

(2012) 05 IPAB CK 0018

In the Intellectual Property Appellate Board

Case No : OA/47/2007/TM/DEL

M/s. T.T. Industries, Through Its Proprietor R.C. Jain. 879,
Master Prithvi Nath Marg, Karol Bagh, New Delhi-110005

APPELLANT

Vs

M/s. Titan Polythylene (Malaysia) Sdn. Bhd., Re, No. 17,
Lorong Dungun, Damansara Heights, 50490, Kuala Lumpur,
Malaysia

RESPONDENT

Date of Decision : 18-05-2012

Acts Referred:

Trade Marks Rules, 2002 — Rule 52

Trade Marks Act, 1999 — Section 9, 11, 12, 18

Citation : (2012) 05 IPAB CK 0018

Hon'ble Judges : Prabha Sridevan, J;V. Ravi, Technical Member

Bench : Division Bench

Final Decision : Dismissed

Judgement

Prabha Sridevan, J

1 . The opponent is the appellant. The opposition was disallowed rejecting the objections under Section Nos. 9, 11 and 18. The respondent filed an

application for registration of label mark consisting of the word TITANLENE and the letter T.T. in Class 2 in respect of raw and natural resins. It

was advertised in the Trade marks Journal No. 1292 dated 1.4.2003 under application No. 839855. The appellant filed his opposition as they have been

on the hosiery and readymade garments business in class 25 from 1968. They had also diversified their trade and gained tremendous reputation. They

are registered proprietor of different trade marks in Classes 23, 24 and 25. They have opposed anyone who tried to falsely apply this mark to their

goods. The applicant's adoption is malafide and cause confusion. The opponent/appellant submitted they had been in the business of manufacturing

and marketing of linear low density polyethylene and high density polyethylene resins are entirely different. The trade mark is derived from the corporate name and the combination of letter T with word TITANLENE which is structurally, visually and phonetically different to the opponent trade mark. The purchasing public of the rival marks are also different. The mark was applied for proposed to be used. On reply to this, the respondent submitted that they are the global proprietor of various trade mark containing the logo 'T' and Titan word like TITANEX, TITANPRO, TITANZEX TITANCEED, etc. There is absolutely no similarity with the appellant mark.

2 . The Registrar first took up the Section 9 objection and held that the unique combination of the different features of the mark should be taken into account and this mark is a composite mark containing letter 'T' in a logo form and word TITANLENE which is capable of distinguishing the goods of the respondent herein from the goods of the other traders.

3 . Next the Registrar held that there was no evidence to show that the appellant herein using the mark in respect of the goods falling under Class 2.

The Registrar relied on several judgments and held that there is no evidence of deception and confusion. The Registrar was also satisfied that the adoption was bonafide.

4. The learned counsel for the appellant submitted that they had been using the mark T.T. since the beginning of the year 1968 as the initials of their trading style. Before that the mark was used by the predecessor-in-interest, M/s. Tarun Textiles Private Limited in respect of Hosiery goods. Now they have diversified and expanded the area of business. According to the learned counsel, T.T. has obtained tremendous reputation and acquired distinctiveness. They are the proprietors of other marks. According to them, the impugned application consists of the letter T.T. imposed one another and the word TITANLENE is placed in small letter and it is confusing and deceptively similar. The counsel referred to the Annexure 'A' where all the applications filed by the appellant are given. The learned counsel also submitted that there is no whisper in the entire counter statement regarding the date and year of user.

5 . He referred to page 40 in Volume II which is the Weekly Hosiery Report of the year 1974 dated 26.10.1974, the appellants mark was advertised.

The learned counsel also referred to page 54 Volume II which is the Trade Mark

Caution Notice. Page 209 onwards are the documents to show

sales. Several orders in opposition proceedings have been enclosed, to show how vigilantly the appellant has been protecting its mark and using it for a long time.

6. The counsel also referred to the evidence in support of the opposition, regarding this diversification and the sale figures. The learned counsel submitted that the appellant has left no stone unturned to protect his mark.

