

(2006) 03 IPAB CK 0002

In the Intellectual Property Appellate Board

Case No : Original Appeal No. 53/2005/TM/CH

Rajive Paul

APPELLANT

Vs

Princeson Jose And Anr.

RESPONDENT

Date of Decision : 17-03-2006

Acts Referred:

Trade And Merchandise Marks Act, 1958 — Section 2(b), 11(a), 12, 12(3)
Trade Marks Act, 1999 — Section 9, 11, 12, 18(1)

Citation : (2006) 32 PTC 705 (IPAB)

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

Bench : Division Bench

Advocate : A.A. Mohan, Mugunthan, P.S. Raman

Final Decision : Dismissed

Judgement

S. Jagadeesan, J

1. The appeal is directed against the order of the Assistant Registrar of Trade Marks, Chennai dated 21.6.2005 rejecting the application No. 795202 in

class 14 of the appellant for registration of the mark 'Chungath Prince Jewellery' in Malayalam with device of a diamond and letters PJ in respect of jewellery.

2. The appellants Mr. Rajive Paul and Mr. Renjith Paul filed application No. 795202 on 17.3.1998 for registration of their trade mark 'Chungath Prince

Jewellery' in Malayalam with device of a diamond and letters in PJ in respect of ""jewellery precious metals and their alloys and goods in precious

metals or coated therewith (except cutlery, forks and spoons) and precious stones falling in class 14 of Schedule of the Trade and Merchandise Marks

Act, 1958. The appellant claimed use of the said mark since 7.8.1996 in respect of the said goods. The Assistant Registrar directed the advertisement

before acceptance and the application was advertised in the Trade Marks Journal No. 1302 dated 1.9.2003 at page 139.

3. Shri Princeson Jose trading as M/s Prince Jewellery, Chennai, filed a notice of opposition mainly on the ground that the opponents are engaged in

the manufacture, marketing, inter lia, of jewellery and precious stones since 1984 and their products have a high reputation in India and the world over.

The opponent's trade mark consisting of the words 'Prince Jewellery' was first adopted in 1984 and due to long and extensive use the same has come

to exclusively identified with the respondent and their products. The respondents are the present proprietors of the registered trade mark 'Prince

Jewellery'. By virtue of long use of the said trade mark, the same has come to be exclusively identified with the respondents and as such the use by

any other trade mark which is identical/deceptively similar will cause confusion. The appellant had adopted the disputed trade mark with mala fide

intention to get profit from the goodwill and reputation acquired by the respondent. The registration of the impugned mark would offend Sections 9, 11

and 18(1) of the Trade Marks Act, 1999. The appellant filed their counter and also the evidence. The respondents also filed evidence in support of

their opposition and also produced the evidence. After the formalities were over the Assistant Registrar heard the learned Counsel on behalf of either

of the parties and under the impugned order he allowed the opposition No. MAS 153819 of the respondent and rejected the application No. 795202 of

the appellant for registration. Aggrieved by the same the present appeal has been filed.

4. The case was taken up for hearing on 8.3.2006. Learned Counsel Shri A.A. Mohan assisted by Shri Mugunthan appeared on behalf of the appellant

and learned senior counsel Shri P.S. Raman assisted by Shri Vinod Kumar, appeared o.. behalf of the first respondent.

5. Learned Counsel for the appellant Shri A.A. Mohan contended that the mark adopted by the appellant is totally different from the mark of the

respondent. Both has its own distinctiveness and there is no possibility of any confusion when the respondent's mark is 'Prince Jewellery' and the

appellant's mark being "'Chungath Prince Jewellery'. He also contended that the respondent filed a suit on the file of High Court of Judicature Madras

for passing off and an interim order was granted in his favour. An appeal was filed and in the appeal it was contended that the appellant has printed

the word 'Chungath' in an insignificant manner and made the rest of the mark 'Prince Jewellery' in a prominent manner and as such the word

