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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 12.12.2024

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THE HON'BLE MR. JUSTICE ABDUL QUDDHOSE

(T) CMA (TM) No.29 of 2023

M/s.Mysore Sangam Agarbatti Works,
Delhi-110 006.

.. Appellant

-vs-

1.M/s.Ganga Products,
Bangalore - 560 070.

2.The Registrar of Trade Marks,
Intellectual Property Rights Building,
Industrial Estate, SIDCO RMD,
Godown Area, G.S.T.Road,
Guindy, Chennai - 600 032.

.. Respondents

Prayer: This Civil Miscellaneous Appeal filed under Section 91 of the Trade Marks Act, 1999 for the following reliefs:

a)The order passed by the learned Registrar of Trade Marks, Chennai dated 28.01.2013 in Appellant's Opposition No.MAS-58747 to Application No.555121 in Class-03 be set aside;

b)The appellant's notice of Opposition under No.MAS-58747 be allowed and applicant's application for registration of Trade Mark Device of Shiv Label under No.555121 be refused for registration;

c)The respondent No.2 be directed to change the status of the



impugned application under No.555121 in Class-03 as "Refused" instead of "Abandoned";

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d) That the respondent No.2 be directed to transmit and certify to this Hon'ble Court the entire records of proceedings before them in the matter of Opposition No.MAS-58747 to Application No.555121 in Class-3;

e) That the respondent No.2 be directed not to proceed the impugned application No.555121 in Class-03 for registration till the disposal of the present appeal and to get correct the orders of this Court thereafter.

For appellant : Mr.Somnath De

For respondents : R1- No appearance

R2- Mr.M.Karthikeyan,
Senior Panel Counsel

JUDGMENT

This appeal has been filed, challenging the impugned order dated 28.01.2013 passed by the second respondent, rejecting the Opposition Petition filed by the appellant.

2.The appellant had opposed the registration of the first respondent's label mark containing the "DEVICE OF LORD SHIVA" in respect of Agarbathies in class 3. The first respondent claims in its Trade Mark Application that they have been using the said label mark since 01.04.1988. The Trade Mark Application of the first respondent was ordered to be



advertised by the second respondent and the same was advertised in the Trade Marks Journal on 16.02.2001. The appellant filed an opposition objecting to registration of the first respondent's aforesaid mark under Sections 9, 11 and 18 of the Trade Marks Act. Under the impugned order, the said opposition was rejected by the second respondent giving the following reasons:

a) All the invoices contain at the left hand corner device of 'SHIVA' (Ganga Products-their trading style) is found which has been applied for registration;

b) In the centre, Ganga Products has been written in a stylized get up;

c) The label of the first respondent contains different elements, including their trading style of which the first respondent intends to seek registration for a part of the mark, which is permissible under the provisions of Section 17 of the Trade Marks Act, 1999;

d) All the invoices produced by the first respondent before the second respondent are identically styled;

e) The paramount requirement that the mark should be used in the course of trade has been met by the first respondent;

f) The usage of 'SHIVA' device by the first respondent along with



Ganga Products is indicative of the source and there cannot be any confusion.

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3. Aggrieved by the findings of the second respondent through which the opposition filed by the appellant has been rejected, this appeal has been filed before this Court. The following grounds have been raised by the appellant in the grounds of appeal:

a) The appellant is the prior user of 'SHIV AGARBATTI LABEL' under No.333892 in Class 3 in respect of Agarbathies;

b) The appellant has been using their registered trade mark since the year 1955 in respect of Agarbathies;

c) The second respondent failed to appreciate that the appellant is the registered proprietor of the mark "SHIV AGARBATTI LABEL" under No.333892 in Class 3 in respect of Agarbathies since 24.02.1978, which is even prior to the alleged date of adoption of the impugned trade mark "DEVICE OF SHIV LABEL" i.e. on 01.04.1988;

d) The second respondent has erred in passing the impugned order and has not dealt with the objections raised by the appellant under Section 11 of the Trade Marks Act;



