IN THE HIGH COURT AT CALCUTTA
SPECIAL JURISDICTION
[COMMERCIAL DIVISION]

Present:

The Hon'ble Justice Krishna Rao

IPDTMA No. 80 of 2023

Girnar Food & Beverages Pvt. Ltd.

Versus

The Registrar of Trade Marks & Anr.

Mr. Sourajit Dasgupta
Mr. N. Banerjee
Mr. Pradipta Basu

... For the appellant.

Hearing Concluded On : 23.04.2024

Judgment on : 18.06.2024

Krishna Rao, J.:

1. The appellant has filed the present appeal under Section 91(1) of the Trade Marks Act, 1999, against the order passed by the Registrar Trade Marks dated 22nd July, 2023, wherein the opposition filed by the

appellant being no. 718498 against the application No. 1411841 in Class 30 of the respondent, was rejected and permitted the application filed by the respondent to proceed for registration.

2. On 8th February, 1989, registration of "JUMBO" mark was granted to the appellant with respect to Tea and Spice (Foods). On 11th September, 2006 further two marks have been registered.

3. It appears from the records that the appellant had notified the respondents regarding the application and its proceeding filed before this Court, but even after being notified about the same, none appears on behalf of the respondents. Thus, this Court had heard the matter *ex-parte.*

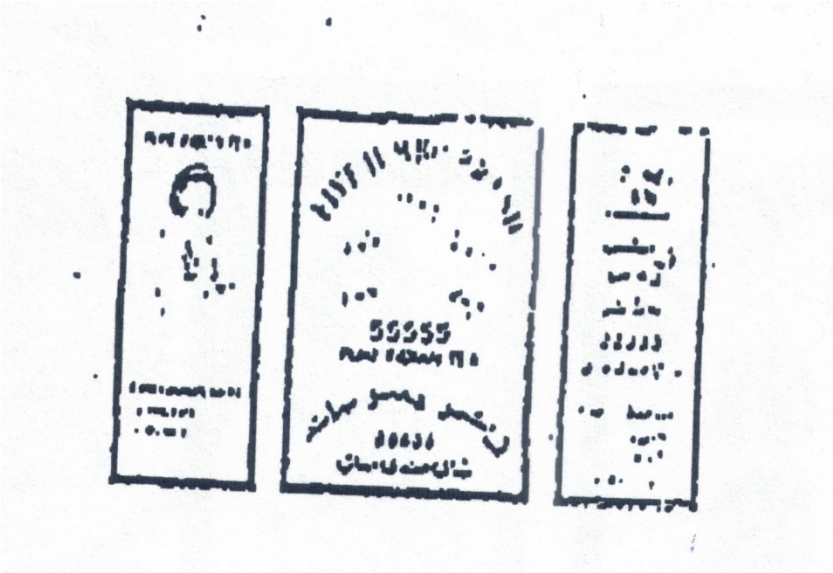
4. The appellant is an old and reputed company carrying on business of manufacturing, selling, and exporting tea including black tea, green tea, flavoured tea, fruit tea/infusions, herbal infusions and premixed tea, iced tea and coffee. The appellant has various offices, factories and warehouses in Ahmedabad, Coimbatore, Coonoor, Guwahati, Kochi, Kolkata, Mumbai, Pune, Siliguri, Umbergaon and Colombo, Sri Lanka. The appellant also has alliances and partnerships in various cities across the world like Dubai (UAE), Warsaw (Poland), St. Petersburg (Russia), Jeddah (Saudi Arabia), Sydney (Australia), New York (USA), Muscat (Oman), Mombasa (Kenya) and Conakry (Guinea).

5. The appellant also exports bulk/loose and packaged tea to various countries including the ones indicated above. The appellant has more

than 50 retail outlets in western and southern India. The appellant further has a virtual/online shop offering a vast, unique and exquisite range and quality of teas and other beverages.

6. The appellant is using its mark, being a device of an Elephant consisting of the word "JUMBO" and "FIVE JUMBO" in India since the year 1985 and is also the registered proprietor thereof. The mark of the appellant is:







7. Registration for the mark "JUMBO" bearing No. 505034 in respect of "Tea and Spices (Foods)". The trade mark "JUMBO" is dated as of 8th February, 1989 and is advertised in the Trade Marks Journal No.891 dated 16th December, 1994.

