

(2008) 03 IPAB CK 0016

In the Intellectual Property Appellate Board

Case No : OA/24/2007/TM/DEL

Kirorimal Kashiram Marketing And Agencies Private Limited APPELLANT
Vs

Ravinder Kumar Khanna Trading As K.C. Ravinder Kumar, RESPONDENT
Bagh Jhanda Singh And The Registrar Of Trade Marks, Trade
Marks Registry

Date of Decision : 19-03-2008

Acts Referred:

Trade Marks Act, 1999 — Section 8, 9, 10, 10(1), 11, 12, 12(3), 18, 18(1), 30(1)(c)
(i), 91

Citation : (2008) 37 PTC 654 (IPAB)

Hon'ble Judges : Z.S. Negi, J; Syed Obaidur Rahaman, Technical Member

Bench : Division Bench

Advocate : S.K. Bansal, Kamal Kishore Arora

Final Decision : Dismissed

Judgement

Z.S. Negi, J

1. This is an appeal under Section 91 of the Trade Marks Act, 1999 (hereinafter referred to as the Act) directed against the order dated 29.3.2007 of the Assistant Registrar of Trade Marks, New Delhi whereby he dismissed the opposition No. DEL-120519 and allowed the application No. 732625 to proceed for registration.

2. It is stated that Shri Ravinder Kumar Khanna trading as M/s K.C. Ravinder Kumar filed an application No. 732625 on 10.9.1996 under the Trade and Merchandise Marks Act, 1958 (hereinafter referred to as the repealed Act) for registration of trade mark K.C. DOUBLE DEER BRAND, claiming user since 20.7.1992, in respect of Large Cardamom Seeds (Illachi Dana) included in class 31. The mark was advertised in the Trade Marks

Journal No. 1296 (S-III), dated 13.6.2003 at page 292. The appellant thereupon filed opposition No. DEL-120519 objecting registration on the ground

that the appellant is since 1966 engaged in the business of processing and marketing of Rice under its trade mark DOUBLE DEER BRAND LABEL.

It is claimed that the predecessors of the appellant has adopted the trade mark in 1966 and got registration as of 5.8.1985 under No. 441206 in class

30 in respect of Rice and by virtue of assignment, the appellant is the subsequent proprietor of the mark. The appellant is also registered proprietor of

trade mark DOUBLE DEER BRAND as of 18.1.1990 under No. 531665 in class 30 in respect of Rice for sale in the States of Andhra Pradesh,

Karnataka, Kerala, Tamil Nadu and Union territory of Pondicherry and that the registration of the trade mark applied for in the name of appellant is

likely to cause confusion and deception in various forms not only to the business of the appellant but also to the larger interest of public. After the

completion of procedural requirements, the matter was set down for hearing on 4.4.2006 and the respondent No. 2 passed the impugned order after

hearing counsel for both the parties.

3. The grounds of appeal are, inter alia, that the respondent No. 2 has not considered the objections raised in the notice of opposition under Section 9

of the repealed Act and the various other objections raised by its counsel under Section 9 of the Act; that the respondent No. 2 erred in rejecting the

objection under Section 11 of the Act and not appreciating the sufficient documentary evidence filed by the appellant; that the respondent No. 2 has

erred in holding respondent No. 1 to be the honest concurrent user without assigning any reason therefore; that the objection of appellant under

Section 18 of the Act has been wrongly rejected without considering that the respondent No. 1 is not the proprietor of the impugned mark and that the

tribunal passed the impugned order mechanically and without due care and caution while exercising its discretionary powers.

4. The respondent No. 1 filed counter-statement dated 19.7.2007 through its sole proprietor Shri Ravinder Kumar Khanna and on 18.9.2007 and the

appellant filed rejoinder to the counter-statement through its Director Shri Arun Kumar Aggarwal. The appeal came up before us for hearing on

9.1.2008 when Shri S.K. Bansal, Advocate appeared on behalf of the appellant and Shri Kamal Kishore Arora, Advocate appeared on behalf of the

respondent No. 1. After hearing both learned Counsel, order was reserved and records of Trade Marks Registry was called for. The Trade Marks

Registry in March, 2008 have intimated that search was caused by their record section but the records have not been traced so far. It was then

decided to record our order on the basis of the arguments heard and the records available with this Appellate Board.

