



## Intellectual Property Appellate Board

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ORA/68/2013/TM/AMD

WEDNESDAY, THIS THE 23<sup>RD</sup> DAY OF DECEMBER, 2020

HON'BLE SHRI JUSTICE MANMOHAN SINGH : CHAIRMAN  
HON'BLE MS LAKSHMIDEVI SOMANATH : TECHNICAL MEMBER (TRADE MARKS)  
HON'BLE MR. MAKYAM VIJAY KUMAR : TECHNICAL MEMBER (TRADE MARKS)

**BRITANNIA INDUSTRIES LTD.**

5/1A, Hungerford Street,  
Calcutta - 700 017

.....APPLICANT

(Represented by: Mr.Manish Kumar)

**Versus**

**RAKESH KUMAR JAIN, VIJAYKUMAR JAIN,**

Trading as RAKESHKUMAR MAHESHKUMAR,  
11, 12, Sahil Apartment,  
PlotNo.17,18,Sector — 9,  
Post Box No. 233, Gandhidham, Kutch, Gujarat.

.....RESPONDENT NO.1

**THE REGISTRAR OF TRADEMARKS**

Office of the Trade Marks Registry, National Chambers,  
15/27, 1st Floor, Ashram Road,  
Ahmedabad - 380009

.....RESPONDENT NO.2

(Represented by: Mr. Kamal V. Verma for R1)

**ORDER**

**Hon'ble Ms. Lakshmidevi Somanath, Technical Member (Trade Marks)**

1. The Rectification Application is filed under Section 57 of Trademark Act, 1999 for Removal of the Registration No. 1424212 for the mark "GOOD DAY" label in Class 30 in the name of Respondent No.1. The application for the impugned registration has been filed on 24<sup>th</sup> February 2006 claiming use since 01/04/2005 and the sealing date for the registration certificate is 23<sup>rd</sup> August 2008.

2. There is no representation on behalf of the Respondents at this and on the last few hearings.

3. The details of the Impugned registered Trade Mark are :

Trade Mark No	:	1424212
Class	:	30
Trade Mark	:	GOOD DAY (label)
Date of Application	:	28/02/2006
First Date of Use	:	01/04/2005
Date of Advertisement	:	16/03/2008
Date of Registration	:	23/08/2008
Valid Till	:	18/10/2022
Goods	:	Salt

#### FACTS OF THE CASE

4. On merit, the facts are as follows:

#### **About the Applicant**

5. The Applicant for Rectification herein,

BRITANNIA INDUSTRIES LIMITED, is a highly reputed public limited company in India incorporated in the year 1918 under the Indian Companies Act, 1913. It is engaged in the business of manufacturing and marketing food products like biscuits, breads, cakes, rusks, dairy products and other related goods. The Applicant-company manufactures and markets its products under its immensely well-known and registered house mark "BRITANNIA."

## About the Applicant's Trademarks

6. The Applicant has coined and/or conceived of and adopted a number of trade marks such as MARIEGOLD, MILK BIKIS, NICE, TIGER, GOOD DAY, LITTLE HEARTS, BOURBON, NUTRICHoice, SNAX, PURE MAGIC, 50-56, MASKA CHASKA, etc. for Applicant's various individual products/range of products, which are used along with its house mark 'BRITANNIA'. These brand names/product marks along with their house mark 'BRITANNIA' enjoy immense popularity and widespread recognition in the mind of the public and are household names in India. One such mark is GOOD DAY, which was arbitrarily and fancifully adopted in 1986 by the Applicant and soon went on to become one of the Applicant's most popular brands. The Applicant has been using the said trade mark GOOD DAY at least since 1986 in respect of its goods on a wide scale. Subsequently, the Applicant also conceived of and adopted other variants of the trademark GOOD DAY by adding other words, features, devices, elements, etc. in respect of its goods.
7. Owing to the superior quality of the Applicant's products, the Applicant's said GOOD DAY trademarks have acquired tremendous reputation and goodwill. Further, through extensive and continuous use, including wide publicity and promotion of the Applicant's goods bearing the GOOD DAY trademarks worldwide, the Applicant's said trademarks have acquired factual distinctiveness and have become inextricably linked with the Applicant- company in respect of the said goods.
8. In order to accord statutory protection to its mark, the Applicant has applied for and obtained registrations of the trademark GOOD DAY and its variants in various classes, the earliest registration being in 1986. The mark GOOD DAY is inextricably associated with the Applicant.

