
(2011) 10 IPAB CK 0002

In the Intellectual Property Appellate Board

Case No : M.P. No. 196/2009 In OA/4512009/TM/CH AND OA/45/2009/TM/CH

T.T. Industries & Anr

APPELLANT

Vs

Registrar Of Trade Marks & Ors

RESPONDENT

Date of Decision : 31-10-2011

Acts Referred:

Trade Marks Act, 1999 — Section 9, 9(2), 9(2)(a), 11(a), 11(1), 11(2), 12(1), 18(1), 31

Citation : (2012) 49 PTC 157 (IPAB)

Hon'ble Judges : Prabha Sridevan, J;S. Usha, J

Bench : Division Bench

Final Decision : Allowed

Judgement

S. Usha, J

1 . Appeal arising out of a common order dated 1.5.2008 allowing the Application Nos. 550287 in Class 01, 550288 in Class 02, 550289 in Class 03,

550290 in Class 04, 550291 in Class 05, 550295 in Class 09, 550297 in Class 11, 550298 in Class 12, 550300 in Class 14, 550301 in Class 15, 550302 in

Class 16, 550304 in Class 18, 550305 in Class 19, 550306 in Class 20, 550307 in Class 21, 550308 in Class 22, 550309 in Class 23, 550310 in Class 24,

550311 in Class 26, 550312 in Class 27, 550313 in Class 28, 550314 in Class 29, 550315 in Class 30, 550316 in Class 31, 550317 in Class 32, 550318 in

Class 33 and 550319 in Class 34 to proceed to registration, dismissing the applications filed by the Appellant - Opponent in Opposition Nos. MAS

51956, MAS-51957, MAS-52356, MAS-51958, MAS-51959 MAS-51963, MAS-56012, MAS-52084, MAS-51712, MAS-51043, MAS-52085, MAS

51964, MAS-52710, MAS-52711, MAS-52622, MAS-52625, MAS-51017, MAS-51016 MAS-52626, MAS-51965, MAS-52623, MAS-52086, MAS-

52087, MAS-51967, MAS 52088, MAS-51966 and MAS-52624 and also imposing the cost of Rs. 2500/- on the Appellant in each of the 27 Opposition

proceedings. The respondent herein filed 27 applications for registration of the trade mark DMR within a heart device (a label mark). All the 27

applications were advertised in the Trade Marks Journal and the same was opposed by the appellant herein. The appellant herein filed a notice of

opposition. The counter statement was filed by the respondent herein and on completion of the pleadings, the second respondent herein passed the

impugned order on the finding that the appellants and the respondent goods are not deceptively similar. The Registrar also held that the letter ""TT"" and

DMR"" are totally different in all respects and there was no possibility of any confusion or deception in the minds of the public and therefore not

prohibited by operation of Section 11(1), 11(2) of the Act. As there was no possibility of confusion and deception the registration therefore not

prohibited by operation of Section 9(2)(a) of the Act. The respondents mark was ""proposed to be used"" but as it was represented in an artistic manner

was capable of distinguishing and therefore qualified for registration. As the respondents were the registered proprietor of the trade mark in No.

334288 they were the proprietors of the mark and therefore qualified for registration under Section 18(1) of the Act. In view of the above the Learned

Registrar disallowed the opposition and allowed the trade mark applications to proceed to registration.

3 . Being aggrieved by the said order, the appellants have filed the present appeal. The appellants adopted the composite trade mark comprising the

expression ""TT"" within an onion like device (sometimes referred to as ""Heart-like Design""). The appellant have been continuously using the said trade

mark for various goods and services throughout India and in foreign countries.

The above mentioned trade mark has been the trade mark/house mark/monogram/logo of the appellant's business and the entire business worth over

several billions of rupees and is solely dependent on the said business. The popularity and the acceptability of the said trade mark would be evidenced

from the fact that in the year 1968-69 the sales turn over which was Rs. 1,99,743 rose to Rs. 26,77,78,000 in the year 1990-91. The appellants have

also spent huge amount towards sales promotion and advertisement.