'Chungath' has lost its importance and the appellant's mark is also identified as 'Prince Jewellery'. The appellant gave an undertaking to modify the

existing mark by printing the word 'Chungath' by given equal significance and prominence and also produced the label of the modified mark. By virtue

of the modification, absolutely there cannot be any confusion or deception. His further contention is that the goods being gold jewellery there cannot be

passing off, especially when the respondent has their trading within Tamil Nadu, as a restriction was imposed in the registration certificate. The

appellant also has confined their trading within Kerala which is totally a different State. In view of the restriction of the trade territory, there is

absolutely no justification for the respondent to claim confusion. The Assistant Registrar did not consider these aspects and as such the order of the

Assistant Registrar is liable to be set aside.

6. On the contrary Shri P.S. Raman, learned senior counsel contended that the appellant started the business with the name of Pavoos Jewellery and

then changed the name as Pavizham Jewellery and even after sometime the name of the appellant changed into Chungath Fashion Jewellery and in

1996 they adopted the name Chungath Prince Jewellery. Within two years of the commencement of the business there was frequent change of the

trade name of the appellant and ultimately they stick to the impugned mark which is similar to the registered mark of the respondent. The statement of

turnover clearly establish the reputation of the respondent and as such there cannot be any dispute that the respondent's mark is a well known mark by

1996 and the respondents had attained a reputation of their own with their trade mark having become a well known one. In such circumstances the

conduct of the appellant in changing the trade name frequently and finally selecting the impugned mark which is similar to that of the registered mark

of the respondent, thereby infringing the trade mark of the respondent, would clearly establish that there is no bona fide in the conduct of the appellant

in selecting the impugned mark. Consequently the appeal is liable to be dismissed.

7. Learned senior counsel further contended that the respondent intends to start a shop at Kerala and already the preliminary work had started. The

respondent also had made an application with the Trade Mark Registry for the removal of the trade territorial restriction and the same is pending since

1999. As soon as the trade territorial restriction is removed, the respondent will start the business at Kerala and other places as well. The Assistant

Registrar has considered in detail all the relevant issues and found in favour of the respondent. Hence, appeal is liable to be dismissed as devoid of any merits.

8. We carefully considered the above contentions of both the counsel. The main contention of the learned Counsel for the appellant is that the

impugned mark of the appellant do not suffer any disqualification either under Section 9 or 11 of the Trade Marks Act, 1999 (hereinafter referred to

as the Act). Further, the Registrar has totally failed to consider the claim of the appellant under Section 12 of the said Act for honest and concurrent

use. In considering the same we are aware of the undisputed facts that the appellant originally started his business in 1994 with the name of 'Pavoos

Jewellery'" and then changed the trade name as 'Pavizham Jewellery' and after sometime the trade name of the appellant changed into 'Chungath

Fashion Jewellery' and in 1996 they adopted the name 'Chungath Prince Jewellery'. From the above facts it is clear that the appellant has resorted to

adoption of the name 'Chungath Prince Jewellery', that is, by substituting the middle word 'fashion' in his trade name or mark with the word 'Prince' in

1996. By the time admittedly the respondent's mark 'Prince Jewellery' had attained a good reputation and also became a well-known mark. The sale

statistics furnished by the respondent is clear proof of the same. This may have probably prompted the appellant to change their name by adding the

word 'Prince'. Otherwise he could have kept their family name 'Chungath Jewellery' as their registered mark or as altered already 'Chungath Fashion

Jewellery'. In the absence of any reason for the appellant to add the word 'Prince' in the year 1996 in their earlier mark, we are of the view that there

is some force in the contention of the learned senior counsel for the respondent that the change is to capitalize the established name of the respondent.

9. Though the learned Counsel for the appellant contended that the appellant in confining their trade within Kerala, it is for us to consider whether the

appellant's mark or the trade name is likely to cause confusion in the minds of the purchaser that the products are that of the respondent. It was

vehemently contended by the learned Counsel for the appellant that the jewellery is not to be identified with any name and as such there cannot be

any passing off so far as the goods are concerned. When that be so, neither Section 9 nor Section 11 is attracted. While considering this plea we are

aware of the fact that the goods are not asked for by any name or label however does not mean that the name or the label is without any significance.

