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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

\+ C.A.(COMM.IPD-TM) 143/2021

MANU GARG AND
RATAN BEHARI AGRAWAL ..... Appellant
Through: Mr. M.K. Miglani, Adv.

Versus

REGISTRAR OF TRADE MARKS ..... Respondent
Through: Mr. Harish Vaidyanathan Shankar, CGSC with Mr. Srish Kumar Mishra, Mr. Sagar Mehlawat and Mr. Alexander Mathai Paikaday, Advs.

CORAM:
HON'BLE MR. JUSTICE C.HARI SHANKAR

JUDGMENT(ORAL)

% 01.02.2023

1. The appellant is aggrieved by order dated 4th February 2021, passed by the learned Senior Examiner of Trademarks in the office of the Registrar of Trademarks, whereby Application No. 3757855 of the appellant has been rejected by the learned Senior Examiner.

2. Written submissions by way of response to the appeal have been filed by the respondent. I have heard Mr. Miglani, learned Counsel for the appellant and Mr. Harish Vaidyanathan Shankar, learned Counsel for the respondent.

Facts

3. Application No. 3757855 was submitted by the appellant for registration of the word mark "COCK" under Class 28 of the NICE classification as adopted by Rule 20 of the Trademarks Rules 2017,

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for "water and colour pistols, water and colour guns, water and colour sprayers, being toys included in Class 28". Mr. Miglani points out that the goods in respect of which the impugned mark was sought to be registered were pistols in the nature of "*pichkaris*" (water guns), used in festivals such as Holi for spraying colours. He submits that, even if akin in shape to guns, the water and colour pistols made by the appellant have nothing in common with fireworks, with which, traditionally, guns are associated. They, therefore, are guns merely in form, not in substance.

4. Consequent to filing of the aforesaid application by the appellant, the learned Senior Examiner in the office of the Registrar of Trademarks, *vide* First Examination Report (FER) dated 13th March 2018, objected to the grant of registration for the appellants COCK mark, citing two marks which, according to him, were identical and used for goods which were similar or allied to the goods in respect of which registration was sought by the appellant. The proprietors, in whose favour the said marks were registered, were Mr. A.S. Chinna Nadar ("Chinna Nadar", hereinafter), Sivakasi and Mr. Lokesh Kataria, Gurgaon.

5. Of these, at the time when the FER was issued, the COCK mark of Mr. Lokesh Kataria was under objections. Subsequently, the application of Mr. Kataria stands rejected by the learned Registrar. As such, the objection of the learned Senior Examiner, predicated on the COCK registration granted to Chinna Nadar alone survives for consideration. This position has already stands noted in the order dated 23rd May 2022 passed in the present proceedings.

6. On receiving the aforesaid FER, the appellant, *vide* reply dated

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2nd April 2018, submitted that the objection of the learned Senior Examiner was misconceived, as the COCK brand registered in favour of Chinna Nadar was for "amorces or paper caps for toy pistols", whereas the appellant was seeking registration of the COCK mark for water and colour pistols, guns and sprayers used to spray colours during festivals such as Holi. It was also pointed out that the mark which stood registered in favour of Chinna Nadar was the device mark  which clearly indicated that the registration was for amorces and for no other goods. The registration sought by the appellant was, on the other hand, for toy pistols used to spray colours, which had nothing in common with amorces. An "amorce", as Mr. Miglani points out from the dictionary, is a percussion cap for a toy pistol. Elsewhere, the expression "amorce" is defined as "a firework which is a percussion cap designed for use in toys, which comprises of paper envelope containing a dot of impact sensitive pyrotechnic composition and which forms part of a roll".

7. I may note, here, that, in India, such rolls, which are fitted in toy pistols, are often used by children on the occasion of festivals such as Diwali. These rolls are often mounted on pistols between the striking surface and the body of the pistol so that, when the pistol is cocked and fired, due to the impact of the strike, a small spark is emitted with a noise imitative of a bullet being fired. Amorces are available in rolls or in individual pieces.

