



IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 18.10.2023

CORAM

THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

(T) CMA (TM)/54/2023
(OA/32/2015/TM/CHN)

M/s.A.Habeebur Rahman Sons
'S' Beedi Manufacturers
Rep., by its Partner
Mr.A.Mohammed Ashraf
244/245, Santhapet
Gudiyatham, Vellore District.

... Appellant

-VS

1.M/s.S.Jaffer Mohideen alias Noushad
6/124, Chinna Bazaar, Tadpatri – 515411
Andhra Pradesh

2.The Deputy Registrar of Trade Marks & GI
Trade Marks Registry, Chennai
IP Building, GST Road, Guindy,
Chennai – 600 032.

... Respondents

PRAYER: Transfer Miscellaneous Appeal (Trade Marks) is filed under Section 91 of the Trade Marks Act, 1999, praying that the order dated 20th February 2014 of the learned Deputy Registrar of

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Trademarks, Chennai, dismissing opposition MAS-82299 and consequently dismiss/refuse registration of application No.676174 in class 34 with costs.

For Appellant : Mr.K.M.Aasim Shehzad for
M/s.BFS Legal

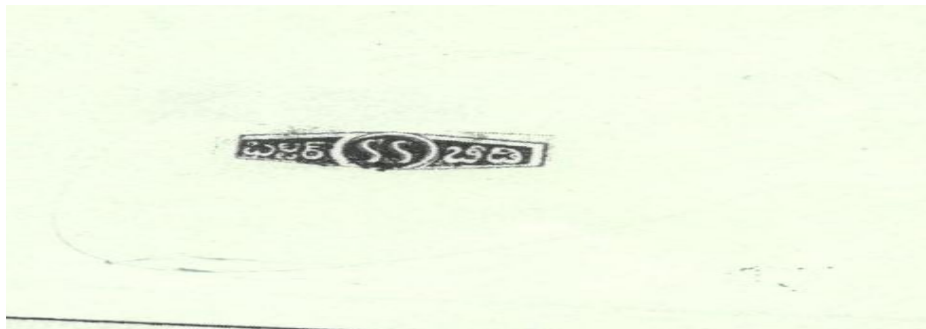
For Respondent 1 : Mr.A.Swaminathan for
M/s.L.R.Swami & Associates

For Respondent 2 : Mr.C.Kulanthaivel, SPC

JUDGMENT

Background

The appellant assails an order dated 20.02.2014 by which Opposition No.82299 was rejected and Application No.676174 in respect of the following label mark was allowed to proceed to registration:



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2. The appellant was the opponent in proceedings before the Registrar of Trade Marks. When the above extracted device mark of the 1st respondent was advertised in Trade Marks Journal No.1282(S-II) on 04.11.2002, the appellant opposed the registration. Such opposition was on the basis that the appellant had honestly conceived and adopted the trade mark “S” since 1930 and had used the said mark openly and continuously since then. In support of the opposition, the appellant filed the Trade Mark registration certificates obtained by it, its sales turnover from the financial years 1937-38 to 2002-2003, photocopies of invoices, advertisement bills and newspaper advertisements. Eventually, after hearing the contesting parties, by order dated 20.02.2014, the opposition was rejected. The present appeal arises in the said facts and circumstances.

Counsel and contentions

3. Oral arguments on behalf of the appellant were advanced by Mr.K.M.Aasim Shehzad, learned counsel, and on behalf of the 1st

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respondent by Mr.A.Swaminathan, learned counsel. The 2nd respondent was represented by Mr.C.Kulanthaivel, learned special panel counsel.