The label or name however remains as a reminder of origin and it is significant if the goods are found to be of good or indeed poor quality after

purchase. Hence, the trade name or mark assumes importance to assess the quality after purchase.

10. To find out the similarity of marks by comparison, it is relevant to refer to the principles laid down by the various Courts. In *Parle Products (P)*

Ltd. v. J.P. and Co., Mysore wherein the Supreme Court has laid down the underlying principles thus:

In order to come to the conclusion whether one mark is deceptively similar to another, the broad and essential features of the two are to be

considered. They should not be placed side by side to find out if there are any differences in the design and if so, whether they are of such character

as to prevent one design from being mistaken for other it would be enough if the impugned mark bears such an overall similarity to the registered mark

as would be likely to mislead a person usually dealing with one to accept the other if offered to him.

11. A Division Bench of the Bombay High Court in *Hiralal Prabhudas v. Ganesh Trading Company* Mr. Justice Lentin speaking for the Division

Bench adverted to the previous decisions of the Supreme Court on the subject and held that the Court must be guided by the following consideration:

5. What emerges from these authorities is (a) what is the main idea or salient features, (b) marks are remembered by the general impressions or by

some significant details rather than by a photographic recollection of the whole (c) overall similarity is the touchstone, (d) marks must be looked at

from the and first impression of a person of average intelligence and imperfect recollection, (e) overall structure, phonetic similarity and similarity of

idea are important and both visual and phonetic tests must be applied, (f) the purchaser must not be put in a state of wonderment, (g) marks must be

compared as a whole, microscopic examination being impermissible, (h) the broad and salient features must be considered for which the marks must

not be placed side by side to find out differences in design, and (i) overall similarity is sufficient. In addition, indisputably the nature of the commodity, the class of purchasers, the mode of purchase and other surrounding circumstances.

It may also be worthwhile to refer to a passage from Kerley's Law of Trade Marks and Trade Names 13th Edition Paras 16-3 at 603:

When the question arises whether a mark so resembles another mark as to be likely to deceive or cause confusion, it should be determined by

considering that is the leading characteristic of each. The one might contain many, even most, of the sample elements as the other, and yet the leading,

or it may be the only, impression left on the mind might be very different, On the other hand, a critical comparison of two marks might disclose

numerous points of difference, and yet the idea which would remain with any person seeing them apart at different times might be the same. Thus, it

is clear that a mark is infringed if the essential features, or essential particulars of it, are taken. In the case of device marks, especially, it is helpful

before comparing the marks to consider what are the essentials of the claimant's device; with word marks, the Court is apt to be more impressed by

the dangers of giving the claimant what amounts to a monopoly in a large class of words.

12. The respondent had established a reputation in their name 'Prince Jewellery' in connection with their goods and business and they can in no sense

be considered minimal, especially considering the business growth as seen from the statistics furnished. The appellant of course adopted the

name/word 'Prince' along with their trade name only in 1996. Even though the claim of the appellant of the use of the said trade mark is within the

territories of Kerala and the respondent's use of the registered mark is within Tamil Nadu, the respondent had already made an application to extend

the use of the mark throughout India and the said application is pending since 1999. When that be so, unless the parties agree we are not in a position

to impose any territorial restrictions.

13. When the appellant started his business subsequent to the respondent and that too with a different trade name, it is for him to explain as to why

and how he adopted the impugned mark with the word 'Prince' substituted for the earlier word 'fashion'. There is absolutely no explanation much less

convincing one is forthcoming from the appellant. Even if the change of the name is to be accepted when the mark offends the already registered

mark then the same cannot be registered. Merely because the appellant's mark has one more word significantly referring the family name, it cannot

be said that it is distinguishable from that of the appellant's mark. When considering the customers and the nature of business dealt with by both the

parties, unhesitatingly we find that the appellant's mark would cause confusion as the same is similar and identical to that of the respondent's mark.