8. The marks have been used by the appellant continuously and uninterruptedly and the products of the appellant always bear the said marks and such products have been sold in India extensively and also exported to other countries.

9. The striking features of the marks are the picture of the five elephants along with the word "JUMBO", over which the appellant has proprietary rights and it also indicates the source of the products of the appellant.

10. The public at large associates such features of a mark with the appellant and the appellant alone, the picture of elephants along with the word "JUMBO" have grasped the consumer consciousness as such any other mark consisting of the device of an elephant with any word meaning elephant in Hindi, English or any other Indian language, would inevitably amount to deception in the minds of the public, along with infringement of the registered trademark of the appellant.

11. The appellant came to learn that an application, numbered as 1411841 for registration of a mark in Class 30, being a device of an elephant consisting of the word "HAATHI" has been filed by the respondent no.2 on 6th January, 2006, claiming use since the year 1970.

12. It is the submissions of the appellant that the adoption of the device of an elephant along with the word "HAATHI" was completely *mala fide* and was in any event deceptively similar to the JUMBO marks of the appellant. Every prominent feature of the appellant's marks was lifted and used by the respondent no.2 for obtaining registration over the said impugned mark.

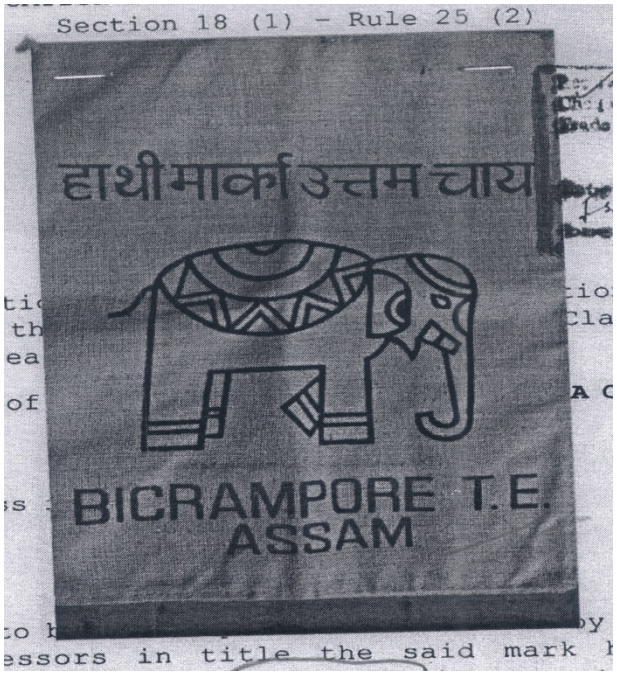
13. Immediately after knowing about the same, the appellant filed its opposition to such application for registration, being Opposition No. 718498 on 4th February, 2008.

14. The respondent no.2 had filed its affidavit before the Registrar contending that it has been doing business outside India for a considerable period of time but the invoices annexed by the respondent

no.2 dates back to the year 2002 and not prior to that. The name of the respondent no.2's mark is Bicrampore T.E Assam, and hence, there could be no reason why the respondent no.2 included the device of elephant and the "HAATHI" word in its application for registration.

15. On the contrary as stated by the appellant that they have been using the mark, being a device of elephants consisting of the word "JUMBO", since the year 1985 and various documents were produced by the appellant to demonstrate such use from the aforesaid date.

16. The appellant submits that the observation of the respondent no.1 is that the prominent feature of the mark goes to the root of the matter, and is a fundamental error, and therefore, the impugned judgment and order deserves to be set aside on such ground alone, wherein, the device of the elephant was the prominent and dominant feature of the label and occupied more than 50% of the label. Additionally, the primary feature of the label mark, namely the drawing of an elephant with the self-explanatory caption "HATHI MARKA UTTAM CHAI" (Literal translation – ELEPHANT BRAND EXCELLENT TEA) pre-empts even the remotest likelihood of confusion as to the correct brand name. The mark of the Respondent No.2 is:



17. The respondent no.1 also committed a grave error by failing to appreciate the purport and intention of Section 17 of the Trade Marks Act, 1999, the respondent no.1 erred in relying on Section 17 to come to the conclusion that the registration of the respondent no.2's trademark as a whole along with the device of the elephant does not amount to any exclusivity to the device of 'Hathi', 'Elephant' or 'Jumbo'. The provision of Section 17 of the Trade Marks Act, 1999, reads as follows:

> ***"17. Effect of registration of parts of a mark.—***
>
> *(1)When a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole.*
>
> *(2) Notwithstanding anything contained in sub-section (1), when a trade mark—*

(a) contains any part—

(i)which is not the subject of a separate application by the proprietor for registration as a trade mark; or
(ii)which is not separately registered by the proprietor as a trade mark;

Or (b)contains any matter which is common to the trade or is otherwise of a non-distinctive character, the registration thereof shall not confer any exclusive right in the matter forming only a part of the whole of the trade mark so registered."

