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

*Reserved on 14<sup>th</sup> December 2022*

*Pronounced on 4<sup>th</sup> January 2023*

+ C.A.(COMM.IPD-TM) 158/2022, I.A. 20094/2022, I.A. 20095/2022 and I.A. 20096/2022

ARMASUISSE .....Appellant  
Through: Mr. Pravin Anand, Mr. Shrawan Chopra, Ms. Madhu Rewari, Mr. Vibhav Mittal, Ms. Shree Mishra, Mr. Achyut Tewari, Advs.

versus

THE TRADE MARK REGISTRY & ANR. .... Respondents  
Through: Mr. Akhil Sibal, Sr. Adv. with Mr. Anirudh Bakhru, Mr. S.K.Bansal, Mr. Rishi Bansal, Mr. Ajay Amitabh Suman, Mr. Anmol Kakkar, Mr. Aditya Rajesh, Ms. Aishwarya, Ms.Asavari, Ms. Sanya and Ms. Tejaswini Chandrashekar, Advs. for R-2

+ C.A.(COMM.IPD-TM) 159/2022, I.A. 20153/2022, I.A. 20154/2022 and I.A. 20155/2022

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Tejaswini Chandrashekar, Advs. for R-2

**CORAM:**  
**HON<sup>BLE</sup> MR. JUSTICE C. HARI SHANKAR**


% **JUDGMENT**  
**04.01.2023**


**C.A.(COMM.IPD-TM) 158/2022, I.A. 20094/2022, I.A. 20095/2022**  
**and I.A. 20096/2022**




**C.A.(COMM.IPD-TM) 159/2022, I.A. 20153/2022, I.A. 20154/2022**  
**and I.A. 20155/2022**

1. These appeals involve cognate issues. Submissions advanced at the bar by both sides are also overlapping. As such, they have been taken up and disposed of together.

2. The appellant is a Federal Agency of the Swiss Federation, and procures armaments for Switzerland's Federal Department of Defence, Civil Protection and Sport. The appellant, therefore, represents, essentially, the military wing of the Swiss Government.

3. Respondent 2, in these appeals, Promoshirt SM S.A. (-Promoshirt, hereinafter) applied to the Registrar of Trademarks, New Delhi for registration of the trademarks (i) -**SWISS MILITARY** in Class 25 in respect of clothing, readymade garments, footwear, headgear, coats, overcoats, jackets, jerseys, undergarments, socks and (ii) the mark  in Class 25 in respect of -textile industries. Both applications were on -proposed to be used basis. The appellant opposed the applications. The opposition of the appellant was rejected, and the trademarks were permitted registration by the learned Deputy Registrar of Trademarks *vide* separate orders

dated 25<sup>th</sup> July 2022. The appellant has, by means of these appeals, assailed the said orders and, therefore, contested the right of the aforesaid trademarks –**SWISS MILITARY**® and  to registration under the Trademarks Act, 1999 (—the Trademarks Act®).

4. I may note, here, the appellant's precise grievance. Mr. Pravin Anand, appearing for the appellant, submits that the appellant has no objection to Respondent 2 using the  logo *per se*, as a white cross on a black background, for its products. His client, however, seriously objects to Respondent 2 being permitted to register or use either (i) a white cross on a red background, i.e.  or (ii) the appellation –**SWISS MILITARY**®. Neither mark, submits Mr Anand, can be permitted either to be registered or used, in view of various statutory proscriptions which are in place. What Respondent 2 actually uses, he seeks to point out, is , i.e. a white cross on a red background with the –**SWISS MILITARY**® appellation below it.

5. Inasmuch as the impugned order dated 25<sup>th</sup> July 2022, read with Section 10(2)<sup>1</sup> of the Trade Marks Act, 1999, allows Respondent 2 to do so, the appellant calls the said order into question in these appeals.


