



WEB COPY



(T) CMA (TM) No.10 of 2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on: 26.07.2024

Pronounced on: 20.09.2024

CORAM:

THE HON'BLE MR.JUSTICE P.B.BALAJI

(T) CMA (TM) No.10 of 2023
(OA/32/2011/TM/CHN)

M /s.The Southern India Exporting Company,
No.131, New Road,
Post Box No.69,
Sivakasi – 626123.

.. Appellant

..Vs.

1.M/s.The Classic Fireworks Industries,
Meenampatti Village (Via),
Sivakasi – 626 123.

2.The Deputy Registrar of Trade Marks,
Office of the Trade Marks Registry,
Intellectual Property Rights Building,
GST Road, Guindy,
Chennai – 600 032.

.. Respondents

Prayer: This Civil Miscellaneous Appeal filed under Section 91 of the Trade Marks Act, 1999, prays that:

a) Set aside/quash the order dated 13.01.2011 passed by the learned Deputy Registrar of Trademarks, Chennai; and

b) Reject the 1st respondent's Application No.1279187 in Class 13 for registration of the mark Garuda Brand by allowing the appellant's opposition MAS-235136.



WEB COPY



(T) CMA (TM) No.10 of 2023

For Appellant : Mr.Arun C. Mohan

For Respondents

For R1 : Mr.P.Valliappan
Senior Counsel
for M/s.P.V.Law Associates

For R2 : Mr.K.Subbu Ranga Bharathi
Central Government Standing Counsel

J U D G M E N T

The present appeal is preferred, challenging the order of the Deputy Registrar of Trade Marks, Chennai, dated 13.01.2011.

2.I have heard Mr.Arun C. Mohan, Learned Counsel for the Appellant and Mr.P.Valliappan, Learned Senior Counsel for the 1st Respondent and Mr.K.Subbu Ranga Bharathi, Learned Senior Panel Central Government Standing Counsel for the 2nd Respondent. I have also perused the records placed before me by way of typed set of papers and also carefully gone through the decisions on which reliance is placed on by the Learned Counsel for the parties.



WEB COPY

3. The Learned Counsel for the Appellant would attack the findings of the Authority on the following grounds:

i) The Appellant is the prior user of its mark, in fact, since 1956 whereas the 1st Respondent has been using its mark only from 1995, which has gone unnoticed.

ii) The impugned order has not touched the aspect of passing off and thereby there has been total disregard of Section 11 of the Act.

iii) The Registrar has failed to step into the shoes of the customer and decide the matter, especially when both the Appellant and the 1st Respondent trade in fireworks and the visual image adopted by the 1st Respondent was likely to cause confusion amongst the customers.

iv) The finding that both the Appellant and the 1st Respondent are from Sivakasi was immaterial and in fact, not even based on record and was also not proved.

v) The similarity/identity test under Section 11(1)(b) of the Trademarks Act, 1999, has not been applied to the facts.

vi) The Registrar has failed to advert to passing off effect under Section 11(3) of the Trademarks Act, 1999.



(T) CMA (TM) No.10 of 2023

vii) The fact that the Appellant did not oppose the earlier registration of the 1st Respondent's mark is irrelevant to application of Section 11 of the Act.

viii) The Registrar has not followed the dictum of the Apex Court in *Cadila Healthcare Ltd., Vs. Cadila Pharmaceuticals Ltd.*, reported in *(2001) 5 SCC 73*.

4.Mr.Arun C.Mohan, Learned Counsel for the Appellant would fortify the above submissions by placing reliance on the following decisions:

1) *National Sewing Thread Company Limited Vs. James Chadwick and Brothers Limited (J&P Coats Limited, Assignee) ((1953) 1 SCC 794)*.

2) *J.C.Eno Limited Vs. Vishnu Chemicals Co. (1940 SCC Online Bom 130)*.

3) *National Chemicals and Colour Co., and Others Vs.Reckitt and Colman of India Limited and Another (1990 SCC Online Bom 104)*.

4) *Bhatia Plastics Vs. Peacock Industries Limited (ILR (1995) 1 Delhi)*.

5) *K.R.Chinna Krishna Chettiar Vs. Shri Ambal and Co., Madras and Another ((1969) 2 SCC 131)*.



6) *Amritdhara Pharmacy Vs. Satya Deo Gupta*
((1963) 2 SCR 484).

5.Per contra, Mr.P.Valliappan, Learned Senior Counsel, would submit that:

i) Both the Appellant and the 1st Respondent are from Sivakasi and selling same goods and there has been no confusion or deception for the last several years.

ii) There is no phonetic or visual similarity between the two rival marks

iii) In terms of Section 33, the Appellant has acquiesced of the use of the mark by the 1st Respondent.

iv) The conduct of the Appellant in not opposing the registrations of the 1st Respondent, one prior and one later would be a relevant factor and have significant bearing in the present case.

v) The images are entirely different and there is no likelihood of any confusion.

vi) The Registrar has taken into account all relevant factors and decided the matter in favour of the 1st Respondent and the same does not require any interference in appeal.

6.I have carefully considered the submissions advanced on either side.



