

(1999) 12 DEL CK 0005
In the Delhi High Court
Case No : C.M. (M) No. 82 of 1998

The British India Corpn. Ltd.

APPELLANT

Vs

Kharaiti Ram and Others

RESPONDENT

Date of Decision : 22-12-1999

Acts Referred:

Trade and Merchandise Marks Act, 1958 — Section 11, 12, 18

Citation : AIR 2000 Delhi 289 : (2000) 84 DLT 799 : (2000) 56 DRJ 608 : (2000) 125 PLR 23

Hon'ble Judges : Dr. M.K. Sharma, J

Bench : Single Bench

Advocate : Manmohan Singh and Chander Shekhar Patney, for the Appellant;
M.R. Bhale Rao, for the Respondent

Final Decision : Dismissed

Judgement

M.K. Sharma, J.—The present appeal is directed against the order dated 7-11-1997 passed by the Assistant Registrar of Trade Marks, New Delhi dismissing the opposition filed by the petitioner herein and accepting the application for registration in class 24 with the condition that the respondents I to 3 would agree to the disclaimer of the word "DHARIWAL" appearing in the mark applied for.

2. On 15-3-1990 the respondents 1 to 3 trading as M/s. Dhariwal Woollen Textile Mills applied for registration of trade mark "DWM-DHARIWAL" vide application No. 526317 in respect of blankets, shawls, lohis and other woollen piece goods included in class 24. The respondents claimed the user of the said mark applied for since 15-9-1987. The aforesaid application was ordered to be advertised before acceptance and was accordingly advertised in the trade mark journal on 1-8-1994. On publication of the advertisement the petitioner gave notice of its intention to oppose the registration of the trade mark advertised on the ground of it being vocative of the Trade and Merchandise Marks Act, 1958 (hereinafter called the Act). The respondents contested the aforesaid notice of opposition by

filing their counter statement supporting the registration of the mark applied for. The evidence was accepted by the Assistant Registrar of Trade Marks through affidavits and thereafter he proceeded to hear the parties and by the impugned order the opposition of the petitioner was rejected and the application for registration was accepted subject to the aforesaid conditions

3. Being aggrieved by the aforesaid order the present appeal has been preferred u/s 109 of the Act. Learned counsel appearing for the petitioner submitted that the petitioner is a Government Company dealing in manufacture of woollen goods i.e. Kashkari Lohis, shawls, lohis, blankets, suiting etc. under the emblem and device of LAMB over the word DHARIWAL which is written in a characteristic manner. According to the petitioner the said trade mark and device are well known and recognised by the members of the trade and public. It was also the contention of the petitioner that the said trade mark "DHARIWAL" along with the device was adopted in the year 1920 and is being used as such in respect of which the petitioner also obtained registration as on 1-12-1955 and advertised in the trade mark journals. It was also stated by the petitioner that the said trade mark "DHARIWAL" and device of LAMB is also the house-mark of the petitioner.

4. Mr. Manmohan Singh appearing for the petitioner submitted that the trade mark applied for by the respondents for "DWM-DHARIWAL" is deceptively similar to the trade mark "DHARIWAL" along with the device of LAMB of the petitioner registered on 1-12-1955 and the same is likely to cause confusion and deception if the same is allowed to be used by the respondents and thus the impugned order accepting the registration is against the provisions of the Trade and Merchandise Marks Act. It was also submitted by him that the respondents are not using the letter mark DWM at the time of user and that they are only using the trade mark DHARIWAL in the same script as well as the device of LAMB in the identical fashion and Therefore the dishonest intention is apparent on the face of the record. In support of the said contention reliance was also sought to be placed by the counsel appearing for the petitioner on the conduct of respondent No. 1 who was admittedly the employee of the petitioner from 19-6-1946 to 26-11-1985, the date on which he was dismissed from service, the respondents Nos. 2 and 3 being the daughter-in-law and other relations of respondent No. 1. He further contended that the respondents 1 to 3 are using the trade mark DHARIWAL as well as the device of LAMB in identical script and fashion as the petitioner is using and Therefore, are guilty of making unwarranted efforts of capitalising on the goodwill and reputation of the petitioner. In support of his submission the learned counsel appearing for the petitioner relied upon various decisions to which reference shall be made at the time of dealing with the issues raised in the present petition.

5. Mr. Bhale Rao, learned Counsel appearing for the respondents, on the other hand submitted that the trade mark applied for by the respondents as "DWM-DHARIWAL" is neither identical with nor deceptively similar to the trade mark DHARIWAL of the petitioner along with the device of LAMB and that there is no

likelihood of deception and confusion in view of the distinctiveness and dissimilarity in the trade marks. It was also submitted that the trade mark DHARIWAL is a geographical name which could be used by respondents 1 to 3 who belong to the place "Dhariwal". It was the contention of the respondents that the mark "DHARIWAL" cannot be said to be a distinctive trade mark, in support of which the learned counsel relied upon the decision in *The Imperial Tobacco Co. of India Ltd. Vs. The Registrar of Trade Marks and Another*, . Counsel for respondents 1 to 3 relied upon the decision in the Imperial Tobacco case (supra) wherein the Calcutta High Court held that a geographical name according to its ordinary signification which is inherently or otherwise incapable of acceptance subject to minor exceptions. In the said decision it was also laid down that a geographical name not used in geographical sense to denote place of origin, but used in an arbitrary or fanciful way to indicate origin or otherwise regardless of location could be sustained as a valid trade mark.

