

(1997) 12 BOM CK 0026

In the Bombay High Court

Case No : Ordinary Original Civil Jurisdiction Miscellaneous Petition No. 8 of 1991

Reliance Industries Ltd.

APPELLANT

Vs

Anand Traders and others

RESPONDENT

Date of Decision : 17-12-1997

Acts Referred:

Trade and Merchandise Marks Act, 1958 — Section 109, 11, 12

Citation : (1997) 12 BOM CK 0026

Hon'ble Judges : K.K. Baam, J

Bench : Single Bench

Advocate : Sh. Virendra V. Tulzapurkar and Sh. Rahul Chitnis, for the Appellant;
Sh. Kumar Desai, for the Respondent

Judgement

Smt. K.K. Baam, J.—This petition has been filed by the petitioner herein challenging the order passed by the Assistant Registrar of Trade Marks dated 4-9-1990 seeking a direction that the same be set aside; that the opposition No. BOM-6003 be allowed and the application No. 367908 filed by Respondents Nos. 1 and 4 be dismissed and rejected. The petitioners have also prayed for certain ad-interim reliefs pending the hearing and final disposal of the petition.

2. Brief facts pertaining to the cause of the cause of action in the petition are stated as under :

"The petitioners are a Company incorporated under the provisions of the Companies Act, 1956 and carrying on the business of manufacturing and marketing of textile fabrics and piece goods. The petitioners were formerly known as Reliance Textile Industries Limited which Company with effect from 27th June, 1985 has changed its name to Reliance Industries Limited.

Respondents Nos. 1 to 7 are trading as M/s. Anand Traders who is respondent No. 8 a firm, and respondent No. 9 is the Registrar of Trade Marks, Bombay. According to the petitioners on 24th/27th October, 1980 respondents Nos. 1 to 5 trading in the name of M/s. Anand Traders made an application being application

No. 367908 in Class 24 in respect of textile fabrics and textile piece goods claiming user from 25th November, 1977 in respect of their label mark consisting of a shaded oval with the five-letter-word "SONAL" written within the oval in an arched manner, the middle letter "N" being in bold and large size. Underneath the word "SONAL" the words "A ANAND PRODUCT" are written in a semi-circular fashion in the lower part of the oval."

It is the case of the petitioners that they are the proprietor of a trade mark "VIMAL" under No. 261765 in part A of the register of trade mark in Class 24 in respect of the textile piece goods of all kinds and description. The petitioners have relied upon the registration certification which bears a representation of the registered trade mark of the Petitioners which has been renewed from time to time and the same is valid and subsisting as on this date.

3. According to the Petitioners, their trade mark consisted of a shaded oval with a five letter word "VIMAL" written within the oval in such a manner that the middle letter "M" is in bold and large size and two letters before and after the letter "M" are smaller and they slope pyramidally. The words "A RELIANCE PRODUCT" are written in a curved line below the word "VIMAL" in a semicircular style at the lower part of the oval. According to the petitioners, their trade mark "VIMAL" and the representation being on original artistic work has been registered under the Copyright Act, 1957.

4. It is the case of the petitioners that there is a striking and patently obvious visual and structural similarity between the petitioner's label mark containing the word "VIMAL" and the impugned label mark containing the word "SONAL" so as to deceive and create confusion, especially so, since the textile piece goods are being purchased by looking at labels. According to the petitioners, the letter "M" of the word "VIMAL" and the letter "N" of the word "SONAL" are so printed that they show the similarity and the visual and structural effect of the two words in the background cause deception to the purchasers, particularly to a person unacquainted with English language.

5. According to the petitioners, the said label trade mark "VIMAL" is extremely popular and the petitioner's goods sold under the said label trade mark have earned excellent reputation in India and abroad by reason of their excellent quality and extensive publicity and promotion and the said label trade mark is associated extensively with the petitioners by the members of the trade and the public. According to the petitioners, the application of the respondents for the label mark "SONAL" was advertised before acceptance in Trade Marks Journal No. 840 dated 1-6-1984 to which opposition was filed as it was the case of the petitioners that the adoption of the label mark "SONAL" by respondent Nos. 1 to 4 was not honest and was adopted with the knowledge of the petitioner's trade mark and with the intention of trading upon and deriving unlawful benefits from the reputation of the petitioner's trade mark "VIMAL" as the use of the label mark "SONAL" would cause deception and confusion and would amount to infringement and to passing off the goods of respondents No. 1 to 4.

