

Ccode - 01
TM:kb:Vir:OPP- IN7095

SSL&S

SINGH & SINGH
LALL & SETHI

Dated: 20 December, 2016

The Registrar of Trade Marks
Baudhik Sampada Bhawan
Plot No.32, Sector-14, Dwarka
New Delhi-110075
India



TOP SECTION
By: Hand

Dear Sir,

Re: Opposition No. 869031 by Paypal Inc
-to-
Application No. 2424471- Trade Mark PAYTM in the Class 36 in the
name of One97 Communications Ltd.

We on behalf of our client Paypal Inc, the Opponent herein.

The Opponent respectfully submits to the learned Registrar that a Notice of Opposition against the subject mark was filed on November 18, 2016. The copy of the Notice of Opposition and filing receipt in this regard are attached as **Annexure A**.

It is brought to the kind attention of the Learned Registrar that the Notice of Opposition was filed online in colour, showcasing the two tone blue colour scheme of the Opponent, in a comparative with the impugned logo of the Applicant, in paragraph 10. The correct table showing the colour scheme mentioned under paragraph 10 of the Notice of Opposition which was filed on November 18, 2016 online is as follows:

Opponent's earlier trade mark	Applicant's impugned mark

Trade Marks Registry

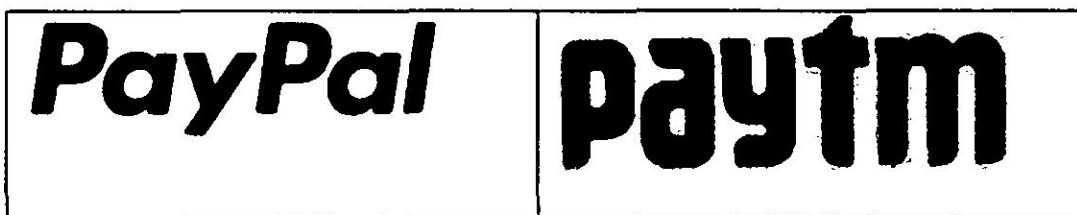
Dy. No. 596805

Date 20/12/2016

D-17, N.D.S.E. - II, New Delhi - 110 049 | Ph: 91-11-4289 9999 | Fax: 91-11- 4289 9900
E-Mail: info@IndiaIP.com | Internet: www.IndiaIP.com

20-Dec-2016/140571/596805/196

However, upon recently reviewing the Notice of Opposition available on the online records of the Trade Marks Registry, we note that there is a change in the two tone blue colour scheme of the Opponent's trade mark PAYPAL in paragraph 10. It appears to us that such change in the colour scheme is merely because of a technical glitch caused to the scanning of the Notice of Opposition in the Trade Marks Registry online records. Extract of paragraph 10 taken from the Notice of Opposition as uploaded in the Trade Marks Registry online records is as follows:



Such adoption and/ or use of the impugned mark is likely to cause confusion and deception amongst the members of trade and public in that they will mistakenly believe that the services under the impugned mark originate from the Opponent or that the Applicant is affiliated or connected with the Opponent, which is not the case. Further, such adoption and/or use of the impugned mark is likely to dilute the brand equity of the Opponent's earlier trade mark.

It is pertinent to mentioned that the representation of correct two tone blue colour scheme can be seen from paragraph 4 of the Notice of Opposition available online.

From the above, it is clear that the Notice of Opposition which has been uploaded by the Trade Marks Registry in its online records is incorrect.

It is hence brought to the kind attention of learned Registrar that the Notice of Opposition enclosed under Annexure A containing the aforesaid representations under Paragraph 10 is the correct document as filed by the Opponent.

We further request the Learned Registrar not to pass any adverse orders against the Opponent without giving us an opportunity of being heard.

Yours sincerely,


Karan Bajaj

Enrolment no . (D/4029/2010)
Singh & Singh Lall & Sethi

Encl: As above

SSI&S

SINGH & SINGH
LALL & SETHI

Ccode - 1
TM:kb:rsr:OPP- IN7095

Annexure "A"

Dated: 18 November 2016

The Registrar of Trade Marks
Baudhik Sampada bhawan
Plot No.32, Sector-14, Dwarka
New Delhi, Delhi : 110075
India

TOP SECTION

By: Online

Dear Sir,

Re: Opposition by PayPal Inc.
-to-
Application No. 2424471 - Trade Mark PAYTM in the Class 36
in the name of One97 Communications Ltd.