8. The appellant's objection was not accepted by the learned Senior Examiner who has, by the impugned order dated 4th February 2021, rejected the appellant's application. The impugned order reads

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thus:

> "Instant mark is phonetically and visually identical to the conflicting marks which is mentioned in the search report and also they are well in prior use in respect of the similar nature of goods which sought by the applicant. The applicant is the well subsequent user among the conflicting mark user period. In view of these grounds, the Tribunal has opined that the applicant has deliberately chosen the subject mark in an effort to ride upon the goodwill and reputation of the conflicting marks. Applicant has no bona fide adoption of the subject mark in respect of the applied goods. Further, the allowance of the subject mark is patently mala fide since the mark has been dishonestly adopted by the applicant hence the applicant cannot claim to be the proprietor of the subject mark under Section 18(1) of the Act. Allowance of the subject mark is adversely affecting the interest of the public; it would lead to confusion as it is more than likely, due to imperfect recollection that the average buyer may confuse the applicant's mark "COCK" as the conflicting owner's product sold under "COCK". In view of such similarities between the nature of the marks and their goods, the applicant's trade channel and counters, there exists a strong likelihood of confusions on the part of the consuming public, including an association, as they are likely to assume and confuse that the applicant's goods are connected or otherwise associated with the conflicting marks goods, when no such connection exists. Consequently, the members of the trade would no doubt, be under the mistaken belief that the applicant's goods originate from the conflicting mark or that they have some trade connection or affiliation thereby causing irreparable loss and damage not only to the conflicting mark trade and business but also suiting erosion of distinctiveness hard earned by the conflicting marks.

In addition to the facts of the subject application, I want to discuss the land mark case of ***Cadila Health Care Ltd. v. Cadila Pharmaceuticals***[1] wherein the Supreme Court has stated that in an action for passing off on the basis of unregistered trade mark generally the following factors have to be considered for deciding the question of deceptive similarity of marks:

(a) The nature of the marks i.e. whether the marks are word marks or label marks or composite marks i.e. both words and label marks

(b) The degree of resemblances between the marks, phonetically similar and hence similar in idea.

(c) The nature of the goods in respect or which they are used as trade marks.

(d) The similarity in the nature, character and

[1] **AIR 2001 SC 1952**

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performance of the goods or the rival traders.

(e) The class of purchasers who are likely to buy the goods bearing the marks they require, on their education and intelligence and a degree of care they are likely to exercise in purchasing and or using the goods.

(f) The mode of purchasing the goods or placing orders for the goods, and

(g) Any other surrounding circumstances which may be relevant in the extent of dissimilarity between the competing marks.

Weightage to be given to each of the aforesaid factors depends upon facts of each case and the same weightage cannot be given to each factor in every case.

Based upon the Supreme Court guidelines, the above mentioned seven factors are obviously applicable to this case. In order to avoid the opposition to the registration as well as passing off actions against the subject mark, the Tribunal is not ready to accept the subject mark for journal publication.

In this position, I would like to enlighten the object of the Trade Marks Act, 1999. The said object is to provide for registration and better protection of trade marks for goods and services and for the prevention of the use of fraudulent marks. If the subject mark is allowed for registration, the object of the Trade Marks Act, 1999 would be jeopardized and the purity of the Register will be affected.

In view of the above said reasons, the Trade Mark Application is refused under sections 11(1)(a) and (b) of the Trade Marks Act, 1999."

Rival Contentions

9. Mr. Miglani submits that the impugned order is misconceived. The finding of the learned Senior Examiner that the use, of the COCK mark registered in favour of Chinna Nadar was for goods which were similar to those in respect of which registration was being sought by the appellant is, he submits, erroneous on facts. The goods in respect of which the appellant was seeking registration, and the goods in respect of which the COCK brand stood registered in favour of

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Chinna Nadar, he submits, are completely different.

10. In fact, submits Mr. Miglani, the appellant stands registered for use of the COCK brand for colours since 1992. The appellant had earlier been issued a legal notice dated 19th February 2018 by Sri Kaliswari Fireworks, of which Chinna Nadar was admittedly the Director, objecting to the use, by the appellant, of its COCK label. The appellant had replied to the said legal notice on 17th March 2018, submitting that, whereas the appellant's COCK mark was used for Holi colours, *gulal* and like goods, Chinna Nadar's mark was used for fireworks, sparklers, crackers, ground wheels, rockets, colour matches etc. Mr. Miglani points out that, on the said reply being submitted by his client, Sri Kaliswari Fireworks had, by its communication dated 30th January 2019, expressed satisfaction with the reply of the appellant.