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e)The appellant is prior in adoption, prior in use and prior in registration, which the second respondent failed to appreciate;

f)The impugned trade mark of the first respondent is non distinctive and devoid of distinctiveness on the date when the first respondent applied for trade mark registration in respect of "DEVICE OF SHIV LABEL" for the impugned goods;

g)The impugned documentary evidence filed by the first respondent in support of their Trade Mark Application, i.e. D1 to D7 does not relate to the impugned trade mark "DEVICE OF SHIV LABEL";

h)The essential and prominent features of the appellant's trade mark has been copied by the first respondent;

i)The impugned trade mark as a whole is highly deceptively similar to that of the appellant's trade mark;

j)The goods of both the appellant and the first respondent are being bought and sold at the same counter by the same class of people and hence, there is every chance of confusion caused in the minds of the public;

k)The trade channels are also same and hence, confusion and deception in the market are imminent;

l)Any person of average intelligence having imperfect recollection



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(T) CMA (TM) No.29 of 2019



will get confused if the first respondent is allowed to get their device label containing the device mark 'SHIVA' registered by the second respondent;

m)The adoption of the impugned trade mark by the first respondent is dishonest and fraudulent and the sole motive of the first respondent is to ride over the reputation and goodwill of the appellant.

4.Learned counsel for the appellant drew the attention of this Court to the following authorities, in support of the appellant's contentions before this Court:

a)A.T.Raja vs. Mangalore Ganesh Beedi Works reported in 1999 (19) PTC 104 (Mad);

b)R.Gopalakrishnan vs. Venkateshwara Camphor Works reported in 2001(21) PTC 233(Mad);

c)Hindustan Pencil Private Ltd. vs. Universal Trading Company reported in 1999 (19) PTC 379 (CB);

d)Amir Chand Om Parkash vs. Monga Perfumery & Floor Mills reported in 1996(16) PTC 385 (Del);

e)Shyam Steel Industries Limited vs. Shyam Sel and Power Limited



and others reported in 2020 (81) PTC 3 (Cal);

f) Indian Hotels Company Limited and another vs. Jiva Institute of Vedic Science & Culture reported in 2008 (37) PTC 468 (DB);

g) K.R.Chinna Krishna Chettiar vs. Shri Ambal and Co., Madras and another reported in 1969 (2) SCC 131;

h) Century Traders vs. Roshan Lal Duggar & Co. reported in AIR 1978 Delhi 250.

5. Relying upon the aforesaid decisions, the learned counsel for the appellant would summarise his arguments as follows:

a) The colour scheme and the overall get up of the packaging has to be seen. According to him, since both the appellant and the first respondent are dealing with the very same product, i.e. Agarbathies and since the essential features of the appellant's label and word mark have been copied by copying the image of "SHIVA", the trade mark registration sought for by the first respondent cannot be granted;

b) Since there is a close affinity of sound between the words "SHIVA" and 'Siwa' and they are phonetically similar in sound, the trade mark registration sought for by the first respondent, which is impugned in this



appeal, cannot be granted;

c)The ocular comparison of the two marks is not always the decisive test and the resemblance between the two marks must be considered with regard to the ear as well as the eye.

6.Hence, according to the learned counsel for the appellant, since the device label of the first respondent contains the essential features of the appellant's label, resembles the appellant's label and is also phonetically similar, no trade mark registration can be granted for the first respondent's label. The appellant is the prior user of the trade mark 'SHIVA' and hence, the appellant's exclusive mark has to be protected. The appellant, having used the name of the God 'SHIVA' for a long number of years from 1955 and having obtained the trade mark registration under Class 3 in the year 1978, no other person can use the same trade mark in respect of the same product. The use of the name 'SHIVA' by itself becomes objectionable if it is used in relation to the same goods. Since the first respondent is using the appellant's trade mark 'SHIVA' in respect of the same goods, it is legally not permissible as per the provisions of the Trade Marks Act.

7.Learned counsel for the appellant also drew the attention of this



Court to the various invoices filed by the first respondent before the second respondent and would submit that all the invoices contain the picture of 'SHIVA', which is an essential feature of the appellant's packaging label and hence, being deceptively similar, the first respondent cannot obtain trade mark registration in respect of their Trade Mark Application, which is the subject matter of this appeal. He would further submit that any person of average intelligence and imperfect recollection will get deceived if the first respondent is allowed to obtain registration for its label which contains the device 'SHIVA'.

8.Learned counsel for the appellant also contends that the first respondent has not been using their trade mark for a long number of years for which trade mark registration has been sought for and on that ground of non-usage, the trade mark registration cannot be granted. According to him, the appellant has satisfied the tests of deceptively similarity and hence, this appeal has to be allowed.

