LAL BABU PRIYADARSHI

v.

AMRITPAL SINGH

(Civil Appeal No. 2138 of 2006)

October 27, 2015

[RANJAN GOGOI AND R.K. AGRAWAL, JJ.]

Trade Marks Act, 1999 – s. 9(2) – Registration of trade mark – Refusal of – Application for registration of word 'RAMAYAN' with the device of crown in respect of incense sticks (agarbatties) and perfumeries etc. by appellant – Opposition application by respondent, dismissed by the Assistant Registrar of Trade Mark – However, appeal by the respondent allowed by the appellate Board – On appeal, held: There is no irregularity in the order passed by the Board – No person can claim the name of a holy or religious book as a trade mark for his goods or services marketed by him – Appellant did not establish that the word "RAMAYAN" for which he has applied the trade mark had acquired a reputation of user in the market since many traders were using the word "RAMAYAN" as a mark for the similar products – Also, respondent was using the artistic mark earlier in point of time to that of the appellant.

Dismissing the appeal, the Court

HELD: 1.1 There are many holy and religious books like Quran, Bible, Guru Granth Sahib, Ramayan etc., to name a few. No person can claim the name of a holy or religious book as a trade mark for his goods or services marketed by him. Moreover, the appellant has not been able to establish that the word "RAMAYAN" for which he has applied the trade mark had acquired a reputation of user in the market inasmuch as, there are more than 20 traders in the city using the word "RAMAYAN" as a mark

A **for the similar products and also in different parts of the country. [Para 18, 19] [1020-G-H; 1021-A-B]**

1.2 On a perusal of the artistic work said to have been created, there is no doubt that both the marks are identical in design, colour, scheme and the reproduction of photographs is in such a manner that an ordinary buyer would reasonably come to a mistaken conclusion that the article covered by one brand can be the article covered by the other. Both the parties have claimed to be manufacturing units engaged in certain goods. Further, the respondent claimed that though he had been in the business since 1980, he had developed and published the artistic work in 1986 and has also been using the mark as a trademark and claiming use since 1986 whereas the appellant claimed use of the trademark since 1987. However, by filing an application, the appellant has claimed the use since 1981. From the facts, it is clear that the respondent was using the artistic mark earlier in point of time to that of the appellant. There is no irregularity in the order passed by the Board while setting aside the order passed by the Assistant Registrar of Trade Marks that the trade mark consists of device of crown and the word "RAMAYAN" is capable of distinguishing the goods and is not included in the list of marks not registrable under the Act, dismissed the application filed by the respondent. [Para 2, 20, 21, 22] [1012-E-F; 1021-C-E, F-H]

Registrar of Trade Marks vs. Ashok Chandra Rakhit **AIR 1955 SC 558:1955 SCR 252;** *Mumbai International Airport Private Limited vs. Golden Chariot Airport and Another* **(2010) 10 SCC 422: 2010 (12) SCR 326 ;** *K.R. Chinna Krishna Chettiar vs. Sri Ambal & Co.* **AIR 1970 SC 146: 1970 (1) SCR 290 ;** *Corn Products Refining*

Co. vs. Shangrila Food Products Ltd. **1960 (1) SCR 968;** *National Bell Co. vs. Metal Goods Mfg. Co. (P) Ltd. and Another* **1970 (3) SCC 665:1971 (1) SCR 70 – referred to.**

Case Law Reference

1955 SCR 252	**referred to.**	**Para 6**
2010 (12) SCR 326	**referred to.**	**Para 7**
1970 (1) SCR 290	**referred to.**	**Para 7**
1960 (1) SCR 968	**referred to.**	**Para 8**
1971 (1) SCR 70	**referred to.**	**Para 10**

CIVIL APPELLATE JURISDICTION: Civil Appeal No. 2138 of 2006.

From the Judgment and Order dated 10.01.2005 of the intellectual Property Appellate Board at Circuit Bench at Kolkata in Original Appeal No. 35/2004/TM/KOL.

