
(1997) 11 DEL CK 0068

In the Delhi High Court

Case No : Civil Miscellaneous (Main) Appeal No. 571 of 1994

Conopco Inc.

APPELLANT

Vs

Banwari Lal

RESPONDENT

Date of Decision : 25-11-1997

Acts Referred:

Trade and Merchandise Marks Act, 1958 — Section 9

Citation : (1997) 6 AD 658 : (1998) 71 DLT 221 : (1997) 43 DRJ 674

Hon'ble Judges : Mohd. Shamim, J

Bench : Single Bench

Advocate : D.D. Singh and V.P. Ghiraya, for the Appellant;

Judgement

Mohammad Shamim, J.

(1) The petitioner through the present petition have taken exception to an order dated September 21, 1994 passed by the Deputy Registrar of Trade Marks whereby he accepted the application No. 433275 in Class 3 for the purposes of registration of the trade mark 'PONAS' and dismissed the objections filed by the petitioner vide opposition No. DI 7110.

(2) Brief facts which gave rise to the present petition are as under: M/s Cosmic Chemicals (India) c/o M/s Atul Trading Co., 248, Second Floor, Timber Bazar, Teliwara Sadar Bazar, Delhi (hereinafter referred to as the respondent for the sake of brevity) moved an application which was numbered as 433275 on February 1, 1985 for registration of trade mark 'PONAS' in Class 3 in respect of cosmetic goods being sold by them. The said application was advertised in the Trade Marks Journal No. 996 dated December 1, 1990 on page 987. The petitioner opposed the said application by filing opposition NO. DI 7110 on March 5, 1991 u/s 21 of the Trade and Merchandise Marks Act, 1958 (hereinafter referred to as the 'Act' in order to facilitate the reference. the petitioner filed evidence in support of their opposition by way of an affidavit of Mr. P. Sankar, Secretary of Pond's India Limited. It was alleged in the notice of opposition that

the petitioner are registered proprietor of registered trade mark 'Pond's' under No. 96629 in Class 3 dated May 22, 1944 in respect of a distillation or extract of hamamelis or witch hazel used as toilet preparation for the skin, tissues and muscles, cold cream, vanishing cream, liquefying cream, cream lotion, skin fresheners, face powders, lipsticks, tissue paper for toilet purposes, dry skin cream, rouge compacts and all other goods in Class 3. The above trade mark was advertised in Trade Marks Journal No. 50 dated October 1, 1957. The above said registration has been renewed from time to time and it is still valid and subsisting. The trade mark Pond's is being used for the last several years. The goods under the trade mark Pond's have been sold in large quantities throughout the world, including India. The said goods manufactured by the petitioner by reason of their excellent quality and volume of sales have gained enormous reputation with the trade and general public as a result whereof the said trade mark Pond's has become distinctive and is exclusively associated and identified with the goods manufactured by the petitioner. In case the trade mark applied by the respondent i.e. 'PONAS' is allowed to be registered the same would facilitate and lead to the passing off the goods of the respondent as that of the petitioner. Hence the registration of the said trade mark Ponas would be contrary to and inconsistent with the provisions of Sections 9, 11(a), 11(e), 12(1), 12(3), and 18(1) of the Act.

(3) The respondents filed their counter statement on May 4, 1994 where through they denied all the averments made in the notice of opposition. According to them, the respondents are the proprietors of the trade mark Ponas since October 1, 1980. They have been continuously using the same. On account of the continuous user the said trade mark has attained goodwill and reputation in the market. The impugned trade mark Ponas is neither deceptively similar nor structurally similar to that of the trade mark of the petitioner. Hence in case it is allowed to be registered the same would not be contrary to any of the provisions of the Act, adverted to above.

