
(2009) 05 IPAB CK 0003

In the Intellectual Property Appellate Board

Case No : ORA/149/2006/TM/MUM

Shivani Detergents Private Limited

APPELLANT

Vs

Mohammad Shafi Trading As Ajanta Soap Works

RESPONDENT

Date of Decision : 01-05-2009

Acts Referred:

Trade Marks Act, 1999 — Section 9, 11, 18, 47, 57, 125

Citation : (2009) 05 IPAB CK 0003

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

Bench : Division Bench

Advocate : Vinod Bhagat, Aditya

Final Decision : Allowed

Judgement

Z.S. Negi, J

1. The applicant has filed this application for removal of Trade Mark No. 1169805 in class 03, registered in the name of the respondent, from the

Register of Trade Marks or rectification of the Register under Section 47/ 57/ 125 of the Trade Marks Act, 1999 (hereinafter referred to as the Act).

2. The applicant is a company incorporated in 1993 under the Companies Act, 1956 and engaged in well established business of

manufacturing/marketing of washing soap and detergent powder. Averment is made that the applicants in or about 1993 have originated and

independently developed various brands and marks and adopted the mark SARGAM and obtained registration thereof under No. 720335 as of

4. 11.1996 in class 03. The applicants have sold their products on large scale and have taken efforts to popularize their products bearing the trade

mark SARGAM by expending substantial sums of money on sale promotion. Due to long, open, regular and extensive sale and publicity as also due to

superior quality and high efficacy, the SARGAM products were well received and became enormously popular, therefore the applicants decided to

extend the marks and accordingly extended the marks by introducing other products under other variant trade marks such as SARGAM GOLD,

SARGAM PLUS and NAYA SARGAM.

3. Apart from the above mentioned registered trade mark, the applicants as on date are the registered proprietors of trade mark SARGAM under

Nos. 1391153 as of 14. 10.2005 and 1446737 as of 26.4.2006 and as many as 6 applications are pending for registration before the Trade Marks

Registry. All the registrations/applications for registration are in class 03 in respect of the above mentioned goods. The products emanating from the

applicants are sold under the trade mark SARGAM and its variants of the applicants' trade marks which are quite well known and have become

inalienably associated in the course of the trade with the applicants and none else. The trade mark SARGAM or its variants are shown prominently on

every wrapper, sachet label or packaging materials for washing soap or detergent or both and the whole layout, design, colour scheme of each

wrapper, sachet label or packaging material is different and unique. These layout, design and colour scheme (hereinafter referred to as the artistic

work) is visualized, conceived, originated and adopted by the applicants. The applicant is the original creator and owner of the copyright and as such

the artistic work constitute the original work and the applicants own the copyright therein. Any person using the identical trade mark and/or artistic

work to the applicants' registered trade mark SARGAM /artistic work in respect of washing soap and detergent is causing and bound to cause

confusion and deception amongst the traders, wholesalers, retailers and consumers.

4 . The applicants have averred that in or about June 2006 they learnt that one Oshiwara Detergents is using the applicants' registered trade mark in

respect of detergent cake having wrapper with identical artistic work of the applicants' product whereupon the applicant sent a cease and desist notice

dated 29.6.2006 through their advocate and reply date 16.7.2006 came to the applicants' advocate from the Oshiwara Detergents through its advocate

refusing to stop using the mark and artistic work by stating that registration of identical mark SARGAM under No. 1169805 exists in the name of

Ajanta Soap Works (in short registered proprietor) and further stating that Oshiwara Detergents is licensee of the registered proprietor. From inquiries made by the applicants, it was revealed that the registered proprietor made application dated 28.1.2003 for registration of trade mark SARGAM SABUN (in devnagri) in respect of goods in class 03 claiming user since 31.12.1999. The applicants claimed that they are in the business of manufacturing/marketing of washing soap and detergents since 1992 and marketing all their products continuously and extensively under the trade mark and packing under the unique artistic work, the registered proprietor ought to have been aware about the use of such trade mark and artistic work at the time of making application for registration of the impugned mark. Thus the adoption of the impugned and confusingly similar trade mark is in bad faith and dishonest intension to pass off its goods as that of the applicants' popular products and to reap illegal benefit and gains. The applicant filed a suit on 25.9.2006 for passing off action against the registered proprietor in District Court of Indore, Madhya Pradesh and also application for interim relief and the suit and application are pending.