## The facts of the Applicant's case against the Respondent No.1

9. The Applicant submitted that it came across the Respondent No.1' trademark application No.1918598 filed on 8<sup>th</sup> February 2010 for 'GOOD DAY' in *Devanagari* script in Class 30 in respect of "*Sall*", which advertised in Trade Marks Journal No.1507 dated 24<sup>th</sup> October, 2011. The Applicant had filed an opposition against the Respondent No.1' said application, which is currently pending before the Learned Registrar of Trademarks, Ahmedabad, under Opposition No.786987. The said trademark application was associated with the Respondent No.1' impugned registered mark GOOD DAY (label) under Registration No.1424212 in Class 30 and use thereof was claimed from 01/01/2007. The Applicant, through its attorneys, sent a cease and desist letter on 9<sup>th</sup> February 2012 asking the Respondent No.1 *inter alia* to cease and desist from any and all use of the disputed "Good Day" mark, withdraw their trademark application No.1918598 and apply for voluntary cancellation of Registration No.1424212. The Respondent No.1, vide their attorneys' letter dated 27<sup>th</sup> February 2012, refused to comply with the Applicant's legitimate demands.
10. The Applicant submitted that aggrieved by the continued presence of the impugned registered mark on the register, and to protect its exclusive rights to the well-known mark GOOD DAY, the Applicant was compelled to file the subject rectification application on 2 January, 2013. The Applicant received a copy of the Counter Statement filed by the Registered Proprietor/1<sup>st</sup> Respondent on 24<sup>th</sup> June, 2013. Thereafter, the Applicant filed its reply to the Counter Statement on 21<sup>st</sup> August, 2013.
11. The Applicant submitted that the 1<sup>st</sup> Respondent must have been fully aware of the reputation and goodwill attached to the Applicant's GOOD DAY trademarks, when the 1<sup>st</sup> Respondent, in 2006, adopted the impugned label mark comprising the identical expression GOOD DAY as the dominant and distinguishing part of the mark. The very adoption of the

impugned registered mark and applicationthereforebythe1<sup>st</sup> Respondentwastainted with dishonesty. TheApplicantistheprioradopter, user and registered proprietor of the markGOODDAYinrespectofthegoodsinClass30.The Applicant therefore submitted that theRespondent No.1couldnot,andevennow,cannotclaimproprietorship to theimpugnedmark undersection18of the TradeMarksAct,1999 and therefore, the impugned registration is contrarytotheprovisionofSection18oftheAct.

12. The Applicant submitted that the impugned label mark contains the expression GOOD DAY, which is identical to the Applicant's prior adopted, registered and well-known trademarkGOOD DAY. The goods under the impugned registration are covered by theApplicant's various registered GOOD DAY trademarks and are similar to and/orof the same description as the Applicant's goods bearing its various GOOD DAYmarks, fall in the same class and share the same trade channels and saleoutletsandthesameultimateconsumers.Thereexistsalikelihoodofconfusion on the part of the public, including the likelihood of association with Applicant's earlier registered and well known trademark.The Applicant submitted that the impugned registeredtrademark,therefore,standsinvioation of Sections 11(1), 11(2) and11 {3)oftheAct.

13. Applicant submitted that its mark GOOD DAY is well known and the said trademark inextricablyassociatedwith Applicant's companyalone and entitledto protectionby law againstidenticaland/ordeceptivelysimilar trade marks. The Respondent No. 1werefullyawareofthereputationandgoodwillattachedto Applicant's markGOOD DAYwhen they dishonestly adopted the identical expression as their mark andapplied for registration thereof. The Respondent No.1 had not come

with clean hands in seeking registration of the impugned mark and as such, the application ought to be regarded as having been made in "bad faith". The impugned registered mark is liable to be canceled under the provisions of Section 11(10) of the Act.

14. The Applicant submitted that the impugned registered mark was filed with claim of use since "01/06/2005", which claim appears to be false and is denied and disputed. In any case, it is submitted that since the very adoption of the impugned mark by the Respondent No.1 is tainted with dishonesty, no amount of use thereof by the Respondent No.1 can inure to their benefit. Therefore, the Respondent No.1 are not entitled to claim any rights to registration under Section 12 of the Act.

15. The Applicant submitted that the impugned registration was obtained through false and misleading statements on the part of the Respondent No.1. Therefore, the legal validity of the trademark being vitiated, the impugned registered trademark is an entry wrongly remaining on the register, without any benefit to the public; on the other hand, the impugned registration is contrary to public interest, and hence the mark is liable to be expunged under Section 57 of the Act.

16. The Applicant submitted that the Respondent No.1 had applied for the registered mark, knowing fully well that the Applicant is the proprietor of the mark GOOD DAY in respect of goods in Class 30 and being fully aware of the reputation and goodwill attached to the Applicant's well known mark GOOD DAY. The Respondent No.1 have obtained registration of the trademark solely to derive unlawful commercial gains at the cost of the Applicant-company. The existence on the Register of an identical trademark in the name of a different entity is detrimental to

Applicant's business interests. The Respondent No.1 are deliberately feigning ignorance of Applicant's GOOD DAY marks and also of the reputation and goodwill attached thereto. The dominant feature of the impugned registered mark is the verbal element "GOOD DAY", the speaking portion of the mark, which is identical to Applicant's well known mark/s. Respondent No.1 have clearly adopted the impugned label mark comprising the identical verbal element "GOOD DAY" in an attempt to sail close to Applicant's well known GOOD DAY marks; and therefore, the adoption is prima facie dishonest. The use of the impugned mark by the Respondent No.1 is bound to lead or must have already led to confusion and/or deception in the minds of the public and members of the trade that the Respondent No.1' goods bearing the impugned mark either originate from us or have been manufactured/sold in association or under some kind of a collaboration with the Applicant.

#### **Judicial Decisions relied on by the Applicant**

17. *MilmetOfibo Industries & Others vs Allergan Inc. (Supreme Court decision dated May 7, 2004)*  
*Appeal (Civil) 5791 of 1998* - The Supreme Court held that the ultimate test is who is first in the market. The mere fact that the mark has not been used in India would be irrelevant if they were first in the world market. The goods nowadays are widely advertised in newspapers, periodicals, magazines and other media which is available in the country. This results in a product acquiring a worldwide reputation. Thus, if a mark is associated worldwide it would lead to an anomalous situation if products bearing identical mark are allowed to be sold in India.
  