(4) Learned counsel for the petitioner Mr. D.D.Singh has vehemently assailed the legality and the validity of the impugned judgment and order dated September, 21, 1994, inter alia, on the following grounds: that the said judgment and order has been passed in utter disregard of the provisions of the Act i.e. Sections 9, 11(a), 11(e), 12(1), 12(3) and 18(1). The impugned trade mark i.e. Ponas is phonetically and structurally similar to the trade mark Pond's. Even the colour scheme and the floral design of the containers are the same. Thus there is every likelihood that the goods manufactured and belonging to the petitioner would be taken and treated by the innocent public i.e. the customers as the goods manufactured by the respondent and vice versa. Thus the trade mark in question proposed to be registered through the office of the Registrar is deceptively similar to the trade mark Pond's which is the registered trade mark of the petitioner. The learned lower Court ignored the evidence led by the petitioner through the affidavit of Mr. P.Sankar without any reason whatsoever once the same was allowed to be taken on record vide letter/order dated May 14, 1993.

(5) Learned counsel for the respondents Mr. Ghiraya on the other hand, has contended that the impugned trade mark Ponas is neither identical nor structurally similar to the trade mark of the petitioner. It is an altogether a different trade mark and there is no likelihood of deception through the said trade mark. Furthermore, the trade mark Ponas has been ordered to be registered for the purposes of Union Territory of Delhi vide the impugned order u/s 12(3) of the Act. The learned counsel further contends that once a discretion has been exercised by the Deputy Registrar of Trade Marks for registration of a particular trade mark u/s 12(3) of the Act the same cannot be interfered with by this Court unless it is shown that there was dishonest concurrent use of the said trade mark.

(6) It is manifest from the brief facts canvassed above that the respondent want the registration of their trade mark u/s 12(3) of the Act. Since the fate of the present petition hinges on an interpretation of the said Section it would be just and proper to make a reference to the said provision before proceeding any further in the matter. It is in the following words:

"12. Prohibition of registration of identical or deceptively similar trade marks. - (1) Save as provided in sub-section (3) no trade mark shall be registered in respect of any goods or description of goods which is identical with or deceptively similar to a trade mark which is already registered in the name of a different proprietor in respect of the same goods or description of goods. (2) (3) In case of honest concurrent use or of other special circumstances which, in the opinion of the Registrar, make it proper so to do, he may permit the registration by more than one proprietor of trade marks which are identical or nearly resemble each other (whether any such trade mark is already registered or not) in respect of the same goods or description of goods subject to such conditions and limitations, if any, as the Registrar may think fit to impose."

(7) It is amply clear from above that no trade mark can be registered which is identical or deceptively similar to the trade mark already registered in the name of a different proprietor in respect of the same goods or description of goods because the same is likely to deceive or cause confusion in the mind of purchasers (vide Section 11(a) of the Act). However, an exception to the above rule has been carved out vide Section 12(3) of the Act, reproduced above. Thus Section 12(3) empowers the Registrar to register a trade mark which is already in use by other proprietors relating to their goods even when it is identical to or nearly resembles a trade mark already registered in case it is shown that there was honest concurrent use or some other special circumstances which in the opinion of the Registrar make it proper to order the registration of the same.

(8) In view of the above a duty has been cast on the shoulders of the respondent herein to show for the registration of their trade mark Ponas in respect of their cosmetic goods under Sections 18A and 12(3) of the Act that the same is tantamount to concurrent honest user. The proprietor of the firm Shri Banwari Lal filed an affidavit on September 6, 1989 in support of their application for

registration of the above trade mark. According to him, the said trade mark Ponas is being continuously used in respect of his goods since 1980. His goods are being identified by the said trade mark as coming from a particular source. Thus it was prayed that the said trade mark be got registered u/s 12(3) of the Act.

(9) A Registrar u/s 12(3) of the Act can exercise his discretion to register a particular trademark only in those discerning few cases where it is shown that two or more parties have been using a similar or identical trade mark honestly without knowing that the said trade mark was being used by some other party for the sale of his goods of the same nature. In other words when they are unaware of the use of the said trade mark by each other.