4. Learned counsel for the appellant submitted that the trade mark “S” was honestly adopted by the appellant in the year 1943. In support of this submission, learned counsel referred to and relied upon the affidavit of A.Mohammed Ashraf, which was filed as evidence in support of the opposition on 22.08.2003. He also relied upon the documents filed along with such affidavit. Such documents include the certificate of registration, the certificate issued by the Chartered Accountant regarding sales turnover from the financial years 1975-76 to 2002-2003, sales invoices and documents issued by the Commercial Taxes Department. By relying thereon, learned counsel contended that the appellant is entitled to protect the trade mark “S” and that the opposition was initiated for that purpose. As regards the 1st respondent, learned counsel submitted that the 1st respondent sells beedis under the brand name "FILTER BEEDI". He further submitted that the 1st



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respondent dishonestly adopted the mark “SS” in the year 1995 so as to unjustly capitalize on the enormous goodwill earned by the appellant through long use from 1943.

5. By referring to the impugned order, learned counsel contended that the Registrar of Trade Marks noticed the contentions of the appellant and the documents submitted in support thereof. In spite of noticing the same, learned counsel contended that the Registrar of Trade Marks recorded entirely untenable conclusions. By way of illustration, learned counsel pointed out that it is recorded in the impugned order that the appellant/opponent did not produce evidence of a single instance of actual confusion. By referring to Section 11(1) of the Trade Marks Act, 1999 (the Trade Marks Act), learned counsel submitted that actual confusion is not necessary and that the test is whether there is likelihood of confusion. Learned counsel further submitted that the Registrar of Trade Marks erroneously referred to the impugned mark as "FILTER BEEDI" without noticing that the



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prominent feature of the impugned mark is the letters “SS” at the centre of the label.

6. In support of the contention that the impugned order is liable to be set aside, learned counsel referred to and relied upon the following judgments:-

(i) *Blue Hill Logistics Private Limited v. Ashok Leyland Ltd. and others*, 2011 (4) CTC 417, particularly paragraph 24.

(ii) *Blue Heaven Cosmetics Private Limited v. Deepak Arora and another*, 2022 SCC Online Del 1001, particularly paragraph 25.

(iii) *TSI Engineering Industries Private Limited and Others v. C.R.I Amalagamations Private Limited*, MANU/TN/9982/2019, particularly paragraphs 36 and 37.



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(iv) *Devi Pesticides Private Ltd. v. Shiv Agro Chemicals Industries(Devi Pesticides), MANU/TN/1436/2006*, particularly paragraph 19.

(v) *Sangeetha Caterers and Consultants LLP, represented by its Designated Partners & another v New Sangeetha Restaurant, 2023 SCC Online Mad 4477.*

7. In response to these contentions, learned counsel for the 1st respondent submitted that the 1st respondent has been engaged in the business of selling beedis since 1955. He pointed out that such business was originally established by the 1st respondent's predecessor-in-interest and ancestor, S. Server Sahib. He also stated that the 1st respondent adopted three types of label. By referring to page 3 of the counter, learned counsel pointed out that the 1st label at the top of the page is used to wrap large bundles consisting of many bundles. The 2nd label on the said page is used to wrap one bundle of beedis and the 3rd,

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which is the impugned label herein, is used as a ring label to wrap a single beedi. He pointed out that the 1st respondent's beedis are known by the brand name "Filter Beedi" and not as "SS" beedis. He further submitted that it is standard trade practice amongst beedi traders to use the initials of the proprietor as one element of the label. Since the founder of the business was S.Server Sahib, he submitted that the element "SS" is found in the ring label.

8. He also pointed out that the label marks set out at pages 2 and 3 of the counter were registered under Trade Mark No.172317 on 16.12.1955 and Trade Mark No.264294 on 08.05.1970. The said registrations were not renewed for some years. Eventually, in 1995, the 1st respondent applied for and obtained registrations in respect of all the three labels covered previously under Trade Mark No.264294. Learned counsel also pointed out that the opposition was rejected and the registration was permitted, subject to the three labels being used in combination as indicated in the final paragraph of the impugned order.

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He also referred to the affidavit of S.Mohammed Ayub dated 14.08.2023 and reiterated that the 1st respondent would not use the logo “SS” separately or independently as a trade mark to sell beedis or claim any independent or exclusive rights over the same.