18. *Century Continuous Stationery P. Ltd. v RadheyShyam Gupta 1998 PTC 553 (Punjab & Haryana High Court decision dated July 9, 1998)* - In this case, the CENTURY mark was highlighted by both parties. The Punjab & Haryana High Court restrained the defendants from using CENTURY even though the defendant was using the said

trade mark with the word SWAROOP and contained the trading name 'Century Continuous Stationery Pvt. Ltd'. The Court held that the defendant has no right to use the trade mark CENTURY even by adding certain words or using the wrapper in different colours. The Applicant referred to paragraphs 32 and 56 of this judgment.

19. *Laxmikant Patel vs. Chetanbhai Shah and Another (2002) 3 SCC 65* - The law does not permit any one to carry on his business in such a way as would persuade the customers or clients in believing that his goods or services belonging to someone else are his or are associated therewith. It does not matter whether the latter person does so fraudulently or otherwise. The reasons are two. Firstly, honesty and fair play are, and ought to be, the basic policies in the world of business. Secondly, when a person adopts or intends to adopt a name in connection with his business or services which already belongs to someone else it results in confusion and has propensity of diverting the customers and clients of someone else to himself and thereby resulting in injury." In this case, the Apex Court further observed that: "Where there is probability of confusion in business, an injunction will be granted even though the defendants adopted the name innocently." The Applicant referred to paragraph 10 of the judgement

20. *Mrs. Rajnish Aggarwal & Others vs Anantam (Delhi High Court, decision dated 26 November, 2009 CS (OS) No. 602/2009)* - The Court held that actual damage or fraud is unnecessary. If there is a likelihood of the offending trade mark invading the proprietary right, a case for injunction is made out. The Applicant referred to paragraph 23 of the judgment.

21. *Jolen Inc. vs Doctor & Company (Delhi High Court decision dated 6 May, 2002) - 2002 (25) PTC 29 Del* - The Court observed that when a party after copying a trade mark comes out with an explanation as to its invention which is unbelievable or may be plausible, its attempt to synchronize combination of words is mere after-thought and is an act

of searching excuses and explanation. The Applicant referred to paragraph 27 of the judgment.

22. *Aktiebolaget Volvo vs. Volvo Steels Limited Decision by Bombay High Court dated October 16 1997 (1998 PTC 47)* - The plaintiff being the proprietor of the VOLVO mark objected to use of VOLVO mark by Volvo Steels and represented "Building on the strength of the Volvo Group" in bold font style in promotional material. The explanation given by the defendant was that the plaintiff's VOLVO mark is not invented word and is a Latin word meaning to roll, business activities of rival parties are different and there is no probability of deception. The Court refused to accept the explanation of the defendants for adopting the word "Volvo", and observed that the dishonestly adopted the Volvo mark/name and the intention of the defendants is only to trade on the reputation and goodwill of the plaintiff. The Applicant referred to paragraphs 74, 75 and 77 of the judgment.

#### **Arguments advanced by the Applicant**

23. Learned Counsel for the Applicant Mr. Manish Kumar argued that in the present case, the two marks are phonetically, structurally and visually similar, the goods in question of both parties are by their nature allied goods.

24. Learned Counsel for the Applicant further argued that the alleged use by the Respondent No.1 of a virtually identical word GOOD DAY as part of its label, way after the adoption of the Applicant of its well known GOOD DAY mark, is clearly dishonest and with a view to trade upon and benefit from the goodwill and reputation of the famous mark GOOD DAY of the Company. The trade and public would assume that the products of the Respondent No.1 under the impugned mark especially bearing the word GOOD DAY are another product extension offered under the GOOD DAY brand of the Applicant. Thus the use of the word GOOD DAY as the trademark for identifying the goods of Respondent No. 1 is wrongful.

Further no amount of use can render adoption of a deceptively similar mark to be legitimate.

25. Learned Counsel for the Applicant also argued that the Respondent No, 1's contention that they in good faith adopted the mark GOOD DAY is not acceptable. Moreover the Company's date of adoption of the mark GOOD DAY, i.e. in the year 1986 – predates the Respondent No. 1's alleged date of adoption of the mark GOOD DAY in the year 2005. Thus being in a trade akin to the Applicant, the Respondent No. 1 ought to have had knowledge of the presence of Company's mark GOOD DAY in the market. Counsel therefore prayed that Respondent no. 2 be directed to remove the impugned mark No: 1424212 from the Register.

#### **About Respondent No.1**

26. The Counter Statement filed by Respondent No. 1 on 22<sup>nd</sup> June 2013 does not contain any details about the Respondent No.1's concern or their business. In relation to the claimed goods, respondent No. 1 submitted that it is the owner and proprietor of the trade mark GOOD DAY and that the mark was honestly and independently conceived and adopted by Respondent No. 1 and has been in continuous use since 2005 in relation to the aforementioned goods.