(10) I am supported in my above view by the observations of a Single Judge of Bombay High Court reported in Consolidated Foods Corporation Vs. Brandon and Company Private Ltd., ,

..."The discretion under the section referred to by the two counsel can only be exercised where two or more parties unknown to each other and unaware of the mark used by each other innocently adopt and use the same mark in respect of their respective goods of the same nature. In this case, however, as I have found that the petitioner corporation was already the sole proprietor of the mark "Monarch" in respect of its food products in several countries of the world and its products were widely advertised in various American Magazines having a large circulation in different parts of the world including this country and in view of the fact that the petitioner corporation could have without importing any of its food products into this country bearing that mark applied for registration of that mark as proprietor thereof prior to 1951 before the respondent company started using that mark, it is difficult to hold that the respondent company had started using that mark quite innocently and without any knowledge on its part about the same being widely used by the petitioner corporation on its food products. On the facts of this case and also in the interest of business morality, it is impossible to exercise my discretion under sub-section (3) of Section 12 of the Act and order concurrent registration of the mark "Monarch" in favor both of the petitioner corporation and the respondent company."

(11) With the above background let us now try to find out as to whether the above ingredients exist in the present case so as to have authorised the Deputy Registrar to register the trade mark Ponas in favor of the respondent that the same was being used concurrently, honestly and without knowledge that a similar trade mark under the name Pond's was in use since long. The respondent for the best reasons known to them have not stated so in their evidence which has been led in the form of an affidavit sworn by Mr. Banwari Lal i.e. proprietor of the firm. They have also not stated so in their application for registration of the trade mark. In fact even the learned counsel for the respondent Mr. Ghiraya during the course of his arguments never claimed ignorance on the part of the respondent with regard to the trade mark Pond's in use by the petitioner in

respect of their cosmetic goods.

(12) Learned counsel for the petitioner Mr. D.D.Singh, on the other hand, has contended that the petitioner are the registered proprietor of the trade mark Pond's in respect of their cosmetic goods. They have entered into an agreement on June 23, 1977 with Conopco Inc. and as such they are entitled to use the trade mark Pond's for their cosmetic goods and other products. The said trade mark Pond's was initially got registered under No. 96629 dated May 22, 1944. It has been further urged for and on behalf of the petitioner that the impugned trade mark Ponas is nothing but a colourable imitation of the registered mark Pond's. In case the same is allowed to be registered in that eventuality it would cause not only irreparable pecuniary loss and damage but also a loss to their reputation and goodwill. The impugned trade mark is phonetically, visually and structurally similar to the trade mark Pond's.

(13) The above rival contentions advanced by learned counsel for both the parties raise a very important and crucial point with regard to the fact as to what is the meaning of the words 'deceptively similar' and how the Court will arrive at a correct conclusion in the teeth of the said controversy. For determination of the above points the Court will look at the two trade marks in order to find out: (a) as to whether they resemble one another phonetically, structurally and visually so as to cause confusion in the mind of the purchasers with regard to the goods of one party as belonging to the other party or vice versa; (b) the nature of the goods being sold by the petitioner and the opponent; (c) the channels where through the goods are being sold; (d) the class and the kind of the customers who purchase the said goods keeping in view their education and intelligence, and (e) other different surrounding circumstances.

(14) The above view was given vent to by Hon'ble Mr. Justice Parker in a case entitled The Platonist Company Ltd., as reported in (1906) 23 Rpc 774

"You must take the two words. You must Judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances: and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods - then you may refuse the registration, or rather you must, refuse the registration in that case."

(15) A situation very much akin to the situation in hand arose before the Hon'ble Supreme Court in Corn Products Refining Co. Vs. Shangrila Food Products Ltd., , when the Hon'ble Supreme Court was called upon to decide as to whether the trade mark Glucovita used in connection with biscuits was similar to the trade

mark Glucovita used with reference to glucose. It was observed

"Again, in deciding the question of similarity between the two marks we have to approach it from the point of view of a man of average intelligence and of imperfect recollection. To such a man the overall structural and phonetic similarity and the similarity of the idea in the two marks is reasonably likely to cause a confusion between them.....

(16) There is no reason why the test of trade connection between different goods should not apply where the competing marks closely resemble each other just as much as it applies where the competing marks are identical. Whether by applying these tests in a particular case the conclusion that there is likelihood of deception or confusion should be arrived at would depend on all the facts of the case.