6. Mr. Akhil Sibal, at the very outset of his submissions, submitted that his client was willing to restrict the registration of the impugned mark to a black and white colour combination, without using red. He,

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<sup>1</sup> 10. **Limitation as to colour.** –

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(2) So far as a trade mark is registered without limitation of colour, it shall be deemed to be registered for all colours.





however, acknowledges that his client has other registrations for the white cross on a red background, i.e. , but states that those registrations are not subject matter of appeal. Mr Sibal would seek to nip these proceedings in the bud by submitting that, in view of the concession he makes, the grievance of the appellant, which is restricted to the use of the mark in a red-and-white colour combination, would stand assuaged.

7. Even if all submissions of Mr Anand were to be accepted, submits Mr. Sibal, the sequitur would not be the setting aside of the impugned order, but limitation of the registration of the impugned mark to a black-and-white colour combination. He also points out that the requirement for the application specifying the colour in which the registration of the mark was sought was introduced only in 2002, whereas the application of Respondent 2 was of 1999.

8. Mr. Anand does not take kindly to the suggestion. He submits – and justifiably, I feel – that Respondent 2 cannot seek to truncate these proceedings by the above concession, thereby leaving the appellant to fight the battle against the red-and-white  **SWISS MILITARY** mark all over again for another day, while it continues to use the said mark, in violation of the law. He also submits that he seriously disputes the entitlement, to registration, of the **‘SWISS MILITARY’** appellation as well.



9. I agree with Mr Anand. Respondent 2, in making the above concession and seeking a closure to these proceedings on that basis, is being less than fair. Mr Sibal, with characteristic candour, acknowledged that, despite having offered the concession on

instructions, his client was not going to desist from continuing to use the red-and-white  mark, or the **SWISS MILITARY**‘ appellation below it, as it had subsisting registrations in that regard, which have not been challenged. In that view of the matter, I see no justification for truncating these proceedings on the basis of the concession extended by Mr Sibal.

10. Had the impugned order restricted the grant of registration to the impugned mark to the white cross on a black background, i.e. , then, perhaps, the appellant might not have been entitled to challenge the use of the  mark in these proceedings, as the challenge would have travelled outside the scope of the impugned order, and would have assailed an entitlement that the impugned order did not grant. As things stand, however, by virtue of Section 10(2)<sup>1</sup> of the Trade Marks Act, the impugned order *permits* the use, by Respondent 2, of the white cross on a background of *any colour* (which would include red). Respondent 2 avowedly uses, and intends to continue to use, the white cross on the red background, as , with the appellation **SWISS MILITARY** below it. The appellant cannot, therefore, in these proceedings, be foreclosed the right to challenge the entitlement, to registration, of the  or the **SWISS MILITARY** marks, used either independently or in conjunction with each other.


11. Mr. Sibal’s submission that, if Mr. Anand’s submissions were to be accepted, the sequitur would only be limiting the grant of registration to the impugned mark to a black and white combination, in my opinion, is bereft of substance. It has merely to be stated to be


rejected. The impugned order allows registration of the impugned mark without limitation of colour. This Court is seized with the correctness of the impugned order. Its brief is not, therefore, limited or restricted to modifying the impugned order in a manner it deems appropriate – though, undoubtedly, as an appellate Court, it can do so. The Court is well within its jurisdiction, therefore, to adjudicate on whether Respondent 1 can be permitted registration, of the impugned mark, in any colour, not merely in black-and-white. Inasmuch as the impugned order, read with Section 10(2)<sup>1</sup>, deems the impugned mark to be registered in all colours, the concession advanced by Mr Sibal, to the effect that his client is willing to let the impugned registration be limited to black-and-white, does not in any way render the discussion academic, especially in view of Mr Sibal's admission that his client has no intention to restrict use of the impugned mark to the black-and-white format, as it has subsisting registrations specifically for the red-and-white format which are not under challenge.

12. I queried of Mr. Anand as to whether the appellant was also objecting to the use, by the respondents, of , i.e. where the white cross was on a black background. Mr. Anand responded by submitting that if the respondents were willing to forgo the words SWISS MILITARY below the logo and were merely using the white cross on a black background, i.e. , his client would have no objection to such use.