We, on behalf of our client PayPal Inc., of the address 2211 North First Street, San Jose, California – 95131 United States of America hereby give notice of our intention to oppose the registration of Application No. 2424471 in Class 36 for the trade mark PAYTM in the name of One97 Communications Ltd., advertised in Trade Marks Journal No. 1754 dated 18/07/2016 at page 4348, made available to public on 18/07/2016 at the office of the TMR. In this regard, please find enclosed our request on Form TM-5 (in duplicate) along with the requisite fee of Rs. 2,500. A copy of the Journal advertisement is enclosed herewith for ease of reference of the Learned Registrar. A copy of the Power of Attorney in our favour from the Opponent is also enclosed.

The learned Registrar is requested to take the above Notice of Opposition on record under intimation to us. The learned Registrar is further requested not to pass any orders against the Opponents without giving us an opportunity of being heard.

Yours faithfully,


Karan Bajaj

Enrolment no . (D/4029/2010)
Singh & Singh Lall & Sethi

Encl: Form TM-5 (in duplicate)
Official fee of Rs.2500/- Through Online dated 18 November 2016 drawn on
Standard Chartered Bank
Copy of the Journal advertisement
Copy of the Power of Attorney

D-17, South Extension-II, New Delhi – 110 049 | Ph: 91-11-4289 9999 | Fax: 91-11- 4289 9900
E-Mail: info@IndiaIP.com | Internet: www.IndiaIP.com

20-Dec-2016/140571/596805/196

THE TRADE MARKS ACT, 1999

Notice of Opposition to Application for registration of
a Trade Mark or a Collective mark or a certification mark
[Sections 21(1), 64, 66, 73, Rule 47(1), 131(1) and 138(1)]
(To be filed in duplicate)

IN THE MATTER OF Application No.
2424471 in class 36 for the Trade Mark
PAYTM in the name of ONE97
COMMUNICATIONS LTD.
and

IN THE MATTER OF Opposition thereto
by PayPal Inc.


We, PayPal Inc., of the address 2211 North First Street, San Jose, California - 95131 United States of America hereby give notice of our intention to oppose the registration of Application No. 2424471 ("Application") in Class 36 for the trade mark PAYTM in the name of One97 Communications Ltd. ("Applicant"), advertised in Trade Marks Journal No. 1754 dated July 18, 2016 at page 4348 made available to the public on July 18, 2016.

The grounds of opposition are as follows:

1. PayPal Inc., (hereinafter referred to as the Opponent and / or PayPal, which will be deemed to include predecessors, successors, parent company, subsidiaries, and affiliates) is global leader in online payment solutions. The company was founded in the year 1998, and began offering its services under the mark PAYPAL in 1999, and subsequently adopted the corporate name PayPal to align the corporate identity with its successful PAYPAL mark. PayPal has its address for service in India at Singh & Singh Lall & Sethi Advocates of the address D-17 South Extension Part II, New Delhi - 110049.
2. The Opponent is the proprietor of the well-known earlier trade mark PAYPAL. The Opponent first used the trade mark PAYPAL (hereinafter referred to as the 'earlier trade mark') in the year 1999 and since then has been using the same in various jurisdictions around the world, including India since as early as 2000

when PayPal registered its first customer accounts from India. PayPal enables global ecommerce by making payments possible across different locations, currencies, and languages.

3. The Opponent is the registered proprietor of the earlier trade mark and its formatives in India, particulars of which are as follows:

Trade Mark	Application Number	Application Date	Class	Goods./Services
PayPal 	1876573	26-Oct-09	9 & 42	<p>Class 9: Computer software for use in developing other computer software and software applications; computer software development tools</p> <p>Class 42: Design and development of computer software and application programming interfaces (API); providing information in the field of computer software and computer software design and development; technical support services, namely, troubleshooting of computer software problems.</p>
PAYPAL	1061614	21-Nov-01	16	Stationery, printed matter, instructional and teaching materials, relating to clearing and reconciling financial transactions via a global computer network, providing a wide variety of banking services and providing financial services, credit card services, processing and transmission of bill and payments thereof, and insurance for financial transactions.

