
(2002) 04 DEL CK 0160
In the Delhi High Court
Case No : O.C.J. (A) No. 4 of 2000

Osram Gesellschaft Mit beschränkter Haftung	APPELLANT
Vs	
Shyam Sunder and Others	RESPONDENT

Date of Decision : 16-04-2002

Acts Referred:

Trade and Merchandise Marks Act, 1958 — Section 11, 11(9), 12, 12(3)

Citation : (2002) 25 PTC 198

Hon'ble Judges : Usha Mehra, J;Om Prakash Dwivedi, J

Bench : Division Bench

Advocate : Navin Chawla, for the Appellant; Mohan Vidhani, for the Respondent

Final Decision : Dismissed

Judgement

Usha Mehra, J.—From the admission made in the pleadings of the parties it appears that there are certain facts which are not in dispute, but those have a material bearing on the facts of this case and we think it would be convenient to refer them at once. First of this is that appellant/opponent is the registered proprietor of trade mark "OSRAM" in class 11 of Schedule IV of the Trade and Merchandise Act, 1958 (hereinafter called the Act) in respect of electric lamps of all kinds and in class 10 in respect of surgical, medical, dental, veterinary instruments and apparatus and electric lamps. The respondent on the other hand is registered proprietor of the trade mark "OSHAM" in class 9 in respect of electric iron. He has also applied for registration of his trade mark "QSHAM" in class 7 in respect of mixer, juicer, grinder and washing machine. Since no opposition has been filed to the same and the period of opposition having expired he is expected to get the registration of his goods in class 7 also. The respondent applied for registration of its trade mark "OSHAM" in respect of portable lamp stands, room heaters, hot air circulator, domestic baking oven (electrical), fans and heating elements in class 11. Respondent had been using this trademark in respect of these goods since August, 1980. The Registrar of Trade Marks advertised the application of the respondent to which the appellant herein

indicated its intention to oppose the registration of the respondent's trade mark in class 11. Respondent subsequently filed an application before the Registrar of Trade Marks seeking deletion of a portion of his application with reference to portable lamp stands which request was acceded to by the Registrar of Trade Marks and the application with reference to portable lamp stands was ordered to be deleted. Opposition of the appellant to the registration of trade mark "OSHAM" in class 11 of the goods of the respondent was rejected by the Assistant Registrar of the Trade Marks by his order dated 9th October, 1996.

2. Aggrieved by that order the appellant preferred an appeal which was listed as Civil Misc. (Main) No. 535/96. By the impugned judgment his appeal has also been dismissed.

3. Aggrieved by the order of the Assistant Registrar and dismissal of his appeal by the learned Single Judge, appellant has preferred this appeal, inter alia, on the grounds that Assistant Registrar of Trade Marks as well as the learned Single Judge ignored that : (1) The trade mark "OSHAM" is deceptively similar to the registered trade mark "OSRAM" in Clause 11 ; (2) That the use of the trade mark "OSHAM" for the goods sought to be registered by the respondent would cause confusion and deception in the mind of the customer ; (3) Use of "OSHAM" is dishonest and violates appellant's rights ; (4) If registered it would tantamount to passing off appellant's goods ; (5) Words "OSRAM" and "OSHAM" are not only visually but also phonetically similar ; (6) Adoption of trade mark "OSHAM" shows dishonest intention of respondent No. 1 ; (7) The Assistant Registrar of Trade Mark as well as the learned Single Judge failed to note similarity of the name, nature of the goods, the class of purchaser and the well established reputation and goodwill of the appellant; (8) There is violation of the provisions of Sections 11(a), 12(1) and 18(1) of the Act; (9) The evidence adduced by the respondent in support of his application was not admissible for want of verification ; and finally (10) The proprietor of a registered trade mark in one class of goods is not entitled to get its goods registered as of right in the other class solely on the ground that previous registration in other class exists. Previous registration in one class is totally immaterial, irrelevant while deciding the application for registration in another class.

4. The question, Therefore, for consideration is whether the goods in respect of which respondent wishes to get his trade mark "OSHAM" registered in class 11 are deceptively similar ; and whether the said registration would cause a real and tangible danger of confusion. In order to determine this question let us have a glance at the relevant provisions of the Act namely Sections 11(a), 12(1) & (3) and 18(1), which are reproduced as under:

Section 11(a)

"11. Prohibition of registration of certain marks - A mark--.

(a) the use of which would be likely to deceive or cause confusion ; or Section 12(1) & (3) 12.

Prohibition of registration of identical or deceptively similar trade marks -

(1) Save as provided in Sub-section (3), no trade mark shall be registered in respect of any goods or description of goods which is identical with or deceptively similar to a trade mark which is already registered in the name of different proprietor in respect of the same goods or description of goods.

(3) In case of honest concurrent use or of other special circumstances which, in the opinion of the Registrar, make it proper so to do, he may permit the registration by more than one proprietor of trade marks which are identical or nearly resemble each other (whether any such trade mark is already registered or not) in respect of the same goods or description of goods, subject to such conditions and limitations, if any, as the Registrar may think fit to impose.