#### **Contentions by Respondent No. 1**

27. As per the Counter Statement filed by the Respondent No. 1 it has been using the trade mark GOOD DAY, as a whole under its stylized label, continuously ever since the year 2005 and has done enormous business under the said mark since then. The goods have been widely sold and a substantial amount has been spent on sales promotion, advertisement and other printing activities undertaken under the said mark. Respondent No. 1 submitted that the said trademark GOOD DAY has

acquired a distinct connotation as being identified exclusively with Respondent No.1 and none else and the said trademark is distinctive of its goods in the trade.

28. Respondent No. 1 submitted that the impugned trademark is distinctive of its goods. The said trademark is inherently distinctive of its goods in the trade and further the said trade has by virtue of its use since the year 2005 acquired the distinctiveness required which can distinguish its company's goods from those of other manufacturers. The said trade mark is thus distinctive of the Respondent No. 1's goods and its registration is and would be in accordance with the provisions of Section 9(1) of the Act. Any use of the trade mark GOOD DAY in relation to the aforementioned goods is and would be exclusively identified with the Respondent and there is no question of confusion or deception from anyone. Respondent No. 1 has not tried to copy or usurp upon the Applicant's rights or their mark. Respondent No. 1 has sufficient goodwill and reputation in the said trade mark and does not need to harp upon or sail on other's winds. The Applicant's trade mark GOOD DAY is distinct and different visually, phonetically and structurally from Respondent No. 1's impugned trademark GOOD DAY. Further on account of honest and independent adoption and use thereof since the year 2005, Respondent No.1 is and claims to be the rightful proprietor and owner of the trademark GOOD DAY within the meaning of Section 18 of the Trade Marks Act, 1999.

29. Respondent No.1 further submitted that the mark GOOD DAY is distinctive of Respondent No. 1's goods and the same has been independently and honestly adopted and openly, bonafidely used by the Respondent No. 1. Hence the said trademark is perfectly registrable in the name of Respondent No. 1

## **DISCUSSIONS**

30. As already mentioned the impugned trade mark of Respondent No. 1 is **GOOD**



**DAY**. Pictorial Depiction: .

31. It is admitted position that the Applicant is the prior user, with usage claim from 1986, whereas the Respondent No. 1 has claimed usage from 2005.

32. It is the case of Applicant that the adoption of the Respondent No. 1 of the impugned trade mark is dishonest, the same having been adopted in the year 2005 and subsequent to the adoption of the Applicant of its trade mark GOOD DAY, which was widely publicized and is well known to the members of the industry. Further said usage has not been substantiated by Respondent No. 1. Therefore, the use of Respondent No.1 is not bonafide and harps on the goodwill and reputation of the Applicant's trade mark GOOD DAY.

33. It is an admitted fact that the parties trade in closely related cognate goods, the Applicant uses its trade mark GOOD DAY on biscuits while the Respondent No.1 uses the impugned trade mark GOOD DAY on salt, the sector, trade channels and consumer base all being the same. There exists a likelihood of confusion on the part of the public, including the likelihood of association with the Applicant's earlier, registered and well-known trademark. The impugned registration is in relation to goods that are cognate to the Applicant's goods; and therefore, it stands in violation of Sections 11(1), 11(2) and 11(3) of the Act.

34. The Applicant's mark GOOD DAY in respect of the aforementioned goods are well known and inextricably associated with the Applicant alone and entitled to protection by law against identical and/or deceptively similar trade marks even in respect of dissimilar goods/services. The Respondent No.1 was fully aware of the reputation and goodwill attached to the Applicant's mark GOOD DAY when it dishonestly

adopted the near identical impugned mark GOOD DAY in respect of identical/similar goods and applied for registration thereof. The Registered Proprietor had not come with clean hands in seeking registration of the impugned mark and as such, the application ought to be regarded as having been made in “bad faith”. The impugned registered mark is liable to be cancelled under the provisions of Section 11(10) of the Act.

35. Respondent No. 1 has not filed any evidence to show usage of the mark. Statement of the annual sales turnover and the amount spent on advertisement, publicity and other sales promotion expenses incurred by the Respondent No.1 for the impugned mark have not been filed before us. Bills from November 2006 upto April 2011 have been filed before us in June 2013. No evidence exists of usage of the impugned mark from 2005-2006 and subsequent to 2011. Further the said bill bear only the price of the goods but not the tax component, originals have not been produced before us.

### **FINDINGS OF THIS BOARD**

a) **The Similarity between the two trademarks**

36. Now, the first question to be considered about the similarity of the two rival marks and it is to be decided upon about the deceptive similarity between the two marks.

It is the admitted position that the phonetic part of both mark are identical, i.e. the word GOOD DAY. The Respondent No.1' argument that the impugned trademark is not identical to Applicant's mark as the expression GOOD DAY is part of a label comprising

“artistic work” is puerile and misleading and utterly misconceived, as the speaking and dominant portion of the impugned label mark is GOOD DAY, which is identical to Applicant's

mark/s. Respondent No.1' products bearing the impugned mark will be sold through the same trade channel to the same purchasers and in the same outlets as Applicant's products bearing Applicant's well known GOOD DAY marks. It is

reiterated that the specified goods “salt” are of the same description as those of Applicant’s goods under Applicant’s mark GOOD DAY. As a whole the phonetic, structural and visual similarity between the impugned mark GOOD DAY and the Applicant’s trade mark GOOD DAY is striking and the arguments of Respondent No.1 to distinguish the same does not hold water. The use of the mark GOOD DAY or any other trademark comprising the word GOOD DAY as a part thereof, or any other mark deceptively/confusingly similar to the Applicant's mark GOOD DAY, in relation to the said goods and/or related goods would connote and denote the Applicant as the exclusive source thereof.