5. Shri S.K. Bansal, learned Counsel for the appellant, contended that the impugned mark is devoid of any distinctive character- not capable of

distinguishing the goods of the respondent No. 1 from those of the appellant-as such the same does not satisfy the requirements of registrability

thereof under the Act and the mark applied for was neither distinctive of respondent No. 1 at the time of making application for registration nor at the

time the mark was advertised or as of today. The respondent No. 2 failed to appreciate that the onus to prove the entitlement of registration of the

mark is on the respondent No. 1 and the respondent No. 1 has not filed cogent evidence to prove its user. The documents prior to 1996 filed by the

respondent No. 1 pertain to trade mark MAHAL, DOUBLE HIRAN BRAND and not relating to the mark applied for. He further contended that the

respondent No. 2 has considered the various objections under Section 9 of the Act by the counsel for the appellant and also the objection raised by the

appellant in the notice of opposition under Section 9 of the repealed Act.

6. Shri Bansal contended that the respondent No. 2 has wrongly rejected the objection raised under Section 11 of the repealed Act by not appreciating

that both the competing marks are deceptively similar, the goods are of similar or allied and cognate nature and that the appellant has filed sufficient

documents to establish its prior and continuous use of the trade mark. Relying upon the judgment in R. Gopalakrishnan v. Venkateshwara Camphor

Works AIR 2001 Madras 92, the learned Counsel submitted that after seeing the two marks one can arrive at the conclusion that the respondent No.

1 while choosing the words of the impugned trade mark could not have done so without keeping the appellant's mark in its mind and such a similarity

cannot be a mere co-incidence or cannot be assumed that the two persons separated in time and place were inspired in the same manner. He also

contended that the respondent No. 2 could not apply the ratio decidendi of the judgments in Kewal Krishan Kumar trading as Kumar Dal Mills v.

Akash Spices & food Industry 1993-PTC-231 and Corn Products Refining Co. v. Shangrila Food Products Ltd. in the right perspective and also failed

to appreciate that the judgments in Khoday Eshwarsa & Sons, Bangalore v. Kalburgi Distilleries, Hubli 1984-PTC-6 at 17 and Mohan Meakin Limited

v. Kalburgi Distilleries 1984-PTC-165 at 175 have no application to the facts and circumstances of the opposition proceedings before him. His further

contention was that the respondent No. 2 has not given the desired credit to the sales figure furnished by the appellant since 1986 whereas it has

erroneously given undue importance to the alleged sales figure furnished by the respondent No. 1 since 1992. It is a fact that the impugned copyright

registration of the respondent No. 1 has no connection in relation with the user of the impugned trade mark but the respondent No. 2 has without

considering this fact has given undue credit therefore. It was also contended that the respondent No. 2 ought to have appreciated that the appellant is

the registered proprietor of trade marks under Nos. 531665 as of 18.1.1990 and 441206 as of 5.8.1985 and by virtue of these prior existing

registrations, the application for registration of the respondent No. 1 ought to have been refused.

7. Shri Bansal next contended that the respondent No. 2 has without assigning any reason held the respondent No. 1 to be the honest and concurrent

user and thus it has wrongly given the benefit of Section 12 of the Act to respondent No. 1. The plank is that the respondent No. 1 was carrying on its

trading business deceptively by passing its goods as the goods of the appellant. When the adoption of mark is not bonafide and honest there cannot be

any honest and concurrent user and no amount of user could cure the same. The respondent No. 1 has not made out any special circumstance under

Section 12 of the Act. In view of these, the respondent No. 1 is not entitled to registration of the impugned trade mark as the same is barred under

Section 12 of the Act. Learned Counsel by drawing our attention to para 16.05 of Narayanan's book on Law of Trade Marks and passing off (6th

edition) submitted that the factors to be taken into account for arriving at a conclusion whether the applicant is entitled to registration under Section

12(3), the respondent No. 2 has not given any finding as to whether the application of the respondent No. 1 falls under that section.

8. Shri Bansal contended that by merely prefixing K.C. with the appellant's famous trade mark DOUBLE DEER BRAND LABEL, the respondent

No. 1 is not the proprietor of the impugned trade mark within the meaning of Section 18(1) of the Act but the respondent No. 2 has without

considering this fact and on extraneous grounds wrongly rejected the objection of the appellant raised under Section 18 of the repealed Act. He

further submitted that the claim of the respondent No. 1 that the impugned mark was honestly and bonafidely conceived by it is false as it has adopted

the identical and similar mark to that of the appellant's to trade upon the goodwill and reputation accrued to the famous and reputed trade mark

DOUBLE DEER BRAND LABEL of the appellant. The claim of respondent No. 1 that its obtaining official search report from the Registrar

establishes its bonafide in making application for registration is irrelevant in the present proceedings. The respondent No. 1 has never made any sales

under the impugned mark, as such the impugned mark has never been used for or upon its goods by the respondent No. 1.

