confusion and deception among the relevant trade and public. This is more apparent when we take cognizance of the fact that the mark "**YUTIKA**" is a trademark so widely known among the relevant trade and public around the world, where the use has resulted in the Opponent's mark gaining substantial goodwill in the business. Further, the use and the registration of the Opponent's mark "**YUTIKA**" is well before the alleged use and the registration of the Applicant's mark "**UTIQUE**". Given the close similarity between the Applicant's mark "**UTIQUE**" and the Opponent's mark "**YUTIKA**", the mark "**UTIQUE**" can never be capable of distinguishing the goods of the Opponent's mark "**YUTIKA**". Thus, in using the "**UTIQUE**" mark, the Applicant's goods will and must always appear to be associated with or connected with the goods of the Opponent's mark "**YUTIKA**" so long as the Applicant's mark is employed in relation to the goods.

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- 55) In reply to para 27 and 28 by referring to paragraphs 20 (I) and 21 of the Opponent's Grounds of Opposition, the Opponent firmly believe that the Applicant has passed off its goods as those of the mark "YUTIKA", which violates common law principles. Furthermore, the use of the Applicant's mark is likely to deceive and cause confusion given its derivation from the mark "YUTIKA". This is grounds for refusal of the Applicant's mark registration as per Section 23 (5) (a), Section 24 (2), Section 24 (3) or Section 34(2)(a), and Section 34(2)(c) of TA 2019.
- 56) Para 29 to 30 is denied as false in fact and law upon the advice of the Opponent's trademark agent. It is submitted that the long, extensive and continuous use of mark "YUTIKA" in Malaysia, and the fame and repute that has been demonstrated from para 9 to para 14 herein, it is obvious that the mark "YUTIKA" satisfies the definition of a well-known mark in accordance with the criteria set forth in said in Regulation 5 of the Trademarks Regulations 2019 as laid down in paragraph 33 of this Statutory Declaration, and the Opponent verily believe that Applicant has adopted the Applicant's mark to take advantage of the well-known mark "YUTIKA" since the use and the registration of the mark "YUTIKA" is well before the alleged use and the registration of the Applicant's mark "UTIQUE". The Applicant's mark and the Applicant's goods will and always appear to be associated with or connected with the mark "YUTIKA". The Opponent has been further advised that by reasons aforesaid and the evidence presented herein has demonstrated a clear case of passing off by the Applicant. The close similarities of the marks and the goods as discussed in the preceding paragraphs of this Statutory Declaration, clearly indicates that the Applicant has misrepresented its goods as and as for the goods of the mark "YUTIKA" to the members of trade and public, thus the registration of the Applicant's mark clearly contravenes section 23 (1) and section 24 (2) of the Trademarks Act 2019 and thus should be refused.
- 57) In reply to para 31, upon the advice of the Opponent's trademark agent, the Opponent affirms the statements made in Para 26 of the Grounds of Opposition. The onus indeed remains on the Applicant to prove that the Applicant's mark satisfies the requirements of the Trademarks Act 2019 and does not contravene any provisions therein. It should be noted that the registration of the Applicant's mark in contention, which bears significant similarity with the Opponent's mark "YUTIKA", does not merely infringe upon the Opponent's rights, but also goes



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against the interest of the Malaysian public by fostering potential confusion and deception. The Opponent asserts that the burden of proof has not been adequately discharged by the Applicant and remains resolute in its opposition.

- 58) In addition to the aforementioned point, it is crucial to highlight that the responses provided by the Applicant are mere denials and evasive in nature. This evasiveness signifies a lack of substantive defence on the part of the Applicant.

For the abovementioned reasons, the Opponent prays that the Learned Registrar may exercise the powers vested in him by the Trademarks Act 2019, the Applicant's Trademark Application No. TM2021028509 should be refused registration and allow this opposition with costs against the Applicant.

And I make this solemn declaration on behalf of the Opponent conscientiously believing the same to be true and in accordance with the Statutory Declarations Act 1960.

Akumar
* Solemnly declared by,)

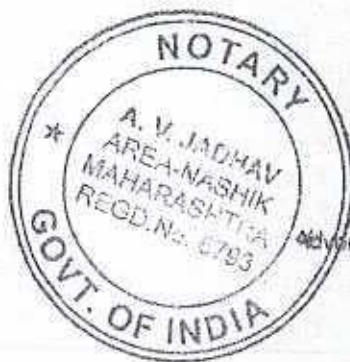
Ambuj Kumar)

At)

this)

25th day of *July* 2023)

Before me,



BEFORE ME

25/7/2023
ANIL V. JADHAV
Advocate & Notary Govt. of India
NASHIK - 422 002

Commissioner for Oaths /
Notary Public

លេខ: 73...../ 7 /B/Lit/DIP

ថ្ងៃសុក្រ ១២ រោច ខែឃ្នា ឆ្នាំ ថោះ បញ្ចស័ក ព.ស ២៥៦៧
រាជធានីភ្នំពេញ ថ្ងៃទី ១៤ ខែ កក្កដា ឆ្នាំ ២០២៣

ជម្រាបជូន

លោក/លោកស្រីនាយកក្រុមហ៊ុន FM WORLD Sp. Z.o.o.