11. The goods in respect of which the appellant was now seeking registration of the COCK brand are, submits Mr. Miglani, goods which are used for spraying the very colours in respect of which the COCK brand already stands registered in the appellant's favour since 1992. Chinna Nadar has already expressed his satisfaction with the use of the said mark by the appellant for colours. As such, he submits, the learned Senior Examiner acted unreasonably in refusing registration to the appellant, for the mark "COCK" in respect of water and colour pistols, guns and sprayers, under Class 28.

12. Mr. Vaidyanathan, learned Counsel for the respondent, on the other hand, supports the impugned order. He submits that the COCK mark registered in favour of Mr. A.S. Chinna Nadar is also used for toy pistols. The mere fact that toy pistols in which the said amorces

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were used, were normally used in Diwali, whereas the toy pistols for which the appellant was seeking registration are used in Holi and like festivals, he submits, cannot make a substantial difference or justify interference with the impugned order which is well-reasoned. He submits that the goods in respect of which registration was being sought by the appellant, and the goods in respect of which the COCK brand was registered in favour of Chinna Nadar were both used in festival celebrations. As such, he submits that both the items would be available from similar small shops and that it was a matter of common knowledge that festivals such as *Durga Pooja*, spraying of colours and fireworks both took place. As such, Mr. Vaidyanathan submits that the learned Senior Examiner cannot be faulted in refusing registration to the appellant's mark.

Analysis

13. I have heard learned Counsel and perused the material on record.

14. Section 11 of the Trade Marks Act provides "relative grounds for refusal of registration", as against "absolute grounds for refusal" envisaged by Section 9. The grounds for refusal, contained in Section 11, essentially relate to earlier marks registered in favour of someone else, or for which an application is pending with the office of the Registrar of Trademarks. We are concerned with Section 11(1)[2].

[2] **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.

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15. Section 11(1)(a) prohibits registration of a trademark which is identical to an earlier trademark and used in respect of similar goods or services, whereas Section 11(1)(b) prohibits registration of a trademark which is similar to an earlier trademark and used in respect of identical or similar goods or services. In either case, there must, additionally, exist a likelihood of confusion on the part of the public, for registration to be refused under Section 11(1). The provision also clarifies that "confusion" would include likelihood of association with the earlier trademark.

16. Having heard learned Counsel for both sides and applied my mind thereto, I am unable to subscribe to the view of the learned Senior Examiner that the goods, in respect of which registration of the COCK word mark was being sought by the appellant, were similar to the goods in respect of which the COCK device mark stood registered in favour of Chinna Nadar. Mr Vaidyanathan's submission that toy pistols are toy pistols, I feel, oversimplifies the issue. The "guns", or "pistols", for which the appellant sought registration of the COCK mark, are guns or pistols merely in form, not in substance. They emit neither heat nor light. They are not, therefore, fireworks in any sense of the expression. They emit – if one may use the expression – not fire, but its antithesis; water. A gun which sprays water and a gun which emits a spark and, therefore, releases heat and light are about as alike as chalk and cheese. The fact that they may both be used on similar occasions does not make them like, similar, or allied, even in ordinary parlance.

17. The appellant seeks registration of the COCK word mark.

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Chinna Nadar holds a registration for the  device mark. Chinna Nadar's mark is a composite device mark which includes, apart from the words "COCK BRAND", the word "AMORCES".

18. Besides, Chinna Nadar's registration was specifically for "amorces or paper caps for toy pistols". As such, the mark was not even registered for toy pistols *per se*, but only for amerces used in toy pistols. The appellant's request for registration could not, therefore, have been refused on the ground that the COCK brand stood registered in favour of Chinna Nadar for toy pistols. The "toy pistols are toy pistols" plea of Mr Vaidyanathan is really, therefore, irrelevant. Chinna Nadar's registration was for amorces. Toy pistols which spray water cannot, howsoever much the imagination were to be strained, be likened to amorces. Indeed, one would extinguish the other.

19. This is not an infringement suit. We are concerned, therefore, not with Section 29, but with Section 11 of the Trade Marks Act. Refusal of an application for registration is justified only if the grounds are relatable either to Section 9 or to Section 11. Section 11(1), as already noted, envisages refusal of registration *only if, either*

(i) (a) the applicant's mark and the earlier mark are identical and the marks are used for similar goods or services, *or*

(b) the applicant's mark and the earlier mark are similar, and the marks are used for identical or similar goods or services, *and*

(ii) registration of the applicant's mark would result in a a

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likelihood of confusion, or association with the earlier mark, on the part of the public.