3. The appellants have registered their trade mark ""TT"" not only in India but

also in other countries namely, Pakistan, Bangladesh, Nepal, Sri Lanka

etc. By virtue of voluminous user for over 41 years uninterruptedly the said trade mark has reached every nook and corner of this country and other

neighbouring countries. The appellants have also exported their goods bearing the said trade mark.

4 . By reason of long standing use for considerable period of time and by advertisements and publicity of the said mark, it has come within the

knowledge of a large section in India and outside. It has acquired the status of a well known mark and it is entitled to protection under the Act. The

ordinary members of the public recognize the appellants trade mark not only by the letters ""TT"" but also by the look and/or visual representation of the

novel onion-like border/artistic design.

The appellant devised the composite trade mark ""TT"" within the onion-like ornamental border in the year 1964. The said trade mark was assigned by a

family arrangement to the present appellant in the year 1967. Since the year 1968 the appellants have been using the said trade mark.

5. The appellants have also initiated legal proceedings against various infringes . The appellant has also initiated proceedings against the present

respondent in F.A.O. (OS) 145/98 before the Hon'ble High Court of Delhi wherein it was observed by the Division Bench -

... To us it appears that the curvilinear shape (referring to the appellant's trade mark) is not a ""heart shape"" but has a closer resemblance to an onion

which is sprouting on both sides, which itself seems to make the design something which does not exist in nature and, therefore, uncommon. Adoption

of such a shape without any material change in its appearance would prima facie be, therefore infringe the Copyright of the Appellant.

6 . The appellant is not only the originator, first adopter and first user of the trade mark but it is also the registered proprietor of the said trade mark in

respect of various kinds of goods/services. The appellants have also applied for and obtained registration under the Copyright Act. The appellant's

trade mark registration dates back to 3.8.1970. As the business of the appellant was diversifying the appellant filed applications for registration of the

trade mark under all the 34 classes of the Fourth Schedule to the Trade & Merchandise Marks Rules, 1959.

7. The appellant filed the oppositions on the ground that the respondent's

application was not only detriment to the trade and public at large as well as to the appellants herein having regard to the close resemblance to the trade marks in question. The respondent's mark was neither distinctive nor capable of being distinguished and therefore was in contravention of the provisions of Section 9 of the Act. The grounds on which the appellants based their appeal are -

(i) That the impugned order was wrongly made by the Deputy Registrar of Trade Mark.

(ii) The Deputy Registrar has not given any consideration of the fact and circumstances of the case and has erroneously taken a view that there is no issue for likelihood of confusion and deception.

(iii) The Deputy Registrar has completely failed to appreciate that the said Respondent is not legally permitted to approbate and reprobate the issues concerned with the proceedings. The Registrar has irrationally relied upon the contention of the 3rd Respondent.

(iv) It is a fact that he has failed to take cognizance of the fact that the impugned mark submitted for registration shall not proceed to registration due to the statutory bar of Section 12(1) of the Act.

(v) The Deputy Registrar has misdirected himself in interpreting the issue of ""Deceptive Similarity"". The Deputy Registrar had also misdirected herself that the competing trade marks are not deceptively similar without taking into consideration the settled principles laid down by the apex Court.

(vi) The Deputy Registrar has failed to appreciate that the likelihood of deception and/or causing confusion is not only guided by the identify of the marks but the provisions of Section 9(2) of the Act aimed to protect the interest of the public.

(vii) The Deputy Registrar has completely ignored the mala fide of the respondents in making the frivolous claims of user.

(viii) The Deputy Registrar has misinterpreted the provisions of Section 18(1) of the Act and failed to apply her judicial mind that registration of the trade mark under No. 334288 in Class 25, even though the said trade mark has been challenged before the same Registrar under opposition No.

MAS-337.

(ix) The Deputy Registrar has erred in allowing the applications for registration of the ""proposed to be used/unsubstantiated claim of user"" without any

restriction and limitation.

(x) The Deputy Registrar by non-application of mind disallowed the appellant's opposition.

(xi) The Deputy Registrar has wrongly overlooked the strong and valid opposition made by the appellant that the acceptance of the impugned application would be against public interest.