9.Since the first respondent has been duly served with notice in this



appeal and continues to remain un-represented on all the hearing dates, they are set exparte by this Court.

10.Learned Standing Counsel appearing for the second respondent on the other hand would contend that the arguments of the learned counsel for the appellant does not hold water for the following reasons:

a)The essential features of the appellant's trade mark has not been copied by the first respondent;

b)All the invoices produced by the first respondent, which were considered by the second respondent, as a piece of evidence contains at the left hand corner, device of 'SHIVA' and in the centre, the trading style of the first respondent, namely Ganga products, which has been written in a stylized get up. It is a label containing different elements, which includes the trading style of the first respondent, namely, Ganga Products.

c)The same type of invoices are used by the first respondent in all the cases filed as a piece of evidence by the first respondent before the second respondent. The usage of 'SHIVA' device label along with the trading style of the first respondent namely, Ganga Products is indicative of the source and origin of the first respondent's product. Therefore, there cannot be any



confusion in the minds of public with average intelligence and imperfect recollection.

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11.Learned Standing Counsel appearing for the second respondent also drew the attention of this Court to the various invoices, which were filed by the first respondent before the second respondent and would submit that the trading style of the first respondent, namely Ganga products has been give more prominence in those invoices, whereas the device mark of 'SHIVA', which is found in the left hand corner of all the invoices, has been given less prominence and therefore, the question of deceptive similarity between the appellant's mark and the first respondent's mark does not arise.

12.Learned Standing Counsel for the second respondent also submits that the device mark of the appellant is in Hindi language, whereas the first respondent's trade mark is in English language. Further he would submit that the word 'SHIVA' and the word 'SIWA' adopted by the first respondent are not deceptively similar. He would submit that there are other registrations granted by the second respondent for the word mark "SHIVA" and its variants. As proof of the same, the learned Standing Counsel for the second



respondent has placed on record various other registrations granted by the second respondent for the word mark 'SHIVA' and its variants.

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Discussion:

13. The likelihood of confusion or deception amongst the consuming public is a 'sine qua non' element to be seen by the Trade Mark Registry while deciding whether to grant trade mark registration for a particular trade mark or not. There are various parameters that are taken into consideration while assessing the degree of likelihood of confusion between two trademarks, such as, a) the goods and services under the disputing marks, b) the class of consumers and c) the trade channels involved, inter alia. The Triple Identity Test, which is an amalgamation of the aforementioned three parameters, is often relied upon by the Courts to assess the similarity between two marks and/or likelihood of confusion amongst the public. It is a settled principle of law that deceptive similarity is adjudged based on the visual, phonetic, and structural similarity between the marks in question. The process of assessing similarity between two composite marks, births a direct conflict between the 'Rule of Anti-Dissection' and the 'Rule of Dominant Feature'. While the spirit of the former rule has been captured by



Sections 15 and 17 of the Trade Marks Act, 1999, the latter is a product of many judicial pronouncements.

14.A plain reading of Sections 15 and 17 of the Act evidences the fact that the legislative intent behind these provisions is that when a trademark consists of several elements, it should be viewed as a whole, i.e, as an indivisible unit and unless a part of such a composite trademark is a separate subject of trademark protection, the proprietor has no exclusive right on a part of the composite mark alone. The rule of anti-dissection is based on the basic assumption that an ordinary prospective buyer would be impressed by the composite mark as a whole and not by its component parts. Hence, it promotes the idea that 'technical gymnastics' should not be done in an attempt to find some minor differences between conflicting marks.

15.On the other hand, over the years, the Constitutional Courts have propounded a rule of dominant feature which means that a mark is said to be infringed by another trader if even without using the whole of it, the latter uses one or more of its essential features. This rule is based on the understanding that a consumer of average intelligence having an imperfect



recollection might only retain the prominent part of a composite mark. The reflection of the rule of dominant feature could be seen in Section 11(b) of the Trade Marks Act which states that a mark ought not to be registered if the said mark is similar to an earlier mark and is being used with respect to similar or identical goods/services and capable of causing confusion and deception amongst the public.