UTIQUE

កម្មវត្ថុ: ការតម្រូវឱ្យផ្តល់ឯកសារគាំទ្រទាក់ទងនឹងបណ្តឹងជំទាស់ការចុះបញ្ជីម៉ាក ជំពូក ៣
លេខចុះបញ្ជី M/1618202/22 ចុះថ្ងៃទី ២១ ខែ ធ្នូ ឆ្នាំ ២០២២ ក្នុងនាមក្រុមហ៊ុន FM WORLD
Sp. Z.o.o.។

យោង: ពាក្យបណ្តឹង ចុះថ្ងៃទី ២៥ ខែ ឧសភា ឆ្នាំ ២០២៣ របស់លោក Jetharam Nemaram Gehlot
តំណាងដោយភ្នាក់ងារ Abacus IP

តាមតាមកម្មវត្ថុ និងយោងខាងលើ ខ្ញុំសូមជម្រាបលោក/លោកស្រីនាយកក្រុមហ៊ុន ជ្រាបថា ភ្នាក់ងារ
Abacus IP បានដាក់ពាក្យបណ្តឹង មកនាយកដ្ឋានកម្មសិទ្ធិបញ្ញា នៃក្រសួងពាណិជ្ជកម្ម ដើម្បីប្តឹងជំទាស់ការ
UTIQUE

ចុះបញ្ជីម៉ាក របស់លោក/លោកស្រី ចេញពីបញ្ជី ដោយបានផ្តល់ឯកសារគាំទ្របញ្ជាក់ថា ម៉ាកនេះមាន
លក្ខណៈដូចគ្នា ឬ ស្រដៀងនាំឱ្យក៏ន្តច្រឡំទៅនឹងម៉ាក YUTIKA របស់អតិថិជនខ្លួនដែលបានចុះបញ្ជី និង
ប្រើប្រាស់យូរមកហើយ។

អាស្រ័យហេតុនេះ សូមលោក/លោកស្រី ផ្តល់ឯកសារគាំទ្រ និងទឡើងវិញ ដែលទាក់ទងនឹងបណ្តឹង
ជំទាស់ការចុះបញ្ជីម៉ាកខាងលើ មកនាយកដ្ឋានកម្មសិទ្ធិបញ្ញា នៃក្រសួងពាណិជ្ជកម្ម ក្នុងរយៈពេល ៤៥ ថ្ងៃ ដោយ
គិតចាប់ពីថ្ងៃទទួលបានលិខិតនេះ។

ក្នុងករណីលោក/លោកស្រី ខកខានមិនបានផ្តល់ឯកសារគាំទ្រ តាមកាលកំណត់ដូចខាងលើ នាយកដ្ឋាន
កម្មសិទ្ធិបញ្ញា នៃក្រសួងពាណិជ្ជកម្ម នឹងបន្តអនុវត្តនីតិវិធីនៃច្បាប់ ស្តីពី ម៉ាក ពាណិជ្ជនាម និងអំពើនៃការប្រកួត
ប្រជែងមិនស្មោះត្រង់ ក្នុងការពិនិត្យ និងសម្រេចលើបណ្តឹងជំទាស់ការចុះបញ្ជីម៉ាកនេះ។

សូម លោក/លោកស្រី មេត្តាជ្រាប និងចាត់ចែងតាមការគួរ។

ប្រធាននាយកដ្ឋាន


ស្តេច វិជ្ជា

ចម្លងជូន: Abacus IP

**TRADEMARKS ACT 2019
TRADEMARKS REGULATIONS 2019
NOTICE OF OPPOSITION**

IN THE MATTER of Trademark Application
UTIQUE



No.: TM2021028509 for in
Class 3 and 4 in the name of FM WORLD SP.
Z O.O.

...Applicant

AND

IN THE MATTER of an Opposition against
the same by JETHARAM NEMARAM GEHLOT

...Opponent

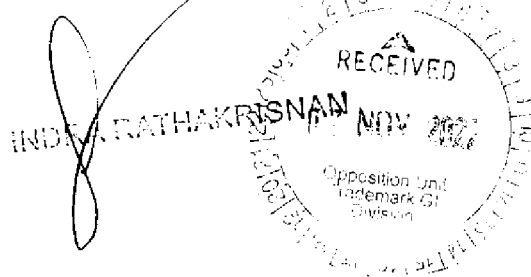
GROUND OF OPPOSITION

I, Jetharam Nemaram Gehlot, the Opponent, residing at 101, Shree White Heights Apartment, Saraswati Nagar, Hirawadi Road, Panchavati, Nashik, Maharashtra 422003,

UTIQUE



India, hereby opposes the registration of mark no.: TM2021028509 for in Class 3 (hereinafter referred to as the "Applicant's Mark"), as advertised in Government Gazette Batch 26/2022 dated 7 July 2022 at pages 279 and 280 in the name of FM WORLD SP. Z O.O., having an address at ul. Zmigrodzka 247 PL-51-129 Wroclaw, Poland with respect to the goods, "*aloe vera preparations for cosmetic purposes; antiperspirants [toiletries]; antiperspirants in the form of sprays; deodorants and antiperspirants; antiperspirants for personal use; aromatics; aromatic oils; lotions for cosmetic purposes; balms, other than for medical purposes; flower perfumes (bases for -); lip gloss; nail glitter; amber [perfume]; tissues impregnated with cosmetic lotions; tissues impregnated with cosmetics; facial wipes impregnated with cosmetics; moist wipes impregnated with a*



