

(1994) 09 DEL CK 0063
In the Delhi High Court
Case No : O.C.J. No. 1 of 1994

John Oakey and Mohan Ltd.

APPELLANT

Vs

Million Abrasives Pvt. Ltd. and Another

RESPONDENT

Date of Decision : 28-09-1994

Acts Referred:

Trade and Merchandise Marks Act, 1958 — Section 21(5), 23

Citation : (1994) 31 DRJ 192

Hon'ble Judges : M. Jagannadha Rao, C.J;A.D. Singh, J

Bench : Division Bench

Advocate : S.K. Bansal, for the Appellant;

Final Decision : Dismissed

Judgement

M. Jagannadha Rao, C.J.—This appeal is preferred by the appellant u/s 109 (2) of the Trade and Merchandise Marks Act, 1958, against the order of the learned Single Judge dated 24.3.1994 John Oakey and Mohan Ltd. Vs. Million Abrasives Pvt. Ltd. and Another, confirming the order of the Deputy Registrar of Trade Marks (2nd respondent) dated 3.12.1992 and rejecting the opposition of the appellant for the registration of the trade mark of the 1st respondent.

2. On 26.12.1981 the 1st respondent filed application u/s 18(1) for registration of trade mark consisting of the word "Million", "numerals 1000000", device of "globe" (in fact elliptical) and other placements thereon in respect of emery paper, flint paper (abrasive paper) included in Class 3. Thereafter, the same was advertised for registration in Part B Register, subject to "disclaimer" u/s 18(4) of numeral 1000000 and device of the (elliptical) globe, in Trade Mark Journal No. 963 dated 16.7.1989. It may be noticed that u/s 18(4), the Registrar may, subject to the provisions of the Act, refuse the application or may accept it absolutely or subject to such amendments, modification, conditions or limitation, if any, as he may think fit.

3. On 18.9.1989 , the appellant, whose trade mark OAKEYS with device of globe

was registered in Class A of Register dated 19.7.1975, lodged the notice of their intention to oppose the registration of the trade mark on the grounds that (1) the appellant was manufacturing and marketing its goods and bonded abrasive under the "trade mark" "OAKEY"S written inside with device of GLOBE", since 1972 and goods of their mark are in heavy demand, (2) the trade mark applied for by the 1st respondent was neither "distinctive" nor capable of distinguishing and it may not satisfy the requirement of the Act as to registrability, (3) the goods of the 1st respondent are identical and/or goods of the same description as those of the appellant and (4) the registration of the mark applied for is contrary to the provisions of Section 11 (a) to (e), Section 12(1), 12(3) and 18(1) of the Act.

4. Thereafter, on 5.12.1990, the 1st respondent (the applicant for registration) lodged its rejoinder.

5. The Deputy Registrar received evidence of the appellant on 25.7.1991 as to user under Rule 53 by way of affidavit dated 31.5.1991 which was accompanied by a few letters and unattested invoices and advertisement cuttings. On 22.1.1992, the 1st respondent (applicant) filed evidence under Rule 54 before the Deputy Registrar and produced their original invoices etc. since 1.10.1981, as claimed in the advertisement. These originals were examined by the appellant's counsel. On 21.2.1992, the appellant filed evidence under Rule 55 in rebuttal. It was heard on 24.11.1992 and order was passed on 3.12.1992.

6. In his order, the Deputy Registrar held that the trade mark sought for the word "Million" with numerals "1000000" was distinct and in view of the condition as to "disclaimer" of the device "globe", there is not going to be any confusion or deception. Even without the globe, the word "Million" was distinctive. The applicant had proved proprietorship and prior user. Hence the trade mark of the word "Million" with numerals "1000000" could be registered. As the "globe" (in fact elliptical) has been disclaimed as per the advertisement notice dated 16.7.1989 u/s 18(4) which was conditional to the extent of disclaiming "globe"; he observed that :-

"...the essential or distinguishing feature of the impugned mark is the word "Million" (1000000) and not the device of globe which has been disclaimed."

Towards the end of the order, the Deputy Registrar clarified that while a "disclaimer" will not prevent any subsequent acquisition by user, the real purpose of "requiring" a disclaimer was to define the rights of the proprietor under the registration so as to minimise, even if it cannot wholly eliminate, the possibility of extravagant and unauthorised claims being made on the score of registration of the trade mark. The Registrar of Trade Marks Vs. Ashok Chandra Rakhit Ltd., . The registered proprietor cannot claim any trade mark rights under the Act in respect of the matter disclaimed, e.g. an action for infringement. His common law rights are, however, not affected and an action for passing off may still be successful (Section 17 proviso).

7. The Parker-Knoll Ltd's case (1962) R.P.C. 265 deals with the question as to when a trade mark can be treated as "deceptively similar". Here the respondent-applicant's globe (which is in fact oval or elliptical in nature) is disclaimed and Therefore respondent has no proprietary right over the so called "globe". Hence Parker-Knoll's case is not relevant in this action for registration subject to disclaimer.

8. It is a standard practice to require disclaimer of letters forming part of a device mark (Ford-Werke 1955 72 R.P.C. 196 and common to require it of descriptive pictorial matter such as a picture of the goods. In one case where the applicants' and opponents' labels included different representations of cat, the Registrar dismissed the opposition, the device of a cat being common to the trade but, the applicants being willing to disclaim the right to the exclusive use of a cat per se, he allowed the registration with that disclaimer. Afterwards, in the Court of Appeal, the decision of the Registrar on the main point was upheld, and the Court refused to interfere with the direction as to the disclaimer (Bagots Hutton [1915] 32 R.P.C. 333 (See Kerly's Law of Trade Marks and Trade Names 12th Ed, 1986 para 9.01). The effect of a disclaimer is that the proprietor of the registered trade mark cannot claim any trade mark rights under the Act, in respect of the parts of the mark to which the disclaimer relates (Pirie v. Goodall 1982 1 Ch. 35, so that, for instance, no action for infringement lies in respect of the use or imitation of the disclaimed particulars (ibid para 9.C4). But the statute provides that no disclaimer is to affect any rights of the proprietor of a trade mark except such as arise out of the registration of the trade mark in respect of which the disclaimer is made : the rights of action against passing-off, in particular. The corresponding statutory provision in England was meant to get over the decision of North, J refusing a passing-off injunction because the matter complained of had been disclaimed (Rosenthal v. Reynolds 1892 2. Ch. 301. The same principle was laid down by the Supreme Court in The Registrar of Trade Marks Vs. Ashok Chandra Rakhit Ltd., .

9. In the present case, the Deputy Registrar permitted the registration of the word "Million" with numerals "1000000" as distinct and in view of the "disclaimer" of the device "globe", there is not going to be any confusion or deception. It is true that the applicant-respondent called the disclaimed device a "globe" but, in fact, this device put by the respondent is oval shaped or elliptical in nature and is prima facie not deceptive. We do not also agree that the word "Million" with numerals "1000000" is not of distinctive nature, as contended.

10. The appellant has filed Suit No. 2539/90 seeking injunction against the respondent (applicant) from using the very trade mark and the parties will have to fight out their rights in that case, subject to the fact that the registration for the respondent is subject to a disclaimer. That case has to be fought on its own merits.

This appeal fails and is dismissed.