
(1980) 01 DEL CK 0023
In the Delhi High Court
Case No : First Appeal No. 40 of 1972

K.R. Beri and Co.

APPELLANT

Vs

The Metal Goods Manufacturing Co. (P) Ltd.

RESPONDENT

Date of Decision : 21-01-1980

Acts Referred:

Citation : AIR 1980 Delhi 299 : (1980) 17 DLT 365

Hon'ble Judges : S.B. Wad, J

Bench : Single Bench

Advocate : A.R. Lal, M. Lahiri, M. Lahiri, A.A. Mohan and Anoop Singh, for the Appellant;

Judgement

This Judgment has been overruled by : Cycle Corporation of India Ltd. Vs. T. I. Raleigh Industries Pvt. Ltd. and others, (1996) 4 AD 674 : AIR 1996 SC 3295 : (1996) 2 ARBLR 5 : (1996) 5 JT 145 : (1996) 4 SCALE 528 : (1996) 9 SCC 430 : (1996) 2 SCR 820 Supp

S.B. Wad, J.

(1) This is an appeal u/s 109 of the Trade and Merchandise Market Act, 1958 against the order of the Assistant Registrar, Trade Marks, Delhi who refused the application of the appellant to register a trade mark. The trade-mark in question is "FIVE 50" in class 12 in respect of the cycle bells. The registration was opposed by the respondent company on several grounds. The learned Assistant Registrar held that the said mark cannot be registered in the name of the appellant as it contravened Sections 11(a) and 12(1) of the Act. It was further held that the appellant is not entitled to the benefit of Section 12(3) of the Act and cannot claim registration on that basis.

(2) At the hearing the counsel for the respondent referred to some evidence on the record and raised an additional objection for registration in terms of Section 8 of the Act. The appellant on the other hand also raised a new point that the respondent's trade-mark was "ASIA-50" and that the appellant's mark "BERI-

FIVE .50" would not cause any confusion or deception and hence his trade-mark should be registered. I am not inclined to to permit either the appellant or the respondent to raise these new points at this stage. Sub-section 7 of Section 109 may be noted on appeal by an applicant for registration against the decision of the Registrar under Sections 17 and 18 or .Section 21. It shall not be open, save with the express permission of the court of the Registrar of any party opposing the appeal to advance grounds other than those recorded in the said decision or advanced by the party in the proceedings before the Registrar, as the case may be....." The contentions of the parties are of such a nature that they will substantially change the original controversy between the parties and would also need fresh evidence to be taken. The appeal would, Therefore, be disposed of on the basis of the contentions advanced and evidence produced before the Registrar.

(3) The appellant's proposed trade-mark is "FIVE-50" while the two trade-marks already registered in the name of the respondent are "Fifty" and "50". These trade-marks are embossed on the handle of the cycle bells manufactured by the appellants as well as by the respondents. Section 11(a) of the Act states "prohibition of registration of certain marks. A mark (a) the use of which would be likely to deceive or cause confusion." In *Amritdhara Pharmacy Vs. Satyadeo Gupta*, , the Supreme Court has held that a proper test for determining whether a mark is deceptive or confusing is to see the over-all similarity between the two marks. The mark should be capable of deceiving and confusing the persons of the class who generally purchase the said goods. The mark should be capable of deceiving or confusing substantial number of persons. In *London Rubber Co. Ltd. v. Durex Products Incorporated* and another, *Mil* 1963. S.G. 1882 the Supreme Court has laid down various circumstances that should be considered by the Registrar, in this connection. The primary consideration is whether the mark which is sought to be registered has acquired sufficient reputation in the market. Another consideration is whether the mark is used in a normal and fair manner so as to avoid the possibility of causing deception and confusion amongst the substantial number of persons. Where the registration is objected, reputation which the objector's mark has achieved in. terms of duration and sales in the market must also be considered. Another consideration which is required to be looked into is whether by virtue of certain circumstances the objector's mark has acquired special significance or meaning in relation to some goods.