cosmetic lotion; wipes impregnated with a skin cleanser; tissues impregnated with make-up removing preparations; tissues impregnated with essential oils, for cosmetic use; essential oils of lemon; deodorants for human beings; deodorants for human beings or for animals; air fragrance reed diffusers; extracts of flowers [perfumes]; herbal extracts for cosmetic purposes; sunscreen preparations; hair dye; incense; joss sticks; cosmetics; make-up preparations; natural cosmetics; cosmetics for eyelashes; eyebrow cosmetics; make-up preparations; cosmetics for children; cosmetics for personal use; skincare cosmetics; skin care creams [cosmetic]; cosmetic creams; skin whitening creams; hair spray; nail polish; cosmetic masks; potpourris [fragrances]; mint for perfumery; almond milk for cosmetic purposes; facial cleansing milk; cleansing milk for toilet purposes; soaps; perfumed soaps; perfumed soaps; antiperspirant soap; toilet soap; cosmetic soaps; soaps and gels; liquid bath soaps; soaps for body care; soap for foot perspiration; deodorant soap; shaving soap; almond soap; nail art stickers; hair nourishers; conditioning preparations for the hair; hair conditioners for babies; jasmine oil; lavender oil; gaultheria oil; almond oil; bergamot oil; rose oil; oils for hair conditioning; peppermint oil [perfumery]; cuticle oil; hair fixing oil; oils for cosmetic purposes; oils for perfumes and scents; oils for perfumes and scents; essential oils; essential oils for personal use; oils for cosmetic purposes; cedarwood (essential oils of -); oils for toilet purposes; cosmetic pencils; breath freshening strips; teeth whitening strips; shoe polish; musk [perfumery]; eye-washes, not for medical purposes; liquid latex body paint for cosmetic purposes; hair lotion; mouthwashes, not for medical purposes; mouthwashes, not for medical purposes; vaginal washes for personal sanitary or deodorant purposes; after-shave preparations; lipstick; pomades for cosmetic purposes; dentures (preparations for cleaning -); make-up removing preparations; eye make-up remover; depilatory preparations; hair removal and shaving preparations; douching preparations for personal sanitary or deodorant purposes [toiletries]; bath preparations; baths (cosmetic preparations for -); bath preparations, not for medical purposes; hair waving preparations; shining preparations [polish]; fumigation preparations [perfumes]; nail care preparations; skin, eye and nail care preparations; refurbishing preparations; denture polishes; hair straightening preparations; sun blocking preparations [cosmetics]; tanning preparations; phytocosmetic preparations; collagen preparations for cosmetic purposes; cosmetic preparations for bath and shower; cosmetic preparations for slimming purposes; breath freshening preparations for personal hygiene; astringents for cosmetic purposes; toiletries; perfumed lotions [toilet preparations]; non-medicated cosmetics and toiletry preparations; perfumed body lotions [toilet preparations]; perfumery; perfumery, essential oils; face powder; eyelashes (false -); bath salts, not for medical purposes; shampoo; dry shampoos; body shampoos; shampoos for pets [non-medicated grooming preparations]; baby shampoo; shampoo bars; shampoos for personal use; false nails; artificial nails for cosmetic purposes; cleansers for intimate personal hygiene purposes, non-medicated; dentifrices; dentifrices and mouthwashes; air

fragrancing preparations; massage candles for cosmetic purposes; talcum powder, for toilet use; mascara; long lash mascaras; petroleum jelly for cosmetic purposes; toilet water; cologne impregnated disposable wipes; lavender water; perfume water; toilet water; floral water; micellar water; javelle water; hydrogen peroxide for cosmetic purposes; moustache wax; cosmetic kits; nail varnish removers; nail varnish remover [cosmetics]; nail polish remover pens; hair gel; shaving gel; make-up removing gels; styling gels; dental bleaching gels; gels for cosmetic use; gels for fixing hair; massage gels, other than for medical purposes and gel eye patches for cosmetic purposes" (hereinafter referred to the "Applicant's Goods") on the following grounds: -

1. The Opponent, based in India, is the owner of the world-renowned company **PREM HENNA PVT LTD**, an innovative and diversified global supplier of quality *Henna, Henna products, hair color, hair dyes, cosmetic dyes, hair care products, soap, lotions, hand sanitizer, hand wash, face creams, lip balms, cosmetics and cleansing agents for hands.*
2. That, the Opponent along with his brothers is engaged in the business of manufacturing and marketing of various products since 1998 and has an established manufacturing unit of *henna powder, henna paste, hair dye, hair color, skin care preparations, hair care preparations, hair oils, cosmetics, depilatory preparations, ayurvedic and medicated preparations, pharmaceutical preparations etc.* and then, in the year 2005 to distinguish its products and its identity from others, the Opponent's brother, Mr. Chutram Nemaram Gehlot, had adopted various trademarks for various products and businesses including the trademark "**YUTIKA**" and had been continuously and uninterruptedly using the well-known mark "**YUTIKA**" which has been adopted since the year 2009.
3. Due to extraordinary efforts, hard work and dedication, the Opponent's business has multiplied. Therefore, the Opponent established a company called "PREM HENNA PVT LTD." in 2012, wherein the Opponent is acting as Promoter, Director and Shareholder. Currently, the company uses the trademark belonging to the Opponent as to the basis for worldwide licensing for the products, including class 3 and other classes. Due to the significant growth in the Opponent's business, in 2018 the Opponent along with other brothers has incorporated a company by the name of "**YUTIKA NATURAL PVT LTD**" and the same company is using the Trademark openly, continuously and uninterruptedly in the market. The use of the said mark by the abovementioned companies is deemed to be used by the Opponent only. That the Opponent's company is manufacturing, marketing, distributing, trading, and exporting products under the mark "**YUTIKA**" and its

variants”.

4. The Opponent is the subsequent proprietor of the trademark **“YUTIKA”** by virtue of the Deed of Assignment executed in favour of the Opponent by his elder brother. Thus, the Opponent is the proprietor of the trademark **“YUTIKA”**, which has been adopted since the year 2009 by the predecessors of the Opponent. The adoption of the Opponent’s predecessor is to be construed as adoption by the Opponent.
5. The Opponent has built up a large international distribution network for its goods, placing the Opponent among the top manufacturers and marketers of the Opponent’s goods worldwide.
6. In Malaysia, the Opponent is the common law owner and registered proprietor of **“YUTIKA”** with a trademark registration no.: TM2020027980 in Class 3 since the year 2020. Further, as a result of long, extensive and continuous use of the mark **“YUTIKA”** in Malaysia, the mark **“YUTIKA”** has acquired well-known mark protection and is therefore entitled to the exclusive use of the same to the exclusion of all others.
7. The mark **“YUTIKA”** of the Opponent has been registered with the Indian Trademark Office since the year 2009, and its concurrent use for the past 14 years has resulted in the mark **“YUTIKA”** being well-known and rooted in the minds of consumers in India and countries all over the world including Malaysia. Below are the details of the Opponent’s registered marks in India, and these registrations are valid, subsisting and are in full force as of date: -