Anuradha Salhotra, K. V. Mohan, Sumit Wadhwa, Advs., for the Appellant.

Sudhir Chandra, Sr. Adv., Sohan Singh, Bindra Rana, Priya Adlakha, M/s. S. S. Rana & Co., Advs., for the Respondent.

The Judgment of the Court was delivered by

R.K. AGRAWAL, J. 1) The present appeal has been filed against the order dated 10.01.2005 passed by the Intellectual Property Appellate Board (in short 'the Board') in Original Appeal No. 35/2004/TM/KOL whereby the Board allowed the appeal filed by the respondent herein while setting aside the order dated 31.03.2004 passed by the Assistant Registrar of Trade Marks.

2) **Brief facts:**

A (a) One Shri Lal Babu Priyadarshi-the appellant herein, trading as M/s Om Perfumery, Bakerganj, Daldali Road, Patna made an application to the Registrar of Trade Marks to register a trade mark by name "RAMAYAN" with the device of crown in class 3 in respect of incense sticks (agarbattis, dhoops) and B perfumeries etc.

(b) One Shri Amritpal Singh-the respondent herein, was a dealer for the sale of the products of the appellant herein and was also trading as M/s Badshah Industries, Chitkohra, Punjabi C Colony, Patna. The respondent herein filed a Notice of Opposition to oppose the registration of aforesaid trade mark under Sections 9, 11(a), 11(b), 11(e), 12(1), 12(3) and 18(1) of the Trade and Merchandise Marks Act, 1958 [repealed by the Trade Marks Act, 1999 (47 of 1999)-in short 'the Act'] D claiming that the impugned mark, being the name of a religious book, cannot become the subject matter of monopoly for an individual.

(c) The Assistant Registrar of Trade Marks, after holding E that the impugned trade mark consists of device of crown and the word "RAMAYAN" is capable of distinguishing the goods and is not included in the list of marks not registrable under the Act, by order dated 31.03.2004, dismissed the application filed by the respondent herein.

F (d) Being aggrieved by the order dated 31.03.2004, the respondent herein preferred an appeal before the Board being Original Appeal No. 35/2004/TM/KOL. The Board, by order dated 10.01.2005, set aside the order dated 31.03.2004, G passed by the Assistant Registrar of Trade Marks.

(e) Aggrieved by the order dated 10.01.2005, the appellant has filed this appeal by way of special leave.

3) Heard Ms. Anuradha Salhotra, learned counsel for the H appellant and Mr. Sudhir Chandra, learned senior counsel for the respondent.

4) The sole question for consideration before this Court is whether the registration of the word "RAMAYAN" as a trade mark, being the name of a Holy Book of Hindus, is prohibited under Section 9(2) of the Trade Marks Act, 1999?

Rival submissions:

5) Learned counsel for the appellant submitted that the appellant was in the business of manufacturing, trading and marketing of incense sticks since 1981 and the respondent herein was a dealer of the appellant herein. The goods under the trade mark "RAMAYAN" have been advertised by him through various means including the publication of cautionary notices in newspapers. Learned counsel further submitted that through extensive use, wide advertisement and the excellent quality of the products, the trademark "RAMAYAN" and the carton in which the products are sold has become distinctive in such a manner that use of the same or similar trademark or carton by any other person will cause confusion and deception in the trade and amongst the public. The sale was done through a network of dealers and distributors and the respondent herein was a dealer of the appellant herein. Learned counsel submitted that after the termination of dealership, the respondent herein started selling incense sticks under the trade mark "RAMAYAN" written in the same style and manner.