PAYPAL	1239748	25-Sep-03	36	Clearing and reconciling financial transactions via a global computer network, providing a wide variety of payment services and providing financial services, namely credit card processing and transmission of bills and payments thereof, conducted via a global computer network.
<i>PayPal</i>	1239749	25-Sep-03	36	Clearing and reconciling financial transactions via a global computer network, providing a wide variety of payment services and providing financial services, namely credit card processing and transmission of bills and payments thereof, conducted via a global computer network included in class 36.
<i>PayPal</i>	1551434	19-Apr-07	9 & 36	Class 9: Computer software for processing electronic payments and transferring funds to and from others; authentication software that may be downloaded from a global computer network and/or recorded on computer media; magnetically encoded credit cards and payment cards; wired and wireless computer peripherals; mouse pads; computer security device, namely a non-predictable code calculator for accessing a host data bank computer Class 36: financial services, namely, enabling transfer of funds and purchase of products and services offered by others, all via electronic communications networks; clearing and reconciling financial transactions via electronic communications networks; providing a wide variety of payment and financial services,

				namely, credit card services, issuing credit cards and lines of credit, processing and transmission of bills and payments thereof, payment services, providing guaranteed payment delivery, and money market funds; financial services, namely providing financial fraud protection and prevention and dispute resolutions services.
--	--	--	--	--

The aforementioned registrations have been renewed from time to time and are valid and subsisting. By virtue thereof and by virtue of the provisions of the Trade Marks Act, 1999, the Opponent has exclusive rights to the use of the earlier trade mark and its formatives. Additionally, by virtue of the registrations and by virtue of the provisions of the Trade Marks Act, 1999, the registrations are conclusive as to their validity.

4. Further, the Opponent has been using the earlier trade mark in connection with its goods and services in a distinctive two-tone blue color scheme since 2007 as follows:

PayPal


5. In addition to the above, the earlier trade mark of the Opponent has been extensively used in several parts of the world, in particular Anguilla, Armenia, Aruba, Azerbaijan Republic, Albania, Algeria, Andorra, Antigua, Antilles, Argentina Benin, Bhutan, Bolivia, Brunei, Burkina Faso, Burundi, Barbuda, Bahamas, Bahrain, Barbados, Belize, Bermuda, Bosnia, Botswana, Bulgaria, Bissau, Caicos, Cambodia, Cape Verde, Chad, Chile, Cayman Islands, Colombia,

Czech Republic, Czech Republic, Costa Rica, Croatia, Cyprus, Comoros, Cook Islands, Democratic Republic of the Congo, Djibouti, Dominica, Dominican, Denmark, Eritrea, Ecuador, Ethiopia, El Salvador, Estonia, Falkland, Futuna Islands, Faroe Islands, Fiji, French, Finland, Gabon Republic, Guiana, Greece, Guadeloupe, Grenadines, Gambia, Guinea, Guyana, Gibraltar, Greenland, Grenada, Guatemala, Hungary, Indonesia, Iceland, Ireland, Jordan Malawi, Jan Mayan, Jamaica, Islands Kiribati, Kyrgyzstan, Kenya, Kuwait, Kazakhstan, Latvia, Lesotho, Liechtenstein, Lithuania, Laos, Luxembourg, Madagascar, Malta, Morocco, Mozambique, Maldives, Mayotte, Mali, Marshall Islands, Mauritania, Malaysia, Martinique Mauritius, Micronesia, Mongolia, Montserrat, Namibia, Nauru, Nepal, Netherlands, Nicaragua, Niger, Norway, Nevis, New Zealand Niue, New Guinea, New Caledonia, Norfolk Island, Oman, Philippines, Polynesia, Portugal, Papua, Pitcairn Islands, Palau, Panama, Peru, Qatar, Romania, Russia, Republic Honduras, Reunion, Republic of the Congo, Rwanda, Saint Pierre Miquelon, Saint Vincent, Slovakia, Saint Kitts South Korea, Sweden, Samoa, São, San Marino, Saudi Arabia, Seychelles, Slovenia, South Africa, St. Lucia, Senegal, Sierra Leone, Solomon Islands, Somalia, Sri Lanka, St. Helena, Suriname, Svalbard, Swaziland, Tomé Príncipe, Tajikistan, Trinidad Tobago, Turks Tanzania, Togo, Tonga, Tunisia, Turkmenistan, Tuvalu, Taiwan, Thailand, Uganda, Uruguay, Ukraine, United Arab Emirates, Venezuela, Vietnam, Vanuatu, Vatican City State, Virgin Islands (British), Wallis, Yemen and Zambia, and is a well-known trade mark in many of these countries, if not all.