Section 18(1) 18.

Application for Registration :-

(1) Any person claiming to be the proprietor of a trade mark used to proposed to be used by him, who is desirous of registering it, shall apply in writing to the Registrar in the prescribed manner for the registration of his trade mark either in Part A or in Part B of the register."

5. In fact Section 11(a) of the Act is not attracted in the facts of this case. The goods which the respondent wants to get registered under class 11, to our mind, will not pass off as appellants goods nor it can be said that those will create any confusion because the respondent's trade mark is already registered under class 9 and 7 of the Act in respect to electric iron, juicer, mixer, grinder and washing machine. Apparently-in these facts it cannot be said that there is tangible danger of confusion. Nor it can cause any confusion nor can deceive the customer in any manner. Regarding "trans border" reputation of the appellant and the evidence led in this regard, to our mind, the learned Assistant Registrar has considered it appropriately. It is only after considering the evidence led before him that he concluded in favor of the respondent. In fact respondent had used the mark and filed evidence of the user. Since the evidence of the parties has been considered and appreciated by the Registrar, we find that appellant has not been able to point out any glaring infirmity in the appreciation of its evidence by the learned Assistant Registrar. Therefore, the application of the respondent is not hit by the provision of Section 11(a) of the Act.

6. Turning to the question of deceptive similarity or goods being identical in nature admittedly provisions of Section 12 of the Act prohibits registration of goods which are identical with or deceptive similar to a trade mark already registered. Thus, Sub-section (1) of Section 12 of the Act envisages that goods in respect of which subsequent registration is sought for must be, (1) in respect of goods or description of goods being same or similar and covered by earlier registration ; and (2) Trade Mark claimed for such goods must be same or deceptively similar to the trade mark already registered and that there is a

dishonest intention to use the deceptively similar trade mark. However, Sub-section (3) of Section 12 carves out exception. It says that wherever there is an honest, concurrent use and/or other special circumstance the same and deceptively similar trade marks may be permitted to another by the Registrar.

7. According to Mr. Mohan Vidhani, counsel for the respondent the mark "OSHAM" is their invented word which was derived from the name of Shyam Sunder, one of the partners of respondent firm, by prefixing "O" against the name of "Sham". Respondent is bona fide user of the trade mark "OSHAM" in respect of goods in class 11 since 1980. These goods for which registration is sought are of a different class and description than the goods registered by the appellant under their registered trade mark "OSRAM" namely electric lamps of all kinds. Thus, there is no question of deceptive similarity or of goods being identical or same. Respondent's case is, Therefore, not covered u/s 12(1) of the Act. So far as this question is concerned we have no hesitation in concluding that the goods of the respondent in respect of class 11 can in no way be called same nor deceptively similar. The goods for which application has been filed by the respondent fall into a distinct category namely domestic appliances. Electric lamps normally are not covered under such category. Electric lamps generally are not sold on the same shop where room heaters, hot air circulators, domestic baking ovens, fans and heating elements are sold. It is not the case of the appellant that beside the electric lamps, it intends to manufacture goods like room heaters, hot air circulators, domestic baking ovens, fans and heating elements and/or that appellants in the near future intends to get such like goods registered in Class 11. By merely getting electric lamps of all kinds registered in Class 11, the opponent/appellant cannot deprive other proprietors to get their goods registered which are neither deceptively similar nor of the same kind. We are supported in this view by the decision of this Court in the case of Nestle's Products Limited and Another Vs. Milkmaid Corporation and Another, wherein observation in the case *Edwards v. Dennis*, (1885-30 Ch.D 454) were relied upon. Those observations since apply to the facts of our case hence are reproduced as under :-

"The registration in the present case has been for the entirety of that class. In my opinion that is wrong. Even if a trade mark can be registered which is not in actual use, it ought to be restricted to those goods in connection with which it is going to be used. In my opinion it is not the intention of the Act that a man registering a trade mark for the entire class and yet only using it for one article in that class, can claim for himself the exclusive right to use it for every article in the Class.

Can a man claim registration for all the articles specified in the class when the business he is engaged is comprises only one specific portion of that articles named in the class. I am of the opinion "he cannot". To paraphrase that can a man who is registered in one class claim in respect of articles not comprised in that class, but, comprised in some of the other classes? In the same way, in my

opinion, he cannot."

8. We have taken aid of Supreme Court decision in the case of Vishnudas Trading as Vishnudas Kishendas v. Vazir Sultan Tobacco Co. Ltd. 1996 (16) PTC 512 to arrive at the conclusion that by merely getting registered its electric lamps of all kinds in class 11 appellant cannot deprive the registration of respondents goods either on the ground of its prior registration or of dishonest intention. Supreme Court in Vishnudas Trading (Supra) case said ;

"If a trader or 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 bona fide 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."