9. Shri Bansal submitted that the impugned order is passed mechanically without application of mind and without due care and caution in exercise of

discretion by the respondent No. 2. The exercise of discretion by the respondent No. 2 is unreasonable, arbitrary and fanciful which is based on

irrelevant and extraneous considerations. Learned Counsel further submitted that the respondent No. 2 has failed to appreciate that the respondent

No. 1 has made a wrong claim that it is a manufacturer whereas the documents filed by it shows that it is a commission agent. Learned Counsel

concluded by submitting that in the interest of justice, equity and good conscience, the opposition No. DEL-120519 may be allowed.

10. Shri Kamal Kishore Arora, learned Counsel for the respondent No. 1, submitted that the respondent No. 1 in the year 1992 honestly and

bonafidely conceived and adopted the trade mark K.C. DOUBLE DEER BRAND for various kinds of large cardamom seeds knowing fully well that

there is no such trade mark in use or exist in the principal markets and since then openly and continuously using the same without any interruption of

any kind whatsoever. By drawing our attention to Annexure R-3 and relying on para 5.20 of the Narayanan's book on 'Law on the Trade Marks and

Passing off' (6th edition), he submitted that the respondent No. 1 has simultaneously ascertained by way of official search report that there did not

exist any identical trade mark in the records of the Trade Mark Registry which fact proves the bonafide of making application by it. The trademark of

respondent No. 1 has acquired distinctive character as a result of use made of it before the application for registration. He pleaded that the mark of

the respondent No. 1 is of distinctive character within the meaning of Section 9 of the Act as has been found so by the Registrar at the pre-

advertisement stage and the respondent No. 2 after taking into full consideration all the materials on record also found so at the time of final

adjudication also. Learned Counsel also pointed out that the appellant has not furnished the details as to what the alleged various other objections were

raised by its counsel but not taken into consideration by the respondent No. 2.

11. Shri Arora submitted that the trade mark of respondent No. 1 taken as a whole is entirely different from the trade mark of the appellant, the goods

of the respondent No. 1 is of different kind or description -falling under different class of goods- and by the use of mark of respondent No. 1 there has

been no confusion or deception in the markets during the past many years and as such the objection of appellant under Section 11 has rightly been

rejected by the respondent No. 2. Reliance was placed in the judgment in Raj Bahadur Gupta and Anr. v. Registrar of Trade Marks and Ors. to say

that the appellant has failed to discharge the initial onus to prove its user and reputation. The appellant by virtue of securing registration of trade for

Rice under class 30 for certain Southern States and that too on the basis of doubtful assignment of trade mark from its alleged predecessor can not

oppose the registration of trade mark K.C. DOUBLE DEER BRAND which is sought to be registered in respect of various kinds of large cardamom

seeds in class 31. By drawing our attention to para 26 at pages 15-16 of the counter-statement, the learned Counsel stressed that there are more than

a score trade marks comprising of the word or device or both ""DEER"" which have been either advertised or registered in favour of different

proprietors in respect of goods of different descriptions included in class 30 and class 31. The learned Counsel in support of his submissions placed

reliance upon the decision in the following cases:

(i) F. Hoffmann-La Roche and Co. Ltd. v. Geofrey Manners and Co. Pvt. Ltd.

(ii) Ayushakti Ayurveda Pvt. Ltd. and Ors. v. Hindustan Lever Limited 2004 (28) PTC 59 (Bom);

(iii) S.M. Chopra & Sons v. Rajendra Prosad Srivastava 1998-PTC-258;

(iv) Rupee Gains Tele-Times Private Ltd. v. Rupee Times 1995 PTC (15) 384;

(v) Amar Singh Chawalwala v. Shree Wardhman Rice & General Mills 1996 (36) DRJ 196

(vi) Aviat Chemicals Pvt. Ltd. and Anr. v. Intas Pharmaceuticals Ltd. 2001 PTC 601 (Del);

(vii) Kraft Jacobs Sucharc Ltd. v. Government of India by Secretary, Ministry of Commerce and Industry and Ors.