NO.	TRADEMARK	APPLICATION NO.	CLASS	APPLICATION DATE	STATUS
1	YUTIKA PHARMA	1827837	5	10-06-09	Registered
2	Yutika	2853795	3	02-12-14	Registered
3	YUTIKA	4518247	3	03-06-20	Registered
4	YUTIKA	4515508	3	31-05-20	Registered
5	YUTIKA	4522559	3	06-06-20	Registered
6	YUTIKA Selfcare Hand Wash Lemon	5066548	3	30-07-21	Registered
7	YUTIKA SevenForest	4289552	3	10-09-19	Registered

8	Yutika	2853797	5	02-12-14	Registered
9	YUTIKA NatureGreen	4321690	5	15-10-19	Registered
10	YUTIKA SevenForest	4322097	5	16-10-19	Registered
11	YUTIKA	4753583	7	23-11-20	Registered
12	YUTIKA	4760840	8	28-11-20	Registered
13	YUTIKA	4769223	12	05-12-20	Registered
14	YUTIKA	4770650	13	07-12-20	Registered
15	YUTIKA	4769944	14	06-12-20	Registered
16	YUTIKA	4782299	19	15-12-20	Registered
17	YUTIKA	4803644	20	01-01-21	Registered
18	YUTIKA	4820679	24	14-01-21	Registered
19	YUTIKA	4762829	25	30-11-20	Registered
20	YUTIKA	4823441	26	17-01-21	Registered
21	YUTIKA	4823471	28	17-01-21	Registered
22	YUTIKA	4824030	30	18-01-21	Registered
23	YUTIKA	4824056	32	18-01-21	Registered
24	YUTIKA	4825576	34	19-01-21	Registered
25	YUTIKA	4823598	38	17-01-21	Registered
26	YUTIKA	4833328	40	24-01-21	Registered
27	YUTIKA	4834149	42	25-01-21	Registered
28	YUTIKA	4986806	44	09-02-21	Registered

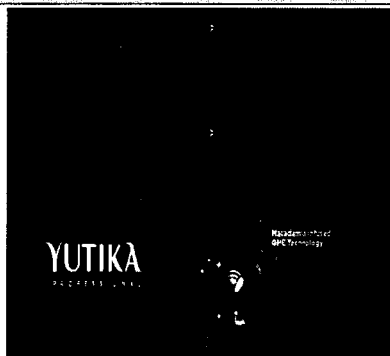
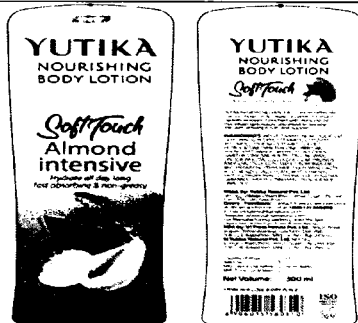
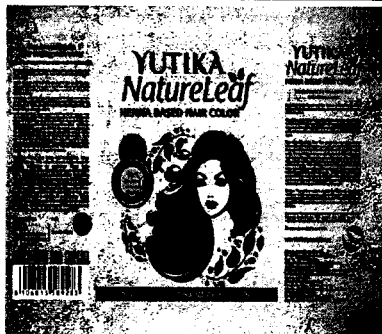
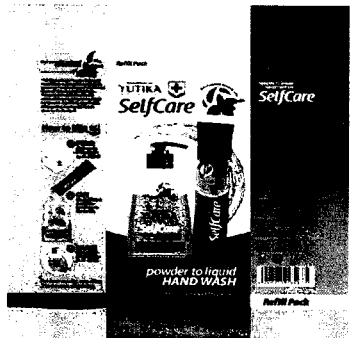
8. That the **Opponent** is exporting the said goods under the said trademark outside India. In order to export the goods under the said trademark, the **Opponent** has also acquired statutory protection in more than 30 countries and has applied for registration of trademark "**YUTIKA**" in more than 50 Countries and has got protection for the said trademark in various countries as given in the Table below. The ownership of all these registered marks is subsisting and is beyond dispute.
9. The Opponent is also a registered proprietor of the mark "**YUTIKA**", among others, in various countries worldwide, such as but not limited to Malaysia, Afghanistan, Bhutan, Myanmar, Hong Kong, China, United Kingdom, Vietnam, Nepal, Andorra, Australia, Burundi, Colombia, Denmark, Germany, Kenya, Lithuania, Morocco, Philippines, Maldives, Brunei Darussalam, Italy, Lichtenstein, Mauritius, Peru, Mongolia, Croatia, Moldova, Sweden, Iceland, Kazakhstan, Latvia, Armenia, Estonia, Chile, Mexico, Czechia, Spain, Romania, Ecuador, Poland, Bulgaria,

Albania, Costa Rica, Uruguay, Singapore, Danish, Cambodia, Indonesia, all included in Class 3 and Class 5 (hereinafter referred to as the "Opponent's goods"). The ownership of all these registered marks is subsisting and beyond dispute. Below are the details of the registered marks in the above-said countries: -

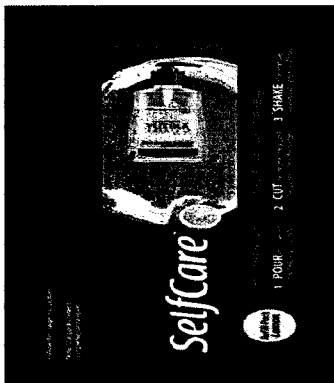
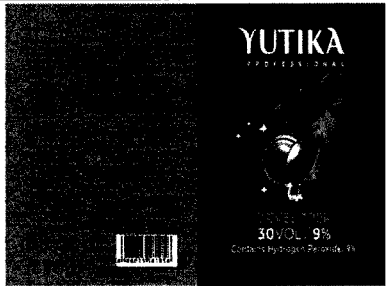