6) Learned counsel further contended that the mere fact that the trade mark, being the name of a religious book, cannot be a sufficient ground for refusal of registration under Section 9(2) of the Act and is not based on evidence on record that the feelings of any section of the Hindus having been hurt by its use in relation to incense sticks. She further submitted that the Assistant Registrar of Trade Marks rightly held that the impugned trade mark consists of device of crown and the word is capable of distinguishing the goods of the appellant herein and the trade mark is not included in the list of marks not registrable under the Act. She further claimed that it has already

A been proved before the Court of Assistant Registrar that the appellant was using the trade mark since 1981 and hence, is the prior user in comparison to the respondent. According to the learned counsel, the Board, totally misconstrued the observations of the Standing Committee in the Eighth Report
B on the Trade Marks Bill, 1993. Relying upon Clause 13.3 of the said report, it was submitted that even though the Committee had observed that "any symbol relating to religious gods, goddesses, places of worship should not ordinarily be
C registered as a trade mark", it specifically refrained from prohibiting registration of such marks. It was further submitted that the Board has erroneously relied upon the decision of this Court in ***Registrar of Trade Marks*** vs. ***Ashok Chandra Rakhit*** AIR 1955 SC 558 by proceeding on the basis that the
D said case was an authority on the question that all religious names or symbols are prohibited from being registered whereas the fact of the matter is that this Court had merely upheld the concurrent findings of the Registrar and the High Court that the word 'SHREE' was incapable of distinguishing
E the goods of any one trader. The said case is also distinguishable by the fact that it was the invariable practice of the trade mark office not to register the word 'SHREE' but this is not so with the word "RAMAYAN".

F 7) Relying upon a decision of this Court in ***Mumbai International Airport Private Limited*** vs. ***Golden Chariot Airport and Another*** (2010) 10 SCC 422, it is further submitted that the respondent herein had himself claimed the use of the identical mark and therefore, it did not lie in his mouth
G to object to the registration of the word in the name of the appellant. She further contended that the Board ought to have seen that there are several cases which indicate that the use of the names of Hindu deities as trade mark is a common practice and no one has complained about the same being
H sensitive to Hindu religious sentiments for which reliance was

placed on a decision of this Court in ***K.R. Chinna Krishna Chettiar*** vs. ***Sri Ambal & Co.*** AIR 1970 SC 146. A

8) Learned counsel also placed reliance on ***Corn Products Refining Co.*** vs. ***Shangrila Food Products Ltd.*** 1960 (1) SCR 968 in support of the submission that before the applicant can seek to derive assistance for the success of his application from the presence of a number of marks having one or more common features which occur in his mark also, he has to prove that those marks had acquired a reputation by user in the market. B C

9) Learned counsel finally contended that the Board erred in law while setting aside the judgment of the Assistant Registrar of Trade Marks while holding adversely about its distinctiveness, the mark causing deception and not having been used in an honest manner. D

10) Learned senior counsel for the respondent contended that the impugned mark, being name of a religious book, cannot become the subject matter of monopoly for an individual. He further contended that the mark "RAMAYAN" is not a distinctive mark and is devoid of any distinctive character. The mark is not capable of distinguishing the goods of one person from those of another. It was also contended that the mark "RAMAYAN" is not registrable since it is the name of a famous and well known religious book. It was also claimed that more than 20 traders in Patna and many more are using the trade mark and thus it has become public *juris*. In support of the same, learned senior counsel placed reliance upon a decision of this Court in ***National Bell Co.*** vs. ***Metal Goods Mfg. Co. (P) Ltd. and Another*** 1970 (3) SCC 665. He further submitted that the impugned mark is identical with the respondent's mark "BADSHAH RAMAYAN" which is pending registration and the impugned registration will cause harassment to other traders and purchasing public would be bound to be confused and deceived. Learned senior counsel finally claimed that the Board E F G H

A was right in setting aside the order dated 31.03.2004 passed by the Assistant Registrar of Trade Marks.

11) We have carefully gone through the relevant documents and perused the material on record.