6. The opposition was ultimately heard by the learned Assistant Registrar of Trade Marks who by his order dated 4-9-1990 dismissed the petitioner's opposition and directed to amending the specification of goods to read "Suitings and Shirtings for sale in the State of Gujarat". Being aggrieved by the said order, the petitioners herein have filed this petition by way of appeal u/s 109 of the Trade and Merchandise Marks Act, 1958.

7. So far as the petitioners are concerned, it is vehemently urged on behalf of the petitioners that on comparison of the trade marks, the essential feature of the petitioner's trade mark "VIMAL" with an oval background with the letter "M" in the centre and being larger than the other words coupled with the circular words "A RELIANCE PRODUCT" in a semi-circle at the bottom of the oval and the label mark of the respondents using the word "SONAL" written in the same fashion as the petitioner's label mark "VIMAL" with oval background, the word "N" being in the centre and larger than the other words and the circular writing of "A Anand Product" at the bottom, it is apparent that there is a deceptive similarity between the two label marks.

8. On behalf of the respondents, it has been vehemently urged that so far as the oval background is concerned, the petitioners cannot claim any right over this oval background as the oval shape is extensively used as a label mark in far as the textile business is concerned. The same does not have any trade mark value and, therefore, so far as the petitioners are concerned, they cannot claim any exclusive right to the user of this oval mark.

9. In support of their contention, reliance has been placed on behalf of the petitioners in the ruling in the case of James Chadwick and Bros. Ltd. Vs. The National Sewing Thread Co. Ltd., , wherein it has been observed as under :

"In deciding whether a particular trade mark is likely to deceive or cause confusion, it is not sufficient merely to compare it with the trade mark which is already registered and whose proprietor is offering opposition to the registration of the former trade mark. What is important is to find out what is the distinguishing or essential feature of the trade mark already registered and what is the main feature or the main idea underlying that trade mark, and if it is found that the trade mark whose registration is sought contains the same distinguishing or essential feature or conveys the same idea, then ordinarily the registrar is right if he comes to the conclusion that the trade mark should not be registered. The real question is 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 looking at the trade mark, and in what respect he would connect the trade mark with the goods which he would be purchasing.

There may be cases where dissimilarity in the object represented may be the deciding factor. If, for instance, a particular class of goods are sold by several dealers under difference kinds of Eagle trade marks, then a purchaser is

expected to know the difference between one trade mark and another, knowing as he does that not more than one person sells goods under the same appellation. But where only one dealer sells the class of goods under the Eagle brand and his goods are known as Eagle or Eagle brand then the position is very different and any attempt to sell the goods under a trade mark fixes in the mind of a purchaser the association of an Eagle would not be justified."

10. Relying on this ruling, it is therefore, vehemently urged on behalf of the petitioner that looking at the label mark and the word "VIMAL" the essential features being that the letter "M" is in capital and larger in size than the other words, similar being the case with the letter "N" as depicted in the word "SONAL" coupled with the fact that both of them have the oval background, the style of writing and the words "A RELIANCE PRODUCT" written in semi-circular fashion; whereas so far as the respondents' label mark is concerned, the same reflects the caption "A ANAND PRODUCT" written in the same semi-circular fashion and the feature being the same, there is every likelihood, that the purchaser who must be looked upon as an average man of ordinary intelligence would react to this particular trade mark and the impression that he would form would connect the same being that of the trade goods of the petitioners.

11. It is urged on behalf of the petitioners that the purchaser would be under the impression that he would be purchasing the goods of the petitioners and that there is every likelihood of there being a confusion in the mind the purchaser.

12. As against this contention, it is urged on behalf of the respondents that since 1977 the respondents have been using this trade mark, that there is no confusion and therefore, so far as the respondents are concerned, they cannot be prevented from using the trade mark or their registration cannot be challenged on this count.

13. On behalf of the petitioners in support of their contention, reliance is placed upon the ruling in the case of Parle Products (P) Ltd. Vs. J.P. and Co., Mysore, , wherein it has been observed as under :

"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 the 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. It is of no use to note on how many points there is similarity and in how many others there is absence of it."

