$~3(Original)

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

\+ C.A.(COMM.IPD-TM) 113/2021

JAINSONS LIGHTS PRIVATE LIMITED ..... Appellant
Through: Mr. Vikram Grover and Mr. Harish K. Chauhan, Advs.

versus

THE REGISTRAR OF TRADE MARKS ..... Respondent
Through: Mr. Harish Vaidyanathan Shankar, CGSC

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

J U D G M E N T (ORAL)

% 22.02.2023

1. Application no. 3487036 was filed by the appellant before the Trade Marks Registry for registration of the Mark JAINSONS LIGHTS SINCE 1978 (hereinafter referred to as "the subject mark") in Class 11, for electric lamps, lighting apparatus and installations, luminaries chandeliers, lamp shades, lamps, led and fluorescent lights, flash lights, lanterns for lighting, lighting fittings and fixtures, decorative lighting, light diffusers, ceiling light, wall lights, outdoor lights, water proof lights, desk lamps, floor lamps, hanging lamps, lighting tubes, light bulbs, security lights, garden lights, mood lighting, display lighting etc. The appellant claimed user of the subject mark since 2014.

2. The Registrar, *vide* First Examination Report (FER) dated 7th March 2017, objected to the registration of the subject mark. In the FER, "M/s JAINSONS LITES" was cited as an earlier trade mark, for

Signature Not Verified
Digitally Signed
By:SUNIL SINGH NEGI
Signing Date:23.02.2023
15:30:55

which Application No. 2242763, submitted by Mr. Rakesh Jain, seeking registration of the mark in Class 11 in respect of "electrical fancy lights, electrical goods, items and instruments", was already in existence with user claim of 2005. The FER objected to the registration of the subject mark on the ground that it was deceptively similar to the earlier mark "M/s JAINSONS LITES".

3. The appellant submitted his response to the FER on 1st May 2017. It was sought to be contended, in the response, that the trade mark "JAINSONS" had been adopted by the predecessor of the appellant in 1978 primarily in respect of lighting goods and was in use since then. The subject mark, it was submitted, was a highly stylised representation of the predominant feature of the trade name of the appellant, which was Jainsons Lights Pvt. Ltd., and also included 1978 as representing the year of adoption of the mark "JAINSONS". Moreover, it was submitted that the subject mark was in a unique colour combination of teal and black, which was specifically claimed while applying for registration of the subject mark. The reply also emphasised the goodwill and reputation that the appellant had gained since 1978.

4. The impugned order dated 27th April 2020 rejected Application No. 3487036 in the following terms:

> "The mark applied for registration is objectionable under following provision of the Trade Marks Act, 1999-
>
> The mark applied for registration is identical with /similar to earlier trademarks on record, as mentioned in the Examination report and by similarity of marks as well as similarity of goods and services covered under such marks, there exists a likelihood of confusion in the mind of public. As such the registration of the mark is objectionable under Section 11(1) of the Trade Marks Act 1999

Signature Not Verified
Digitally Signed
By:SUNIL SINGH NEGI
Signing Date:23.02.2023
15:30:55

ADV. HARISH appeared and argued and submitted that, the cited mark is different, heard, and checked the details of application, it appeared that. Reply perused not satisfactory, Deceptively and phonetically and conceptually similar registered mark no. 12242763 with the identical goods are on record, so it will cause the confusion to the public and in the market, moreover user claim since 2014, and user affidavit submitted along with the evidence in support has proved the user since 2014 which is subsequent to the user of the cited mark, and adv. also fails to establish the significance and uniqueness in the adoption of the trade mark, since the prefix is a common English term, as there is phonetically similarity with the cited mark, hence no difference between cited mark and the applicant mark, so; upon considering the material on record and submissions made by the adv. And applicant is fail to prove the justification for waving off obj. raised under sec. 11 trade Mark Act 1999."

5. With some effort, the court has been able to glean, from the impugned order, the grounds on which the Senior Examiner has rejected the appellant's application as

(i) phonetic similarity between the subject mark and Mark No. 2242763,

(ii) conceptual similarity between the subject mark and Mark No. 2242763,

(iii) the fact that both marks were claimed in respect of identical goods/services.