(17) The respondent applied for registration of the mark Glucovita used with reference to biscuits manufactured by him. The appellant who had been using the registered mark "Glucovita" with reference to his glucose with vitamins opposed the application u/s 8(a). It was established that the appellants' trade mark had acquired a reputation among the buying public.

(18) Held applying the above tests that the commodities concerned were so connected as to make confusion or deception likely in view of the similarity of the two trade marks. Apart from the syllable "co" in the appellant's mark, the two marks were identical. That the syllable was not such as would enable the buyers in our country to distinguish the one mark from the other. Hence the respondents' mark could not be registered."

(19) The same view was also reiterated by a Single Judge of this Court as reported in *Essco Sanitations Vs. Mascot Industries (India)*, .

(20) Admittedly, in the instant case the respondent want their trade mark Ponas to be registered which can very safely be said to be similar or at least deceptively similar to the trade mark Pond's phonetically, structurally and visually inasmuch as there is only a difference of letter "a" i.e. the respondent have used in their trade mark "a" instead of letter "d" otherwise all the letters in the impugned trade mark are the same. Moreover, both the parties in the instant case are dealing in cosmetic goods. The goods of both the parties being cosmetic goods are to be sold through the same channels i.e. the shops and the counters. The customers of both the parties would be the same as those who want to deal in cosmetic goods or who want to have them for their day-to-day use in connection with their make up such as cream, powder, lipstick.

(21) There is another aspect of the matter. This Court had had an opportunity to examine the containers wherein the goods of both the parties are being sold and on a comparison of the same this Court found that the containers are of the same shape and size. The floral design and colour scheme on both the containers belonging to the rival parties are also same. Thus, there is nothing strange when

learned Counsel for the petitioner contends that in the case the impugned trade mark Ponas is allowed to be registered it would cause irreparable pecuniary loss, damage, as well as loss to the reputation of the petitioner.

(22) Learned counsel for the respondent has not challenged the fact that the petitioner are the prior user of the trade mark Pond's as they have been using the same since the year 1977 by virtue of the agreement (vide para 2 of the affidavit of Mr. P.Sankar). The respondent have started using the impugned trade mark since the year 1980 (vide para 3 of the affidavit of Shri Banwari Lal). The sale as shown in the said affidavit runs only into thousands (vide para 6 of the affidavit) whereas the sales of the cosmetic goods belonging to the petitioner run in crores. Furthermore the petitioner are spending crores of rupees per year on the advertisement of their goods (vide para 5 of the affidavit of Mr. P.Sankar). Thus, I am of the view that the petitioner have the priority both in the adoption and the user of the trade mark.

(23) A perusal of the affidavit sworn in by Mr. P. Sankar, Secretary, Pond's India Ltd., reveals that the products of Pond's India Ltd. are being advertised on a very wide scale including in newspapers, magazines, television and radio throughout the country. Some of the magazines have been placed on the file (vide paras 4, 5 and 6, of the affidavit). Thus it does not appeal to the reason that the respondent were not aware of the above said trade mark Pond's. However, the respondent have neither denied nor admitted the said fact through the affidavit of Shri Banwari Lal. They are silent on this fact. Thus, by no stretch of imagination it can be said that the respondent were not aware of the same and their concurrent user of the trade mark Ponas was not a dishonest one.

(24) Learned counsel for the respondent Mr. Ghiraya has then contended that the affidavit dated April 28, 1993 sworn in by Mr. P.Sankar is not even worth the paper on which it has been typed out inasmuch as the same has not been drafted in accordance with Order 19 Rule 1 of the Code of Civil Procedure. According to the learned Counsel it is a well recognised principle of law that in case an affidavit has not been properly verified the same cannot be looked into and is liable to be flung to the winds. The learned Counsel in support of his contention has led me through the observations of the Hon'ble Supreme Court as reported in A.K.K. Nambiar Vs. Union of India (UOI) and Another,

"The appellant filed an affidavit in support of the petition. Neither the petition nor the affidavit was verified. The affidavits which were filed in answer to the appellant's petition were also not verified. The reasons for verification of affidavits are to enable the Court to find out which facts can be said to be proved on the affidavit evidence of rival parties. Allegations may be true to knowledge or allegations may be true to information received from persons or allegations may be based on records. The importance of verification is to test the genuineness and authenticity of allegations and also to make the deponent responsible for allegations. In essence verification is required to enable the Court to find out as to whether it will be safe to act on such affidavit evidence.