6. In the context of the aforesaid submissions of the learned Counsel appearing for the parties I have perused the records. The first question Therefore, which falls for my determination is to scrutinise as to whether the trade mark "DHARIWAL" is a geographical and common name and if that be so whether the said trade mark is unregistrable. The Assistant Registrar held that the word "DHARIWAL" is the name of a place in Punjab and Therefore, the petitioner could not claim to have exclusive right of property and Therefore, the word "DHARIWAL" has to be disclaimed by respondents 1 to 3. The application of the respondents was accepted on the ground that the comparison of the two trade marks, taking both as a whole, indicates that they are different from each other, for the trade mark of petitioner consists of the device of lamb in quite a distinguishing manner while the trade mark of respondents consists of the letters DWM in addition to the word "DHARIWAL" which is common in both the trade marks and Therefore, there is an over all difference which is so prominent that there is no likelihood of confusion. He also held that both the petitioner and the respondents have the right to use the word "DHARIWAL" to describe their place of business.

7. I have considered the submissions and in my opinion the decision in *The Imperial Tobacco Co. of India Ltd. Vs. The Registrar of Trade Marks and Another*, cannot be said to be applicable to the case pleaded by the respondents, for the said decision also holds that a geographical name under certain circumstances could be used as a valid trade mark. The trade mark of the petitioner is dhariwal with a device of lamb over the word "DHARIWAL" which is written in a characteristic manner. The petitioner has also obtained registration in respect of the said trade mark as far back as 1-12-1955. It is also on record that the said trade mark was being used by the petitioner along with the device from the year 1920. The prayer for registration of the respondents was accepted for trade mark "DWM-DHARIWAL" and Therefore, even the Registrar has recognised that a mark of the nature could be registered.

8. While using the aforesaid trade mark on their goods the respondents 1 to 2 are using the trade mark under the name DHARIWAL with a similar picture of lamb and thus similar mark and the device is being used by respondents 1 to 3. It is also necessary to mention herein that the trade marks cover goods of the same description and of the same class. Since both the devices have close resemblance with the same picture mark an over all impression is created that the goods manufactured and marketed by respondents 1 to 3 have their origin at the same place.

9. u/s 11(a) of the Trade and Merchandise Marks Act a mark the use of which is likely to deceive or cause confusion shall not be registered as a trade mark. u/s 12(1) it is provided that 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 the trade mark which is already registered in the name of a different proprietor in respect of the same goods or description of goods.

10. In the present case it is the specific case of the petitioner that the trade mark that is sought to be registered by respondent is likely to deceive and confuse inasmuch as there could be a possibility and an apparent likelihood of creating confusion and deceiving the general public as the trade mark may create an impression that the goods are the goods manufactured by the petitioner. As delineated above, the devices used by the petitioner and the respondents are similar to one another and the trade mark used by both the petitioner and the respondents in their goods is also "DHARIWAL" and thus there is every likelihood of the general public being deceived.

11. Reference may be made to the decision of this Court in Kedar Nath Vs. Monga Perfumery and Flour Mills Delhi-6, . This Court in the said decision held that the impugned trade mark clearly infringed the registered trade mark of the plaintiff and the pre-fix "Vijay" to the word "Sudershan" was not likely to catch the eye of an ordinary purchaser who would easily be deceived into thinking that he was buying the product of the plaintiff. The petitioner has placed material on record that they are well established manufacturers of Shawls, blankets and that they have been selling their goods from 1920 under the trade name "DHARIWAL" with the device of lamb written in a characteristic style and has also a registration granted in its favor in the year 1955. Therefore, the possibility of confusion between the goods of the two manufacturers by virtue of their using the trade mark containing the same device and the same trade name is very real. Although the respondents 1 to 3 applied for registration of their trade mark under the name "DWM-DHARIWAL" they have in fact been using a part of the trade mark namely the trade mark "DHARIWAL" which is registered in the name of the petitioner and by dropping the prefix "DWM" from the trade mark in doing actual business an effort is being made by the respondents to deceive the general public which cannot be said to be an honest intention.

12. It is an admitted position that the respondent No. 1 was an employee of the

petitioner from 19-6-1946 till he was dismissed from service on 26-11-1985. The said respondent No. 1 has adopted a trade mark which is almost similar to that of the petitioner i.e. "DWM-DHARIWAL" as against "DHARIWAL" of the petitioner and also using the same device as also using the trade mark in the same script. The adoption of the aforesaid trade mark cannot be said to be an honest adoption, for dishonesty is writ large on the face of the record. In Consolidated Foods Corporation Vs. Brandon and Company Private Ltd., it was held that the discretion u/s 12(3) of the Act can only be exercised where two or more parties unknown to each other are unaware of the mark used by each other innocently adopt and use the same mark in respect of their respective goods of the same nature. The present is a case of a contrary nature, for the parties were known to each other, the respondent No. 1 being an employee of the petitioner for a long period of time till he was dismissed from service and Therefore, respondent No. 1 was fully aware of the trade mark used by the petitioner. Even in spite of such awareness he proceeded to adopt deceptively similar trade mark and thus the user cannot be said to be honest concurrent user. Thus the adoption of the trade mark is also against the provisions of Sections 12 and 18 of the Act.

13. In this regard I may appropriately refer to the Division Bench decision of the Bombay High Court in M/s. National Chemicals and Colour Co. and Others Vs. Reckitt and Colman of India Limited and Another, , wherein it was decided that where the applicant was aware that there were other similar registered trade marks and nevertheless continued to use the same device on their goods, the same cannot be held to be honest concurrent user. The ratio of the said decision is fully applicable to the facts of the present case.

14. Considering the aforesaid facts and circumstances of the case, I am of the considered opinion that the order of the Assistant Registrar accepting the registration is illegal and without jurisdiction. The impugned order is, Therefore, set aside and quashed. The application for registration consequently stands dismissed. The appeal stands allowed but without any costs.