(iv) the possibility, therefore, of confusion to the public were both marks to be registered,

(v) the user claim of the appellant, of 2014, being subsequent to user claim of Mr. Rakesh Jain in respect of Mark No. 2242763, which was 2005, and

(vi) lack of significance and uniqueness in the subject mark, as "lights" was a common English term.

6. Of these findings, no cavil, in the opinion of the court, can be taken with the findings no. (i), (iii), (iv) and (v).

Signature Not Verified
Digitally Signed
By:SUNIL SINGH NEGI
Signing Date:23.02.2023
15:30:55

7. The court is in agreement with the Senior Examiner in her observation that

(i) the subject mark was phonetically identical to Mark No. 2242763 as the subject mark was "Jainsons Lights" and Mark No. 2242763 was "M/s Jainsons Lites",

(ii) the registration of the marks were sought in respect of identical goods, i.e. electrical lamps, lights, electrical goods and fittings etc. and

(iii) the claim of user, by the appellant, was subsequent to the claim of user of Rakesh Jain in respect of Mark no. 2242763.

8. The court is also in agreement with the finding of the Senior Examiner that permitting registration of both the marks is likely to result in confusion. Section 11(1)(b)[1] of the Trade Marks Act proscribes registration of a trade mark if, owing to its similarity to an earlier trade mark, and the identity of similarity of the goods or services covered by the two marks, a likelihood of confusion on the part of the public can be said to exist.

9. There can be no gainsaying the fact that the mark "Jainsons Lights" is similar to the mark "Jainsons Lites". Both marks were used in respect of similar goods and services.

[1] **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.

Signature Not Verified
Digitally Signed
By:SUNIL SINGH NEGI
Signing Date:23.02.2023
15:30:55

10. Mr. Grover has sought to contend that the Senior Examiner as erred to note (i) the unique stylised nature of the subject mark, which distinguished it from the "Jainsons Lites" mark of Rakesh Jain and (ii) the inclusion, in the subject mark, of the phrase "since 1978" which was essentially intended to indicate tht the mark "Jainsons", which was the prominent part of the subject mark, had been in use since 1978.

11. As already noted, the aspect of likelihood of confusion, for the purposes of Section 11(1)(b) has to be examined from the point of view of "the public", as the clause refers to "likelihood of confusion on the part of the public". Insofar as the aspect of confusion, in the matter of trade marks is concerned, it is settled that the test has to apply from the point of view of a customer of average intelligence and imperfect recollection. Viewed from the perspective of such a customer, the court cannot characterise the finding, of the Senior Examiner, that there is a likelihood of confusion between the subject mark "Jainsons Lights" and the earlier mark "Jainsons Lites" as arbitrary, or otherwise deserving of interference in appeal, especially as both the marks were being used in respect of identical goods. The unwary customer of average intelligence and imperfect recollection cannot be attributed the perspicacity to be able to recollect that, in one case, "lights" was spelt "Lites" and, in the other, "Lights". Nor can the mere inclusion, in the subject mark, of the words "since 1978", or of the word "M/s" in Mark No. 2242763, be regarded as factors which would mitigate the possibility of such confusion arising in the minds of the customer of average intelligence and imperfect recollection as these are elements of a mark which may change from time to time.

Signature Not Verified
Digitally Signed
By:SUNIL SINGH NEGI
Signing Date:23.02.2023
15:30:55

12. Besides, in the JAINSONS LIGHTS SINCE 1978, the dominant impression that the average customer, who views the mark without prior familiarity with it, would carry with him, is of "JAINSONS LIGHTS", rather than of "since 1978". An average consumer, realistically speaking, would identify the appellant from its name "JAINSONS LIGHTS", rather than from the year from which it had started using the mark "JAINSONS". This reality is apparent from the mark itself, in which the "since 1978" slogan is in disproportionately small letters, as compared to "JAINSONS LIGHTS". If the mythical customer of imperfect recollection were to to be asked to recollect the mark, he would recollect it as "JAINSONS LIGHTS", not as "JAINSONS LIGHTS SINCE 1978". Equally, he would recollect Mark No. 2242763 as "JAINSONS LITES", not as "M/s JAINSONS LITES".