9. In support of these contentions, learned counsel referred to and relied upon the following judgments:-

(i) Carlsberg India Pvt. Ltd. & another v. Radico Khaitan Ltd. & another (Carlsberg India), CDJ 2011 DHC 1362, particularly paragraphs 25 to 29.

(ii) London Rubber Company Limited v. Durex Products Incorporated & another, CDJ 1963 SC 258, at page 7 thereof.



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10. By way of rejoinder, learned counsel for the appellant submitted that the 1st respondent is not entitled to protection under Section 35 of the Trade Marks Act because such protection is available only when a person uses his or the founder's full name as a trade mark and not when initials are used.

Discussion, analysis and conclusions

11. While considering an application for registration of a trade mark, the focus of inquiry by the Registrar of Trade Marks should be on whether such registration is liable to be refused on absolute or relative grounds. In this case, it appears that the application was accepted for advertisement and that objections were raised pursuant thereto by the appellant herein. The objections are on the ground that the goods are identical and that the marks are deceptively similar. The appellant did not assert that its mark is a well known mark as defined in Section 2(1)(zg) read with Section 11(2) and other sub-sections of Section 11 of the Trade Marks Act. Therefore, Section 11(1) is the principal

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provision that becomes applicable. Section 11(1) reads as follows:-

“11. Relative grounds for refusal of registration.-(1)

Save as provided in section 12, a trade mark shall not be registered if, because of-

(a) its identity with an earlier trade mark and similarity of goods or services covered by the trade mark; or

(b) its similarity to an earlier trade mark and the identity or similarity of the goods or services covered by the trade mark,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

12. As is evident from the above, Section 11(1)(b) is applicable when the trade mark sought to be registered is similar to an earlier trade mark and the respective goods are either identical or similar. The admitted position is that the contesting parties are trading in beedis and applied their marks to such goods. Therefore, there is no doubt that the goods are identical. Turning to the marks, the device mark of the 1st respondent was set out *supra* at paragraph 1. As regards the appellant,

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the appellant has obtained registrations in respect of multiple marks, most of which are device marks. Learned counsel for the appellant relied on the word mark “S.Beedi” set out at page 67 of the appeal typed set to contend that the impugned mark is deceptively similar thereto. This mark was registered as Trade Mark No.226329B on 31.12.1964. Therefore, the comparison should be made between this or the other marks of the appellant, on the one hand, and the impugned label mark of the 1st respondent, on the other. While making such comparison, the question to be considered and answered is whether there would be a likelihood of confusion on the part of the public, including by way of association with the earlier trade mark.

13. It should be recognised that the word mark of the appellant uses the letter “S” as one of the elements and the said word mark is “S.Beedi”. The contention of learned counsel for the appellant was that the letter “S” is the prominent feature of the trade mark and that consumers of beedis would identify the product by reference to the



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prominent feature. In support of this contention, learned counsel relied upon the judgment of the Division Bench of this Court in *Devi Pesticides*, where, at paragraph 19, the Court concluded that the marks “BOOM” and “SUPER BOOM” are deceptively similar because “BOOM” was registered by the applicant therein in 1987 and that the respondent could not be permitted to infringe the said mark by prefixing “SUPER”. Likewise, learned counsel submitted that the 1st respondent herein should not be permitted to infringe the appellant's trade mark merely by adding an additional “S”. The above discussion leads to the conclusion that the appellant did not obtain registration for the alphabet “S” on a stand alone basis. The closest registration that the appellant relies upon is the registration of the word mark “S.Beedi”

14. Learned counsel for the 1st respondent relied on paragraphs 25 to 29 of the judgment of the Division Bench of the Delhi High court in *Carlsberg India* to contend that a single numeral or alphabet cannot be protected as a trade mark. Under the Trade and Merchandise Marks



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Act, 1958, it was typical for the Registrar of Trade Marks to expressly impose conditions and limitations precluding claims to exclusive use over individual elements of a composite or device mark. Under the current legal regime, Section 17 (2) of the Trade Marks Act expressly provides that the registration of a trade mark consisting of more than one element would not confer exclusive rights over a part of such trade mark unless such part is separately registered.