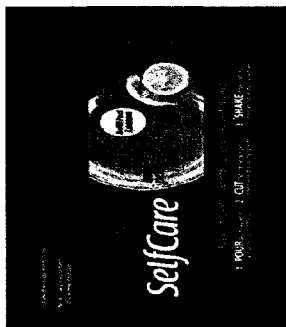
NO.	COUNTRY	MARK	APPLICATION/ REGISTRATION NO.	CLASS	DATE OF REGISTRATION
1	Afghanistan	YUTIKA	18121	3	02/05/2021
2	Afghanistan	YUTIKA Selfcare	24803	3	17/10/2021
3	Albania	YUTIKA	22599	3	27/04/2021
4	Algeria	YUTIKA	121095	3	20/04/2021
5	Andorra	YUTIKA	42453	3	23/04/2021
6	Armenia	YUTIKA	20211133	3	20/05/2021
7	Australia	YUTIKA	2120353	3	16/09/2020
8	BENELUX	YUTIKA	1443702	3	27/05/2021
9	Bhutan	YUTHIKA	BT/T/2015/8526	3	14/07/2016
10	Bhutan	YUTHIKA	BT/T/2015/8527	5	14/07/2016
11	Bhutan	YUTIKA Selfcare	BT/T/2021/9993	3	29/10/2021
12	Bolivia	YUTIKA	199078-C	3	14/04/2022
13	Brunei Darussalam	YUTIKA	51714	3	19/10/2020
14	Bulgaria	YUTIKA	2021162770N	3	18/05/2021
15	Burundi	YUTIKA	97081BI	3	07/07/2021
16	Cambodia	YUTIKA	KH/2021/84272	3	11/01/2021
17	Chile	YUTIKA	1358712	3	16/11/2021
18	China	YUTIKA	40901650	3	07/06/2021
19	Colombia	YUTIKA	688557	3	17/08/2021
20	Costa Rica	YUTIKA	302807	3	21/04/2021
21	Croatia	YUTIKA	Z20210588	3	19/04/2021
22	Czechia	YUTIKA	388500	3, 5	03/11/2021
23	Denmark	YUTIKA	VR 2021 00947	3	18/01/2021
24	Ecuador	YUTIKA	SENADI_2022_TI_2424	3	19/01/2022
25	El Salvador	YUTIKA	155845	3	12/10/2021
26	Estonia	YUTIKA	60435	3	06/12/2021
27	Germany	YUTIKA	30 2021 106 799	3	06/07/2021
28	Hong Kong	YUTIKA	305462604	3	13/04/2021

29	Hungary	YUTIKA	236 634	3	13/12/2021
30	Iceland	YUIKA	V0121787	3	31/05/2021
31	Indonesia	YUTIKA	IDM000943573	3	07/01/2021
32	Italy	YUTIKA	302020000086638	3	12/10/2020
33	Kazakhstan	YUTIKA	102056	3	22/04/2021
34	Kenya	YUTIKA	115308	3	22/12/2020
35	Latvia	YUTIKA	M 77 217	3	20/12/2021
36	Liechtenstein	YUTIKA	19615	3	22/09/2021
37	Lithuania	YUTIKA	84333	3	13/07/2021
38	Malaysia	YUTIKA	TM2020027980	3	24/11/2020
39	Mauritius	YUTIKA	30491/2021	3	18/11/2020
40	Mexico	YUTIKA	2279044	3	26/07/2021
41	Moldova	YUTIKA	35604	3	18/09/2021
42	Mongolia	YUTIKA	40-0023991	3	03/11/2020
43	Morocco	YUTIKA	224972	3	02/03/2021
44	Nepal	YUTHIKA	2015/059128	5	23/02/2018
45	Nepal	YUTHIKA	2015/059129	3	23/02/2018
46	Paraguay	YUTIKA	2021-531197	3	25/10/2021
47	Peru	YUTIKA	312128	3	20/07/2021
48	Philippines	YUTIKA	4/2021/00501546	3	21/01/2021
49	Poland	YUTIKA	349440	3, 5	10/06/2021
50	Romania	YUTIKA	179225	3	16/02/2022
51	Singapore	YUTIKA	40202104239W	3	22/02/2021
52	Spain	YUTIKA	4.119.450	3	26/04/2021
53	Sweden	YUTIKA	2021/04760	3, 5	11/11/2021
54	Turkey	YUTIKA	2021 034087	3	02/03/2021
55	UK	YUTIKA	UK00003560792	3	26/11/2020
56	Uruguay	YUTIKA	521748	3	26/02/2021
57	Vietnam	YUTHIKA	292985	5	21/12/2017

10. That, in addition to the Mark Registration, the Opponent is also the owner of the copyright of the painting consisting and/or containing the brand "**YUTIKA**" which are registered under The Indian Copyright Act, 1957: -

NO.	REGISTRATION NO.	COPYRIGHT NAME	ARTWORK
1	A-139177/2021	YUTIKA- PROFESSIONAL CREME HAIR COLOR	
2	A-137795/2021	YUTIKA-NOURISHING BODY LOTION SOFT TOUCH- ALMOND INTENSIVE	
3	A-139665/2021	YUTIKA - NATURELEAF	
4	A-139680/2021	YUTIKA- SELFCARE- POWDER TO LIQUID HAND WASH- NEEM & TULSI	

5	A-139855/2021	YUTIKA SELF CARE POWDER TO LIQUID HAND WASH-NEEM & TULSI	
6	A-139935/2021	YUTIKA-SELF CARE- LEMON POWDER TO LIQUID	
7	A-139739/2021	YUTIKA SOFT TOUCH- ALMOND INTENSIVE	
8	A-139738/2021	YUTIKA- SELF CARE- POWDER TO LIQUID HAND WASH- NEEM & TULSI	
9	A-139735/2021	YUTIKA- SELF CARE - POWDER TO LIQUID HAND WASH- NEEM & TULSI	