13. Mr. Sibal, needless to say, was not willing to restrict the impugned registration to a white cross on a black background without the words –SWISS MILITARY


14. The battle lines thus stand drawn.


15. I would, therefore, be examining only whether the  mark, depicting a white cross *on a red background*, and the SWISS MILITARY word mark, individually or in conjunction with each other, can be registered.

16. There being no dispute on facts, and the issue in controversy being the entitlement of the trademarks SWISS MILITARY and  to registration, one may proceed directly to the rival submissions made by learned Counsel before me.

**CA(COMM.IPD-TM) 159/2022**

**Submissions of Mr. Pravin Anand on behalf of the appellant Armasuisse**

17. Mr. Pravin Anand, learned Counsel for the appellant initially addressed arguments on CA(COMM.IPD-TM) 159/2022, which was directed against the order which rejected the appellant's opposition and allowed registration of the trademark  by Respondent 2.

18. Respondent 2 applied, on 8<sup>th</sup> November 2000, for registration of the  mark for textile on a -proposed to be usedll basis. While so applying, Promoshirt disclaimed exclusivity in the words SWISS MILITARY.

19. The appellant's opposition to the mark, as already noted, stands

rejected by the impugned order dated 25<sup>th</sup> July 2022.

Statutory proscriptions

20. Mr. Anand submits that the impugned logo of Promoshirt cannot be registered in view of the proscriptions contained in Sections of Section 2(1)(i)(I) and 2(1)(i)(IV)(a)<sup>2</sup> read with Sections 102<sup>3</sup> and 103<sup>4</sup>, 9(1)(a) and (b)<sup>5</sup>, Section 9(2)(a)<sup>6</sup> and Section 11(3)(a)<sup>7</sup> of the

<sup>2</sup> 2. **Definitions and interpretation.** –

- (1) In this Act, unless the context otherwise requires, -  
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- (i) –false trade description|| means –  
(I) a trade description which is untrue or misleading in a material respect as regards the goods or services to which it is applied; or  
(IV) any marks or arrangement or combination thereof when applied –  
(a) to goods in such a manner as to be likely to lead persons to believe that the goods are the manufacture or merchandise of some person other than the person whose merchandise or manufacture they really are;

<sup>3</sup> 102. **Falsifying and falsely applying trade marks.** –

- (1) A person shall be deemed to falsify a trade mark who, either, -  
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- (b) falsifies any genuine trade mark, whether by alteration, addition, effacement or otherwise.
- (2) A person shall be deemed to falsely apply to goods or services a trade mark who, without the assent of the proprietor of the trade mark, -  
(a) applies such trade mark or a deceptively similar mark to goods or services or any package containing goods;  
(b) uses any package bearing a mark which is identical with or deceptively similar to the trade mark of such proprietor, for the purpose of packing, filling or wrapping therein any goods other than the genuine goods of the proprietor of the trade mark.

<sup>4</sup> 103. **Penalty for applying false trade marks, trade descriptions, etc.** – Any person who –

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- (d) applies any false trade description to goods or services; or  
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- (g) causes any of the things above mentioned in this section to be done, shall, unless he proves that he acted, without intent to defraud, be punishable with imprisonment for a term which shall not be less than six months but which may extend to three years and with fine which shall not be less than fifty thousand rupees but which may extend to two lakh rupees:

Provided that the court may, for adequate and special reasons to be mentioned in the judgment, impose a sentence of imprisonment for a term of less than six months or a fine of less than fifty thousand rupees.

<sup>5</sup> 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;  
(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;

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shall not be registered.

<sup>6</sup> 9. **Absolute grounds for refusal of registration.** –

- (2) A mark shall not be registered as a trade mark if –  
(a) it is of such nature as to deceive the public or cause confusion;



Trade Marks Act.