18. The respondent no.1 has also failed to appreciate the ratio of the order of the Hon'ble IPAB and came to the wrong conclusion that the same had been passed under the Trade Marks Act, 1958, whereas the legal position in accepting any composite label trademark as a whole is different under the Trade Marks Act, 1999.

19. The respondent no.1 had failed to appreciate that the appellant had provided sales figures providing use of their tea under their trademarks from the year 1985-1986 onwards duly certified by a Chartered Accountant whilst the Respondent no.2 had failed to adduce a single document evidencing sale of its tea in India.

20. The respondent no.1 had committed a grave error which is apparent on the face of the record by failing to take into consideration that the petitioner is the registered proprietor of the following trademarks:

(i) Jumbo (word), Five Jumbo Logo and Five Jumbo label bearing trademark application nos. 505034, 505035 and 505036 in Class 30 since 1989 claiming use since 1985;

(ii) *Mark Five Jumbo Brand (device of elephants) and Five Jumbo brand (device of girl and elephants) bearing trademark application nos. 1485728, and 1485729 in Class 30 since 2006 claiming use since 1985;*

(iii) *Mark Pach Hathi Chai (device of elephants) bearing trademark application no.1538651 in Class 30 since 2007 claiming use since 1985;*

(iv) *Mark Hathi Ghoda (device of animals) bearing trademark application no. 2343262 in Class 30 since 2012 claiming use since 2012;*

(v) *Mark Girnar Jumbo Tea (device) bearing trademark application no. 2914864 in Class 30 since 2015 claiming use since 1985.*

21. Mr. Sourojit Dasgupta, Learned Counsel for the appellant in support of his submissions relied upon the judgment in the case of ***The Gillette Company LLC –vs- Tigaksha Metallics Private Ltd. and Another*** reported in ***2018 SCC Online Del 9749*** in which the Delhi High Court held that :

> *"As far as the contention of the senior counsel for the defendant No.2,qua distinction between two marks owing to the word "WILKINSON" in the mark of the plaintiff and the word "ZORRIK" in the mark of the defendants is concerned, the Division Bench in judgment aforesaid has also held that since OFFICER"S CHOICE and COLLECTOR"S CHOICE were found to convey the same meaning and deceptively similar, the impact of the differences in trade dress was unlikely to rule out consumer confusion between the two products. Mention may also be made of Section 2(1)(zb)(ii) of the Trade Marks Act, 1999 inter alia defining a „trade mark" as meaning a mark capable of distinguishing the goods of one person from those of others for the purpose of indicating or so to indicate a connection in the course of trade between the goods and some person having the right to use the mark, whether with or without any indication of the identity of that*

> *person. It is thus clear that mere disclosure of the identity of the defendant along with the use by the defendant of the impugned mark would be irrelevant."*

In the case of ***T.G. Balaji Chettiar –vs- Hindustan Lever Ltd.***, ***Bombay*** reported in ***1965 SCC Online Mad 69***, the Madras High Court held that:

> *"A mark shall be deemed to be deceptively similar to another mark if it is so nearly resembles with the other mark as to be likely to deceive or cause confusion. In deciding this question it is sufficient to consider two registered trade marks of the respondents: (i) mark No. 87107 consisting of a label containing a device of the rising Sun and the legend 'Sun light' and (ii) Registered trade mark No. 147011 consisting of the word 'Sun' (solus). The argument of the respondents which has found favour with the Asst. Registrar of Trade Marks is that the Tamil word 'Surian' (trade mark of the appellant) is the translation of the word Sun and is therefore deceptively similar to their mark, so as to be governed by the prohibition contained in S. 12(1) of the Act and S. 11(a). From the supporting affidavit which have been filed by the respondents there can be no doubt it that a Tamil Knowing purchaser who is not conversant with English will refer to and ask for the respondents' soap as the Surian mark soap. There is every likelihood of customers and dealers being given the Surian mark soaps of the appellant when those customers and traders really intend and mean the Sunlight soap of the respondents. There is great room for confusion and mistakes occurring in the minds of the trading community in thinking that the Surian mark soap(marketed by the appellant) is the product of the respondents. It must be forgotten that the soaps manufactured and marketed by the respondents are low priced soaps and are used*