10	A-139663/2021	YUTIKA- SELF CARE- LEMON POWDER TO LIQUID HANDWASH	
11	A-139238/2021	YUTIKA-DEVELOPER	
12	A-139730/2021	YUTIKA- SELF CARE- POWDER TO LIQUID HANDWASH -LEMON	
13	A-140156/2021	YUTIKA NATURALS SELF CARE NEW POWDER TO LIQUID HAND WASH REFILL PACK - PRACTICE GOOD HYGIENE	
14	A-140149/2021	YUTIKA NATURALS SELF CARE NEW POWDER TO LIQUID HAND WASH - REFILL PACK - LEMON	

15	A-140150/2021	YUTIKA NATURALS - SELF CARE NEW POWDER TO LIQUID HAND WASH REFILL PACK - NEEM & TULSI	
16	A-140151/2021	YUTIKA NATURALS SELF CARE - POWDER TO LIQUID HAND WASH REFILL	

11. The Opponent has built up a large international distribution network for its goods, placing the Opponent among the top manufacturers and marketers of the Opponent's goods worldwide. The Opponent distributes the Opponent's Goods to more than 50 countries worldwide. In Malaysia, the Opponent began to market the Opponent's Goods bearing the Opponent's Marks in the year 2020 in various trade channels and platforms.
12. The Opponent is the registered proprietor of the Opponent's Mark and has used the Opponent's Mark with respect to the goods for an extensive period of time worldwide. The Opponent has expended significant effort marketing the Opponent's goods through advertisements and promotional undertakings which results in the public and traders easily identifying the Opponent's goods, marks, and their origin.
13. In addition, the Opponent has and continues to expend large sums of money to promote and advertise "**YUTIKA**" and its other brands through various digital and media platforms, aside from actively participating in well-known exhibitions globally including Malaysia. The table below shows the social media channels that have been used to promote Opponent's goods bearing the mark "**YUTIKA**". The table below shows the media channels that have been used to promote the Opponent's Mark:

SOCIAL MEDIA PROMOTION CHANNELS	WEBLINK
Website Prem Henna (Corporate & Brands)	http://www.premhenna.com
Social networking site Facebook (Corporate & Brands)	https://www.facebook.com/premhen na/
Video sharing site YouTube (Corporate & Brands)	https://www.youtube.com/user/pre mhenna
Video sharing site YouTube (Henna in Costa Rica)	https://www.youtube.com/channel/U CvxfQjlvXr9VmSGjckBCWng
Professional website LinkedIn (Corporate & Brands)	https://www.linkedin.com/in/premhe nna/
Picture sharing website Pinterest (Corporate & Brands)	https://www.pinterest.com/premhen na/
Nepal	https://www.facebook.com/Yutika-Natural-Nepal-777018465835266
Peru	https://www.facebook.com/Yutika-Natural-Peru-134813400476840
Brazil	https://www.facebook.com/Yutika-Natural-Brazil-122551731730738
Madagascar	https://www.facebook.com/Yutika-Natural-Madagascar-132953944035925
Myanmar	https://www.facebook.com/Yutika-Natural-Myanmar-1530476833699892

14. As a consequence of the extensive use and advertising of the Opponent's Mark **"YUTIKA"** and its variants, in respect of the Opponent's goods, the Opponent has acquired tremendous goodwill and reputation over the Opponent's Marks as a well-known mark with respect to these goods worldwide. Such use has generated significant goodwill and reputation for the Opponent's goods, and as a result of the trade and purchasing public, when confronted with the Opponent's Marks, would relate it to the Opponent and no other trader.
15. The Opponent has created a product catalog that is specially created for marketing collateral that lists essential product details that helps buyers make a purchase decision. The Opponent has spent, incurred and invested a sufficient amount of

money, labour, skill, time, energy and expertise in establishing products under the said trademark in the market and now enjoys exclusivity. The products bearing the said trademark are also been sold via online shopping websites which makes the said trademark more accessible and known to the Indian and Global public.

16. In addition, the Opponent has carried out a lot of publicity and promotion of **"YUTIKA"** products around the world, including actively participating in the well-known exhibition and spending high costs for advertising on print publications. As a consequence of the extensive use and advertising of the Opponent's Mark **"YUTIKA"** and its variants", in respect of the Opponent's goods, the Opponent has acquired tremendous goodwill and reputation over the Opponent's Marks as well-known respect to these goods worldwide. Such use has generated significant goodwill and reputation to the Opponent's goods, and as a result of the trade and purchasing public, when confronted with the Opponent's Marks, would relate it to the Opponent and no other trader.
17. In the past several years, the sales of Opponent's products have grown rapidly and have built an enviable reputation in the market. The turnover of the company is as follows and there is a tremendous demand for the products under the said trademark **"YUTIKA"** which is evident from the sales figures of the trademark as mentioned herein in the table below.

YEAR	USER DETAILS	TOTAL TURNOVER	CONVERTED IN USD @ INR 78
2009-2017	Use of assignor shall be deemed to be used by Assignee	-	
2018-2019	Total turnover of YUTIKA NATURAL PVT LTD	18,30,70,622/-	23,47,059.26
2019-2020	Total turnover of YUTIKA NATURAL PVT LTD	1,83,28,97,594/-	2,42,67,917.87
2020-2021	Turnover of YUTIKA brand	3,78,19,455/-	4,84,864.80
2021-2022 31.01.2022	Turnover of YUTIKA brand	9,13,20,295/-	11,70,773.012

18. Pursuant to the above, the Opponent's Marks are deemed to be well known in Malaysia under Sections 34(2)(c)(ii) and 34(2)(a) in conjunction with Section 24(3)(b) TA 2019, primarily because the Opponent's Goods are widely available

for purchase and use by consumers in Malaysia.