16. Here, a deceptively similar mark could also mean a mark wherein the dominant feature of another mark is being used. Though predominantly the Constitutional Courts have applied the anti-dissection rule in some cases, they have also applied the rule of dominant feature. Hence, which test is to be applied would completely depend on the unique facts of each case. Where there are both similarities and differences in the marks, they must be weighed against one another to see which predominates. However, the fundamental criterion for assessing similarity between two trade marks is the likelihood of confusion and there is no one straight jacket rule that can be relied upon to assess the confusion amongst consumers. The same would depend on the unique facts of each case and therefore, it would lead to arbitrariness and absurdity if one rule is given prominence over the other.

17. In the case on hand, both the appellant's trade mark and the first



respondent's trade mark are device marks. The device mark of the appellant and the device mark of the first respondent are re-produced hereunder:

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APPELLANT'S TRADE MARK



FIRST RESPONDENT'S TRADE MARK



18.The first respondent's trade mark consists of the expression **"GANGA PRODUCTS, BANGALORE"** and the bust portrait of 'Lord Shiva' enclosed within two concentric circles, whereas, the appellant's trade mark consists of inter alia, the expression **"SHIV AGARBATTI"** and the full figure of Lord 'SHIVA' in a sitting position and the trading style **"SUNDAR CHEMICAL AND AGARBATHI WORKS, DELHI"**.

19.Section 9(2)(b) of the Trade Marks Act while addressing absolute grounds for refusing a trade marks registration, prohibits the registration of a



trade mark if it includes elements likely to offend the religious sensitivities of any segment of Indian Citizens. When a trade mark incorporates the name of God, it restricts normal individuals and devotees from using the divine name. This provision aims to prevent the commercialisation of religious symbols, as outlined in Article 25 of the Constitution of India, which safeguards against exclusive rights that may hinder others from utilising the same. The Act also extends its prohibition to personal names such as those of Lord Buddha, the Sikh Gurus, etc., asserting that trade mark registrations causing religious discomfort objectify sacred symbols and titles. This stance aligns with the belief that names of public deities, existing in the public domain, should not be monopolised as intellectual property, as it not only offends religious sentiments, but also obstructs devotees from freely invoking the name of God. Therefore, 'SHIVA' being the name of a deity, who is being worshipped, cannot be treated as an essential feature of any composite trade mark.

20. In the case on hand, the appellant, who is having trade mark registration for its device label "SHIV AGARBATTI" under Class 3 claims



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that they have the exclusive right to use the image of 'SHIVA' for its Agarbatti products and no one else can use the image of 'SHIVA' if they are also dealing with the Agarbatti products as according to them it would cause confusion in the minds of the consumers. In Trade Mark Law, the average consumers are considered to have average intelligence and imperfect recollection. This means that they are unlikely to notice the difference between similar marks and may mistake one for the other. The average consumer test is a long standing test used by the Courts to determine if there is a likelihood of confusion between similar marks.

21. While evaluating trade marks, the Courts considers the following factors:

- a) Phonetic similarity, visual similarity and structural similarity;
- b) Likelihood of confusion: Where consumer would see the marks one at a time or side by side;
- c) Structural re-collection: Consumers are likely to recall any difference between the marks.

Therefore, there is absolutely no deceptive similarity between the appellant's device mark and the first respondent's device mark as there is no phonetic,



visual or structural similarity between them.

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22. In the case on hand, the trade mark applied by the first respondent is for the trade mark 'SIWA' under Class 3 and the type of the trade mark is device mark, whereas the trade mark registration obtained by the appellant is for the trade mark "SHIV AGARBATTI" and the type of the trade mark for which registration has been obtained is also a device mark. As observed earlier, the device mark of the appellant, as re-produced supra, is totally different from the device mark of the first respondent for which trade mark registration has been sought for by the first respondent. The trade mark of the first respondent consists of the expression "**GANGA PRODUCTS, BANGALORE**" and the bust portrait of Lord Shiva enclosed within two concentric circles, whereas, the appellant's trade mark consists of inter alia, the expression "**SHIV AGARBATTI**" and the full figure of Lord 'SHIVA' in a sitting position and the trading style "**SUNDAR CHEMICAL AND AGARBATHI WORKS, DELHI**".