Sections 2(1)(i)(I) and 2(1)(i)(IV)(a)<sup>2</sup> of the Trade Marks Act

**21.** Mr. Anand contends, firstly, that the impugned mark is a –false trade description<sup>1</sup> within the meaning of Section 2(1)(i)(I) and Section 2(1)(i)(IV)(a)<sup>1</sup> of the Trade Marks Act and was not, therefore, registrable. He has invited my attention, in this context, to para 26 of the notice of opposition filed by the appellant to Promoshirt’s application for registration of the impugned mark, which reads thus:

–26. The registration of the impugned mark would amount to "false trade description" as per the provisions of Section 2(i)(I) and Section 2(i)(IV)(a) and hence cause irreparable damage and hardship in the related business and to the public at large.<sup>1</sup>

Mr. Anand points out, on the basis of the invoices submitted by Respondent 2 with its application for registration, that the goods in respect of which Respondent 2 was using the impugned mark were manufactured in China, not in Switzerland and that, therefore, by using the appellation ‘**SWISS MILITARY**’ and the distinctive red cross which constitutes Switzerland’s insignia, Respondent 2 was seeking to make it appear that goods were of Swiss origin which amounted to a –false trade description<sup>1</sup>.

**22.** In this context, Mr. Pravin Anand also drew my attention to Tax Invoice dated 12<sup>th</sup> July 2008, issued by Swiss Military Products SA (as Respondent 2 was earlier named) to Bausch & Lomb India Ltd, in

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<sup>7</sup> 11. **Relative grounds for refusal of registration. –**

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(3) A trade mark shall not be registered if, or to the extent that, its use in India is liable to be prevented –



(a) by virtue of any law in particular the law of passing off protecting an unregistered trade mark used in the course of trade;

respect of a laptop shoulder bag, bearing the impugned mark, albeit in the form of a white cross on a red background, in which the amount chargeable was reflected as ₹ 1,11,112.50. Mr. Anand submits that the ₹ symbol for the Rupee came into force only on 15<sup>th</sup> July 2010, which was more than two years after the aforesaid invoice was issued, for which purpose he placed reliance on a Cabinet Circular dated 15<sup>th</sup> July 2010 released by the Press Information Bureau, Government of India, approving, on that day, the symbol '₹' for the Indian rupee. Having, therefore, furnished a fabricated invoice in support of its application, Promoshirt was, according to Mr. Pravin Anand, *ex facie* disentitled to registration. Mr. Anand points out that there is no finding in the impugned order on this objection by the appellant.

23. Mr. Anand next submits that there is yet another aspect on which the application of the respondents for registration compromises on truth. He refers me to the record of Registration No. A-71091/2005 dated 29<sup>th</sup> April 2005, whereby copyright registration was granted by the copyright office of the Government of India to the artistic work . He pointed out that, in the application for registration, the applicant was shown to be Mr Jean Luk Boegli, *of Indian nationality, c/o Ashok Sawhney, W-41, Okhla Industrial Area, Phase II, New Delhi.* Mr. Jean Luk Boegli was also shown, in the said application, to be the author of the copyright; again, of Indian nationality. The form also disclosed that the first publication of the impugned mark was in 1989 in India and that the publisher was also of Indian nationality. The date on which the application for copyright registration was made was reflected as 17<sup>th</sup> March 2004.

24. Mr. Anand has drawn my attention to an official Certificate

dated 19<sup>th</sup> July 2006, on the reverse side of a Power of Attorney granted by Mr. Jean Luk Boegli in favour of Ashok Sawhney, CEO of Respondent 2, in which the date of birth of Mr. Jean Luk Boegli is reflected as 16<sup>th</sup> July 1976. By that reckoning, submits Mr. Pravin Anand, Mr. Jean Luk Boegli, in 1989, would have been 13 years of age. He submits that it is inconceivable that a 13 year old boy would create the  logo. Accordingly, he submits that the Respondent 2 has resorted to misrepresentation even while seeking copyright registration for the impugned logo.

