

(2004) 12 IPAB CK 0002

In the Intellectual Property Appellate Board

Case No : Transferred Appeal No. 218/2004/TM/DEL (CM (M) 464/97)

Brij Mohan Sharma

APPELLANT

Vs

Milton Plastics

RESPONDENT

Date of Decision : 03-12-2004

Acts Referred:

Trade And Merchandise Marks Act, 1958 — Section 9, 11(a), 12(3), 18, 18(1)
Trade Marks Act, 1999 — Section 100

Citation : (2005) 31 PTC 693 (IPAB)

Hon'ble Judges : S. Jagadeesan, J;Raghubir Singh, J

Bench : Division Bench

Advocate : S.K. Bansal, Ajay Amitabh Suman, Amarjit Singh

Final Decision : Dismissed

Judgement

Raghubir Singh, J

1. CM (M) No. 464/97 has been transferred to this Board in terms of section 100 of the Trade Marks Act, 1999 from the High Court of Delhi and has

been numbered as TA/218/04/TM/DEL.

2. The appellant Shri Brij Mohan Sharma, Proprietor, Arun Electricals, appellant herein filed an application No. 483050-B for registration of trade

mark 'MILTON' in respect of goods being parts of electrical fittings, including electric switches, coil holders, plugs, coil adopters, electric connectors,

electric testers, electric bells and buzzers, iron and voltage stabilizers included in class 9. The same was ordered to be advertised before acceptance

and was accordingly advertised in Trade Marks Journal No. 1068 dated 1.12.1993 at page 954. The respondent herein M/s Milton Plastics gave notice

of their intention to oppose the registration on 1.3.1994. The appellant filed his counter statement on 8.9.1994.

3. The learned Assistant Registrar of Trade Marks held the hearing on 3.4.1997 and came to the following conclusion. He found that the matter

mainly related to Sections 9, 11(a) and 18(1) of the Trade and Merchandise Marks Act, 1958 (hereinafter referred to as the Act). The learned

Assistant Registrar was of the view that the impugned word 'MILTON' is a known surname and is inherently non-distinctive and also incapable of

distinguishing the goods of its proprietor from that of the goods of the other proprietors. In matter of acquired distinctiveness or the acquired capability

of distinguishing by user, he came to the conclusion that in the light of evidence submitted by the appellant, the mark is not qualified for registration.

The appellant in his affidavit has claimed that they had adopted the mark since 1.1.1985. The sale figures given in their affidavit are from the year

1986-87 to 1994-95. The earliest of the four photocopies of sale invoices submitted relate to 19.4.1986, the date of application being 21.12.1987. Such

a short period was taken to be not sufficient for imparting either the distinctiveness or capability of distinguishing to the goods.

4. In matter of his examination under Section 11(a) of the Act the Assistant Registrar came to the conclusion that the respondent's goods, namely,

domestic containers and the appellant's goods like electric bell, buzzers, electric iron are having trade connections. Relying upon the dictum of the

Hon'ble Supreme Court in Corn Products case, he came to the conclusion that the impugned word 'MILTON' is likely to deceive or cause confusion

amongst the consumers in view of the earlier use and reputation of the respondent. In view of the mark having not qualified under Sections 9 and

11(a) of the Act, he came to the conclusion that the right of proprietorship under Section 18(1) of the Act also fails. In view of the insufficient user of

the appellant he found that the impugned mark does not qualify for honest concurrent use under Section 12(3) of the Act.

5. The appellant in the appeal filed in the High Court of Delhi has claimed that they are continuously using the trade mark 'MILTON' since 1.1.1985.

The respondent never used the trade mark 'MILTON' in relation to electric items prior to 1.1.1985. Learned Assistant Registrar came to an erroneous

conclusion in matter of his examination under Sections 9, 11(a), 12(3) and 18(1) of the Act. Respondent in his reply rebutted the averments of the

appellant.

6. The appeal was taken up for consideration on 2.11.2004 in the sitting of the Board held at New Delhi. Learned counsel Shri S.K. Bansal appeared on behalf of the appellant and learned Counsel Shri Amarjit Singh appeared on behalf of the respondent.