(viii) Aysha Hosiery Factory Pvt. Ltd. v. Asha Hosieries and Anr.

(ix) Kewal Krishan Kumar v. Rudi Roller Flour Mills (p) Ltd. and Anr.

(x) Kedar Nath Gupta v. J.K. Organisation 1998 PTC (18) 189.

Learned Counsel submitted that on the facts and circumstances of the case, the ratio decidendi of the judgment in Kewal Krishan Kumar trading as

Kumar Dal Mills (supra) and Corn Products Refining Co. (supra) have been applied in the proper perspective and the judgments in Khoday Eshwarsa

& Sons, Bangalore v. Kalburgi Distilleries(supra) and Mohan Meakin Limited have rightly been taken into consideration by the respondent No. 2. The

appellant has failed to give any reason either in the pleadings or at the time of hearing for its objection in this regard. The general objection that the

impugned order is passed mechanically without application of mind and the exercise of discretionary power without due care and caution cannot be

taken note of in the absence of specific reason therefore given by the appellant.

12. Shri Arora submitted that the trade mark as a whole of the respondent No. 1, the goods in respect of which it is used and the class in which such

goods fall is quite different from that of the appellant's and that is the reason that the respondent No. 2 has on the basis of all the materials on record

held the respondent No. 1 to be the honest and concurrent user. He further submitted that the respondent No. 1 is registered owner of the artistic label

'K.C. DOUBLE DEER BRAND' under the Copyright Act, 1957 which ownership is a special circumstance under Section 12 and besides this the

respondent No. 1 is entitled to save its vested rights under Section 30(1)(c)(i) of the Act. Relying upon the dictum as approved by the Apex Court in

Amritdhara Pharmacy v. Satya Deo Gupta that if a trader allows another person who is acting in good faith to build up a reputation under a trade

name or mark to which he has rights, he may lose his right to complain, and may even be debarred from himself using such name or mark, it was also

the submission of the learned Counsel that the appellant has acquiescence the

use of the mark by the respondent No. 1.

13. Shri Arora submitted that by virtue of honest and bonafide adoption of the trade mark K.C. DOUBLE DEER BRAND, its regular and

uninterrupted use since the year 1992, the respondent No. 1 has already become the true and lawful proprietor thereof within the meaning of Section

18(1) of the Act. This fact is very well within the knowledge of the appellant. The fact that the respondent No. 1 has got the official search made by

making an application dated 13.9.1996 to the Trade Marks Registry and got the report that only one trade mark device of DEER is registered and

there is no pending application for registration proves the bonafides of making application for registration by, and claim of proprietorship of, the

respondent No. 1.

14. Shri Arora submitted that the general objection that the impugned order is passed mechanically without application of mind and discretionary

power is exercised without due care and caution cannot be taken note of in the absence of specific reason given therefore by the appellant. The

learned Counsel concluded by making submission that the present appeal which is based on wrong, baseless and contradictory statements is liable to

be dismissed with award of costs to the respondent No. 1.

15. After carefully hearing both the learned Counsel the issue in this appeal arise are mainly under Sections 9, 11, 12 and 18 of the Act and certain

other general issues. As regards the first issue under Section 9 of the Act, the appellant's contention that the mark applied for registration by the

respondent No. 1 is devoid of any distinctive character and will deceive the public or cause confusion. Section 9 of the Act enumerates the absolute

grounds for refusal of registration of trade mark. One of the grounds for refusal of registration under Sub-section (1) is that the trade mark is devoid

of any distinctive character but an exception to that sub-section has been carved out that a trade mark shall not be refused registration if before the

date of application for registration it has acquired a distinctive character as a result of the use made of it or is a well-known trademark. Likewise, one

of such grounds under Sub-section (2) is that a trade mark shall not be registered if it is of such a nature as to deceive the public or cause confusion.