25. Mr. Anand next referred me to various advertisements and trade promotion catalogues, etc., in which Promoshirt was promoting the impugned  brand. Mr. Anand points out that there were various representations in the said advertisements/promotional campaigns intended at communicating a link between goods bearing the  brand and Switzerland. In one of the advertisements, the Swiss flag was shown with the Alps in the background. In another advertisement, the following recital was to be found:

-Our motto of ‘Swiss quality at Affordable Prices’ stems from the fact that the Corporate Gift segment today suffers from either inferior quality or exorbitant prices. This is the gap we intend to fill in with a mission to produce the best products available with the most economically viable resources


The -India catalogue for various goods such as travel gear, watches, writing instruments, sunglasses, accessories, bicycles, electronics, alarm clocks, etc., brought out by Respondent 2, also shows a train in a foreground with the snowclad Alps in the background. All this material, through which Respondent 2 promoted and advertised its brand, submits Mr Anand, was intended to convey the immediate

impression that the goods bearing the brand were of Swiss origin. Mr Anand relies on Section 144<sup>8</sup> of the Trade Marks Act to submit that the manner in which Respondent 2 was using the mark was relevant to a decision on whether to allow, or not to allow, its registration. He places reliance, for this purpose, on the decision of a coordinate Single Bench of this Court in *Louis Vuitton Malletier v. Manoj Khurana*<sup>9</sup>.

26. Invariably, submits Mr. Anand, Respondent 2 uses the impugned logo with the white cross on a red background. He has also shown me pictures of bag packs with the said logo and even produced, in the Court, a physical sample of such a bag pack. A photograph of one such bag pack may be provided thus:



Section 9(1)(b)<sup>5</sup> of the Trade Marks Act

27. The use of the Swiss  insignia, along with the words 'SWISS MILITARY', submits Mr Anand, would serve in trade to designate the goods as being of Swiss geographical origin. The mark is, therefore, *ex facie* non registrable under Section 9(1)(b)<sup>5</sup>, which

<sup>8</sup> 144. Trade usages, etc., to be taken into consideration. – In any proceeding relating to a trade mark, the Registrar or the High Court, as the case may be, shall admit evidence of the usages of the trade concerned and of any relevant trade mark or trade name or get up legitimately used by other persons.

<sup>9</sup> (2015) 64 PTC 559

proscribes registration of marks which –consist exclusively of marks or indications which may serve in trade to designate, *inter alia*, –geographical origin ... of the goods.

28. Mr Anand has, in this context, also relied on the Manual of Trade Marks Practice and Procedure by the Ministry of Commerce and Industries which contains the guidelines followed by the Registry in the matter of registration of trade marks. The following guidelines, to be found with respect to registration of trade marks which indicate the geographical origin of the goods, are cited:

**– –Geographical origin”**

Name of places with populations of less than 5000 in India prima facie be acceptable. However if the location covers a large area having a reputation in the goods or service, the application may attract objections.

- In the case of overseas names, location is considered more important than size.
- In the case of Industrialised countries such as USA, Japan or Europe, while population size of 100,000 for reasonable for acceptability, it is to be borne in mind if the location has a reputation or services, the size of the location of its remoteness will not help acceptability of the geographical name as a trademark.

**Geographical names used fancifully**

Geographical names, used in a fanciful manner such as NORTH POLE or MOUNT EVEREST for banana, which are not likely to be indicating the origin of the goods, can be accepted.

**Names of rivers, seas and deserts etc.**

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Where the geographical location covers a large area (even if sparsely populated) and/or reputation in the goods, the application will face an objection.

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### **Names of suburbs of big cities**

In India many suburbs of Mumbai such as Andheri, Borivali or Bhendi Bazar etc., are as large and well-known as many towns. They should be considered as a town per se with comparable population figures. In the case of an application to register the name of district of Mumbai, Examiners should consider whether the name is likely to be seen as fanciful use of the name or as a plausible indication of geographical origin.¶

Mr. Anand submits that, as Switzerland is a large country with a population of almost 1 crore, the word –Swiss¶ is unregistrable as a trade mark under the Trade Marks Act. He has placed reliance, in this context, on the decision of the High Court of Calcutta in *Imperial Tobacco of India v Registrar of Trademarks*<sup>10</sup>, which holds –Simla¶ to be unregistrable as a trade mark.