B **Discussion:**

12) The appellant herein filed an application dated 25.08.1994 being No. 638073-B in class 3 for registration of a trade mark consisting of the word "RAMAYAN" with the C device of crown in respect of incense sticks (agarbatties) and perfumeries etc. The appellant herein claimed the user since 01.01.1987. He further filed a request to rectify the user from 01.01.1981 which was allowed by the Assistant Registrar of Trade Marks. While opposing the application in class 3 for D registration of the trade mark, the respondent herein filed a notice of opposition under Sections 9, 11(a), 11(b), 11(e), 12(1) and 18(1) of the Act. He claimed the use of the trade mark "BADSHAH RAMAYAN" prior to the appellant herein. The respondent herein put forth an objection that the impugned E mark, being name of a religious book, cannot become the subject matter of monopoly for an individual. He further added that his application for the registration of the same trade mark claiming user since 05.11.1986 is pending for registration. The application was further opposed with the reasoning that it F carries a large sentimental value for the people and therefore, no one can claim sole right to the use of such a word. It was also admitted by the respondent herein that more than 20 traders in Patna are using the trade mark "RAMAYAN". Finally, G it was submitted that the impugned mark is identical with the respondent's mark "BADSHAH RAMAYAN" which is pending registration and the impugned registration will cause confusion among general public. Though the Assistant Registrar of Trade Marks dismissed the application filed by the respondent herein, H the Board set aside the said order after holding that the trade mark "RAMAYAN" is not distinctive of the goods of the appellant

as it is being used as a mark for the same products by more than 20 traders in Patna and in different parts of the country and has become public *juris* and common to the trade. A

13) In view of the above, it is relevant to mention Section 9 of the Act which reads as under:- B

"9. Absolute grounds for refusal of registration – (1) The trade marks –

(a) which are devoid of any distinctive character, that is to say, not capable of distinguishing the goods or services of one person from those of another person; C

(b) which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, geographical origin or the time of production of the goods or rendering of the service or other characteristics of the goods or service; D

(c) which consist exclusively of marks or indications which have become customary in the current language or in the bona fide and established practices of the trade, E

shall not be registered:

Provided that a trade mark shall not be refused registration if before the date of application for registration it has acquired a distinctive character as a result of the use made of it or is a well-known trade mark. F

(2) A mark shall not be registered as a trade mark if – G

(a) it is of such nature as to deceive the public or cause confusion;

(b) it contains or comprises of any matter likely to hurt the religious susceptibilities of any class or section of the citizens of India; H

A (c) it comprises or contains scandalous or obscene matter;

(d) its use is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1950 (12 of 1950).

B

(3) A mark shall not be registered as a trade mark if it consists exclusively of –

(a) the shape of goods which results from the nature of the goods themselves; or

C

(b) the shape of goods which is necessary to obtain a technical result; or

(c) the shape which gives substantial value to the goods.

D

Explanation. – For the purposes of this section, the nature of goods or services in relation to which the trade mark is used or proposed to be used shall not be a ground for refusal of registration."

E

This section stipulates that the trade marks which are devoid of any distinctive character or which consist exclusively of marks or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, values, F geographical origin or the time of production of goods or rendering of the services or other characteristics of the goods or service or which consist exclusively of marks or indications which have become customary in the current language or in the bona fide and established practice of the trade shall not G be registered, unless it is shown that the mark has in fact acquired a distinctive character as a result of use before the date of application. It also provides that a mark shall not be registered as trade marks if (i) it deceives the public or causes confusion, (ii) it contains or comprises of any matter likely to H hurt the religious susceptibilities, (iii) it contains scandalous

or obscene matter, (iv) its use is prohibited. It further provides that if a mark consists exclusively of (a) the shape of goods which form the nature of goods themselves, or (b) the shape of goods which is necessary to obtain a technical result, or (c) the shape which gives substantial value of the goods then it shall not be registered as trade mark. A B

14) From Clause 13.3 of the Eighth Report on the Trade Marks Bill, 1993 submitted by the Parliamentary Standing Committee, we find that the Committee expressed its opinion that any symbol relating to Gods, Goddesses, places of worship should not ordinarily be registered as a trade mark. However, the Committee did not want to disturb the existing trade marks by prohibiting their registration as it will result in a chaos in the market. At the same time, the Committee trusted that Government will initiate appropriate action if someone complaints that a particular trade mark is hurting his religious susceptibilities. This report was presented on 21.04.1994. When the report was presented, the appellant's trade mark had not been registered and the application filed by the respondent herein opposing its registration was dismissed only on 31.03.2004 by the Assistant Registrar of Trade Marks. C D E