Section 11 of the Act deals with relative grounds for refusal of registration. Sub-section (1) of that section provide that save as provided in Section 12,

a trade mark shall not be registered if, because of its identity with or similarity to an earlier trade mark and identity or similarity of goods or services

covered by the trade mark, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier

trade mark. Sub-section (2) of that section provide that a trade mark, which is identical with or similar to an earlier trade mark and which is to be

registered for goods or services which are not similar to those for which the earlier trade mark is registered in the name of a different proprietor shall

not be registered, if or to the extent, the earlier trade mark is a well-known trade mark in India and the use of the later mark without due cause would

take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trade mark. In the present appeal, DOUBLE DEER or

DEER is undisputedly not invented but are the ordinary English dictionary words or word to which no body can claim monopoly. The said words or

word is not inherently incapable of distinguishing the goods of respondent No. 1 from the goods of the appellant and do not consist exclusively of

words which may serve in the trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of

the goods or other characteristics of the goods. Though the competing marks are closely resembling but having regard to the goods covered by each

mark and other factors, which we will discuss a little later, they do not appear likely to cause confusion or deception among the consumers. The

impugned mark is claimed to be used before the date of making application for registration by the respondent No. 1. The respondent No. 2 in his

impugned order has recorded that the respondent No. 1 in para 11 of the affidavit filed a sales figure commencing from 1992-93 to 2003-04 in respect

of cardamom seeds and the sales thereof in 1992 was Rs. 16,07,137-84 which rose up to the tune of Rs. 44,08,455-80 in the year 2003-04. The

evidence of user from 1992 to the date of application mentioned by the respondent No. 2 in the impugned order shows that the mark of the respondent

No. 1 has acquired distinctive character. The averment of the appellant that the evidence adduced by the respondent No. 1 in relation to use of mark

do not pertain to the impugned mark but there is no evidence available on the record in support of such an averment. The appellant, except making an

averment in the appeal that the respondent No. 2 has not taken into consideration various other objections under Section 9 of the Act raised by the

counsel for the appellant, has not given any details of the alleged objections. On the contrary, the respondent No. 2 has come to the conclusion thus:

The opponent objection raised under Section 9 in my view is not maintainable because the opponent have failed to produced any reason or argument

as to how the mark is hit by the provisions contained in Section 9 of the Act.""
The relative grounds of refusal on similarity of goods or the appellant's

mark being well-known in India is also not available in the present case as the requisite evidence especially for determining whether the trademark of

the appellant is well-known [as per Sub-sections (6) to (10) of Section 11 of the Act] is insufficient. In view of the discussion above, we see no reason

to interfere with the conclusion arrived at by the respondent No. 2 in relation to registrability of the impugned mark.

16. The mark of the respondent No. 1, with disclaimer of 'K.C. and DOUBLE BRAND' is K.C. DOUBLE DEER BRAND and on the other hand

the registered mark of the appellant, with disclaimer of the word 'BRAND' is DOUBLE DEER BRAND. In order to determine as to whether the

mark is likely to cause confusion or deception, the Courts have laid down certain principles to be followed. The Apex Court while considering the

deceptive similarity of mark 'PROTOVIT' and 'DROPOVIT' in the case of F. Hoffmann-La Roche and Co. Ltd. (supra) held at paras 11 and 12 as

under:

11...The tests for comparison of the two-word marks were formulated by Lord Parker in Pianotist Co. Ltd.'s Application, (1906) 23 RPC 774 at p.

777 as follows:

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 customers 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 trademarks 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.

12. In order to decide whether the word 'DROPOVIT' is deceptively similar to the word 'PROTOVIT' each of the two words must, therefore, be

taken as a whole word. Each of the two words consists of eight letters, the last three letters are common and in the uncommon part the first two are

consonants, the next is the same vowel 'o' the next is a consonant and the fifth is again a common vowel 'o'. The combined effect is to produce an

alliteration....

In the case of Corn Products Refining Co. (supra), the Supreme Court held that the question whether the two marks are likely to give rise to confusion

or not is a question of first impression and that it was well recognised that in deciding a question of similarity between two marks, the marks have to

be considered as a whole. Causing deception or confusion must relate to the goods along with the trademark and not alone to the trademark. A simple

similarity in the name in the trade mark alone is not sufficient to ascertain confusion or deception but certain other factors have to be examined. In

Kedar Nath Gupta (supra) the Court held as under:

30. No doubt 'JK' may be the house mark of the JK Organisation but this house mark could only be confined to the goods to which there is registration

and not for all kinds of goods, for the Act does not recognise any collective mark excepting certification trade mark and for the present purpose in the

trade mark and certification trade mark both are related to goods and not independent of goods, for the present purpose. The 'JK' trade mark, thus

may have a particular bearing in respect of the registered trade marks in respect of specific class of goods and not all the goods. Except the phonetic

similarity, no other thing is alleged to be common.