### Section 9(2)(a)<sup>6</sup> of the Trade Marks Act

**29.** Section 9(2)(a)<sup>6</sup>, submits Mr. Anand, is also breached by the impugned mark, as the use of the impugned mark would deceive and confuse the public into believing that the goods bearing the impugned mark are of Swiss origin or bear an association with the Swiss Army or Switzerland, whereas, in fact, the goods are of Chinese origin and have no connection with Switzerland whatsoever. Likelihood of confusion or deception would suffice to attract this clause, submits Mr. Anand; actual confusion or deception need not be shown. Distinguishing between –confusion¶ and –deception¶, Mr. Anand submits that if the customer is in a stage of wonderment as to the existence of a connection, it indicates –confusion¶, whereas, if he, acting on the basis of the confused impression that is conveyed,

proceeds to make a purchase, he is –deceivedll. He cites, for this purpose, para 6 of the report in *Shree Nath Heritage Liquor Pvt Ltd v. Allied Blender & Distillers Pvt Ltd*<sup>11</sup> and *Allied Blenders and Distillers Pvt. Ltd. v. Sentino Bio Products Pvt. Ltd.*<sup>12</sup> and the decision of the House of Lords in *Parker-Knoll Ltd. v. Knoll International Ltd.*<sup>13</sup>. Likelihood of confusion, submits Mr. Anand, relying on *Laxmikant V. Patel v. Chetanbhai Shah*<sup>14</sup>, is all that is required to disentitle the mark to registration; not actual confusion. In this context, Mr. Anand submits that the onus is always on the applicant seeking registration of its mark to establish the existence of a geographical connect between the goods on which the mark is used and the location to which the mark adverts, for which he relies on para 6 of *Amritdhara Pharmacy v Satya Deo Gupta*<sup>15</sup> and *In Re Dunn's Trade-marks.*<sup>16</sup>.

**30.** On the aspect of likelihood of confusion or deception, paras 27 to 29 of the impugned order read thus:

-27. Now, if we see the impugned trademark in the Indian context, the defense forces in India – be it – the army or military, air force or navy, *all are held in high respect as performing the sovereign function to protect and defend the territorial sovereignty and integrity of the country. They are never regarded as entities involved in commercial activities and doing trade or business in the impugned goods i.e. textile items, and for the purpose having or using trade or business marks. Therefore, to my mind, the adoption of the impugned trademark by the applicant in India in respect of the impugned goods is only arbitrary and fanciful and can't be said to be non-distinctive or descriptive of geographical origin of goods or termed as a false trade description or amounting to false swiss designation or said to be malafide with a view to confuse or mislead the consumers in India to think that the impugned goods*

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<sup>10</sup> AIR 1977 Cal 413

<sup>11</sup> 221 (2015) DLT 359 (DB) : (2015) 63 PTC 551 (DB)

<sup>12</sup> 2014 SCC OnLine Del 3423

<sup>13</sup> 1962 RPC 265

<sup>14</sup> (2002) 3 SCC 65

<sup>15</sup> (1963) 2 SCR 484

<sup>16</sup> [L.R.] 41 Ch.D. 439

*originate from the opponent or from the Swiss military or from Switzerland and thereby causing confusion and/or deception amongst the consumers and tricking them to buy those goods. To my mind, the impugned trademark is fairly capable of distinguishing the applicant's goods from those of others including the opponent in India. The contentions of the opponent to the contrary are accordingly rejected.*