23. It is also to be noted that the trade mark of the appellant as seen from the label is in Hindi, whereas the expression "**GANGA PRODUCTS,**



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BANGALORE" in the first respondent's trade mark is only in English. As observed earlier, the deity 'SHIVA' cannot be treated as an essential feature of any trade mark as nobody can claim exclusive monopoly to use the name of a deity. Therefore, this Court will have to assess the composite mark of the appellant and the composite mark of the first respondent by applying the rule of anti-dissection as laid down under Sections 15 and 17 of the Trade Marks Act, 1999. The rule of dominant feature can never be applied to the case on hand since any registered proprietor of a trade mark can never claim monopoly to use the name of a deity.

24. In the case of **Lal Babu Priyadarshi vs. Amritpal Singh reported in 2015 (12) SCALE 76**, the Hon'ble Supreme Court has held that no one could claim trade mark over Gods/Goddesses/Deities or religious books like the Holy Quran, Holy Bible, Guru Granth Sahib, Ramayana etc. over goods or services. Therefore, it is a well established fact that in a device mark, even if the image of a deity is found, a registered proprietor of the trade mark cannot claim monopoly over the same stating that he has been in long and continuous usage of the said mark and that the image of the said deity can be used only by him for his products and no one else.



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25. Before the second respondent, the first respondent has also produced invoices for their continuous usage of their claimed device mark, for which trade mark registration has been sought for from the year 1988 onwards. In all the invoices only in the left hand corner of the said invoices, the bust portrait of Lord 'SHIVA' enclosed within two concentric circles is found, whereas the trading style of the first respondent namely "GANGA PRODUCTS" is predominantly disclosed in the centre of all the invoices and is more prominent than the Lord 'SHIVA' image found in the left hand corner of all the invoices. There is also no contra evidence produced by the appellant before the second respondent to disprove the invoices filed by the first respondent as a piece of evidence to prove that they have been in continuous usage of the device mark from 1988 onwards. In fact as seen from the impugned order, the appellant through their letter dated 01.07.2003 have informed the second respondent that they do not wish to file any evidence in support of Opposition but intend to rely upon the statements made in the notice of opposition. On the other hand, the first respondent filed an affidavit of B.D.Sandhyavathi, Partner as evidence in support of the Trade Mark Application along with Exs. A, C, D and D series and Xerox



copy of the affidavit of Mr.B.Venkataiah Shetty filed at the application stage.

26.The decisions relied upon by the learned counsel for the appellant, during the course of his arguments and referred to supra, have no bearing for the facts of the instant case since the law is now well settled through the decision of the Hon'ble Supreme Court in the case of **Lal Babu Priyadarshi vs. Amritpal Singh reported in 2015 (12) SCALE 76**, wherein it has been held that no one could claim trade mark over Gods/ Goddesses/Deities or religious books like the Holy Quran, Holy Bible, Guru Granth Sahib, Ramayana etc. for any goods or services.

27.The Bombay High Court decision, relied upon by the learned Standing Counsel for the second respondent in the case of **Freudenberg Gala Household Product Pvt. Ltd. Vs. GEBI products reported in MANu/MH/1859/2017** also supports the well established law that the names of Hindu Gods are not exclusive and such word cannot be monopolised by one party. Learned Standing Counsel appearing for the second respondent also brought to the notice of this Court the Computer



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Generated TM Search Report dated 03.05.2024, pertaining to the trade marks registered in which the word 'SHIVA' is a component and as seen from the same, there are also other device marks registered, in which 'SHIVA' is a component and therefore, the question of allowing the Opposition Petition filed by the appellant, opposing the trade mark registration sought for by the first respondent, does not arise.

28. For the foregoing reasons, this Court does not find any infirmity in the findings of the second respondent. Accordingly, there is no merit in this appeal and the same is dismissed. However, since the appellant categorically contends that the first respondent has not been using the trade mark for which they have sought for trade mark registration, which is the subject matter of this appeal, for a long number of years, this Court grants liberty to the appellant to file an application under Section 47 of the Trade Marks Act, 1999 seeking for cancellation of the first respondent's trade mark in case the second respondent has already granted trade mark

registration in favour of the first respondent as sought for by them through their Application No.555121 dated 25.07.1991.



(T) CMA (TM) No.29 of 2024

12.12.2024

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Index : Yes/No

Speaking/Non Speaking Order

Neutral Citation Case : Yes/No

To

The Registrar of Trade Marks,
Intellectual Property Rights Building,
Industrial Estate, SIDCO RMD,
Godown Area, G.S.T.Road,
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(T) CMA (TM) No.29 of 2023

ABDUL QUDDHOSE,J.

vga

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