41. It appears that simple similarity in the name in the trade mark alone is not sufficient to make out a case either of infringement or of passing off for

in both the cases confusion or deception is the essential element. For ascertaining confusion one has to examine (a) the nature of the two marks

including the letters used, the style of using the letters, the device in which they have been used, the colour combination of the trade mark (b) the class

of customers (c) the extent of reputation (d) the trade channels (e) the existence of any connection in the course of trade and (f) all other surrounding

circumstances. No doubt, it is not essential that all such factors should exist in

each and every case to make out a case of passing off or infringement or to deny the registration of similar trade mark. But at the same time, it is also true that in case of presence of one single factor, leading to alleged deception or confusion would itself not be sufficient to uphold the objection for registration of the trade mark.

42. The names starting with letters 'J' and 'K' being very common names, it is submitted that it cannot be inferred that it would cause deception and confusion in relation to different kinds of goods under Clause 'a' of Section 11. It is further argued that in case this kind of proposition is accepted, then any letter and common words used by public in general could be monopolized. Even 'Sun' and 'micro' could be monopolised by one or the other firm.

43. Causing confusion or deception must relate to the goods along with the trade mark and not alone to the trade mark, is the submission of the learned Counsel. It is rightly contended that the moment it is accepted that the confusion and deception has to be in relation to the goods and that the opponent were not producing locks nor they had got any trade mark registered for the purpose of manufacturing the locks or anything of the class 6, there could neither be confusion nor deception nor it is possible to presume so.

The Courts while considering the similarity of marks involved in Kewal Krishan Kumar's case (supra) held that there was a vast difference between

the two marks 'Shiv Shakti' and 'Shakti Bhog Atta', Similarly, in Ayshakti Ayurveda Pvt. Ltd.'s case (supra) it was held that the competing marks

'AYUR' and 'AYUSHAKTI' were not similar, much less deceptively similar so as to say, prima facie, that defendants pass off their goods as that of

plaintiffs, in Fox & Company reported in 1920 37 RPC 37 trade marks 'Motrate' and 'Filtrate' were held to be not similar. In S.M. Chopra & Sons

(supra) held that the words 'Raja' and 'Maharaja' were not deceptively similar. In the case of Amar Singh Chawalwala (supra) it was held as under:

Plaintiff's rice known as GOLDEN QILLA, LAL QILLA or NEELA QILLA- Any goods bearing the mark of HARA QILLA are not likely to be

purchased by any one mistaking them as the goods marketed as GOLDEN QILLA, LAL QILLA or NEELA QILLA. Replica of historical Red Fort

is so well known that anyone having a little idea of Red fort would not mistake the defendant's Qilla as Lal Qilla. The device used by the plaintiff along

with GOLDEN QILLA is so materially different from the device used by the

defendant along with Hara qilla that there is no likelihood of the customer inclined to purchase Lal Qilla rice being deceived into purchasing Hara Qilla rice. There is no visual or phonetic similarity between the defendant's name and mark and the plaintiff's name and mark either of the three. So is the case with Lal Qilla and Neela Qilla. It is not the case of the plaintiff nor does it appear to be reasonable and plausible to assume that the goods of the plaintiff are being marketed or are likely to be marketed merely by using the name Qilla. Any one accustomed to or desirous of consuming the plaintiff's goods would certainly ask for Golden qilla or Lal Qilla or Neela qilla brand rice while any one desirous of purchasing the defendant's goods would ask for Hara Qilla brand rice.

In the cases of identical or similar mark it is for the Registrar to come to a conclusion whether the mark applied for registration is likely to deceive or cause confusion. What the Registrar has to see is whether looking at the circumstances of the case of particular trademark is likely to deceive or to cause confusion. In the National Sewing Thread Co. Ltd. (supra) the Supreme Court held as under:

The burden of proving that the trade mark which a person seeks to register is not likely to deceive or to cause confusion is upon the applicant. It is for him to satisfy the Registrar that his trademark does not fall within the prohibition of Section 8 and therefore it should be registered. Moreover, in deciding whether a particular trademark is likely to deceive or cause confusion that duty is not discharged by arriving at the result by merely comparing it with the trademark which is already registered and whose proprietor is offering opposition to the registration of the mark. The real question to decide in such case is to see as to how a purchaser, who must be looked upon as an average man of ordinary intelligence, would react to a particular trade mark, what association he would form by looking at the trademark, and in what respect he would connect the trade mark with the goods which he would be purchasing.