5 . The applicant claiming to be the person aggrieved by the entry of the impugned trade mark in the register of trade marks in the name of registered proprietor has filed the present application for cancellation of the mark on the grounds, inter alia, that the registered proprietor's impugned mark neither was/is distinctive of the goods of the registered proprietor nor was/is capable of or adapted to distinguish the goods of the registered proprietor and the claim of user made in the application by the registered proprietor was in bad faith; that the impugned mark of the registered proprietor is practically identical with the applicants' registered and reputed trade mark which is already in use since 1993 and the use of the impugned mark in relation to the registered proprietor's goods is likely to deceive or cause confusion as to the trade origin having regard to the wide and immense reputation and goodwill earned by the applicants in their trade mark SARGAM in relation to washing soap and detergents; that the applicants are not only prior registered proprietor, prior adopter but also prior user of the trade marks SARGAM , SARGAM GOLD, SARGAM PLUS, NAYA SARGAM; that the registered proprietor is not the proprietor of the impugned mark; that the impugned mark would otherwise be disentitled to protection in a court as

its use would tantamount to passing off the registered proprietor's goods as that of the goods of the applicants; that the adoption of the impugned mark by the registered proprietor was not honest; that the entry relating to the impugned mark wrongly remains on the register and that the registered proprietor has obtained registration of the impugned mark by practicing fraud, misrepresentation and concealment of facts and, therefore, the registration of the impugned mark is liable to be cancelled under Sections 57, 125 and other provisions of the Act.

6. A copy of application by notice on Form No. C, dated 11.12.2006 was served on the registered proprietor calling upon him to file counter-statement within two months, if he wishes to contest the application. Though the registered proprietor had received the said notice on 19.12.2006 but no counter-statement has so far been filed by the registered proprietor. The hearing notice dated 15.1.2009 (for hearing fixed on 6. 2.2009 at Mumbai) sent to the registered proprietor has been received back undelivered with the postal remarks ""Left"". The application came up before us for hearing on 6.2.2009 wherein Shri Vinod Bhagat, Advocate i/b Aditya & Associates, appeared for the applicants and no one represented the registered proprietor. It was decided that no useful purpose will be served in adjourning the matter in which the registered proprietor has not shown his inclination/intension to contest the matter. Accordingly, we proceeded to hear the learned Counsel for the applicants.

7 . Learned Counsel for the applicants submitted that the registered proprietor (defendant) has been proceeded ex-parte in the suit before the District Court at Indore and the District Judge passed the decree in the suit on 18.7.2008. He submitted that the respondent has adopted the impugned mark which is phonetically identical with the prior registered trade mark of the applicants. The goods covered by both the competing marks are identical and the trade channel and consumers are also common and therefore the use of impugned mark during the course of trade is bound to cause confusion or deception. While furnishing a certified copy of decree the learned Counsel has submitted that the P.W. No. 3 has made a statement that he is wholesaler of detergent and soap and the dealership of Shivani Detergents Private Limited for the Dulia district is with him and about one to one and half years a go he received complaints about bad quality products of Shivani Detergent under the trade mark SARGAM and when it was enquired

from different shops, then he came to know that a similar kind of matching duplicate product in the name of SARGAM is being sold in the market and then he intimated this to company for taking necessary action so as to stop the dilution of the reputation of the company's product. Thus the deception or confusion has already taken place. There is no doubt that the applicant is the prior adopter and user of the mark SARGAM and the adoption of deceptively identical mark by the respondent cannot be said to be bona fide or honest. The right and interest of the applicant who is first in the market is required to be protected. He further submitted that the registration of the impugned mark is in contravention of the provisions of Sections 9, 11, 18 and other provisions of the Act. Learned Counsel urged that the impugned registration be cancelled and cost be awarded in favour of the applicant.

8 . After hearing the learned Counsel for the applicant and on perusal of the documents available on record, the foremost question to be considered by us first is as to whether the applicant is the person aggrieved to file the present application. The Courts have given liberal construction to the expression person aggrieved especially when the application is for removal of the mark under Section 57 of the Act. A trader dealing in the same class of goods to which the registered trade mark relate, or persons who are in some way or the other substantially interested in having the mark removed from the register, are persons aggrieved. The test for such determination is propounded in Powell's Trade Mark 1894 (11) RPC 4. A person aggrieved includes the rivals in the same trade who are aggrieved by the entry of the rival's mark in the register or person whose legal rights would or might be limited if the mark remains on the register, he could not lawfully do that which, but for the existence of the mark on the register he could lawfully do. The applicant in the present case is in the same business of manufacturing and marketing in washing soap and detergent powder like the respondent. The registration of trade mark obtained by the respondent is in restraint to the legal rights of the applicant and the goodwill and reputation of the applicant's mark would be diluted and debased by use of the impugned registration, therefore, the applicant is in one way or the other substantially interested in having the mark of the respondent removed from the register. Applying the above referred propounded test, the applicant is the person aggrieved to file the present application.

