

(2004) 01 IPAB CK 0013

In the Intellectual Property Appellate Board

Case No : TA/100/2003/TM/DEL (CM (M)/551/94)

Swastik Pipes Ltd.

APPELLANT

Vs

Rikab Chand Jain

RESPONDENT

Date of Decision : 30-01-2004

Acts Referred:

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

Citation : (2004) 28 PTC 555 (IPAB)

Hon'ble Judges : Ragbir Singh, J; T.R. Subramanian, Technical Member

Bench : Division Bench

Advocate : Amrithraj Lal, G.D. Chugh,

Final Decision : Allowed

Judgement

T.R. Subramanian, Technical Member

1. This is an appeal against the order of the Deputy Registrar of Trade Marks, New Delhi dated 5th October 1994 following the opposition No. DEL-

7758 filed by the respondents opposing the registration of the appellants' trade mark application No. 487904.

2. The appellants M/s. Swastik Pipes Limited, New Delhi had filed trade mark application No. 487904 on 23rd March 1988 at the Trade Marks

Registry, New Delhi for registering the trade mark consisting of the letters T.T. enclosed in an oval and the words 'Swastik' in respect of steel pipes

and tubes included in Class 6 claiming user from 1975. The mark was ordered to be associated with No. 417580 and advertised in the Trade Marks

Journal 1029 dated 16th April 1992.

3. On 17.6.1992, M/s. T.T. Industries, the respondent's hereinabove filed a notice of opposition opposing the registration of the appellant's trade mark.

They have submitted that they are the registered proprietors of the trade mark containing the letters T.T. under No. 334423 dated 13.3.1978, No.

266085 dated 3.8.1970, No. 277801 dated 20.1.1972, No. 334422 dated 13.3.1978 and No. 432270. The above trade marks are valid and subsisting.

They have further submitted that they have also applied for registration of the same trade mark containing the letters T.T. in Classes 18, 17 and 25.

They submitted that they have been carrying on the business of manufacturing and marketing of all kinds of hosiery goods such as Genjis, Jangias,

Bras, socks, etc., in the name and style of M/s. T.T. Industries since the year 1968. They have submitted that the letters T.T. of the appellant's mark

with or without the oval border is identical to the opponents' trade mark and that the appellants have adopted the mark with a view to trade upon and

benefit from the reputation and goodwill attached to the opponents trade mark. They further submitted that the registration of the trade mark applied

for by the applicants is contrary to the provisions of Sections 9, 11(a), 11(e), 12(1) and 18 of the Act.

4. On 30.4.1993, the appellants filed the counter statement denying all the material averments in the notice of opposition and contended that they

adopted the trade mark since the year 1975 in respect of steel pipes and tubes. They further submitted that the goods of the appellants and that of the

respondents are different. The respondents filed their evidence. Thereafter the appellants also filed their evidence which was followed by filing of the

reply evidence by the respondents. The case was heard by the Deputy Registrar of Trade Marks on 2.9.1994 and by his order dated 5th October

1994, he had allowed the opposition and refused registration of the appellant's trade mark application. The appellants filed an appeal (CM (M)/551/94)

before the Hon'ble High Court of Delhi, which was transferred to the Intellectual Property Appellate Board (IPAB). The appeal was heard by the

Board on 23rd January 2004.

5. At the hearing before this Board Shri Amrithraj Lal and Shri G.D. Chugh, Advocate appeared for the appellants and none appeared for the respondents.

6. The learned counsel for the appellants Shri Amrithraj Lal submitted that the Deputy Registrar has erred in deciding that the appellants have dis-

honestly adopted the mark. He submitted that the appellant's mark comprises of

the letters T.T. within an oval and the word Swastik. He submitted that this is a composite mark and the same has been used in respect of steel pipes and tubes from the year 1975. On the other hand he submitted that the respondents' trade mark comprised of the letters T.T. only enclosed in a heart-shaped device and the respondents have been using the mark for hosiery goods. He submitted that the two trade marks are completely different and also the goods are also completely different. Hence there cannot be any confusion of deception in the minds of the public. He also referred to the advertisement of the appellant's trade mark in the Trade Marks Journal 1029 and submitted that the mark has been associated with their earlier registered TM No. 417580 and that they have also disclaimed the right to the exclusive use of the letters T.T. appearing on the label. He submitted that the appellant's trade mark also consists of the words 'Swastik' which is a distinctive word and could be registered even on the basis of proposed to be used. He referred to the counter statement filed by them and submitted that their firm used the trade mark T.T. till September 1985 and thereafter, they added the word 'Swastik' to it on 17th September 1985 as most of the manufacturers and traders started using the trade mark T.T. for pipes and tubes. It is seen from the records that the appellants have started using the mark T.T. Swastik from 7.9.1988 and before that they have been using the mark T.T. within an oval from 13.3.1982. It is also seen that the respondents have not applied for registration of their trade mark in respect of steel pipes and tubes in Class 6. Furthermore, the appellants have adopted the trade mark T.T. within an oval alongwith the word 'Swastik' and they have disclaimed the exclusive use of the letters T.T. appearing in their label. The appellant's trade mark is, therefore, a composite mark consisting of the letters T.T. within an oval and the word 'Swastik' whereas the respondent's trade mark is the letters T.T. within a heart-shaped device. The rules for comparison of words has been laid down by Lord Parker in Pianotist Company Limited's application, (1906) 23 RFC 774 at p. 777, which is as follows:-

You must take the two words. You must judge 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 in a normal way as a trade mark for the

goods of the respective owners of the marks. If considering all those 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"".

7. It has been stressed that the question whether the two marks are likely to give rise to confusion or not is a question of first impression (Corn

Products Refining Co. v. Shangrila Food Products Ltd., AIR 1960 SC 142).

8. It is also a well-settled proposition that the marks have to be compared as a whole. Also to determine whether the two marks are deceptively

similar the test of an average person with imperfect recollection has to be applied. The authority has to visualize, if a customer who may be an

ordinary citizen and who may want to purchase a medicine would get confused.

9. In view of the above decisions of the various authorities, we are of the opinion that the rival marks are different and also the goods of the appellants

and that of the respondents are also different. In view of this, we hold that the respondent's objection under Section 2(1) is not sustained.

10. As far as the respondent's objection under Section 11(a) is concerned, as we have already held that the rival marks are not deceptively similar, it is

not necessary to go into the question of reputation and use of the respondents mark to decide the question of confusion or deception. Hence, the

respondents objection under Section 11(a) is also not sustained.

11. As regards Section 18(1) of the Act, the Deputy Registrar has held that the appellants have not honestly adopted the trade mark. We have already

held that the rival marks are not deceptively similar. Further, it is seen from the advertisement of the appellant's trade mark application in Trade Marks

Journal No. 1029 that it has been associated with the earlier registered trade mark No. 417580. It means that the appellants have been using the

letters T.T. from the date of the trade mark application No. 417580. However, they have now added the words 'Swastik' to the letters T.T. and have

filed the present trade mark application No. 487904. The appellants have also disclaimed the use of the letters T.T. on the directions from the

Registrar of Trade Marks. From the records it is seen that the appellants have honestly adopted the trade mark 'T.T. Swastik' with effect from

7.9.1988 only. They, therefore, cannot claim use of the trade mark from the year 1975 as has been stated in their application. During the hearing,

when this was pointed out to the counsel for the appellants, they agreed to amend the application to read as 'proposed to be used'.

12. In view of the above, we allow the appeal subject to the condition that the appellants file a request on TM 16 for amending the application to read

as 'proposed to be used'. There is no order for costs.