7. Learned counsel for the appellant argued that the trade mark registrations No. 379531 and 460288 for the word 'MILTON' held by the respondent

are only in relation to the small domestic containers. Respondent had nowhere in his opposition in TM-5 filed before the Registrar had made a

mention that he is using the mark for electric food warmers being manufactured by them. It is only in the order of the Assistant Registrar that a

reference as to the use of the mark 'MILTON' in relation to electric food warmers is given. Thus, in view of the conflict between the pleadings and

the evidence, the benefits thereof should not accrue to the respondent. The learned Assistant Registrar could have only relied upon whatever was

there in the pleadings. He has put his reliance upon a plea which was not in the pleadings. Learned counsel put his reliance upon the observation of the

Supreme Court in *M/s. Trojan and Co. v. N.N. Nagappa Chettiar*, AIR 1953 SC 235 para 2 where the Apex Court had held that a decision of the

case cannot be based on grounds outside the pleadings of the parties and it is the case pleaded that has to be found. Without an amendment of the

plaint the Court was not entitled to grant the relief not asked for. He further put his reliance upon the *Gramophone Co. of India Limited v. Mars*

Recording Pvt. Ltd. and Anr., 2001 PTC 681 (SC,) para 10 wherein the Apex Court held that in absence of any pleadings or any record, the Court

cannot decide the matter on that score. In view of that, proper amendment of the pleadings is necessary. We have carefully examined the above

objections raised by the learned Counsel for the appellant with regard to the procedural aspect of the case. In both the cases referred to above the

issues relate to strict observance of the provisions of Code of Civil Procedure since the matters involved related to Civil Courts down below. The

Supreme Court has rightly made its observation for strict adherence of the rules of pleadings contained in the Code of Civil Procedure. The Registrar

of Trade Marks being a quasi-judicial institution created under the Trade and Merchandise Marks Act, 1958, is not strictly bound by the technical rules

of the Code of Civil Procedure. Thus, if something which comes in arguments to the notice of the Registrar, we find that there is nothing wrong in his

relying upon the same in his order in the larger interest of furthering the principles of natural justice. While arguing the case on merits, the learned

Counsel for the appellant observed that there are no trade connections between the goods for which the impugned trade mark is to be used and the

goods for which the respondent is holding its registrations. He relied upon the following case in support of his arguments. Vishnudas trading as

Vishnudas Kishendas v. Vazir Sultan Tobacco Co. Ltd., 1996 PTC (16) SC 512. The issue in this case relates to rectification of the Register where

the respondent company was only manufacturing cigarettes and was holding registration in broad classification relating to tobacco. It is worthwhile to

take note of the concluding observations of the Court wherein they have made it clear that they have not expressed any opinion on the claim of

registration of the trade mark 'CHARMINAR' in favour of the appellant for zarda and quiwam being manufactured by them. The issues involved in

that case are not relevant in the instant matter.

In United Brothers v. United Traders 1997 PTC (17) DEL PG. 603 the Court has specifically distinguished the goods of the petitioner from the goods

of the respondent and held that both are not allied or cognate goods.

In Roshan Lal Oil Mills Ltd. v. Assam Company Limited, 1996 PTC (16) DEL 69 the Court held that besides the goods being distinct the marks too

were visually dissimilar.

J. Lyons and Co. Ltd.'s Appln. for Rectification, (1959) RFC 120 (C.A). The case is not relevant in the instant matter. In this case the Register was

ordered to be rectified by excluding 'ice cream' from the goods for which the mark was registered as the proprietor admitted non user of the mark in

respect of ice cream. In the cases cited above, the Courts looking into the description of various products involved held them to be of dissimilar nature

and as such allowed registration of the impugned marks.

Learned counsel for the appellant tried to take support from The Procter and Gamble Co. v. Satish Patel, 1996 PTC (16) DEL 64 6 case which related

to passing of action wherein an injunction was sought against user of trade mark 'SAFEGUARD' since 1984 and an injunction through that suit was

sought in 1995. The petitioner did not raise any objection for full 11 years. Injunction was refused on this ground. We feel this case is of no hold to the

appellant where user is hardly little more than one year prior to the filing of

application for registration. Learned counsel tried to rely upon *Hindustan Pencils Pvt. Ltd. v. Prem Chand Gupta*, 1985 PTC 33 DEL where the petitioner and the respondent both were having registrations in relation to specific items of stationery and the petitioner filed rectification application against the respondent for removal of his registration from the Register. The issues involved in that case are not of much relevance in the instant matter.

8. Learned counsel for the respondent submitted that the crux of arguments by learned Counsel for the appellant is that the goods involved are different. Impugned application for registration was filed on 21.12.1987 and the user claimed is since 1.1.1985 and the appellant has been able to prove his user only since 19.4.1986. He argued that there are the same trade channels, same consumers and same trade connections in relation to both the goods. This fact has neither been denied nor challenged in the pleadings of the appellant. Even the evidence adduced in this regard remains un rebutted. There is complete identity of the marks. He relied upon the following observations of the Supreme Court in *Corn Products Refining Co. v. Shangrila Foods* AIR 1960 SC 142.