(25) To the same effect also the opinion of the Single Judge of this Court as reported in *Sunder Industries and Others Vs. General Engineer Works*, .

(26) Learned counsel for the respondent Mr. Ghiraya In view of above contends that there is absolutely no verification in the instant case. Hence the affidavit filed by the petitioner herein sworn in by Mr. P.Sankar is absolutely of no avail to the petitioner. It is a trash and as such it should not be looked into and is liable to be ignored. Learned counsel for the petitioner has urged to the contrary, According to him, the provisions of the CPC are not applicable to the affidavits filed before the Registrar under the Act.

(27) I find myself in perfect agreement with the contention of the learned counsel for the petitioner. A perusal of Rule 116 of the Trade and Merchandise Marks Rules, 1959 reveals that it deals with the form of affidavits which are to be filed under the Act. It provides as under:-

"116. Form, etc., of Affidavits (1) The Affidavits required by the Act and the rules to be filed at the Trade Marks Registry or furnished to the Registrar, unless otherwise provided in the Second Schedule shall be headed in the matter or matters to which they relate, shall be drawn up in the first person, and shall be divided into paragraphs consecutively numbered; and each paragraph shall, as far as practicable, be confined to one subject. Every affidavit shall state the description and the true place of abode of the person making the same, shall bear the name and address of the person filing it and shall state on whose behalf it is filed."

(28) It is crystal clear from the relevant provision of law that Rule 116 deals with the particulars which are to be furnished and the form in which an affidavit is to be drawn which is proposed to be filed before the trade mark Registry. It is abundantly clear from above that verification of the affidavit as envisaged under Order 19 Rule 3 of the CPC is not required to be done in the case of affidavits which are to be filed under the Act. It would be noteworthy to mention over here that in case the contention of the learned counsel for the respondent is taken to be correct in that eventuality the affidavit filed by Shri Banwari Lal also cannot be looked into and is liable to be ignored inasmuch as it does not bear any verification. It has also been drawn up in the same manner and in the same way as that of the affidavit of Mr. P.Sankar, relied upon by the petitioner.

(29) The next contention raised for and on behalf of the respondent is that there is absolutely no evidence from the side of the petitioner as observed by the learned lower Court inasmuch as all the three applications dated March 1, 1993 for extension of time to lead evidence up to May 1, 1993 and the application dated July 5, 1993 (filed on July 7, 1993) to take on record the affidavit dated June 8, 1993 sworn in by Mr. Kenneth C.Leonard were dismissed as withdrawn vide order dated November 30, 1993. There is no dispute with the said order and with the said fact that all the three applications were got dismissed as withdrawn as per the statement of the learned Counsel for the petitioner before the Deputy

Registrar. However, the learned Counsel while so urging is oblivious of the fact that the prayer to lead evidence has already been allowed vide order dated May 14, 1993 passed by the Deputy Registrar. I am tempted here to cite the said order in extenso in support of my above view. The said order is in the form of a letter issued from the office of the Deputy Registrar addressed to M/s Remfry & Sagar, Remfry House, 3, Nangal Raya Business Centre, New Delhi. It is in the following words:-

"I am directed by the Deputy Registrar of Trade Marks to inform you that the evidence filed by you in support of Opposition/Application, has been taken on record."

(30) Thus, the evidence in the form of affidavit of Mr. P.Sankar dated April 28, 1993 was very much taken on record by the Deputy Registrar. Hence this Court feels that the Deputy Registrar fell into a grave error by ignoring the said affidavit and by observing that there was no evidence at all from the side of the petitioner in support of their case.

(31) In view of the above the petitioner are entitled to succeed. the petition is allowed with costs throughout assessed at Rs. 10, 000.00 . The impugned order dated September 21, 1994 passed by the Deputy Registrar of Trade Marks is hereby set aside. The application No. 433275 moved by respondent No. 1 for registration of the trade mark Ponas in Class 3 is hereby dismissed.