When the traders are to be identified by their trade name, which incidentally becomes their trade mark also, the use of similar names by more than one

would definitely cause confusion.

14. We do not want to over burden ourselves by referring to various judgments elaborately. It would suffice to mention a few of the rulings thereof:

Learned single Judge of the Madras High Court in the case of *K. Hoday Distilleries v. Scotch Whisky Association* Scotland and Ors. AIR 1999 Madras

274 : 1999 PTC (19) 493(Mad) held that the mark 'Teterscott' in relation to whisky made in India was deceptively similar to 'scotch' and was likely to

lead the consumers of whisky into thinking the whisky manufactured in this country and sold under the trade mark 'Teterscott' was also scotch whisky

and such trade mark was ineligible for registration. In yet another case in *P.L. Anwar Bash v. N. Natarajan* it was held that 'Meen Mark Beedi' used

by both the parties are likely to cause confusion and deception within the meaning of Section 2(b) of the Trade and Merchandise Marks Act, 1958.

The Bombay High Court in the case of *Tata Tea Limited v. Suruchi Tea Company* 2004 PTC 83 has held that Tata Tea of the petitioner therein and

Suruchi Tea of the respondent are similar and likely to cause confusion on the ground that the overall similarity of the two marks has to be regarded

with reference to the essential features and that the respondent has clearly not been able to discharge the fundamental requirements under Section

11(a) of the said Act. The respondent therein furnished no cogent explanation as to how he came to adopt the trade design thus striking a resemblance

of the mark of the appellant.

15. The appellant had filed the application for registration of the mark 'Chungath Prince Jewellery' with device of diamond and letters 'PJ'. The letters

'PJ' is obviously referring to 'Prince Jewellery', which being the trade mark of the

respondent. Further it is the trade practice in the jewellery business that a jeweler will identify his jewellerys by entering the letters of their trade name and as such the respondent will engrave the letters 'PJ' in his jewellerys. When that be so, the registration sought for by the appellant of their mark with the letters 'PJ' would definitely lead not only to confusion. But also amounts to infringement.

16. The next contention of the learned Counsel for the appellant that the claim of the appellant for registration under Section 12(3) of the said Act ought to have been considered. Section 12(3) of the old Act corresponds to Section 12 almost in pari materia. What is contemplated under Section 12 is honest and concurrent use. Definitely the appellant cannot be considered to be an honest concurrent user especially in the absence of any plea that the appellant was not aware about the trade name of the respondent 'Prince Jewellery' at the time when he included the word 'Prince' along with their earlier adopted trade mark. As already discussed, in the absence of any valid reason for the change of name and the necessity to include the word 'Prince' in the place of the word 'fashion' in 'Chungath Fashion Jewellery' the original Trade name and mark of the appellant there is lack of bona fides in the conduct of the appellant in adopting the impugned trade mark.

17. Learned Counsel for the appellant further made an earnest request that in the appeal pending on the file of the High Court of Judicature at Madras before the first Bench against the order of the learned single Judge granting injunction restraining the appellant from using the word 'Prince', the appellant has modified the mark by changing the words and also adopted as follows:

Of course there is some difference in the format. We cannot consider the claim of the appellant as there is no justification or bona fides in using the word 'Prince'. The appellant is not the prior user of the mark with the word 'Prince' and the same was included subsequent to the adoption of three different trade names and it creates a doubt with regard to the bona fides in adoption of the word 'Prince' by the appellant. When it is found that the impugned mark 'Chungath Prince Jewellery' is identical or similar to that of the registered mark of the respondent 'Prince Jewellery', in our view the mere change of the style in using the same words which forms the mark is of no consequence. Consequently the appeal is devoid of any merits. The

same is dismissed. However there will be no order as to costs.