6. The earlier trade mark of the Opponent mentioned above is known and recognized by the public at large, inter alia, by virtue of the promotion of the earlier trade mark through extensive advertising and publicity.
7. Furthermore, by virtue of extensive sales and sales promotion activities carried out by the Opponent world-wide, including India, the earlier trade mark is exclusively associated with the Opponent and the Opponent alone, and has

acquired an enviable reputation and goodwill. The earlier trade mark is a well-known trade mark in India and was a well-known trade mark on the date of filing of the impugned Application.

8. The earlier trade mark of the Opponent being a well-known trade mark defined under section 2 (1) (zg) of the Trade Marks Act, 1999, the same is entitled to enhanced protection granted to well-known trademarks under the Act.
9. The Opponent wishes to oppose the trade mark forming subject matter of Application No. 2424471 (hereinafter referred to as "impugned mark") inter alia in respect of all the services for which the Applicant is seeking registration.
10. The impugned mark sought by the Applicant is deceptively and confusingly similar to the Opponent's earlier trade mark inasmuch as the Applicant has slavishly adopted the two-tone blue colour scheme of the Opponent in its entirety. The first syllable in each mark is in dark blue color and the second syllable in a light blue color. Further, both marks begin with the term "PAY" which consumers tend to remember more than the second syllable, and the marks are of similar length. These similarities cause a likelihood of confusion in the aggregate, especially considering the fame of the Opponent's earlier trade mark. There is no reason for the applicant to adopt the identical colors and color scheme other than to take advantage of the reputation the Opponent has built up into this combination in connection with its popular services. The applicant could have chosen from a sheer endless variety of colors and color combinations. A representation of the marks is shown in the table below which clearly shows the intent of the Applicant to come closer to the fame of the Opponent's earlier trade mark to be able to ride upon the goodwill acquired by the Opponent.

Opponent's earlier trade mark	Applicant's impugned mark
	

PayPal

paytm

Such adoption and/ or use of the impugned mark is likely to cause confusion and deception amongst the members of trade and public in that they will mistakenly believe that the services under the impugned mark originate from the Opponent or that the Applicant is affiliated or connected with the Opponent, which is not the case. Further, such adoption and/or use of the impugned mark is likely to dilute the brand equity of the Opponent's earlier trade mark.

11. The Applicant is attempting to register a trade mark which is of such nature as to deceive the public and cause confusion. The registration of the impugned mark is therefore liable to be refused registration under the provisions of Section 9(2)(a) of the Trade Marks Act, 1999.
12. The impugned mark for which registration is sought by the Applicant is deceptively and confusingly similar to the earlier trade mark of the Opponent. Additionally, the services in respect of which registration is sought by the Applicant are identical to the services in respect of which the earlier trade mark of the Opponent is used and registered. There exists a likelihood of confusion on the part of the public which includes likelihood of association with the earlier trade mark. The registration of the impugned mark is accordingly liable to be refused under Section 11(1) of the Trade Marks Act, 1999.
13. The Application of the impugned mark is deceptively and confusingly similar to the earlier trade mark and the use of the same would without due cause take unfair advantage of and be detrimental to the distinctive character and repute of the earlier trade mark and is liable to be refused registration under Section 11(2) of the Trade Marks Act, 1999.