very largely(a substantial major portion) by low class and illiterate people who do not know English and are not even familiar with the Tamil and there is greater danger of the appellant's soaps(with Surian marks) being dumped in the market and passed off as the Sunlight Soaps manufactured by the respondents. It is too much to except the poor class of customers like laborers and servants to embark upon a minute investigation of the difference of the Sunlight soap and Surian soap as belonging to two different proprietors. The evil of the situation becomes more apparent when we notice the imitation and close similarity in get up of the label and the particular colour scheme which has been copied by the appellant. I have therefore no hesitation in holding that under S. 11(a) and 12(1) of the Act registration will have to be refused on the ground that the use of the word Surian, the Tamil equivalent of 'Sun' is deceptively similar and sure to cause confusion. In this case the conclusion has to be reached not merely on a consideration of the principle in the abstract but also on the evidence as disclosed in the supporting affidavit which demonstrates the actual confusion and mistake which had crept into the market."

22. In the present case, the respondent no.2 made an application being No. 1411841 for registration of a mark in Class 30 being the device of an elephant consisting of the word "HATHI" claiming since 1970 and when the appellant came to know, the appellant has filed its objection. In the objection, the appellant has submitted its all registrations showing that the Trade Mark "JUMBO" (word), Five Jumbo logo and Five Jumbo labels being trade mark application Nos. 505034, 505035 and 505036 in Class 30 since 1989 claiming use since 1985. Mark Five Jumbo Brand (device of elephants) and Five Jumbo Brand (device of girl and

elephants) bearing trade mark application Nos. 1485728 and 1485729 in Class 30 since 2006 claiming use since 1985. Mark Pach Hathi Chai (device of elephants) bearing trademark application No. 1538651 in Class 30 since 2007 claiming use since 1985. Mark Hathi Ghoda (device of animal) bearing trademark application No. 2343262 in Class 30 since 2012 claiming use since 2012. The Mark Girnar Jumbo Tea (device) bearing trademark application no. 2914864 in Class 30 since 2015 claiming use since 1985.

23. The respondent no.2 claims that the respondent no.2 is continuously using the "HATHI MARKA UTTAM CHAI" since 1970 but has not submitted any documents before the respondent no.1 with respect to its contention. The documents which the respondent no.2 relied upon are of 2002. The respondent no.1 has come to the conclusion that the appellant has been the prior user of the JUMBO brand and they have earned an enormous goodwill in respect of their mark but the respondent no.1 has erred in coming to the conclusion that the respondent no.2 also been using the same concurrently and evidences produced by the respondent no.2 shows that they are continuously in the business of selling tea with their trademark which is Bicrampore T.E. (Label showing Hathi Marka Uttam Chai).

24. In finding, the respondent no.2 held that:

> *"1. The Opponent's objections on the grounds of the deceptive similarity cannot be tenable as the combination of the label as reproduced*

herein shows that the representations of the marks are completely different and the subject trademark is described as "BICRAMPORE T.E. (LABEL)", whereas the opponent's mark is "FIVE JUMBO BRAND". This implies that the prominent feature of the subject trademark is "Bicrampore T.E." and not the "Elephant".