14. On behalf of the respondents, it has been contended that so far as this ruling is concerned, the same would not apply to the facts of the present case inasmuch as in the case under reference there were similarities with regards to the picture appearing on the wrappers being the design of a girl with one arm

raised and carrying something on the other with a cow or cows near her and hens or chickens in the foreground. In the background there is a farm house with a fence.

15. So far as the present case under reference is concerned, it has been urged on behalf of the respondents that the words "VIMAL" and "SONAL" are different and the same can by no stretch of imagination cause confusion in the mind of the public. However, so far as the case of the petitioners is concerned, it is pertinent to note that a perusal of the two label marks, considering the essential feature of the two, the way and the manner in which the words "VIMAL and SONAL" are written with accentuation on the letter "M" so far as the word "VIMAL" is concerned and on the letter "N" so far as the word "SONAL" is concerned, which are written in bold and large lettering as compared to the fact that both are placed in oval background with the words "A RELIANCE PRODUCT" in the semi-circle and, whereas so far as the Respondents are concerned, the caption "A ANAND PRODUCT" written in semi-circular fashion, clearly reflects that there is an overall similarity which is likely to mislead a person to accept the one for the other if it is offered. It is not that the oval mark by itself is a distinguishing feature, but it is an impression created and the overall pattern of the label mark which is likely to cause confusion in the mind of the purchaser.

16. On behalf of the petitioners, reliance is also placed upon the ruling in the case of *Dr. Cordova and others v. Vick Chemical Co.* 68 RPC 103 in the case of *Seville Perfumery Ltd. v. June Perfect Ltd.*, and *F.W. Woolworth & Co. Ltd.* 58 RPC 147, and an unreported judgment of the Division Bench of this Court in the case of *Reckitt & Coleman of India Ltd. v. Wockhardt. Limited* (Appeal No. 1180 of 1991 in Notice of Motion No. 2141 of 1991 in Suit No. 2970 of 1991). Further, so far as the petitioner's trade mark is concerned, the same has been registered and has been in exclusive use since 1974.

17. So far as the respondents are concerned, it is contended on their behalf that they have put this trade mark to use since 1977. The petitioner's label mark has been registered in January, 1970. It is urged on behalf of the petitioners that the respondents' trade mark is hit by the provisions of Section 12(1) of the Trade and Merchandise Marks Act, 1958 which reads as under :

"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 a different proprietor in respect of the same goods or description of goods."

18. Hence, by virtue of the fact that the petitioner's registered label mark and that of the respondents label mark are deceptively similar, as essential features of the words "VIMAL" and "SONAL" are phonetically similar coupled with the oval background and as both these marks pertaining to the textile goods are identical, there is substance in the contention that there is likelihood of the same causing

as laid down u/s 11(a) of the Trade and Merchandise Marks Act, 1958, which prohibits the registration of certain marks, use of which is likely to deceive or cause confusion.

19. Further, it is urged on behalf of the petitioners that so far as this label mark is concerned, the same is applicable to the goods which are identically similar and purchased by the class of people who are likely to be confused. Hence on that count also the petitioners have challenge the order of the Registrar.

20. It is contended on behalf of the petitioners that the respondents have not been able to state as to how and on what basis they have derived this word "SONAL", the idea of the user of this mark and hence on this count also the registration has been challenged.

21. Reliance has been placed on behalf of the petitioner on the ruling in the case of Hiralal Parbhudas Vs. Ganesh Trading Company and Others, , which is the case pertaining to the labels "Hiralal Chhap Bidi" and "Himatlal Special Bidi" where the two marks were deceptively similar and it has been observed therein as under :

"In deciding the question of similarity of two marks, the following well established principles are to be observed :

(i) marks are remembered by general impressions or by some significant detail rather than by a photographic recollection of the whole;

(ii) overall similarity is the touchstone;

(iii) marks must be looked at from the first impression of a person of average intelligence and imperfect recollection :

(iv) overall structure, phonetic similarity and similarity of idea are important; and both visual and phonetic tests must be applied;

(v) marks must be compared as a whole, microscopic examination being impermissible; and

(vi) 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. In addition, the nature of the commodity, the class of purchasers, the mode of purchase and other surrounding circumstances must also be taken into consideration."

22. In the instant case also, looking at the two marks, there is an overall similarity plus the overall phonetic similarity. Visually between the two marks, if compared, there is a similarity between the two. In addition to this, bearing in mind the commodity, the textile goods, for which these label marks are to be used and the class of purchasers, there is a strong possibility that the marks are deceptively similar and likely to confuse.