(xii) The impugned order is contrary to law and is not sustainable at all either in law or in fact. The impugned order if allowed to stand would occasion a failure of justice and serious prejudice to the appellant.

8 . The third Respondent herein filed a counter statement denying the various allegations made in the grounds of appeal. They stated that -

(i) They adopted a trade mark consisting of the letter ""DMR"" within an ornamental border on 10.3.1968 and ever since that date has been using the same continuously.

(ii) They had applied for and obtained registration of the trade mark under No. 334288 as of 10th March 1968 and the same has been renewed and it is subsisting.

(iii) In view of the continuous use and in order to safeguard their rights they had applied for registration of the trade mark in all the 34 Classes which

was opposed to by the appellant herein and the learned Registrar was right in disallowing the opposition and allowing the applications for registration.

(iv) The appellants herein had also applied for registration in Class 25 and the same has been opposed to by the respondents herein. The appellants

had in fact stated that there is no likelihood of confusion or deception and hence the objections under Section 11(a) are not maintainable. By the

scrutiny of the said opposition the Learned Registrar had observed that the distinguishing features of the two marks are ""TT"" and ""DMR"" and that

there would be no confusion between the two marks. The said opposition was dismissed and allowed the application to proceed for registration. The

appellant had also filed a cancellation proceeding against the 3rd respondent's copyright registration which was also dismissed by the Copyright Board

by its order dated 23.10.1997. It is also pertinent to mention here that the orders passed in the opposition proceedings before the Trade Marks Registry

at Delhi was not challenged by the appellants therein and has become final and therefore the observations made by the learned Registrar would apply

to the facts of this case.

(v) The third Respondent submits that this mark applied for is a composite trade mark consisting of the letter "DMR" within the ornamental border.

The appellant's trade mark is also a composite trade mark consisting of the letter "TT" within an ornamental border. It is settled law that comparison

of the composite trade mark should be done as a whole" and not in part and the matter be decided based on the essential feature of the two trade

marks.

9. In the above circumstance, the third Respondent prays that the Hon'ble Board may dismiss the above appeal with exemplary costs.

10. We have heard Dr. Alok M. Saha, Counsel for the appellant and Ms P.V. Rajeswari, Counsel for the respondent.

11. The learned Counsel for the appellant submitted that they were initially dealing only with Hosiery goods then expanded their business to other

goods. They were carrying on business under the name Tarun Textiles which they later changed to T.T. Industries. The appellants adopted a

composite trade mark comprising the expression T.T. within a onion like device in the year 1968 and had allowed registration of the trade mark in

Class 25 as of 1970. They had obtained registration in various other classes before the respondent's adoption and use. The Counsel then brought to our

notice the various registrations obtained by them. The Counsel further submitted that all the applications for registration were filed in the year 1991

claiming to be proposed to be used except for classes 15 and 18 where it was claimed to be used since the year 1968. The various shipment bills were

produced before us to prove their user since the year 1968.- The auditors certificate to prove their sales figures were placed before us.

12. The Counsel then submitted that the trade mark comprising the letters DMR was not distinctive nor capable of being distinguished. The Counsel

drew our attention to the observation of the Registrar as regards deceptive similarity. The Counsel submitted that the rival marks were deceptively

similar and was likely to cause confusion and deception among the public.

13. The Counsel then relied on the judgment reported in -

(i) PTC (Suppl) (1) 346 (SC) - Parle Products (P) Ltd. v. J.P. and Co., Mysore to say that the marks should not be placed side by side to find out if

there are any difference in the design and to decide whether the marks are

deceptively similar.

(ii) AIR 1953 SC 357 : PTC (Suppl) (1) 475(SC) - National Sewing Thread Co. Ltd. v. James Chadwich & Bros. was relied on to say that the burden

to prove that the registration of the trade mark would not cause confusion or deception was on the applicant for registration.

(iii) 2004 (28) PTC 83 (Bom). - Tata Tea Limited v. Suruchi Tea Company and Anr. - The applicants has to prove that the registration of the

impugned trade mark would not cause confusion and the use of an identical get up where no reason given for such adoption is dishonest.

