

(1994) 03 DEL CK 0067

In the Delhi High Court

Case No : Civil Miscellaneous (Main) Appeal No. 98 of 1993 and Civil Miscellaneous Appeal No. 464 of 1993

John Oakey and Mohan Ltd.

APPELLANT

Vs

Million Abrasives Pvt. Ltd. and Another

RESPONDENT

Date of Decision : 24-03-1994

Acts Referred:

Trade and Merchandise Marks Act, 1958 — Section 2(1)

Citation : AIR 1994 Delhi 288 : (1994) 29 DRJ 307

Hon'ble Judges : Usha Mehra, J

Bench : Single Bench

Advocate : K.G. Bansal and G.L. Rawal, for the Appellant;

Judgement

Usha Mehra, J.

(1) M/SJOHN Oakey & Mohan Ltd. felt aggrieved against the order of the Deputy Registrar of Trade Marks dated 3rd December, 1992, whereby his opposition was rejected/dismissed, hence challenged the same by this petition.

(2) In order to appreciate the objection of the petitioner against the impugned order, the brief facts which require consideration and which are relevant for proper adjudication of this petition are that the petitioner is dealing in the business of manufacturing coated and bonded abrasives under the trade name of "OAKEV s". The petitioner is the registered proprietor of his trade mark OAKEY"s with the device of globe which device is duly registered under the Trade and Merchandise Marks Act, 1958. He has been using this trade mark since the year 1972. He has acquired reputation in the market because of his high standard quality of products. His trade mark, according to him, has contained distinctive mark and is associated with the good quality of abrasives. The respondent No. 1 herein on account of the reputation and goodwill of the petitioner adopted identical and deceptively similar trade mark with the device of globe and has sought registration of the same. This registration had been opposed by the petitioner but by the impugned order, the respondent No. 2 dismissed the same

on the ground that the registration of the trade mark sought by respondent No. 1 is neither identical nor similar nor would deceive or cause confusion in the minds of the customers.

(3) The petitioner's main contention has been that the registration sought by the respondent No.1 of his trade mark falls within the prohibition of Section 12(1) of the Act. It does not qualify for registration u/s 9 of the Act. Moreover, if permitted it will deceive the customers because they will associate the product i.e. abrasive of the petitioner with that of the respondent No. 1. Moreover, respondent No. 1 is not the proprietor of the alleged trade mark. Therefore, registration cannot be granted in favor of respondent No. 1. On the other hand, the main thrust of the respondent No. 1's argument has been that he is not going to use the device of globe for his trade mark nor the work "OAKEY". The trade mark sought for registration has no device of globe at all. What has been sought by the respondent No.1 is an oval superimposed on his trade mark "MILLION". In fact the respondent No. 1 had been selling its products under the trade mark "MILLION" written in words as well as in numerical .The device of small oval superimposed on it and other placements are very insignificant in comparison to the trade mark "MILLION" used by the respondent No. 1. The word is "MILLION" and not the device of the globe which has been disclaimed.

(4) I have heard the learned counsel for the parties and perused the record. Admittedly, the products of the petitioner are sold under the trade mark Oakey with the device of globe. Whereas the trade mark which the respondent No. 1 wants to get registered is "MILLION" but not with the device of globe. The distinguishing feature as rightly observed in the impugned order is "OAKEY's" with the device of globe of the petitioner and "MILLION" with oval super imposed on it that is of the respondent No. 1. These features are absolutely distinct and dissimilar. Therefore, respondent No. 2, to my mind, rightly came to the conclusion that there is no likelihood of confusion amongst the buyers of this product nor the public or the purchaser can get deceived by the rival trade marks of respondent No. 1. I have also compared the rival trade marks, the perusal of the same shows that they are quite distinct and dissimilar. The dominating trade mark of respondent No. 1 is the work "MILLION" oval super imposed on it. The oval used by respondent No. 1 is not globe in shape and nor it is in round shape as that of the petitioner. Hence, by the existence of this oval shape super imposed on the trade mark "MILLION" it cannot by any stretch of imagination be called globe or devise of globe. There is no quarrel with the proposition contented by the petitioner that the trade mark is to be taken as a whole. It is only after taking the trade mark as a whole that one can come to the conclusion that there cannot be any deception if one keeps both the abrasive papers in front of him. The dominating and distinguishing feature in the petitioner's paper is the devise of globe, in the centre of which "OAKEY" word is written whereas in case of respondent No. 1, the dominating word is "MILLION" and not the device of the globe. Since, the proprietary right of device of globe is with the petitioner., it was for this reason that disclaimer was ordered. Disclaimer was not for the reason

that the trade mark of the respondent No. 1 has the device of globe. In fact it is on record that the respondent No. 1 had been using the trade mark "MILLION" for his order products for a long period and for this product i.e. abrasive paper he is using the trade mark "MILLION" for the last two months. Therefore, it cannot be said that since respondent No. 1 has started using the trade name "MILLION" for this product only for the last two months, hence he has no cause of action. This argument has no force, not the contention of the counsel for the petitioner that the device of globe forms material part of the respondent's trade mark has any merits. Though admittedly, the device of globe is a material part of petitioners registered trade mark but that is not so with the proposed trade mark of respondent No. 1. Respondent had partnership firm which was being run under the name and style of M/s Million Tapes Manufacturing Pvt. Ltd. It was in existence from 1963 to 1976. It was dealing in the business of wrappers and packages having the device of oval with figure and words "MILLION". Thus according to counsel for the respondent the respondent had been using this trade mark exclusively since 1963 with an offending device of oval and not globe.

(5) On comparison, even to the naked eye the proposed trade mark of the respondent No. 1 has no similarity with that of the petitioner. One can see the distinction between the registered trade mark of the petitioner and the trade mark proposed to be registered by respondent No. 1. The dominating feature of the petitioner's registered trade mark is a big globe in the centre of which is written the word "OAKEY's". The distinguishing mark ""OAKEY's" in the centre of the globe is a dominant device. Whereas in the case of the respondent No. 1 there is no globe nor the oval shape super imposed on the word "MILLION" is the dominant device. The dominating device is the word "MILLION" . Therefore, taking the trade mark as a whole one can safely come to the conclusion that the essential feature of the registered trade mark of the petitioner and the proposed registered trade mark of the respondent No. 1 are quite distinct and dissimilar. The small oval superimposed on the word "MILLION" makes it a composite trade mark different and distinct from that of the petitioner. The article abrasive is normally purchased in the market by the carpenters, masons and people of all classes who use this abrasive for giving finishing touch to their products. Even a layman or an illiterate person by mere look at these abrasive papers can tell that these two different trade marks are totally dissimilar to each other. It cannot be said that the proposed trade mark of the respondent No. 1. will deceive or cause confusion amongst the public and the purchaser of this product.

(6) For these reasons, I find no infirmity in the impugned order of the respondent No. 2. The petition is accordingly dismissed.