15) The word "RAMAYAN" represents the title of a book written by Maharishi Valmiki and is considered to be a religious book of the Hindus in our country. Thus, using exclusive name of the book "RAMAYAN", for getting it registered as a trade mark for any commodity could not be permissible under the Act. If any other word is added as suffix or prefix to the word "RAMAYAN" and the alphabets or design or length of the words are same as of the word "RAMAYAN" then the word "RAMAYAN" may lose its significance as a religious book and it may be considered for registration as a trade mark. However, in the present case, we find that the appellant had applied for registration of the word "RAMAYAN" as a trade mark. We also find that in the photographs, after adding "OM's" F G H

A to the word "RAMAYAN", at the top and in between "OM's and RAMAYAN", the sentence, "Three Top Class Aromatic Fragrance", is also written. Thus, it is not a case that the appellant is seeking the registration of the word "OM's RAMAYAN" as a trade mark. Further, from the photographs, B we find that the photographs of Lord Rama, Sita and Lakshman are also shown in the label which is a clear indication that the appellant is taking advantage of the Gods and Goddesses which is otherwise not permitted.

C 16) ***In National Bell Co. (supra)***, this Court has held that the distinctiveness of the trade mark in relation to the goods of a registered proprietor of such a trade mark may be lost in a variety of ways e.g. by the goods not being capable of being distinguished as the goods of such a proprietor or by extensive D piracy so that the marks become public *juris*. The principle underlying clause (*c*) of Section 32 is that the property in a trade mark exists so long as it continues to be distinctive of the goods of the registered proprietor in the eyes of the public or a section of the public. If the proprietor is not in a position to E use the mark to distinguish his goods from those of others or has abandoned it or the mark has become so common in the market that it has ceased to connect him with his goods, there would hardly be any justification in retaining it on the register.

F 17) It has also come on record that the word "RAMAYAN" is being used as a mark for the similar products by more than 20 traders in Patna and in different parts of the country, and therefore, it has become public *juris* and common to the trade.

G **Conclusion:**

18) There are many holy and religious books like Quran, Bible, Guru Granth Sahib, Ramayan etc., to name a few. The answer to the question as to whether any person can claim the name of a holy or religious book as a trade mark for his goods H or services marketed by him is clearly 'NO'.

19) Moreover, the appellant has not been able to establish that the word "RAMAYAN" for which he has applied the trade mark had acquired a reputation of user in the market inasmuch as, we find that there are more than 20 traders in the city using the word "RAMAYAN" as a mark for the similar products and also in different parts of the country.

20) On a perusal of the artistic work said to have been created, there is no doubt that both the marks are identical in design, colour, scheme and the reproduction of photographs is in such a manner that an ordinary buyer would reasonably come to a mistaken conclusion that the article covered by one brand can be the article covered by the other. Both the parties have claimed to be manufacturing units engaged in certain goods.

21) Further, the respondent herein claimed that though he had been in the business since 1980, he had developed and published the artistic work in 1986 and has also been using the mark as a trademark and claiming use since 1986 whereas the appellant herein claimed use of the trademark since 1987. However, by filing an application to the concerned authority, the appellant has claimed the use since 1981. Further, in various pleadings in the Title Suits filed by the respondent herein, the appellant herein has admitted the use and publication of the artistic mark of the respondent before the date of claim of the first use by the appellant, that is, 1987. From these facts, it is clear that the respondent herein was using the artistic mark earlier in point of time to that of the appellant herein.

22) In view of the foregoing discussion, we do not find any irregularity in the order passed by the Board dated 10.01.2005, consequently, the appeal fails and is accordingly dismissed. However, the parties are left to bear their own costs.

Nidhi Jain Appeal dismissed.