37. Since the very adoption of the impugned mark comprising the identical expression

“GOOD DAY” is tainted with dishonesty, the question of any honest concurrent use by the Respondent No.1 under Section 12 of the Act does not arise at all. Whether the Respondent No.1's use of the mark is strictly confined to “salt” only or whether the Respondent No.1 have no intention to penetrate into other goods is immaterial. There is no denying the fact the Applicant’s mark GOOD DAY is a household name and branded on consumer minds indelibly. Respondent No.1's use of the impugned mark for salt, or for any other goods, particularly in Class 30, would be in direct conflict with Applicant’s prior adopted, registered and well known GOOD DAY marks, and is bound to lead to dilution of the distinctiveness attached to Applicant’s GOOD DAY marks.

38. Further the Applicant is the prior adopter, user and registered proprietor of the well known mark GOOD DAY in India. The word GOOD DAY does not have any significance in relation to the Applicant's goods on which it is applied and as such, it is a distinctive trademark for the said goods. The Applicant's said GOOD DAY trademarks, have acquired tremendous reputation and goodwill. Further, through extensive and continuous use, including wide publicity and promotion of the Applicant's goods bearing the GOOD DAY trademarks, have acquired factual distinctiveness and have become inextricably linked with the Applicant company. The

Applicant's various GOOD DAY trademarks are thus well-known trademarks within the ambit of Section 2(1)(zg) of the Trade Marks Act, 1999 in respect of the said goods.

39. The impugned label mark contains the expression GOOD DAY, which is identical to the Applicant's prior adopted, registered and well-known trademark GOOD DAY. The goods under the impugned registration are covered by the Applicant's various registered GOOD DAY trademarks; belong to the same category of food products as the Applicant's goods bearing its various GOOD DAY marks; fall in the same class; and share the same trade channels and sale outlets and the same ultimate consumers. There exists a definite risk of confusion among the consumers and in the market in general, including the likelihood of association with Applicant's earlier registered and well known trademark. We have examined the present case in hand with various judgments such as in the case of *Lakme Ltd. vs. Subash Trading*, 1996 (16) PTC 567 (Del) the Delhi High Court held the Defendant's mark LIKE-ME is visually and phonetically similar to the Plaintiff's mark LAKME. It was also held that there is every possibility of deception and confusion being caused in the minds of the prospective buyers of the Plaintiff's products. The Court granted injunction in favour of the Plaintiff and restrained the Defendant from using the mark "LIKE-ME". The Delhi High Court in the case of *Glaxo Group Ltd. & Anr. vs S.D. Garg & Ors.* on 12 May, 2015 was of the view that phonetically on comparison of the sound, the mark GENTAC was deceptively similar to the brands ZINETAC and ZANTAC. Further in the case of *Encore Electronics Ltd. vs. Anchor Electronics and Electricals Pvt. Ltd.* 2007 935 PTC 714 [Bom] the Division Bench of Bombay High Court dealt with phonetically similarity between the trademarks ENCORE and ANCHOR. The Court restrained use of the ENCORE mark. The court viewed that phonetic structure of marks indicate how the rival marks ring in the ears and therefore phonetic similarity constitutes an important index in evaluating whether a mark bears a deceptive or a misleading similarity to another. The Gujarat High Court in *Vikram Stores And Anr. vs S.N. Perfumery Works And Anr.* on 30 November, 2007 AIR 2008 Guj 65 held that the

Mark 'RANGILI' is deceptively similar to registered Trademark RANGOLI. A man of imperfect recollection and of average intelligence will be deceived by mark used by the defendants. The Calcutta High Court in the case of Banwaridas Pugaliavs Colgate Palmolive Co. And Ors. on 8 June, 1978, AIR 1979 Cal 133 held that the marks FORMIS is likely to be confused as CHARMIS on the basis that the fact that both the words contain four common letters 'RMIS' while holding so the Calcutta High Court relied case of Re: Pianotist Co.'s Application, (1906) 23 RFC 774 where Parker, J, observed as follows at: "*You must take the two words. You must judge them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trademarks is used in a normal way as a Trademark for the goods of the respective owners of the marks.*"

40. The Apex Court in *Ruston and Hornby Ltd. vs. Zamindara Engineering Co.* AIR 1970 SC 1649 held the marks RUSTON and RUSTAM INDIA were held to be deceptively similar. It was held that the use of suffix INDIA to the word RUSTAM would not obviate confusion with the trademark RUSTON.

41. In the case of *K.R. Chinna Krishna Chettiar versus Sri Ambal & Co.* AIR 1970 SC 146 wherein the rival trademarks of the parties were Ambal and Andal, the Supreme Court of India held that there is a striking similarity and affinity of sounds between the two trademarks and in spite of there being no visual resemblance between the two marks, the ocular comparison is not always the decisive test. The resemblance between the two marks must be considered with reference to the ear as well as the eye.