(iv) 1913 RPC 660 - The Registrar of Trade Marks v. W. and G. DU Cros LD. - Although letters can be register able as trade marks but can be

registered only if distinctive.

(v) AIR 1963 SC 1882 - The burden is on the applicant to prove that the registration will not be in contravention of the provisions of the Act.

(vi) The Counsel then submitted that the registration under No. 334299 relied on by the respondent and observed by the Registrar that they were the

proprietors cannot be held to be correct as there was a rectification application pending against the said registration before the same Trade Marks

Registry. Therefore, the finding that the respondents are the proprietors of the trade mark is not correct and therefore is in contravention of the

provisions of Section 18(1) of the Act.

14. In reply, the Counsel for the respondent submitted that the impugned order was correctly passed and therefore the registration granted was

correct. The Counsel then relied on the provisions of Section 31 of the Act.

15. We have heard both the Counsel and have gone through the pleadings and documents.

16. To qualify for registration, a mark must be distinctive by use. Here the mark is a letter mark consisting of the letter ""DMR"". The use of the letter

DMR by an individual, by registration would give exclusive right/ monopoly to that particular individual. The respondents had adopted the trade mark

as a composite mark with the letters DMR.

17. The onus is on the applicant/ the respondent to prove that the registration of the impugned trade mark will not cause any confusion or deception as

well the reason for the adoption of a similar trade mark. In the instant case, the respondent has not proved the above.

18. For deciding the test of deceptive similarity the marks are not to be placed side by side was the observation of the Supreme Court in Parle

Products Case (supra). In the instant case the ornamental design/onion shape device is almost identical with that of the appellants. It was also the

argument of the respondents that there was a variation in the ornamental borders. When it is settled principle that the marks are not to be placed side

by side then an overall look is to be considered. On an overall comparison it is seen that both the marks are deceptively similar

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19. The Respondents have not disputed the appellants use, as well the respondents have not given any reason for the adoption of a similar ornamental

border. Both the appellants and the respondents are mainly in the business of textiles. While granting registration the public interest is also to be taken

into consideration. The class of customers are to be seen into for the purpose of deciding the question of confusion or deception. The class of

purchasers are both literate and illiterate. The customers are prone to go by the look of the mark. The letters TT and DMR are two different ones no

doubt. The settled principle is that the marks are to be looked at as a whole and not split into. In such cases it is on the overall look - the visual

resemblance is almost alike. The unwary purchaser would go by the look and may be misled to think that the respondents goods are that of the

appellants. As regards the period of user the appellants are claiming user since the year 1968 whereas the respondents claim use since the year 1968

but as regards the impugned application for registration it is proposed to be used as on 02/05/1991. There is no proof to say that the respondents use is

from the year 1968.

20. On a bare perusal of the two marks, it is clear that the respondents have adopted the ornamental onion shape get up/design only to ride upon the

goodwill and reputation earned by the appellants. Assuming the respondents have adopted the letters from their trading style DMR Textiles, they have

given no reason for adopting the onion design. We therefore are of the view that the adoption is dishonest. When the adoption is dishonest any amount

of user does not help the respondents to prove their case.

21. We have looked at the orders passed by the Assistant Registrar of Trade Marks, New Delhi in an application filed by the appellant herein and

opposed by the respondents herein. The impugned order is just a verbatim copy of the earlier order passed by the Assistant Registrar, New Delhi

which only shows the non application of mind of the Deputy Registrar. It is very unfortunate that while exercising quasi judicial powers, the person

who is vested with such power has discharged his duty in this manner.

22. For the above mentioned reasons, we are of the view that -

(a) The impugned trade mark is neither distinctive nor capable of being distinguished and no user is proved as it was a proposed to be used mark as on the date of application, i.e., on 02.05.1991.

(b) The rival marks are deceptively similar and therefore there is every possibility of confusion and deception being caused in the minds of the public.

(c) The respondents cannot be considered to be the proprietors of the trade mark as their adoption is not honest.

We therefore allow the appeal and set aside the impugned order with no order as to costs.