However, the initial burden will be on the opponent to prove his user and reputation. In the case of Raj Bahadur Gupta & Another (supra), this Appellate Board held as under:

17. ...When the issue of confusion or deception is raised, though the burden lies on the applicant to prove that there will be no confusion, but still the

initial burden will be on the opponent to prove his user and reputation. The burden to prove no instance of confusion will shift to the applicant only after

it is discharged by the opponent. Here we observe the appellant has neither filed any evidence nor any affidavit as to deception or confusion.

In the case of *London Rubber Co. Ltd. v. Durex Products Incorporated* and Anr. it was at para 8 held as under:

8. The provisions of Sections 8 and 10 of the Act are enabling provisions in the sense that it is not obligatory upon a proprietor of a mark to apply for

its registration so as to be able to use it. But when a proprietor of a mark, in order to obtain the benefit of the provisions of the Trade marks Act, such

as a legally protected right to use it, applies for registration of his mark he must satisfy the Registrar that it does not offend against the provisions of

Section 8 of the Act. The burden is on him to do so. Confining ourselves to Clause (a) the question is which the Registrar has to decide is, whether

having regard to the reputation acquired by use of a mark or name, the mark at the date of the application for registration if used in a normal and fair

manner in connection with any of the goods covered by the proposed registration, will not be reasonably likely to cause deception and confusion

amongst a substantial number of persons (see 38 Halsbury's Laws of England, pp.542, 543). What he decides is a question of fact but having decided it

in favour of the applicant, he has a discretion to register it or not to do so. Re: *Hack's Application* (1940) 58 RPC 91. But the discretion is judicial and

for exercising it against the applicant there must be some positive objection to registration, usually arising out of an illegality inherent in the mark as

applied for at the date of application for registration. Re: *Arthur Fairest Ltd.'s Application* (1951) 68 RPC 197. Deception may result from the fact that

there is some misrepresentation therein or because of its resemblance to the mark, whether registered or unregistered or to a trade name in which a

person other than the applicant had rights, *Eno v. Dunn* (1890) 15 AC 252. Where the deception or Confusion arises because of resemblance with a

mark which is registered, objection to registration may come under Section 10(1) as well (See note 'K' at p. 543 of Halsbury's Law of England)....

Where a person trades in or manufactures one good or article under a broad classification having no bonafide intention to trade in or manufacture all

goods or articles falling under that broad classification, he cannot be permitted to enjoy monopoly in all articles carrying under such classification. In

the case of Vishnudas trading as Vishnudas Kishandas (supra) the Supreme Court held as under:

45. In our view, if a trade manufacturer actually trades in or manufactures only one or some of the articles coming under a broad classification and

such trader or manufacturer has no bonafide intention to trade in or manufacture other goods or articles which also fall under the said broad

classification, such trader or manufacturer-should not be permitted to enjoy monopoly in respect of all the articles which may come under such broad

classification and by that process preclude the other traders or manufacturers to get registration of separate and distinct goods which may also be

grouped under the broad classification.

If registration has been given generally in respect of all the articles coming under the broad classification and if it is established that the trader or

manufacturer who got such registration had not intended to use any other such registration had not intended to use any other article except the articles

being used by such trader or manufacturer, the registration of such trader is liable to be rectified by limiting the ambit of registration and confining such

registration to specific article or articles which really concern the trader or manufacturer enjoying the registration made in his favour.

By applying the above principles, when compared the competing marks as a whole, they closely resemble structurally. In both the marks the prominent

word DEER is common in both the marks but there appears to be no phonetic or visual resemblance. The goods covered by the trademark of the

appellant (in class 30) is Rice which is a daily food item of most people of the populace in several areas whereas the goods covered by the trademark

of the respondent No. 1 (in class 31) is cardamom which is a spice which most people of the populace do not use daily or use occasionally. There is

huge difference of price of both the goods and also difference of number of consumers. Keeping in view of the huge price difference, the size, etc. of

packages are bound to be different. There is no doubt that both rice and cardamom are generally available at the same shop or counter but it is

unbelievable that a consumer who wants to purchase rice will in confusion or deception purchase cardamom or vice-versa. The appellant's averment

that the goods in question are also same/similar/allied and cognate in nature is not sustainable as the same has not been substantiated as how both the