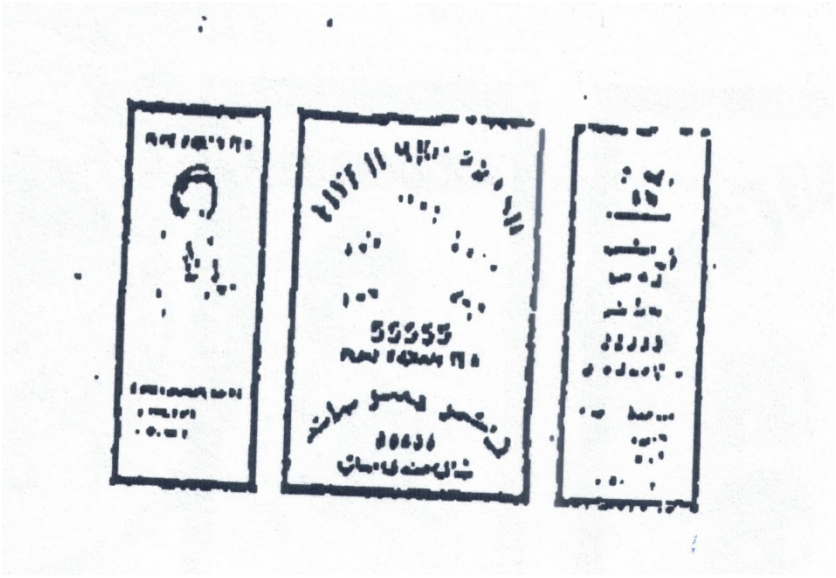
2. The Applicant has pressed that they are primarily selling the tea in bulk and the target consumers of the opponents are different from the applicant. The Opponent has been prior user of the "JUMBO" brand and they have earned an enormous goodwill in respect of their trademark. But the applicant has also been using the same concurrently and the evidences, produced by the applicant shows that they are continuously in the business of selling tea with their trademark which is "BICRAMPORE T.E. (LABEL showing Hathi Marka Uttam Chai)". The application is pending for registration since 2006 and this is a special circumstance, which creates the balance of convenience in favour of the applicant herein. The applicant has never claimed to have used their Hathi Mark as a prominent part of the trademark and the acceptance of the subject application shall not give any exclusive right to the device of the "elephant" which is an inalienable part of their composite label trademark."

The finding of the respondent no.1 is not correct that the Trade Mark of the Respondent no.2 is "Bicrampore T.E. and not the "Elephant". The Trade mark of the respondent no.1 is as follows:



Mark of the appellant are as follows:







In paragraph 2 of the findings of the respondent no.1, it is held that the respondent no.2 is continuously in the business of selling tea with their trade mark which is Bicrampore T.E. (Label showing Hathi Marka Uttam Chai). The findings of the respondent no.1 in paragraph 1 and paragraph 2 are contradictory. Admittedly, the trade mark of the

respondent no.2 “Bicrampore T.E.” having the label of Hathi Marka. The word Hathi means elephant which in turn is another word for JUMBO and that rival labels each had the device of elephant.

25. In the case of ***T.G. Balaji Chettiar (supra),*** the Madras High Court held that parties have to furnish evidences on factual question of user but in the instant case, the respondent no.2 has not produced any evidence to establish that the respondent no. 2 carries the business with the trade mark of HATHI MARKA UTTAM CHAI since 1970.

26. In the case of ***The Gillette Company LLC (supra),*** the Delhi High Court held that since OFFICER’S CHOICE and COLLECTOR’S CHOICE were found to convey the same meaning and deceptively similar, the impact of the differences in trade dress was unlikely to rule out consumer confusion between the two products. In the instant case also the trade mark of the appellant JUMBO and Five Jumbo with device of Elephants and the trade mark of the respondent no.2 Bicrampore T.E. (Lable showing Hathi Marka Uttam Chai) are similar which confuse the mind of the consumers.

27. In the case of ***J.C. Eno Limited (supra),*** the Bombay High Court held that:

> *“I have already pointed out that very many people in India know English as well as different vernacular languages. But even if an Indian does not know English, but knows only some vernacular language, if a trader is permitted to use in that language words which have become associated with the goods of another trader in another language and are distinctive of the goods of that*

> *other trader, he is thereby putting it into the power of unscrupulous dealers to mislead and practise a deception upon the individual knowing only the one language, in that he may thereby be enabled to pass off upon that unsuspecting person goods as and for the goods of the other trader to which those particular words in another language have by long user become attributed."*

In the present case also the appellant and the respondent no.2 both are in same business of manufacture and sale of tea, the class of consumers of both the parties are same. The general consumers simply buy the product looking at the device of the elephant.

28. Considering the above facts, this Court finds that the respondent no.1 has not considered the documents produced by the appellant and has wrongly come to the conclusion that the respondent no.2 is carrying the business of the said trade mark since 1970 though there is no documents on record to support the findings of the respondent no.1. The finding of the respondent no.1 is contrary to the documents available on records.

29. In view of the above, the impugned order dated 22nd July, 2023, passed by the Asst. Manager of Trade Marks is set aside and quashed. The certificate to the registration bearing no. 1411841 in Class 30 is also recalled.

30. **IPDTMA No. 80 of 2023** is **allowed**.

(Krishna Rao, J.)