42. It is pertinent to go through the other decisions of the Apex court in *Amritdhara Pharmacy v. Satya Deo Gupta* reported in AIR 1963 SC 449, *Parle Products (P) Ltd. v. J.P. & Co.* reported in AIR 1972 SC 1359 and *Cadila Health Care Ltd. v. Cadila Pharmaceuticals*

*Ltd., reported in 2001 (1) CTMR 288 (SC). In Amritdhara's case, the Supreme court was dealing with the words Amritdhara and Lakshmandhara and held that the words had overall structural and phonetic similarity. It was further held by the Supreme court in the said case that "the trade mark is the whole thing-the whole word has to be considered". In Parle Products (P) Ltd's case the Supreme court held that "In order to come to the conclusion whether one mark is deceptively similar to another, the broad and essential features of the two are to be considered. They should not be placed side by side to find out if there are any differences in the design." In Cadila Health Care Ltd., v. Cadila Pharmaceuticals Ltd., reported in 2001 (1) CTMR 288 (SC), the Supreme court, relied upon its earlier decision in Amritdhara's case and held that "It is also important that the marks must be compared as a whole". It is not right to take a portion of the word and say that because that portion of the word differs from the corresponding portion of the word in the other case there is no sufficient similarity to cause confusion. But in all the above cases, phonetic similarity alone was not taken to be the sole deciding factor. On the other hand, the Supreme Court emphasized the need to apply the test of "overall structural and phonetic similarity" in Amritdhara's case and "visual and phonetic tests" in Cadila's case. Similarly, the Supreme Court applied the test of "broad and essential features" in Parle Products case.*

43. Applying the aforesaid judicial pronouncements to the present case, it is clear that the presence of the GOOD DAY word within a composite label will not obviate any confusion between the rival marks. Clearly, the adoption of the mark GOOD DAY label is intended to cause confusion of GOOD DAY mark of the Applicant. The impugned registered trademark, therefore, stands in violation of Sections 11 (1), 11(2) and 11(3) of the Act.

b) **Prior knowledge and bad faith adoption of the Respondent No.1**

44. The Applicant is the prior adopter, user and registered proprietor of the GOOD DAY trademark in respect of the goods in class 30. The Respondent No.1 must have been fully aware of the reputation and goodwill attached to the Applicant's GOOD DAY trademarks, when the Respondent No.1, in 2006, applied for registration of the

impugned label mark containing the identical expression 'GOOD DAY' as the primary, dominant and distinguishing part of the mark.

45. The Respondent No.1 must have also been aware that the mark GOOD DAY, or any other trademark comprising the expression GOOD DAY as a part thereof, especially when used in relation to edible goods, would connote and denote the Applicant as the source thereof, being a household name in India for several decades. Therefore, the very adoption of the impugned registered mark and application therefor by the Respondent No.1 in respect of the specified goods was tainted with dishonesty, stemming, as it did, out of the intention to cash-in on the reputation and goodwill of the Applicant's mark GOOD DAY trademarks. Therefore, the Respondent No.1 could not, and even now, cannot claim proprietorship to the impugned mark under Section 18 of the Trade Marks Act, 1999 (hereinafter, referred to as "the Act") and therefore, the impugned registration is contrary to the provision of **Section 18** of the Act.

c) **The "well-known" character of the Applicant's GOOD DAY mark**

46. The concept of well known mark, first elaborated on in cases such as *Daimler Benz Aktiengesellschaft & Anr v. Hybo Hindustan*, AIR 1994 Del 2369 and was further expanded in *Kamal Trading Co., Bombay and Others v. Gillette U.K. Limited, Middle Sex, England*, 1998 PTC 288 DB, *Kirloskar Diesel Recon Pvt. Ltd. v. Kirloskar Proprietary Ltd.*, AIR 1996 Bom. 146 and a plethora of subsequent decisions. We have also declared vide Applicant's judgement in TA/1/2007/TM/DEL/(C.M.(M)) No. 148 of 2002 dt. 11/12/2009 that KIT KAT is a well-known mark having trans-border reputation. Further we also recognised the trans-border reputation enjoyed by the mark WOOLWORTH 2004 (29) PTC 477. Other marks we have declared well known are AMUL (OA/56/2011/TM/KOL), RAYMOND (OA/16-17/2010/TM/CH), SONY (OA/49/2007/TM/KOL), ENFIELD BULLET (2006(32) PTC 397), LETTER\*T IN A CIRCLE (2006 (32) PTC 296), NIRMA for

washing & cleaning preparations (2004(29) PTC 634), USHA For sewing machines, electric fans etc. (2004(29) PTC 647), Canon (Order in OA/43/2005). The GOOD DAY trade mark of the Applicant is well known to the public at large in India. It is an industrial and services conglomerate with a long duration, extent and geographical area of usage of the said trademark. The Applicant's mark is in use for more than three decades. The name has acquired a distinctive secondary meaning in the business or trade circles. The Applicant's trade mark GOOD DAY therefore qualifies as well known under Sec. 11(10) of TM Act 1999. In *Kirloskar Diesel Recon Pvt. Ltd. vs Kirloskar Proprietary Ltd.*, AIR 1996 Bom 149, the Court while extending protection to the mark 'Kirloskar' stated that –*“in case of trading name which has become almost a household word and under which trading name a variety of activities are undertaken, a passing off can successfully lie if the defendant has adopted identical or similar trading name and even when the defendant does not carry on similar activity. Even if the defendant's activities in such circumstances, are remote, the same are likely to be presumed a possible extension of plaintiff's business or activities. In the instant case, the Respondents have established that word 'Kirloskar' has become a household word and their businesses cover variety of activities and that there is even a common connection with some activities of the Respondents and activities of the Applicants.”* We note that the goods covered under the impugned marks are similar and/ or cognate to the Applicant's goods for the mark GOOD DAY in class 30. Even otherwise, the Applicant's GOOD DAY Marks are liable to be entitled to be protected across classes being a well-known trademark.