(T) CMA (TM) No.10 of 2023

WEB COPY 7. For better appreciation, the marks of the Appellant and the 1st

Respondent are reproduced hereunder:

Appellant's mark:



1st Respondent's mark:



8. The admitted fact is that both the Appellant and the 1st Respondent are traders in fireworks. The Appellant's brand is Eagle and the 1st Respondent's brand is Garuda. No doubt, when the marks are



(T) CMA (TM) No.10 of 2023

placed next to each other, a person of ordinary intelligence can call out the differences between the two marks by saying that in one, the bird is in flight mode and it is sitting on a globe and in the other, the bird is perched on a tree branch. However, the line of settled decisions does not approve of such an approach.

9.Firstly, the image of an Eagle and Garuda can easily be confused and used interchangeably. Though the law is well settled that the mark has to be seen as a whole and not dissected into parts, it is ultimately the prominent or dominant feature of a mark which would stand out in the minds of the end users. A person who goes to the shop to buy fireworks cannot be expected to bear in mind that one brand is an Eagle sitting on a globe with its wings spread and the other brand is a Garuda, a divine bird perched on a tree branch. The test is to see whether the impugned mark would be seen as the mark of another and there is likelihood of confusion or deception.

10.No doubt, in the present case, there is no phonetic similarity, one being Eagle and the other being Garuda. However, when it comes to visual similarity, the same cannot be said since the relevant and proper



(T) CMA (TM) No.10 of 2023

test is to see whether the customer will get confused on seeing the impugned mark. In fact, a literal translation of Garuda, a tamil word to English would only mean Eagle and therefore, it cannot be said that there is no similarity between the two.

11. In so far as prior use, the Appellant has shown by producing satisfactory documentary evidence that it has been using the brand from as early as 1956 and has also shown continuous and extensive use. The 1st Respondent claims to have been in the market, using the Garuda mark from 1995 onwards, a good 9 years prior to the date on which an application was made for registration. However, to establish such a plea, the 1st Respondent has not filed satisfactory or sufficient documentary evidence excepting for some handwritten bills which have not even been shown to be remotely connected to the 1st Respondent. The other invoices filed by the 1st Respondent also do not lend any credence to the claim of use from 1995 onwards as most of the invoices are not carrying the impugned label also. The documents appear to be very doubtful and may have been fabricated to suit the case of the 1st Respondent as evidenced from the manner of writing GARUDA in such of those invoices. None of



(T) CMA (TM) No.10 of 2023

the invoices prior to the year 2000 contain the GARUDA label and in all the invoices, the word GARUDA appears to be introduced later on. I am unable to satisfy myself about the genuineness of the hand written invoices prior to the year 2000. In any event, the Appellant has shown to be the prior user.

12.The next contention raised by Mr.P.Valliappan, Learned Senior Counsel is that applying Section 33, the Appellant is disentitled to relief. Section 33 refers to the effect of acquiescence and states that when a proprietor of an earlier trade mark has not challenged the use of another for a period of 5 years, he would thereafter be disentitled to attack the invalidity of the later mark or oppose the use of the later mark, unless it is shown to have been not applied in good faith. I do not see how this Section will even come into play in the facts of the present case.

13.The application of the 1st Respondent that has been opposed by the Appellant is A.No.1279187. Admittedly, the 1st Respondent has applied for registration of the mark only on 15.04.2004, in Class 13 claiming a user from 26.05.1995. The mark has been published in the journal on 15.01.2006 and the Appellant has immediately objected to the



(T) CMA (TM) No.10 of 2023

same by filing an opposition on 28.08.2006 itself. I therefore do not see any delay or acquiescence in the matter on the part of the Appellant.

Section 33 will not come into play under such circumstances. Merely because an earlier application and a later application have not been opposed by the Appellant, it would not amount to acquiescence in so far as the present application is concerned. The law is well settled that a person need not go after every other mark and it is only those marks that appear to be a threat to the person need to be challenged and therefore, viewed from any angle, I do not see the Appellant's opposition being barred under Section 33 of the Act.

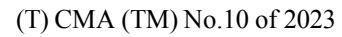
14. Coming to the last limb of the argument of the Learned Senior Counsel that Section 12 would come to the rescue of the 1st Respondent, I am afraid the same cannot be countenanced. The Appellant has been in the same fireworks industry for several decades and the adoption of the mark by the 1st Respondent, deceptively similar to the Appellant's mark can never be termed as honest or bona fide. In fact, the adoption of a bird similar to that of the Appellant's bird, the prominent feature of the mark itself appears to be mala fide/dishonest, only with a view to cash in on the



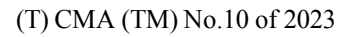
(T) CMA (TM) No.10 of 2023

good will and reputation built by the Appellant. The customer or the end user in the present case, a person buying fireworks cannot be expected to be from the intellectual strata of society and invariably the end user is illiterate and a person of average intelligence who will not be in a position to memorise the two different marks and purchase the one he wants. Therefore, testing it from this angle, there is a strong likelihood of confusion arising and consequently, leading to deception as well. Therefore, I do not find any of the special circumstances contemplated under Section 12 of the Act to come to the aid of the 1st Respondent.