9. Admittedly, respondent has been using the trade mark "OSHAM" in respect of the goods in Class 9 for electric iron as well as his goods under Class 7 for mixer, juicer, grinder and washing machine etc. Respondent has also been trading in its goods for which he applied in class 11 since August, 1980. To us it appears that there had been honest concurrent use. The respondent has been able to carve out special circumstance as stipulated under Sub-section (3) of Section 12 of the Act which permits even same and deceptively similar trade mark to another by the Registrar of course subject to such condition as may deem just and proper to the Registrar. The special circumstance carved out in this case can be summarised thus :- (1) Respondent is already using its trade mark "Osham" in respect of its goods registered in class 9 and 7 of the Act ; (2) The goods which the respondent wants to get registered in class 11 are not deceptively similar to that of the goods registered by the appellant in class 11 i.e. electric lamps which are of a different and distinct description than that of the respondent's good ; (3) The appellant has only challenged the registration in class 11 and has not challenged the registration of the respondent in class 7 & 9 ; (4) The Trade Mark "Osham" is an invented word by prefixing "O" with Sham" and this has been duly explained by respondents in its evidence. Moreover, registration of portable lamps has already been deleted by the respondent; (5) The respondent has been using and selling these goods, now want to get registered in class 11, since 1980. These are the grounds which make out a case of the respondent as a special circumstance as envisaged u/s 12(3) of the Act. There is honest and concurrent use of trade mark "Osham". We find that the discretion exercised by the Asstt. Registrar of Trade Marks vide his order dated 9th October, 1996 is neither arbitrary, illegal nor violative of any right of the appellant.

10. In view of our above observation that use of the trade mark is not dishonest, Therefore, the decisions relied by appellant in the cases of Parkington's Appln. (1946) 63 RPC 171, Shamlal v. Parle AIR 1967 Mad. 116, Revti Prashad v.

Raghubir Dayal (1981) PTC 26 Hami Brothers Vs. Hami and Co. and Another, , M/s. National Chemicals and Colour Co. and Others Vs. Reckitt and Colman of India Limited and Another, and 5 S. Mehar Singh Vs. M.L. Gupta and Co., are of no held to him. On facts these cases are distinguishable. No doubt the earlier registration of the respondent in class 7 or 9 by itself is no ground to entitle him to get registration in class 11 as well. But in view of our finding that respondent is honest user of his mark "Osham", he has also built up a case of "Special Circumstance" on account of the fact that respondent is holding registration in class 9 and going to receive registration certificate in class 7. Hence, we don't find that the impugned order suffers from any infirmity. The respondent has been honest, concurrent user of the mark "Osham". In fact there is no similarity in the description of goods nor it can create confusion in the mind of the purchaser. Reliance by the appellant on the decisions in the cases of Aswini Kumar Ghosh and Another Vs. Arabinda Bose and Another, , Rao Shiv Bahadur Singh and Another Vs. The State of Vindhya Pradesh, and The J.K. Cotton Spinning and Weaving Mills Co. Ltd. Vs. The State of Uttar Pradesh and Others, is misplaced.

11. As a matter of fact a registered trade mark holder cannot in law claim exclusive monopoly rights for its trade mark as extended to goods of all descriptions falling within the same class in which its sole and solitary product falls. If that is permitted then it would tantamount to preventing the other traders and manufacturers to get registered their distinctive articles which also fall under the same class of general classification. Appellant's trade mark in class 11 no doubt has been used on a large scale but for electric lamps only. But as already pointed out above the electric lamps by no stretch of imagination can be equated with room heaters, hot air circulators, domestic baking ovens, fans etc. nor these can fall in the same category of goods. Moreover, respondent's goods in class 11 are not marketed through a common trade channel. Those goods which the respondent wants to get registered in class 11 are marketed as distinct articles of use in different manner. In common trade channels such articles are not only held different and distinct articles but are marketed separately.

12. We also find no force in the submission of Mr. Navin Chawla that "Osham" is not the invented word of the respondent. Adoption of word "Osham" as explained by the respondent by prefixing the letter "O" to the word "Sham" which is the name of one of the partners of the respondent viz. Shyam Sunder is quite convincing. Why alphabet "Y" has been dropped from the word "Sham" is irrelevant. Dropping of the alphabet "Y" from Shyam and using the word "Sham" does not indicate dishonest intention to gain proximity as rightly observed by the learned Single Judge.

13. There is no quarrel with the proposition as urged by Mr. Navin Chawla that under Sub-rule (3) of Rule 26 an application for registration of the "same" trade-mark in different classes shall be treated as separate and distinct application and the registration in respect of the goods included in each separate class shall be deemed to be a separate registration for all the purposes of the Act. No doubt

each application. has to be dealt with and considered separately on its own merits. It is not to be influenced by the fact of registration of the trade mark in another class of goods. From the record we find that registration of respondent's application in class 11 was not solely on the ground that respondent was registered for his goods in class 9 and 7. This may have been one of the factor but not the sole ground. If respondent's trade mark in class 9 & 7 could be registered, it is difficult to apprehend why it could not be registered in respect of its goods in class 11 particularly when respondents goods are not deceptively similar or same. Hence on this count also we find no infirmity in the impugned orders.

14. For the reasons stated above we find no merit in the appeal. Dismissed.