Where there are a "series" of marks, registered or unregistered, having a common feature or a common syllable, if the marks in the series are owned by different persons, this tends to assist the applicant for a mark containing the common feature. But before the applicant can seek to derive assistance for the success of his application for registration from the presence of a number of marks having one or more common features which occur in his mark also, he has to prove that these marks had acquired a reputation by user in the market.

On this score he argued that the appellant's claim miserably fails in relation to Section 11(a) of the Act. He further argued that the relevant date for the purpose of assessing distinctiveness of the mark being 21.12.1987 when the application was made, the appellant has miserably failed to support his claim for acquiring distinctiveness. He has been using the mark since 19.4.1986 only. Here the user is of 20 months only. The four invoices which have been adduced to prove the user till the date of filing of the application have only one out of those which relates to electric iron. Thus, the appellant has miserably failed to support his claim for qualifying under Section 9 of the Act. This fact has been taken note of by the Assistant

Registrar in arriving at his conclusions at page 9 of the impugned order. Besides relying upon the Corn Products Case, the learned Counsel for the respondent referred to SIA Gems and Jewellery Pvt. Ltd. v. SIA Fashion, 2003 (27) PTC 227 (Bom) wherein the said High Court held that the plaintiff selling jewellery under the trade name SIA and the defendants selling dress material and sarees in a shop bearing the name SIA shall lead to likelihood of confusion. It was held that the defendant's goods are cogent to plaintiffs goods and thus there is likelihood of causing damage to plaintiffs reputation. He put his reliance also upon Shamlal v. Parley Products, AIR 1967 Madras 117 where the said Court held that 'Pearl' was deceptively similar to the mark Tarle's' and was likely to cause confusion in the minds of public. In Kumar Electric Works v. Anuj Electronics, 1990 PTC 26 DEL, the High Court of Delhi held that the trade mark 'OLYMPUS' registered in respect of electric flat iron in the name of the plaintiffs attracts the case of infringement and passing-off for the use of the same mark by the defendant in respect of television sets.

9. We have carefully considered the contentions of both the counsel and find that with a view to qualify for registration for the purpose of section 9 of the Act the mark should be distinctive of the goods of the proprietor or if it is not distinctive it should be capable of distinguishing the goods of the proprietor from the other proprietor. It is sufficient to conclude that the use of hardly for 20 months prior to the filing of application for registration of the mark has no capacity to acquire distinctiveness. Further, the mark being a name or surname, is inherently non-distinctive and is thus not capable of distinguishing the goods of its proprietor from that of the goods of the other proprietor. It has to acquire distinctiveness over a long use with a view to be capable of distinguishing the goods. Whereas the respondent's mark 'MILTON' is in abundant use since 1971. Thus, the appellant miserably fails in his claim under Section 9 of the Act. In matter of scrutiny under Section 11(a) of the Act, the learned Counsel for the appellant marshalled many instances in supporting his claim. However, we find that much of them are either not relatable to the issues or in some of them, looking into the very character and nature of the marks and the description of goods for which they are being used, it has been held that the goods belong to different description and thus there is no likelihood of any confusion. The Vazir Sultan case is a land mark case in relation to rectification of the Register where

simply for the non-user of the mark for certain specific goods the rectification of the Register was done. However, while passing orders on this score, the Supreme Court has very clearly spelled out that they have not gone into the merits of the registration application of the plaintiff in relation to the products which they have ordered to be excluded from purview of category of tobacco for which the registration was held. Hence, the said judgment is of no hold to the appellant in the present case. To the contrary, there is a strong case to reach the conclusion that the requisite parameters required for qualifying under Section 9 of the Act are grossly lacking in view of the user of the mark being for a very limited period of 20 months and that too confined to a specific item relating to electrical goods, that is, electric iron. Similarly, there being the same consumers, same trade channels and same selling outlets for both the products and there being closer similarity amongst the goods, there is every likelihood of causing confusion to attract disqualification under Section 11(a) of the Act. Since the very distinctiveness-acquired or potential-is in jeopardy under Section 9 of the Act, the right of proprietorship under Section 18 of the Act cannot be made available. The honest concurrent use under Section 12(3) of the Act needs the use surely which has to be honest and concurrently but over a long period which is patently lacking in the present case.

10. In view of the above we feel that the Assistant Registrar of Trade Marks has rightly disallowed the registration and accepted the opposition.

Hence, the appeal is dismissed with no order as to costs.