15. Learned counsel for the 1st respondent referred to paragraph 3 at page 3 of the counter and pointed out that the three labels set out at the top of the said page are used in combination by the 1st respondent. In particular, he pointed out that the 1st label is used to wrap a large bundle consisting of multiple bundles of beedis; the 2nd label is used to wrap a single bundle consisting of multiple beedies; and the 3rd, which is the impugned label, is used to wrap a single beedi by way of a ring label. He also pointed out that the registration was subject to the condition that the use would be in the aforesaid manner. The affidavit

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of undertaking of S.Mohammed Ayub was also relied upon in this connection. In relevant part, it is affirmed therein as under:

“Therefore, we undertake that the we will not use the Logo “S.S” alone independently as a separate Trade Mark for selling our beedis and we will not claim independent or exclusive right over the Logo “S.S” alone by registering the present Trade Mark Application No.676174 under Class-34.”

16. The impugned order should be examined against the above backdrop. The operative part of the impugned order is set out below:

“From the records, it is found that the applicant is claiming user of his mark right from 1955 and has also filed supporting documents. Further, the marks are also phonetically and visually different. Except for filing the present opposition, opponents have not been able to bring even a single instance of actual confusion although both the marks have been in the market all these years. As such, the applicants are eligible for concurrent registration of their impugned mark “FILTER BEEDI” by virtue of honest



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use. The mark is used for over 5 decades and there is no material to prove confusion itself makes the applicant eligible for recognition. Once I arrive at this conclusion, I am of view it is not essential for me to proceed further discussing elaborately the various other issues.

It is accordingly ordered that opposition No.82299 is dismissed and application no.676174 in class 34 is accepted subject to association as agreed to at the application stage and shall proceed further as per law. There shall be no order as to costs."

17. From the above extract, it is clear that the Registrar of Trade Marks concluded that the marks are phonetically and visually different. He also concluded that the opponent had not produced any evidence of actual confusion although the relevant marks were in the market for a considerable number of years. He further referred to the impugned mark as "FILTER BEEDI". As contended by learned counsel for the appellant, actual confusion is not necessary to attract Section 11(1) of the Trade Marks Act. At the same time, if the relevant marks have been in use for a considerable period of time, proof of actual confusion

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cannot be construed as irrelevant or immaterial. Since the mark of the 1st respondent is a device mark, it should be looked at as a whole. If so viewed, the mark bears writing in the Telugu language. Neither party denies that the Telugu script contains the words “FILTER BEEDI”. The 1st respondent has placed on record evidence in the form of the certificates of registration obtained by the 1st respondent. These certificates of registration are in respect of label marks and the common feature of all these label marks is the conspicuous element “FILTER BEEDI”. Several invoices were also placed on record by the 1st respondent. These invoices are from the year 2003 onwards and all the invoices refer to the beedis as filter brand beedis. In light of this evidence, it cannot be concluded that the prominent feature of the 1st respondent's trade mark is the letters “SS”. Therefore, it cannot be concluded that consumers of beedis bearing the impugned device mark of the 1st respondent would be confused or that they would associate the said trade mark with the appellant.



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18. For reasons set out above, I conclude that the impugned order does not call for interference subject to the following conditions:-

- (i). The impugned label shall be used in combination with the two labels set out at page 3 of the counter with the top label being used in respect of large bundles comprising multiple bundles, the next label in respect of single bundles of multiple beedis and the ring/impugned label in respect of individual beedis.
- (ii). The undertaking provided by the 1st respondent that the said respondent will not use the logo “SS” as a separate trade mark for selling beedis and that the said respondent would not claim individual or exclusive rights over the logo “SS” shall be recorded in the records of the Registrar of Trade Marks.

19. (T) CMA (TM) 54 of 2023 is disposed of on the above terms and conditions without any order as to costs.

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Internet: Yes/No

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SENTHILKUMAR RAMAMOORTHY.J.,

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