28. Further, given the fact that *there is no cogent evidence by the opponent on record to show any use of SWISS MILITARY as a trademark in the course of trade in India in respect of the impugned goods or in respect of goods of the same description or in respect of any, allied or cognate goods, or to show .any reputation or goodwill enjoyed by SWISS MILITARY as a trademark in the course of trade of any such goods in India or of any transborder reputation therein trickling or being recognized in India in respect of any goods, the adoption of the impugned trademark by the applicant in India can't be said to be malafide or in bad faith done to usurp any reputation or goodwill of the opponent or of the swiss defense forces in the trademark SWISS MILITARY or to pass off its goods as those originating or coming from the opponent or from the Swiss military or from Switzerland.*

29. Thus, the adoption of the impugned trademarks by the applicant in India seems fairly honest and independent of the opponent or of any goodwill or reputation of the opponent or of the Swiss defense forces including the Swiss military in respect of SWISS MILITARY as a trademark or as Swiss designation.¶

(Emphasis supplied)

Mr. Anand submits that the finding of the learned Deputy Registrar, that people would not assume, from the impugned mark, that the goods on which the mark was affixed were of Swiss Origin, was no more than his *ipse dixit*. No basis for the finding is forthcoming in the impugned order.

Section 11(3)(a) of the Trade Marks Act read with the Geneva Conventions Act, 1960, the (Swiss) Federal Act on the Protection of Trade Marks and Indications of Source, the (Swiss) Ordinance On The Register Of Appellations Of Origin and Geographical Indications for Non-Agricultural Products Regulations and the Paris Convention for the protection of the Industrial Property



**31.** Mr. Anand next trains his sights on Section 11(3)(a) of the Trade Marks Act, juxtaposed with various other statutory provisions, Indian as well as foreign.

**32.** At this juncture itself, I deem it appropriate to observe that the words –by virtue of any law, employed in Section 11(3)(a), howsoever widely construed, cannot embrace laws enacted in foreign jurisdictions, which have not been made specifically enforceable in India in a manner known to law. The expression –any law has, therefore, to be understood as referring to laws in force in India, and not laws in force anywhere in the world. Else, the learned Deputy Registrar would have to conduct global checks of all laws in force across the world before registering a mark. That, quite obviously, cannot be the intent of Section 11(3)(a).

**33.** I do not, therefore, intend to refer to the the (Swiss) Federal Act on the Protection of Trade Marks and Indications of Source, the (Swiss) Ordinance On The Register Of Appellations Of Origin and Geographical Indications for Non-Agricultural Products Regulations, which are laws in force in Switzerland with no extra-territorial application extending to India.

**34.** Section 11(3)(a) of the Trade Marks Act prohibits registration of a trademark if its use in India is liable to be prevented –by virtue of any law in particular the law of passing off protecting an unregistered trade mark used in the course of tradell. The words –any law submits Mr. Anand are compendious and all-embracing and would, in his submissions, cover not only domestic but also international law. He seeks to substantiate his allegation that the registration of the

impugned mark would infract Section 11(3)(a) as under:

(i) Mr. Anand first draws my attention to the Geneva Conventions Act, 1960, particularly Sections 12(d) and 12(e)<sup>17</sup> thereof. These provision, he submits, clearly prohibit use of the red and white cross, being the heraldic emblem of Switzerland, by any person for any purpose. He submits that the impugned order has dismissed this contention by merely observing that, in the application submitted by Respondent 2, the mark was in the form of a white cross on a black background, and not a white cross on a red background. Mr. Anand submits that the impugned order, thereby, ignores the actual mark which was being used by Respondent 2.