15. In *National Sewing's* case (cited herein supra), the Hon'ble Apex Court was deciding a very similar rival claim relating to a device of a bird with wings fully spread out and perched on a cylinder of cotton sewing thread with 'Eagle Brand' printed on the mark and on objection, the word 'Eagle' was replaced with 'Vulture'. However, the same was not satisfactory as in all other aspects the mark remained unchanged. The Apex Court held that the particular feature of the trade mark by which the goods are identified is the representation of an eagle appearing in the trademark and unwary purchaser is likely to accept the goods of the Appellant as answering the requisition for Eagle goods and therefore,



16. In *J.C. Eno's case* (referred herein supra), the Bombay High Court took note of the fact that many people in India know different local languages and when a person does not know English may be misled for a ride by unscrupulous dealers and mislead and practice a deception by passing off goods of the other trader. Here also, both Eagle and Garuda are printed in English language and when an illiterate consumer goes to buy the fireworks, he is likely to be deceived by the similarity of an eagle and may not be able to differentiate between an eagle



17. In *National Chemicals case* (referred herein supra), the Division Bench of the Bombay High Court held that when the rival marks are so similar that they are likely to be confused, the fact that one mark contains the legend Robin and Bul Bul, what would normally be retained in the mind of the consumer, is the picture of a bird and the fact that it carries Robin or Bul Bul, and this would not make any difference to the overall similarity of the two marks. The ratio laid down in this case will also apply to the facts of the present case, as ultimately the end user will only be able to recollect the dominant feature, viz., the eagle image and he cannot tell the difference between an eagle and Garuda.

<https://www.mhc.tn.gov.in/judis>
13/18



WEB COPY

19.In the leading case of ***K.R.Chinna Krishna Chettiar*** (referred herein supra), the Apex Court deciding a rival claim between Andal and Ambal, held that the customers would only have a vague recollection of the portrait of a goddess and they cannot be expected to remember the fine distinction between a Vaishnavite goddess and a Shaivite deity. This ratio laid down by the Apex Court would also apply in all force to the facts of the present case.

20.In ***Amritdhara Pharmacy's case*** (referred herein supra), the Apex Court held that for deceptive resemblance two important questions have to be answered, viz., 1) who are the persons whom the resemblance must be likely to deceive or confuse and 2) what rules of comparison are to be adopted in judging whether such resemblance exists. It further ruled that as to confusion, the state of mind of a customer who on seeing the mark, thinks that it differs from the mark on the goods which he has previously bought, but is doubtful whether that impression is not due to imperfect recollection. Therefore, the issue has to be approached from the point of view of a man of average intelligence and imperfect recollection.



(T) CMA (TM) No.10 of 2023

WEB COPY

21. Applying this test to the facts of the present case, there is no doubt that there is bound to be confusion and deception at the hands of the end user.

22. Having elaborately discussed the merits and demerits of the respective cases put forth by the Appellant and the 1st Respondent, I now turn to see if the decision of the Deputy Registrar is liable to be interfered with.

23. The Registrar has admittedly taken note of the fact that the rival goods are identical goods. Despite holding that both Garuda and Eagle are the same, meaning-wise, the Registrar has proceeded to render a finding that the marks are not deceptively similar. In arriving at such a finding, the Registrar has neither assigned any justifiable reasons nor tested the marks in line with settled legal principles, which I have elaborately discussed hereinabove, already. By merely stating that the marks have to be compared as a whole, the Registrar has jumped to the conclusion that the marks are not deceptively similar. Such a finding fails reason or logic and hence, deserves to be set aside.



(T) CMA (TM) No.10 of 2023

WEB COPY

24.The Registrar has further held that the Appellant having not opposed the earlier registration of the 1st Respondent, is not entitled to oppose the application. This finding is also perverse and as already discussed herein above, the fact that some other application for registration was not opposed, especially when it is not shown to be an associated mark, it would not disentitle the Appellant to oppose the present impugned mark even before it is accepted for registration.

25.The Registrar has also strangely held that both parties hail from Sivakasi which is famous for fireworks and therefore, obviously they know each other being members of Tamilnadu Fireworks and Amorges Manufacturers Association and the 1st Respondent being in business from 1995 within 5 kms radius from the Appellant's place of business, the Appellant is not entitled to any protection by way of opposition application. I am unable to affirm such findings which are baseless and without any material placed before the Registrar in this connection.



(T) CMA (TM) No.10 of 2023

26.From the foregoing discussions and for all the above reasons,
the impugned order of the 2nd Respondent cannot be sustained, both in
law and on facts and it deserves to be set aside.

27.In fine, the appeal is allowed as prayed for. However, there shall
be no order as to costs.

20.09.2024

Index : Yes/No
Speaking/Non-speaking order
ata

To

The Deputy Registrar of Trade Marks,
Office of the Trade Marks Registry,
Intellectual Property Rights Building,
GST Road, Guindy,
Chennai – 600 032.



WEB COPY



(T) CMA (TM) No.10 of 2023

P.B.BALAJI,J.

ata

(T) CMA (TM) No.10 of 2023

20.09.2024