"Likelihood of confusion" is not to be easily presumed. The nature of the goods and the class of their purchasers has to be borne in mind.

20. The appellant's COCK word mark and Chinna Nadar's COCK device mark cannot, strictly speaking, be said to be identical. That apart, mere identity or similarity of the marks is not sufficient to disentitle an applicant for registration under Section 11(1). It has, additionally, to be shown that

(i) the goods or services in respect of which the earlier mark stood registered or applied for, were identical or similar to the goods or services in respect of which registration was being sought, and

(ii) registration of the mark in favour of the applicant would result in a likelihood of confusion on the part of the public.

21. Registration of an "eligible" mark is a valuable commercial right. Registration brings, in its fold, several inalienable entitlements; most importantly the entitlement to protection against infringement. Registration, where the mark is eligible therefor cannot, therefore, be refused. An application for registration of a trade mark, therefore, can be rejected only if it falls strictly within the peripheries of the criteria envisaged by Sections 9 and 11 of the Trademarks Act.

22. Viewed thus, for the following reasons, I am of the opinion that the appellant's mark would be entitled to registration:

(i) The appellant's mark cannot be treated as identical or similar to the mark which already stood registered in favour of

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Chinna Nadar. The appellant sought registration of the word mark COCK. The mark registered in favour of Mr. A.S. Chinna Nadar was the  device mark, which contained, prominently, the words "COCK BRAND" above the figure of a strutting cock and, below that, the word "AMORCES". A person viewing the mark would, therefore, be made clearly aware of the fact that the mark was used only in respect of amorces and nothing else. There could not, therefore, be said that there existed any likelihood of confusion, much less a possibility of Chinna Nadar's goods being passed off as a goods of the appellant by reason of the registration of the appellant's mark.

(ii) That apart, amorces and toy spray guns used for spraying water and colours are neither identical or similar. Chinna Nadar's COCK brand was registered only for amorces; not even for toy guns. Amorces are not used with spray guns which spray water or colour; indeed, water would extinguish the amorce and render it unusable. Amorces are fireworks. The appellant's guns spray coloured water. Fire cannot be likened to water. The appellant sought registration of the word mark COCK for toy pistols or guns used for spraying coloured water during festivals. They have nothing in common with toy pistols used in fireworks; much less with amorces used with such pistols. The mere fact that, in some festivals, both may be used, is irrelevant. Similarity, for the purposes of Section 11(1), has to be of the goods or services, not of the occasion of their user. The impugned order of the learned Senior Examiner has not

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considered this aspect or the difference in the nature of the goods for which the appellant sought registration, vis-à-vis the goods for which the COCK mark was registered in favour of Chinna Nadar.

(iii) Further, there is little chance of any likelihood of confusion in the minds of public between the two marks, or likelihood of any association, by registration of the COCK word mark in favour of the appellant, with the rgistratioon of the  device mark in favour of Chinna Nadar. As already noted, the appellant's mark was being used in toy pistols which sprayed coloured water during festivals. The  device mark registered in favour of Chinna Nadar was, on the other hand, used for amorces, which are in the nature of small fireworks. It cannot, therefore, be said, in the absence of any material to indicate to the contrary, that the registration of the COCK word mark in favour of the appellant, as sought, would result in any likelihood of confusion in the minds of the public.

23. None of the three criteria, which require cumulative satisfaction in order for an application for registration of a mark to be rejected under Section 11(1) of the Trademarks Act can, therefore, be said to be satisfied in the present case.

24. In that view of the matter, it is not necessary for this Court to enter into the allegations of *mala fide* etc. which find place in the impugned order and which, in my opinion, ought not to have been

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returned without adequate evidence.

Conclusion

25. For the aforesaid reasons, I am unable to sustain the impugned order, which is accordingly quashed and set aside. Application No. 3757855 of the appellant would accordingly stand allowed in terms thereof.

26. The appeal is, accordingly, allowed with no order as to costs.

27. Consequential steps be taken by the learned Registrar in accordance with law.

C.HARI SHANKAR, J

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