13. The Senior Examiner is also correct in her observation that "lights" – whether spelt "lights" or "lites" – is an ordinary English word. Perhaps it would be more appropriate to hold that the dominant part, whether of "JAINSONS LIGHTS" or "JAINSONS LITES", is "JAINSONS". That dominant part, in the two marks, is identical, thereby exacerbating the chance of confusion.

14. Mr. Grover has also sought to press into service Sections 12[2] and 34[3] of the Trade Marks Act.

---

[2] **12. Registration in the case of honest concurrent use, etc**. – In the case of honest concurrent use or of other special circumstances which in the opinion of the Registrar, make it proper so to do, he may permit the registration by more than one proprietor of the trade marks which are identical or similar (whether any such trade mark is already registered or not) in respect of the same or similar goods or services, subject to such conditions and limitations, if any, as the Registrar may think fit to impose.

[3] **34. Saving for vested rights. –** Nothing in this Act shall entitle the proprietor or a registered user of registered trade mark to interfere with or restrain the use by any person of a trade mark identical with or nearly resembling it in relation to goods or services in relation to which that person or a predecessor in title of his has continuously used that trade mark from a date prior –

Signature Not Verified
Digitally Signed
By:SUNIL SINGH NEGI
Signing Date:23.02.2023
15:30:55

15. I am, unfortunately, unable to accept his submission that either of these provisions would serve to vitiate the impugned order. Section 12 permits the Registrar, in an appropriate case, to allow registration of a mark which is identical, or similar to an earlier trade mark, where the case is one of "honest concurrent use", or where there are "other special circumstances".

16. Mr. Grover seeks to submit that the present case has to be regarded as one involving "other special circumstances", the "special circumstance" being that the "Jainsons" mark had been in use by his client since 1978. For this purpose, Mr. Grover seeks to submit that Section 12 may be read in conjunction with Section 34 of the Trade Marks Act.

17. Section 34 of the Trade Marks Act allows the Registrar to register a trade mark which is identical with or nearly resembling an earlier trade mark, in respect of identical goods or services, *provided the user of the former is prior in point of time both to registration and user of the latter*.

18. This defence obviously, cannot come to the aid of the appellant, as the claim of user of the appellant, in respect of the subject trade mark, is of 2014, whereas the user claim of Rakesh Jain in respect of Mark No. 2242763 is of 2005. Though Mr Grover emphasizes that the mark "JAINSONS" was being used since 1978, that is irrelevant. The court, while applying Section 34, has to take into account the

---

(a) to the use of the first-mentioned trade mark in relation to those goods or services be the proprietor or a predecessor in title of his; or

(b) to the date of registration of the first-mentioned trade mark in respect of those goods or services in the name of the proprietor of a predecessor in title of his;

whichever is the earlier, and the Registrar shall not refuse (on such use being proved) to register the second mentioned trade mark by reason only of the registration of the first-mentioned trade mark.

Signature Not Verified
Digitally Signed
By:SUNIL SINGH NEGI
Signing Date:23.02.2023
15:30:55

claim of user in respect of the subject mark which, in the present case, is "JAINSONS LIGHTS SINCE 1978". "Since 1978" is only a *part* of the complete JAINSONS LIGHTS SINCE 1978 mark, and user, in respect of the complete mark, is claimed, by the appellant itself, since 2014.

19. Inasmuch as the appellant itself has claimed user, while applying for subject mark, of 2014, it cannot claim prior user over Rakesh Jain, so as to entitle it to the benefit of Section 34 of the Trade Marks Act.

20. For the aforesaid reasons, I do not find that a case for interference with impugned order dated 27th April 2020 can be said to exist.

21. The appeal is accordingly dismissed.

C. HARI SHANKAR, J.

FEBRUARY 22, 2023
dsn

Signature Not Verified
Digitally Signed
By:SUNIL SINGH NEGI
Signing Date:23.02.2023
15:30:55