7. The counsel submitted that the Volume III which deals with the sales figure of the respondent and is referred to as Exhibit-A cannot be received in evidence since no Exhibit - A is referred to in the affidavit of Mr. Koh Boon Wah. The learned counsel referred to the evidence stating that they have

been using the mark for many years in other countries. He submitted that user elsewhere cannot make a mark distinctive. The learned counsel

submitted that the Registry had applied two different yardsticks for the appellant and the respondent. The learned counsel submitted that when the

mark is proposed to be used, Section 12 will not come into play.

The learned counsel referred to 2004 (30) PTC 345 (IPAB) - Berkefeld Filter Analagenbau GmbH Vs. Registrar of Trade Marks and Others

1997 (17) PTC (DB)- Rob Mathys India Pvt. Ltd. Vs. Synthes Ag chur

1999 (19) PTC 521 - Essel Packaging Limited and Others Vs. Essel Tea Exports Ltd.

2005 (31) PTC 121 (IPAB) - Pradeep Kumar Dhoot & Anr. Vs Jai Prakash Gupta & Others

2009 (41) PTC 184 (Cal.) (FB) - Sony Kabushiki Kaisha Vs Mahaluxmi Textile Mills

2012 (49) PTC 209 (Del.) (DB) - Trans Tyres India Pvt. Ltd Vs. Double Coin Holdings Ltd. & Anr.

(1941) 58 RPC 147 - Saville Perfumery Ltd. Vs. June Perfect Ltd. And F.W. Woolworth & Co. Ltd.

AIR 1965 SC 980 - Kaviraj Pandit Durga Dutt Sharma Vs. N.P Laboratories (Ayyangar J.)

2010 (44) PTC 448 (Cal.) - R.R. Proteins and Agro Limited Vs. Hari Shankar Singhanian and Anr.

AIR 1953 SC 357-National Sewing Thread Co. Ltd Chidambaram Vs. James Chadwick & Bros. Ltd.

8 . The learned counsel for the respondent made oral and written submission. According to him there is no deceptive similarity. The caution notice was only in relation to Hosiery goods. The addition of the graphic was sufficient to distinguish the impugned mark, there was no justification for interference.

These are the marks.

9 . The Registrar on looking at the marks was convinced that the composite mark containing a letter T with the word TITANLENE was not likely to confuse. The Learned Registrar was correct in concluding that since the purchasing public is different and the class of goods is different, there is no likelihood of confusion.

10. The objection raised by the appellant that the evidence filed in Volume-III cannot be received since there is no reference to Volume 'A' in Mr.

Koh Boon Wah affidavit must be accepted. The evidence filed under Rule 52 in support of the application must be referred to the affidavit. There is a

petition filed by the advocate to take on record, the affidavit of KOH BOON WAH along with the affidavit. But the affidavit filed by the said officer

does not refer to the evidence requesting that it should be recordal evidence.

11. However, in this case that will not change our conclusion. But we refer to it indeed to impress the importance of referring to the evidence in the

affidavit. It is necessary to describe each document in detail. The affidavit is filed in lieu of giving oral evidence. So the affidavit must state on oath, to

give an example ""Ex. A1 is the registration Certificate, Ex. A2 is the sales statistics certified by our auditor, Ex. A3 are the invoices to show sales of

our goods from 1983"" and so on. Only if the document is proved as above it can be received as evidence. We are not able to find any error in the

approach of the Registrar. We have reproduced the marks above to show that no one will mistake the one mark for the other.

12. The respondent referred to the decision of the Board where the Board held that

22. It is a well settled principle that the prior users rights are to be protected against the subsequent user. In the instant case, the issue as to who is the

prior user or adopter need not have to be gone into when we have already decided that the rival marks are not similar.