14. The use of the impugned mark for which the Applicant is seeking registration is liable to be prevented by virtue of the law of passing off and is liable to be refused registration under Section 11(3) of the Trade Marks Act, 1999.
15. The Opponent, in its capacity as the owner of the earlier trade mark does not wish to consent to the registration of the impugned trade mark, and has not done so, and the Applicant is therefore not entitled to rely upon Section 11(4) of the Trade Marks Act, 1999.
16. The adoption of the impugned mark by the Applicant is not honest and the Applicant cannot therefore claim to be the proprietor of the impugned mark and registration is therefore liable to be refused under Section 18(1) of the Trade Marks Act, 1999. The Applicant is not entitled to claim registration under Section 12.
17. The Applicant has filed the application on the basis of proposed user. The Applicant has neither used the mark nor has any intention to use the mark in the future. Refusal of the application is accordingly not likely to inconvenience the Applicant.
18. The adoption and use, if any, of the impugned mark by the Applicant being neither honest nor bona fide and the Applicant is therefore not entitled to claim registration under Section 11(10) of the Trade Marks Act, 1999.
19. The Applicant is not the proprietor of the impugned mark and the application is therefore contrary to the provisions of Section 18(1) of the Trade Marks Act, 1999.
20. The registration of the impugned mark in the name of the Applicant will be contrary to the provisions of Sections 9, 11 and 18 of the Trade Marks Act, 1999.
21. In view of the grounds set above, the Opponent prays that the Application under opposition be refused registration.

22. The Opponent also prays that the costs of the proceedings be awarded to the Opponent.

All communications in relation to these proceedings may be sent to the following address:

SINGH & SINGH LALL & SETHI
D-17, South Extension – II
New Delhi – 110049

Dated this the 18th day of November, 2016.

PayPal Inc.
by their Agents,



Karan Bajaj
Enrolment No. (D/4029/2010)
Singh & Singh Lall & Sethi

VERIFICATION

I, Karan Bajaj, verify that I am acquainted with the facts of the present case and state that the averments made in paragraph 1 to 7 are derived from the records of the Opponent and believed by me to be true and the averments made in paragraphs 8 to 20 are based on legal advice believed by me to be true and the averments made in paragraphs 21 and 22 are my humble submissions to the Learned Registrar.

Verified at New Delhi on this the 18th day of November, 2016.



(signature of the verifier)

To
The Registrar of Trade Marks
Office of the Trade Marks Registry
At: Delhi

paytm

2424471 07/11/2012

ONE97 COMMUNICATIONS LIMITED

FIRST FLOOR DEVIKA TOWER NEHRU PLACE NEW DELHI 110019

SERVICE PROVIDER

Address for service in India/Attorney address:

SIGMA LEGAL SERVICES LTD

487 KOHAT ENCLAVE PITAMPURA NEW DELHI

Proposed to be Used

DELHI

PROVIDES FINANCIAL SERVICES



भारत सरकार / GOVERNMENT OF INDIA
 व्यापार चिन्ह रजिस्ट्री / TRADE MARKS REGISTRY



The Trade Marks Registry, Boudhik Sampada Bhawan, Plot No. 32, Sector 14, Dwarka, New Delhi-110075

RECEIPT

PAGE No : 1

To,
 SINGH & SINGH LALL & SETHI
 D-17 SOUTH EXTENSION, PART-II, NEW DELHI 110049
 ATTORNEY : 16551 e-mail: trademarks@indiaip.com

RECEIPT NO : 1619900
 FILING DATE : 18/11/2016 18:37:44
 BRANCH NAME : DELHI
 USER : ssls

S.NO.	Form	Type	Application No	Class	No of Class	Ref No.	Party Type	Party Code	Party Name	Amount(Rs.)
1	TM-5	OPPOSITION	869028	41	1	2813333	Opponent	863670	INDEPENDENT NEWS SERVICE PVT. LTD	2500
2	TM-5	OPPOSITION	869029	41	1	2392016	Opponent	863670	INDEPENDENT NEWS SERVICE PVT. LTD	2500
3	TM-5	OPPOSITION	869030	35	1	2424472	Opponent	860140	PAYPAL INC.,	2500
4	TM-5	OPPOSITION	869031	36	1	2424471	Opponent	860140	PAYPAL INC.,	2500
Amount In Words			Ten Thousand						Total ₹	10000

Payment Mode : Bank Transfer

Transaction ID :

*Class 99 indicates As Multi class Application



*This is a computer generated receipt, hence no signature required.

*Please provide your email id with every form or document submitted to the Trademark Registry so that you may also receive acknowledgements and other documents by email.