19. The Applicant's Mark, TM Application No.: TM2021028509, was applied for by the Applicant on 2 March 2021 in Class 3 and Class 4 with respect to the Applicant's goods as aforementioned.
20. The Application of the Applicant's Mark is opposed by the Opponent herein for the following reasons: -
- a) The Applicant's Mark and the Opponent's Marks are structurally, visually and phonetically identical and/or confusingly similar, with respect to the use of the word "**UTIQUE**", which is taken, borrowed, and derived from the Opponent's Marks, "**YUTIKA**". The three alphabets of the Opponent's Mark "**U, T, I**" are intentionally copied, and the alphabet "**Y**" is removed at the beginning of the Applicant's word, and the alphabets "**K, A**" in the Opponent's Mark are substituted with additional alphabets "**Q, U, E**" at the end of the Applicant's word, in which when pronounced, the combination of the five last vowels "**-TIQUE**" is aurally identical to the Opponent's Mark, "**-TIK-**". Furthermore, the first alphabet "**U**" in the Applicant's Mark is aurally identical to the Opponent's Mark, "**YU**" (-u:) when pronounced. Overall, the phonetic impression of both the mark is similar as the sound of YU and U is the same and also the sound of **TIK** and **TIQUE** is the same, hence the average consumer obviously confuses with the Applicants mark as the mark of the Opponent.

OPPONENT'S MARKS	APPLICANT'S MARK
YU	U
TIK	TIQUE

- b) The alphabet "**Y**" at the beginning of the Opponent's word mark when removed results in "**UTIKA**", which has high visual similarity to the Applicant's Mark of "**UTIQUE**". As such, the arrangement in "**YUTIKA**" and "**UTIQUE**" causes the marks to look identical, virtually similar and associated with one another. It merely shows that the Mark has a different spelling compared to the Mark "**YUTIKA**", but in fact, both "**YUTIKA**" and "**UTIQUE**" are confusingly similar and highly identical and aurally identical.
- c) Aurally, the Applicant's Mark is identical to the Opponent's Mark and when

paired with the identity of the goods, will result in public confusion because consumers tend to call a brand by its name. The Opponent is a well-known mark that has been actively engaging in promoting and advertising “**YUTIKA**” mark through various digital and media platforms. If a reference is made via a digital audio platform such as a radio channel or online radio, the reference will rely entirely on the pronunciation of the mark, therefore when it comes to two aurally identical marks, the public shall be confused, and mistake the Applicant's mark as associated, linked or belonging to the Opponent. This is not an intended result when marketing to promote one's mark and it will prejudice the Opponent. The arrangement and visual resemblances which result in an identical aural comparison and confusing visual similarity are shown below: -

OPPONENT'S MARK	APPLICANT'S MARK
YUTIKA	UTIQUE

- d) The Opponent's Mark is well known in Malaysia and has imprinted on the minds of the Malaysian public. The public would be confused and/or deceived into believing that the Applicant's goods originate from the Opponent's members, or that the Applicant is in some way associated, related or endorsed by the Opponent because the average consumer has an imperfect recollection and would normally perceive a mark as a whole and does not proceed to analyse its various details and the average consumer only rarely has the chance to make a direct comparison between the marks. As a consequence of this imperfect recollection, the highly identical pronunciation, identical prefix of the Opponent's “**YUTI**” and the Applicant's “**UTI**” and the Opponent's “**-TIK**” and Applicant's “**-TIQUE**”, and the overall aural and visual similarity between “**YUTIKA**” and “**UTIQUE**” is highly confusing to the average consumer and is indistinguishable to the public.
- e) Pursuant to the identical nature and the general impression of the marks, the public or trade, when faced with the Applicant's Mark will be confused with respect to the source or origin and will be confused into thinking that the Applicant's Mark originates from the Opponent or has any business relation through franchisee or association and that the use of the word “**UTIQUE**” is endorsed, permitted or authorised to be used by the Opponent.

- f) The Opponent claims exclusive rights for the copyright in **"YUTIKA"** under the Indian Copyrights Act 1957 and the Berne Convention with effect from the year 1975. Thus, the registration of the opposed mark would offend Section 24(4)(b) of the TA 2019, which compels the Registrar to refuse the registration of the Applicant's mark by virtue of an earlier right under the law of copyright. The law of copyright in Malaysia is governed by the Copyright Act 1987 and the Berne Convention to which Malaysia acceded in 1990. Thus, as a member of Berne Convention, Malaysia recognizes artistic works created in Malaysia or any other country which is a party to the Berne Convention including India. Therefore, with these exclusive rights under the law of copyright vested in the Opponent's mark, the Applicant's mark ought to be refused as its registration would be contrary to the law pursuant to Section 24(4)(b) of the TA 2019.

- g) The Applicant's Mark was applied for by the Applicant with the intent to usurp the Opponent's goodwill and reputation of a well-known mark, as it is evident that the wordings of **"UTIQUE"** are directly derived from **"YUTIKA"**. The Applicant, therefore without permission, authorization and endorsement of the Opponent, could not have been, and is not the *bona-fide* proprietor and originator of the Applicant's Mark. Further, it dilutes the value of the Opponent's Mark which is owned and widely used by the Opponent worldwide.

- h) The specification of goods filed under the Applicant's Mark includes goods in nature and/or similar to the Opponent's goods which are under the category of *"toiletries, personal care and cosmetic products"*. Therefore, both would undoubtedly share the same trade channels and targeted towards the same type of customers. Majority of the common products of the Opponent and Applicant are commonly sold and marketed in the health and beauty sections of pharmacy, drug and department stores.