goods are same/similar/allied or cognate in nature. It is not the case of the appellant that it has the bonafide intention to deal in cardamom or both Rice and cardamom fall in the same classification of goods. Even if both the goods are falling in the same broad classification, the appellant cannot be given monopoly to the trade mark unless appellant's bonafide intention to trade in cardamom is shown. In the absence of any evidence the averment of the appellant that the respondent No. 1 has made misstatement that it is manufacturer whereas it is a commission agent remains unproved. We are of the opinion that marketing includes commission agents also. Hence, there does not appear to be any misstatement made by the respondent No. 1. There is no material on record to show any instance of confusion or deception having taken place in the past. Having regard to the above and the conclusion arrived at by the respondent No. 2 that the composite label of the respondent No. 1 and different description of goods resolute that there will be no confusion in the market if both the marks are simultaneously used in respect of Rice and cardamom seeds, we do not find any necessity to reverse the conclusion arrived at by the respondent No. 2.

17. The respondent No. 1 has been using the impugned mark since 1992 and by virtue of its long and continuous use of the impugned mark has acquired reputation and goodwill in the trade. The respondent No. 1 has stated in the counter-statement that it had honestly and bonafidely conceived the mark in 1992 knowing fully well that there was no such trademark in use or existence in the principal markets. The averment of appellant that the adoption of mark by the respondent No. 1 is dishonest and no amount of user can cure is not sustainable on the face of details of score of registered or pending registration of trade mark consisting of word DEER/DOUBLE DEER/HIRAN/STAGE, etc furnished by the respondent No. 1. In view of this it is difficult to sustain the contention that the respondent has while choosing the words of the trade mark had kept the appellant's mark in mind. The decision in R. Gopalakrishnan case (supra) relied upon by the appellant is not applicable to the case on hand. The submission of the respondent No. 1 that the official search report obtained by it proves is also not sustainable as the request for search has been made after application was made for registration. After over all consideration, we did not find anything on record to support the contention of the appellant that the adoption of mark by

the respondent No. 1 was not honest and bonafide. We are inclined to agree with the submission of the respondent No. 1's ownership of copyright is a

special circumstance which entitles it to get its impugned trade mark registered. Moreover, the use of the impugned mark by the respondent No. 1 has

acquiescence by the appellant as the appellant has allowed the respondent No. 1 to build up a reputation under the impugned mark by not taking any

legal action against the respondent No. 1. In *Amritdhara Pharmacy v. Satya Deo Gupta* the Apex Court held thus: '14. We now go to the second

question, that of acquiescence. Here again we are in agreement with the Registrar of Trade Marks, who in a paragraph of his order quoted earlier in

this judgment has summarized the facts and circumstances on which the plea of acquiescence. The matter has been put thus in Halsbury's Laws of

England, Vol. 32 (second edition) page 636-657, paragraph 966.

If a trader allows another person who is acting in good faith to build up a reputation under a trade name or mark to which he has rights, he may lose

his right to complain, and may even be debarred from himself using name or mark.

But even long user by another, if fraudulent, does not affect the plaintiff's right to a final injunction; on the other hand prompt warning or action before

the defendant has built up any goodwill may materially assist the plaintiff's case.

18. The respondent No. 1 has submitted that it has honestly and bonafidely adopted the mark knowing fully no such mark is in use in the market in

1992. The appellant has not shown that the respondent No. 1 has adopted its mark having knowledge that the appellant's mark was in use at the time

of adoption of mark K.C. DOUBLE DEER BRAND. The respondent No. 2 has convinced with the explanation offered by the respondent No. 1 that

the goods covered by the competing trade marks trade are different and they fall under different classifications of goods. There is no evidence to hold

that the respondent No. 1 has adopted the mark dishonestly or malafidely. We hold that the respondent No. 1 is the proprietor of the impugned trade

mark.

19. In the absence of any detail or cogent evidence, we do not find any merit in the general issues raised by the appellant. It has not been

substantiated as to how the ratio decidendi in the decisions relied upon by the appellant have not been properly applied by the respondent No. 2. A

mere general allegation will not be sufficient to reverse the finding on the respondent No. 2.

20. The respondent No. 2 has while summing up his conclusion that all the objections raised by the appellant are not maintainable, consequently he

does not see any reason as to why he should use his discretion against the respondent No. 1. When the respondent No. 2 has not exercised his

discretion in favour of or against the respondent No. 1, the question of judicial exercise or otherwise thereof does not arise.

21. We find no reason to interfere with the conclusion arrived at by the respondent No. 2. We, accordingly, dismiss the appeal as devoid of any merit.

There is, however, no order as to costs.