47. The Applicant's mark GOOD DAY is a “well-known trademark” within the meaning of Section 2(1) (zg) of the Trade Marks Act, 1999 and is entitled to protection as such under Section 11 of the Act. The following factors prove the well-known nature of the Applicant's GOOD DAY trademark:

- i. Owing to extensive use and promotions of the Applicant's GOOD DAY brand of products across the length and breadth of the country, the mark GOOD DAY is widely known and recognized in India and is solely and exclusively associated with the Applicant and no other entity. It is submitted that such is the knowledge and recognition of the GOOD DAY mark among

the public and members of the trade in India that it falls within the parameters for consideration as a “well known trade mark” as specified under Section 11(6) (i) and also under Section 11(7) of the Act.

- ii. The Applicant had commenced use of the GOOD DAY trademark nearly **34 years ago**. It is submitted that the duration, extent and geographical area of use of Applicant’s mark GOOD DAY and promotions of its products under the said mark is such that the GOOD DAY mark falls within the parameters for consideration as a “well known trademark” as specified under Section 11(6)(ii) and (iii) of the Act.
- iii. The Applicant has obtained numerous registrations of its GOOD DAY trademarks in India in various classes, the earliest registration being dated 1986. Many of the Applicant’s trademark registrations for the GOOD DAY mark include “salt”, which are the goods under the impugned registration. It is submitted that the duration and extent of the Applicant’s trademark registrations clearly reflect the use and recognition of the trademark to qualify it as a “well-known trademark” as envisaged under Section 11(6) (iv) of the Act.
- iv. The Applicant has been vigilant in protecting its trademark GOOD DAY and has been enforcing its rights thereon against all forms of infringement/dilution. The Applicant has consistently taken, and continues to take, suitable actions for protection of its GOOD DAY marks before appropriate for a. In a number of trademark oppositions filed by the Applicant against trademark applications of various parties for “Good Day” or other deceptively similar marks, the Applicants have either abandoned or withdrawn their applications. The Applicant has also received favourable orders or merit for their GOOD DAY trademarks. The record of successful enforcement of rights in the Applicant’s trademark GOOD DAY fulfills the parameters for qualifying as a “well-known trademark” as laid down under Section 11(6)(v) of the Trade Marks Act, 1999.

d) **Dilution of the Applicant's well known GOOD DAY mark**

48. User by the Respondent No. 1 will also dilute and debase the goodwill and reputation of the Applicant in its GOOD DAY Marks. In the case of dilution under Section 29, a plaintiff is required to establish dissimilarity of goods, reputation in India, mark's use without due cause detrimental to it, or the defendant taking undue advantage (*TTC Limited vs Philip Morris Products Sa And Ors.*) [ILR (2010) 2 DELHI 455]. A weakening of the mark when the relevant consumers start relating the mark with a new source (*Caterpillar Inc. vs Mehtab Ahmed And Ors.* 99 (2002) DLT 678) would result in dilution and in the present case, any use of the impugned mark GOOD DAY in respect of the abovementioned Goods in Class 30 tends to mislead the public to believe that the Respondent No. 1's business and goods are that of the Applicant.

49. Therefore, the Respondent No.1 cannot claim proprietorship to the impugned mark under Section 18 of the Act and therefore, the impugned registration is contrary to the provision of Section 18 of the Act.

e) **Usage of the impugned mark and Intention of the Respondent No.1**

50. The second question before us is the question of usage of the impugned trade mark. Under Section 47(1)(a) of the Trade Marks Act, a registered trade mark has to be taken off the register if such trade mark was registered without any bona fide intention to use the mark in relation to the goods or services. Time and again, on the issue of non-user of the mark, the courts have held that a genuine and real intention to use a mark has to manifest. This was dealt by the Supreme Court in *Kabushiki Kaisha Toshiba Versus Toshiba Appliances Company and others* reported in (2009)10SCC-766 where the Hon'ble Supreme Court has observed as follows: "46. *The intention to use a trade mark sought to be registered must be genuine and real. When a trade mark is registered, it confers a valuable right. It seeks to prevent trafficking in trade marks. It seeks to distinguish the*

*goods made by one person from those made by another. The person, therefore, who does not have any bona fide intention to use the trade mark, is not expected to get his product registered so as to prevent any other person from using the same. In that way trafficking in trade mark is sought to be restricted”.*