23. The other issue as to possibility of confusion or deception also fails on

account of the reason that in our considered opinion that the marks are not deceptively similar. Therefore, the objection raised by the Respondent does not sustain. In *National Sewing Thread Co. Ltd. Vs. James Chadwick & Bros. Ltd.* case, the Supreme Court held that the consideration in passing off action are different than the consideration in an application for registration and that the burden of proving that the trade mark is not likely to deceive cause confusion is on the applicant. The Supreme Court held that the real question was how an average man react to a particular trade mark. This ratio favours the respondent.

2010 (44) PTC 448 (Cal.)-*R.R. Proteins and Agro Limited Vs. Hari Shankar Singhania and Anr.*-Learned Judge held that the defendants had not been able to establish "'Sandhya Arati'" was prior to the plaintiff adoption of 'Arati' and the nature of the goods are the same therefore this would not apply for the present case.

AIR 1965 SC 980-*Kaviraj Pandit Durga Dutt Sharma Vs. N.P. Laboratories (Ayyangar J.)*-the Supreme Court held that the similarity between the two marks is so close either visually, phonetically or otherwise no further evidence is required. In this case the respondent mark is a composite mark and the marks are not identical.

1941 (58) RPC 147 - *Saville Perfumery Ltd. Vs. June Perfect Ltd. And F.W. Woolworth & Co. Ltd.* - in that case the essential feature of the plaintiffs mark, so the special script in which the word June written and it was held that this essential feature of this mark had been taken by the appellant and used as a mark for goods of the class for which the respondent mark was registered. In this case, the duplication of the word is not at all identical in both the marks and the class of goods are different.

2012 (49) PTC 209 (Del.) (DB) - *Trans Tyres India Pvt. Ltd. Vs. Double Coin Holdings Ltd. & Anr.* - It is referred to the Territoriality Doctrine and said that the prior use of the trade mark in a dominion would not ipso facto entitle to owner to claim exclusive trade mark rights in another dominion. In this case it is not on the ground of priority but on the ground of dis-similarity and unlikelihood of confusion that the respondents mark was ordered to be registered.

2009 (41) PTC 184 (Cal.) (FB) - *Sony Kabushiki Kaisha Vs. Mahaluxmi Textile Mills* The Full bench of the Calcutta High Court held that an

infringement action was maintainable even in respect of different class of goods. There the mark was Sony.

Here the mark is not just T.T. alone but it is a composite mark. Further the depiction of the appellants mark is always T.T. inside the onion like figure.

This has nothing to do with shaded straight T's the respondent had been using.

2005 (31) PTC 121 (IPAB) - Pradeep Kumar Dhood & Anr. Vs. Jai Prakash Gupta & Others. - This Board held that two identical marks cannot be registered merely because of goods are different description.

Here the Registrar rightly come to the conclusion with the two marks are not identical.

1999 PTC (19) 521 - Essel Packaging Limited and Others Vs. Essel Tea Exports Ltd. - Hon'ble Bombay High Court held that confusion and

deception to the public is the relevant consideration that arose in a passing off and their ESSEL was the mark and the explanation for adopting the mark was not acceptable.

Here, the companies name is starts with T and according to the respondent that is the reason why they have adopted. It is a plausible explanation.

1997 (17) PTC (DB) - Rob Mathys India Pvt. Ltd. Vs. Synthes Ag Chur The Hon'ble Delhi High Court held that to use abroad was not relevant and trade mark law has no extra territorial application.

In the view that we have taken that there is no deception or confusion, this case will not apply.

2004 (30) PTC 345 (IPAB) - Berkefeld Filter Analagenbau GmbH Vs. Registrar of Trade Marks & Others. - Both the marks were Berkefeld. In that

case, the opposition was allowed and the Board held that the applicant has to establish the right to claim such registration and the question of user was

relevant since the applicant had changed user from proposed user to user from 1984.

In this case, the mark remains proposed to be used.

13 . The respondent has asserted his right to registration on the ground that the adoption is honest because T is the first letter of the name of its

company and that the mark should be treated as composite mark and that there is no likelihood of confusion. The Registrar accepted this and ordered

registration, we do not see any perversity in the order. We are not inclined to interfere with it. The appeal is dismissed with costs of Rs. 3000/-.