(4) On going through the evidence the Assistant Registrar has come to a conclusion that the respondent has established the reputation of his trademark and has also established that the respondent had been using the said mark much prior to the date of application for registration by the appellant. The affidavit of Badri Pershad Aggarwal, Managing Director of the respondent-company has stated that the trade-mark "Fifty-50" have been continuously and extensively used by them throughout India since 1950. Exts. B-1 to B-35 are the copies of the orders received by the respondent company from various dealers from 1952-58. Exhibit A shows that advertisement expenses made by the respondent

company for the sale of their cycle bells from 1949 to 1960. The earliest advertisement, advertising the cycle bells bearing the mark "Fifty" "50" appeared in Daily Calcutta Cycle Market Report dated 30-5-51 (Ext.A-1). The respondent has also furnished the sale figures from 1949 -1950 to 1959-1960. In 1949-50 the sales were Rs. 19,644.75. In 1957-58 the sales were of the amount of Rs. 1,15,49,936.00. This evidence of the respondent is not seriously challenged by the appellant. I agree with the Assistant Registrar that the respondent has proved his user and reputation in regard to his trade-marks.

(5) On comparison of the trade-marks, claimed by the appellant and the respondent I find that the whole of the registered trade-mark "50" has been bodily taken by the appellant and has just added the word "FIVE" to it. The words "FIVE" used by the appellant and the word "FIFTY" used by the respondent are also such which cannot be easily distinguished, unless the purchaser (the consumer or retailer trader) carefully examines each piece and satisfied himself. The phonetic identity of the word "FIFTY" is also very obvious. Where a consumer tells the shop-keeper to give him a cycle bell of the mark "50" it would be difficult to know whether he is referring to the appellant's goods or the respondent's goods. Bicycle is still the only cheap means of traveling for the vast number of low-income illiterate people and villagers in India. They would naturally go by the general reputation of cycle bells which bear the mark "50". I agree with the learned Assistant Registrar that the appellant's mark is reasonably likely to create deception and confusion in the minds of the customers. The registration of the appellant's mark is thus clearly barred by Section 11(a) and Section 12(1) of the Act.

(6) The appellant then relies on section 12(3) of the Act and contends that he had been honestly and concurrently using the said mark showing number "50" for a considerable time. He also states that the respondent is not exclusively using the number "50" and there are several other manufacturers who are using the number "50" on cycle bells manufactured by them. He further contends that the number "50" was originally used by foreign manufacturers and after import of the cycle bells was stopped, number of Indian manufacturers have started using the said mark. There is no evidence on the record to show as to who are the other manufacturers who are using the number "50" in their trade-mark and whether their manufacture of bells with the said trade mark was started concurrently with that of the respondent. It is only the respondent who had registered the trade marks with the word "FIFTY" and with the number ""50" and none else. The evidence on the record shows that the respondent company is using the marks atleast from 1949-1950. As against this the appellant is claiming the user from 1953. The accounts regarding the sales produced by the appellant are only of the year 1955-56. The appellant published the advertisement for the first time on 11th October 1955 in the cycle market bulletin of Delhi. It is clear from these facts that the appellant had come in the field much after the respondent and has failed to establish the concurrent user. By 1955-56 the sales of the respondent's bill had reached to the amount of Rs.

10 Lacs. The inference from the facts is very clear. The appellant had the knowledge of the reputation and sales of the respondent's bells and he started using the mark deceptively similar to that of the respondents from the year 1955. It cannot also be said that the respondent had acquiesced in the user of the similar trademark by the appellant. It is an admitted fact that the respondent had taken action under the Act under the similar attempt to appropriate the respondent's trade mark by other manufacturers. For the appellant to succeed on the plea of acquiescence he must show that his user was a substantially longer user. The appellant started using the mark from 1955 and applied for registration on 8th of April 1958. The concurrent user, if at all, is of such a short duration that it cannot be said that the respondent had acquiesced in it. The appellant Therefore, cannot derive any support for registration of his trade mark from section 12(3) of the Act. The questions involved in the appeal are pure questions of fact and are decided by the authority specially created by the Act. I am naturally slow in disturbing the discretion of the Assistant Registrar. The appeal is dismissed with costs.