51. The burden of proof to establish the user during relevant period is always upon the registered proprietor. In *Imperial Group Limited V/s. Philips Morris Company Limited*, reported in 1982 FSR72(CA) where the Court of Appeal held the following: “According to the judgments given in this court in that case a bona fide use should be “ordinary and genuine” (per Lord Evershed M.E. at p. 36), “perfectly genuine,” “substantial in amount,” “a real commercial use on a substantial scale” (per Jenkins L. J. at p. 41) and not “some fictitious or colourable use but a real or genuine use” (per Morris L.J. at p. 42). The Respondent No.1 has not filed any evidence before us of usage, from what we have perused of their usage from 2006-2011; their use of it was not substantial; it was not a real use in any commercial sense. From the material on record. it is apparent that the Respondent No. 1 has not undertaken any use, much less bona fide use, of the impugned trade mark. there is no evidence of any substantial use and advertisement of the impugned trade mark in this period from 2005 till date. there is also no evidence submitted of any use of the impugned trademark subsequently. There is no material, advertisement or any other document which shows that the Impugned Trade Mark was actually used as the case would be in the event of any bonafide use. In nutshell the position is that there is no cogent, evidence is available on record to prove that the documents /evidence produced is in relation to the impugned trade mark.

52. On the contrary the adoption and usage of the mark as admitted by the Respondent No.1 is since 2005 which much latter to the adoption and usage of the mark by the Applicant and thus can conclude the adoption of the mark of the Respondent No.1 is not bonafide Adoption. The Respondent No.1 has no plausible explanation for adopting the **GOOD DAY** word in the label **GOOD DAY**. Thus the very adoption of the mark containing the phonetically similar word **GOOD DAY** is dishonest.

f) **Claim of “use” by the Respondent No.1**

53. The impugned registered mark was filed with claim of use since “01/04/2005” and no documentary evidence has been placed before us to substantiate the same. Even assuming that the Respondent No.1 had sold any product under the impugned registered mark, since the very adoption of the impugned mark by the Respondent No.1 is tainted with dishonesty, no amount of use thereof by the Respondent No.1 can inure to their benefit. Therefore, the Respondent No.1 are not entitled to claim any rights to registration under Section 12 of the Act.

54. It is a judicially settled principle that no amount of use can render adoption of deceptively/ phonetically similar mark to be legitimate. In the case of *Laxmikant Patel vs. Chetan Bhai Shah AIR 2002 SC 275*, the Supreme Court observed as under: ‘*A person may sell his goods or deliver his services such as in the case of a profession under a trading name or style. With the lapse of time such business or services associated with a person acquire a reputation or goodwill which becomes a property which is protected by courts. A competitor initiating sale of goods or services in the same name or by imitating that name results in injury to the business of one who has the property in that name. The law does not permit anyone to carry on his business in such a way as would persuade the customers or clients in believing that the goods or services belonging to someone else are his or associated therewith. It does not matter whether the latter person does so fraudulently or otherwise*’. Even if the mark is honestly adopted by the Respondent No.1 is not allowed as per this judgment.

55. It was held by Courts in various judgments such as in *Jolen Inc. vs. Doctor & Co. 2002 (25) PTC 29 (Del)* the Delhi High Court held that the advertisements and sales figures of the defendant are of no relevance if the adoption of trade mark is subsequent, tainted and dishonest. In such a case even long user, reasonable reputation and goodwill of the trade mark cannot vest the right in the defendant to protect it. In *Aktibolaget SKF vs. Rajesh Engineering Corp. 1996 PTC 160 DEL* it was held that if adoption of the trade mark is dishonest – the use of trade mark for a long period is of

no consequence and in *Tube Investments of India Ltd. vs. Tata Engineering and Locomotive Company Ltd.* 2001 (21) PTC 562 (Reg) (Mad), the court held that where the marks are deceptively similar, the adoption is considered to be dishonest and an application for registration of the same is liable to be dismissed. In this case, even though the goods were different, it was held that use of the impugned label mark would lead to confusion and deception.

56. The Respondent No.1 has failed to prove its alleged bona fide adoption and use of the mark **GOOD DAY**label on the other hand, the Applicant filed sufficient documentary evidence to prove its prior adoption and use of the **GOOD DAY** trade mark/ name internationally as well as in India. Further it is a matter of record that the Applicant is the prior registered proprietor of **GOOD DAY**mark.

57. The Respondent No.1 has no plausible reason and/ or basis of adoption of the mark “**GOOD DAY**” label phonetically similar/deceptively similar to that of the Applicant**GOOD DAY**mark and allowing the same would severely prejudice the essence of Trademark law and would likely to mislead consumers believing products of Respondent No.1 emanating from that of the Applicant.

58. In the light of above the Petition is allowed and Respondent No.2 is directed to delete the entry of registered Trade mark No. 1424212 for the mark “GOOD DAY” label in Class 30 in the name of Respondent No.1 from the Register under the provisions of Section 47(1)(a) and (b) and Section 57 of the Trade Marks Act, 1999. Copy of order be sent to the parties as well as Respondent No.2 who is directed to remove the said mark from the Register.

59. GOOD DAY is hereby declared a well known mark as per Section 2(1) (zg) read with Section 11(6) and (7) of the Trade Marks Act, 1999

60. There shall be no orders as to the Costs.

-Sd/-

-Sd/-

-Sd/-

(Ms. Lakshmidēvi Somanath)  
Technical Member (Trademarks)

(Shri. Makyam Vijay Kumar)  
Technical Member (Trademarks)

(Shri Justice Manmohan Singh)  
Chairman

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