9 . The next issue we would determine is whether the two marks are similar or identical to cause confusion or deception. It is well settled that while

comparing the marks we have to take the mark as a whole, dissection of mark is not permissible. The Supreme Court in Parle Products (P) Ltd. v.

J.P. & Co. Mysore MANU/SC/0412/1972 has laid down the test to determine the question when a trade mark is deceptively similar to another. Their

Lordships observed at page 1362:

It is therefore clear that 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 a character as to prevent one design from being mistaken for the other. It would be enough if the impugned marks bear such an overall similarity

to the registered trade mark as would be likely to mislead a person usually dealing with one to accept the other if offered to him." A little later it was

observed:

After all, an ordinary purchaser is not gifted with the power of observation of a Sherlock Holmes.

Two marks, when placed side by side, may exhibit many and various differences, yet the main idea left on the mind by both may be same. A person

acquainted with one mark, and not having the two side by side for comparison, might well be deceived, if the goods were allowed to be impressed with

the second mark, into a belief that he was dealing with goods which bore the same mark as that with which he was acquainted. Thus, for example, a

mark may represent a game of football; another mark may show players in a different dress, and in very different positions, and yet the idea conveyed

by each might be simply a game of football. It would be too much that persons dealing with trade marked goods, and relying, as they frequently do,

upon marks should be able to remember the exact detail of the marks upon the goods with which they are in the habit of dealing. Marks are

remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole. Moreover, variations in

detail might well be supposed by customers to have been made by the owners of the trade mark they are already acquainted with for reasons of their

own.

The Supreme Court relied on the following passage in Karly's Law of Trade Marks and trade Names (9th Edition, paragraph 838):

The test in this matter has been laid down by Mr. Justice Parker in the case of In re Pianotist Co's Application (1906) 23 RPC 774 (C), at p. 777.

You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be

applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must consider all the surrounding

circumstances; and you must further consider what is likely to happen if each of those trade marks is used of the respective owners of the marks. If,

considering all these circumstances, you come to the conclusion that there will be a confusion, that is to say, not necessarily that one man will be

injured and the other will gain illicit benefit but that there will be a confusion in the mind of the public which will lead to confusion in the goods, then

you may refuse the registration, or rather you must refuse the registration in that case.

10. In the present case, both the marks SARGAM are label marks one is in English and the other in Devnagri. The competing marks are phonetically

identical. The goods for which the marks are registered are same or similar and trade channel and consumers are same. The purchaser while

purchasing soap and detergent powder will place order by pronouncing or uttering the brand name SARGAM and due to phonetic similarity in

pronouncing the word SARGAM, the shopkeeper will generally give any of the soap or detergent powder or both, as the case may be, bearing or

packed under the label SARGAM , unless the purchaser is very meticulous to closely scrutinise the getup and colour scheme of packing material (for

such scrutiny, the purchaser should remember the getup and colour scheme of packing material of goods which he intends to buy). In other words a

man of average intelligence and imperfect recollection will not remember the get up and colour scheme of packing material but tend to remember

striking feature of the wrapper or label that is SARGAM written in Hindi/Devnagri. It is seen from the copies of the registration

certificates of the applicant (under No. 1391153 and 720335) that NAYA SARGAM a n d SARGAM PLUS are written in Hindi and likewise in the

advertisement of respondent's mark in the Trade Marks Journal SARGAM SABUNis written in Hindi. Though the wrappers of the parties have not

been filed, the District Court has in the Decree observed that both wrappers have been found to be similar. In view of the foregoing, we are of the opinion that use of respondent's mark is bound to deceive or cause confusion to the public. There is also possibility that the purchaser/consumer may associate the goods of the respondent with the applicant or think that the soap and detergent powder of the respondent are emanated from the applicant because of business expansion. From the copies of the registration certificates and Trade Marks Journal, it is evident that the applicant is the prior adopter and user of the trade mark SARGAM and the applicant is first in the market. The impugned registration is barred by Sections 9 and 11 of the Act. We do not have the benefit of explanation of the respondent as to how it came to settle on the impugned mark when identical mark for identical goods was in use by the applicant, as the respondent has not filed counter-statement to the application. The applicant has also not adduced any evidence in support of its application. We are therefore passing this order only on the basis of deceptive similarity of the two marks and to maintain the purity of the register, which is in the public interest.

1 1 . The result is that the present application succeeds only on the ground of deceptive similarity of the respondent's mark with that of the applicant's prior adopted mark and to maintain the purity of register. Accordingly, we allow the application and direct the Registrar of Trade Marks to remove the impugned registration No. 1169805 in class 03 from the Register of Trade Marks. Let a copy of this order be forwarded to the Registrar of Trade Marks for compliance. There shall be no order as to costs.