23. On this count, it has been urged behalf of the respondents that so far as these marks are concerned, the words are different. Merely because of the embellishment of the oval background coupled with the fact that it is contended

on behalf of the respondents that at the time when a purchaser purchases this commodity he does not look at the label mark which according to the respondents is to be found only at the end of the rim, there is no likelihood of any confusion being caused. However, so far as these two marks are concerned, it is apparent that these marks are visually identified by the purchaser by the general impression which in the case of these two marks is similar as can be seen from the perusal of the writing, the background, the mode and the manner in which the words are written.

24. It is also urged on behalf of the petitioners that respondent No. 1 has failed to explain as to how and under what circumstances he has adopted the oval background and the style of lettering in that label mark and therefore the principle of *res ipsa loquitur* applies and the adoption of the trade mark by respondent No. 1 cannot be said to be honest to entitle him to take advantage of Section 12(3) of the Trade and Merchandise Marks Act, 1958. So far as this argument is concerned, on behalf of the respondents, it has been urged that the oval background is commonly used to represent the mark in textile trade and the petitioners cannot claim any exclusive monopoly or right over the oval background. However, so far as the word "SONAL" and the manner of writing the said word is concerned, coupled with the fact that the way and the manner in which the word "A ANAND PRODUCT" is written, the respondents have not been able to offer any satisfactory explanation. It is not that the petitioners are claiming any monopoly over the oval background in the trade mark as the respondents have placed before the court material to support their contention that the oval mark is extensively used and the same is common to trade. However, it is not only the oval mark but it is also the label which contains the writing in the oval background, the writing being deceptively similar, the manner of writing and the overall impression which bring about the similarity between the two trade marks.

25. It is also urged on behalf of the petitioners that respondent No. 2 erred in passing his decision on the ground that there is no question of similarity as the word "SONAL" means golden and conveys the idea different from the petitioners' trade mark and that this was sufficient to distinguish between the two. So far as this issue is concerned, on this count, reliance is placed on behalf of the petitioners on the ruling in the case of *Amritdhara Pharmacy Vs. Satyadeo Gupta*, wherein it has been observed as under :

"What degree of resemblance is necessary to deceive or cause confusion must in the nature of things be incapable of definition in priori.

For deceptive resemblance two important questions are :

- (1) who are the persons whom the resemblance must be likely to deceive or confuse, and
- (2) what rules of comparison are to be adopted in judging whether such resemblance exists.

As to confusion, it is perhaps an appropriate description of the state of mind of a customer who, on seeking a mark, thinks that it differs from the mark on goods which he has previously bought, but is doubtful whether that impression is not due to imperfect recollection."

26. It is not only the word "SONAL" which has to be taken into consideration, but also the overall effect of the trade mark, the totality of all the circumstances, the overall similarity between the way and the manner in which the name is written in the backdrop coupled with the fact that the same refers to the same type of goods. In that even there is every likelihood of deception or confusion within the meaning of Section 11(1) of the Trade and Merchandise Marks Act, 1958.

27. On behalf of the respondents, it was vehemently urged that so far as the appeal is concerned, the same is not maintainable inasmuch as u/s 109 of the Trade and Merchandise Marks Act, 1958, it is a discretionary order which cannot be interfered with. To that extent, reliance has been placed on the ruling in the case of James C. & Bros. v. N.S.T. Co. (supra), wherein it has been observed as follows :

"The Registrar in coming to the conclusion whether a trade mark should or should not be registered, exercises the discretion vested in him by statute and the court in appeal should always be extremely loath to interfere with the discretion. Discretion exercised by the Registrar should not be interfered with unless the court comes to the conclusion that the Registrar in coming to the conclusion that he did was clearly wrong or patently in error."

28. However, so far as this ruling is concerned, the same does not apply to the facts of the present case inasmuch the discretion exercised by the Registrar is based upon an erroneous conclusion with regard to the two trade marks as to whether they are likely to deceive or causes confusion and the discretion being injudiciously exercised, it is not open for the respondents at this stage to contend that this court cannot interfere with the order of the Registrar.