- i) According to the Guidelines for Control of Cosmetic Products in Malaysia (1st Revision - February 2017), cosmetic products are defined as "any substance or preparation intended to be placed in contact with various external parts of the human body (epidermis, hair system, nails, lips and external genital organs) or with teeth and the mucous membranes of the oral cavity, with a view exclusively or mainly to cleaning them, perfuming them, changing their appearance and/or correcting body odors and/or protecting them or keeping them in good condition." Some examples of cosmetic products include body soap, facial cleansers and creams, sunscreens, toothpaste and mouth rinse,

hair shampoos and conditioners, hair dyes, perfumes and deodorants, and colour cosmetics including lipsticks, eye shadow, compact powder and nail polish.

- j) The examples of goods that are similar between both Opponent and Applicant are *essential oils, deodorants, toiletries, perfumes and scents, personal sanitarities, lotions, lip balm, face cream and soaps and personal hygienes*. There is a list of Opponent's registered marks in India, as stated in para 8 claiming protection for the goods of pharmaceuticals, cosmetics such as personal hygiene and skin care preparation. The proximity in relation to the nature of goods of interest and similar business activities of the Applicant and the Opponent would thus make confusion and deception unavoidable and inevitable, particularly against the Opponent's Marks as used for the Opponent's goods. Both the Opponent's Mark and the Applicant's Mark claim for cosmetics, personal care, skin care preparation and personal hygiene products will overlap resulting in confusion and deception to the public.
 - k) Further, the public and/or consumers would undoubtedly associate and/or view the Applicant's Mark to be a variant or sub-brand or goods of the Opponent. The unsuspecting trader and public would be confused and/or deceived into believing that the Applicant's goods originate from the Opponent's members, or that the Applicant is in some way associated, related or endorsed by the Opponent. There is a risk that if the application is allowed for registration, there is a chance that consumers will mistake Applicant's Mark as also referring to all other goods offered or manufactured by the Opponent. This leads to the dilution of a trademark in the trademark register as well as in the mind and eyes of the general public and thus the registration of the Applicant's Mark would be confusing and deceptive to the public.
 - l) Pursuant to all the above, registration of the Applicant's Mark is contrary to law and would offend the provisions of Section 23(5)(a), Section 24(2), Section 24 (3) and/or Section 34(2)(a) of the TA 2019.
21. Further, and/or alternatively and by reasons aforesaid, the Applicant has passed off its goods as for the Opponent's, for which the Opponent as the common law owner of the Opponent's Marks in various jurisdictions including Malaysia, has a legal basis to commence an action under the common law tort of passing off. On this ground, the Applicant's Mark ought to be refused registration and its registration would be contrary to the law and would not be entitled to protection by any court

of law pursuant to Section 34(2)(a) and Section 34(2)(c) of TA 2019.

22. In relation to the above, the use of the Applicant's Mark is calculated to deceive and cause confusion, particularly when the entire mark is derived from the Opponent's Mark. On this ground, the Applicant's Mark ought to be refused its registration as its registration would be contrary to the law pursuant to Section 24 (3)(b), Section 34(2)(a) and Section 34(2)(c) of TA 2019.
23. By reasons of the foregoing, the Applicant's Mark can never be considered as being capable of distinguishing the Applicant's goods from the goods of the Opponent. The Applicant's goods will always be wrongly associated with or connected with the Opponent so long as the Applicant's Mark is employed in relation to the Applicant's goods and contains the word "**UTIQUE**", and as a result, can never be deemed to be distinctive nor registrable. Further, the Applicant's Mark contains unregistrable elements because of the total incorporation and usurpation of the Opponent's Mark; the unregistrable element being a prior right by way of trademark registration and/or copyright over "**YUTIKA**". The registration of the Applicant's Mark would thus be contrary to the registrability provisions stipulated in Section 23(1) and Section 24(2) of TA 2019.
24. Further, and by reasons aforesaid, the Applicant is not entitled to claim to be the *bona-fide* proprietor and/or originator of, or to have exclusive use of the Applicant's Mark with respect to the goods applied for, particularly when the Applicant's Mark rightfully belongs to the Opponent and/or is obviously directly derived from the Opponent's Mark. As a result, its registration, if allowed, would be contrary to Section 17(1) TA 2019.
25. The Opponent's Mark is a well-known mark under Article 6bis of the Paris Convention, Article 16 of the TRIPS Agreement, and, Regulations 5 of the Trademarks Regulations 2019, and therefore is protected under Section 76 TA 2019. The Applicant's Mark ought to be refused registration pursuant to Section 24(2)(a) and Section 24(3)(b) TA 2019 by virtue of it being identical or so nearly resembling the Opponent's Mark for the goods filed for. The use of the Applicant's Mark in relation to the Applicant's goods would indicate a connection between the Applicant's goods and the Opponent's Marks, which are well-known, and the interests of the Opponent is likely to be damaged by such use.
26. Hence, it can also be established that there is an infringement by Applicant where Applicant was taking unfair advantage of Opponent's Mark since the Opponent is

the common law owner of the Opponent's Marks in various jurisdictions including Malaysia, a *bona-fide* proprietor of the mark, having its status and strength as a very well-known mark as a result of long, extensive and continuous usage, as evident in sales turnover figures laid down in the table mentioned para 19 herein.

27. The Opponent will further rely on other provisions of the Trademarks Act 2019 and the Trademarks Regulations 2019 not expressly mentioned herein to support the opposition.
28. The onus is on the Applicant to establish that the Applicant's Mark satisfies the requirements of the TA 2019 and that its registration will not contravene the provisions of the Act. The burden shall not be discharged as the registration of the Applicant's Mark not only prejudices the Opponent's legal rights and interests but will also be against the interest of the Malaysian public.

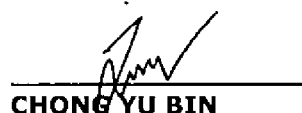
By reasons of the matters set forth above and by virtue of the law and the exercise of the Registrar's discretion, the Opponent prays that the Opposition is allowed and that the Applicant's Mark be refused registration with costs against the Applicant.

Dated this 7th November 2022.

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Yours faithfully,



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