29. On behalf of the respondents, reliance has also been placed on the ruling in the case of Laura Ashley Ltd. v. Coloroll Ltd. (1987) RPC 2, wherein it has been held as under :

"The plaintiffs brought an action for infringement of a trade mark consisting or a logo containing the words "Laura Ashley". Essential features of the logo were said to be an oval perimeter consisting of concentric border lines of different widths with the thicker line outside and unblocked interior ground with no heavy elements of coloring, open lettering with the name being curved, and the inclusion of a floral spring. The marks complained of, which contained the word "COLOROLL", were alleged to share these essential features, with addition of a swallow. The plaintiffs pointed to the fact that the defendants have complained to the traders about the use of similar marks as supporting their case."

It was held therein as under :

"The decision depended on that was recorded as the essential feature or features of the plaintiffs' mark. The Court's first impression had been that the essential feature of the mark was the words "Laura Ashley". None of the evidence the court had heard showed that anyone would think that the essential features were the oval border and the floral additional."

So far as this case is concerned, the ruling does not apply to the facts of the present case where there is an overall similarity in the mark of the plaintiffs and that of the defendants.

30. Reliance has been placed on behalf of the respondents on the ruling in the case of *Pentagon Trade Mark (Registration)*, (1964) Reports of Patent, Design and Trade Mark Cases 138, wherein an application to "register" as a trade mark, a flattened pentagonal outline was rejected in accordance with a settled practice of rejecting geometrical outline of the sort commonly used as borders for embellishing marks.

31. It was also held therein that the mark looked like a mere frame or embellishing design, and had no inherent qualities of distinctiveness. This judgment is cited to support the contention that so far as the oval background is concerned, the same was only used in the textile trade and, therefore, so far as the same is concerned, it could not be considered as being distinctive or essential feature of the mark. However, it is not the question of the oval background by itself being an essential feature, but it is the fact that the oval background along with the essential features that make the mark deceptively similar. On that count, so far as this ruling is concerned, the same does not apply to the facts of the instant case.

32. Reliance has also been placed on behalf of the respondents on the ruling in the case of *Indo-Pharma Pharmaceutical Works Pvt. Ltd. v. Ferbanfabriken Bayer AG*. (1975) RPC 545, in the matter of the words "INDON" and "BAYER" written in cruciform in a circle and whether the same is likely to deceive or cause confusion and it was held in that case that in respect of pharmaceutical preparations, a mere circle irrespective of the words used or the letters used therein cannot be regarded as an essential feature of the mark. It was further held that the words "BAYER" and "INDON" being the essential features of the two respective house marks, there was no possibility or probability of deception or confusion between those two marks.

33. In the instant case, there is a use of the word "VIMAL" and the word "SONAL" but the two words are used in a design and in a lettering which is the same with an oval background and with the words "A RELIANCE PRODUCT" and "A ANAND PRODUCT" written in the semicircle fashion and since overall impression will be same, there is every possibility of deception and confusion between these two marks. Hence, this ruling also does not apply to the facts of the present case.

34. Reliance has also been placed on behalf of the respondents on the ruling in

the case of Allgemeine Elektricitäts Gesellschaft's Application for a trade mark (1957) Reports of Patent, Design and Trade Mark Cases 120 to support the contention that they were using the marks since 1977 and that the same has not caused any confusion. However, so far as this ruling is concerned, it is clear from a perusal of the two label marks that the petitioner's trade mark was a registered one and that it has been in use since 1972 whereas the respondent's trade mark has been in use since 1977.

35. A perusal of the two label marks clearly gives an impression that they are similar and there is every likelihood of causing deception or confusion. Hence, even though the mark has been in use by the respondents since 1977 by virtue of the fact that the two labels are identical and similar in the essential features namely the words, the use of the letters M and N, the fact that they both are having oval background and that the words "Reliance Products" and "Anand Product" being written in the semicircular fashion, there is no doubt that the purchasers of the goods can be deceived when similar trade marks are used in respect of the identical goods. The fact remains that the customer remembers the product by the general impression of a trade mark and, therefore, there is every likelihood of the same goods causing confusion in the mind of an ordinary individual.

36. Therefore, so far as this petition is concerned, in the light of the above discussion, the same is allowed and the order of the Assistant Registrar of Trade Marks dated 4th September, 1990 is set aside and the Application No. 367908 filed by Respondents No. 1 to 4 is rejected.

37. Petition allowed.