(ii) In this context, Mr. Anand invites my attention to the 13<sup>th</sup> Lok Sabha debates at the time of tabling of the Trade Marks Bill 1999. The 13<sup>th</sup> Loksabha Debates, with respect to Clause 11(3)(a) of the Trade Marks Bill, which was later enacted as Section 11(3)(a) in the Trade Marks Act, recommended as under:

-Regarding the clause 11(3)(a) providing for a relative ground of refusal of registration by virtue of law of copyright *should be further elaborated* so as to protect India's commitments under the Universal and the Berne Copyright Conventions as endorsed by Parliament in the International Copyright Order 1991 as also its obligations under the TRIPS Agreement of the GATT.¶

(Emphasis supplied)

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<sup>17</sup> 12. **Prohibition of use of Red Cross and other emblems.** – No person shall, without the approval of the Central Government, use for any purpose whatsoever –

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(d) the emblem of a white or silver cross with vertical and horizontal arms of the same length on, and completely surrounded by, a red ground, being the heraldic emblem of the Swiss Confederation; or

(e) any design or wording so nearly resembling any of the emblems or designations specified in the preceding clauses of this section so as to be capable of being mistaken for, or, as the case may be, understood as referring to, one of those emblems.

The binding nature of India commitments under the Universal and the Berne Copyright Convention was, therefore, submits Mr. Anand, recognized even in the Lok Sabha debates which preceded the enactment of the Trade Marks Act in 1999.

(iii) Mr. Anand next refers to Clause (1)(a) in Article 6<sup>ter</sup><sup>18</sup> of the Paris Convention for the Protection of the Industrial Property (herein after –the Paris Convention), which, he submits, is binding on India, as India was a member country of the Convention. The impugned mark, points out Mr. Anand, clearly violates Article 6<sup>ter</sup>(1)(a) of the Paris Convention, as it represents the flag of the Swiss Confederation.

(iv) To buttress these contentions, Mr. Anand also invokes Section 57(8)<sup>19</sup> of the Indian Evidence Act, 1872 (—the Evidence Act), which requires Courts to take judicial notice of the national flag or States or Sovereigns recognized by the Government of India.

**35.** Mr. Anand submits that the impugned order does not deal with the submissions of the appellant at all. Paras 30 to 47 of the impugned order, which address these submissions, read thus:

“30. The opponent has vehemently pressed that the impugned trademark is prohibited under Article 6<sup>ter</sup> and 10bis the Paris of

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<sup>18</sup>(1)(a) The countries of the Union agree to refuse or to invalidate the registration, and to prohibit by appropriate measures the use, without authorization by the competent authorities, either as trademarks or as elements of trademarks, of armorial bearings, flags, and other State emblems, of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them, and any imitation from a heraldic point of view.

<sup>19</sup> **57. Facts of which Court must take judicial notice.** – The Court shall take judicial notice of the following facts:

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(8) The existence, title, and national flag of every State or Sovereign recognized by the Government of India:

Convention for Protection of Industrial Property. Additionally, the Ld. Counsel for the opponent has, during the hearing, contended that the impugned trademark is barred by the provisions of Article 22.

31. At the outset, it is to be borne in mind that India is a sovereign country governed by its own laws. The registration of trademarks in India is governed by the Trade Marks Act, 1999 and rules framed thereunder. Therefore, the validity and entitlement of the impugned trademark for registration is to be tried and tested in accordance with the provisions of the Trade Marks Act and rules.

32. The Trade Marks Act and rules do not provide for any objection to any application for registration of a trademark on ground that it violates the provisions of the Paris Convention or TRIPS. However, as an obligation of the Country towards international conventions, I deem it fit to consider the said objection raised by the opponent.

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35. Further, the registration and protection of geographical indication in India is governed by the Geographical Indications (Registration and Protection) Act, 1999 and rules framed thereunder. Any geographical indications to have statutory protection from unauthorized use are to be registered under the GI law of India.

36. As already stated earlier, India is a sovereign country governed by its own laws. Even it is accepted for a moment that the impugned mark is a Swiss appellation/geographical indication under Swiss laws, the same is of no effect as the Swiss laws have no force and applicability within India and from my personal knowledge SWISS MILITARY is not registered as a geographical indication in India under the provisions of the Geographical Indication (Registration and Protection) Act, 2002.

37. Thus, Article 22 of the TRIPS relating to protection of geographical indication has no applicability to the present matter. The contention of the opponent is accordingly rejected.

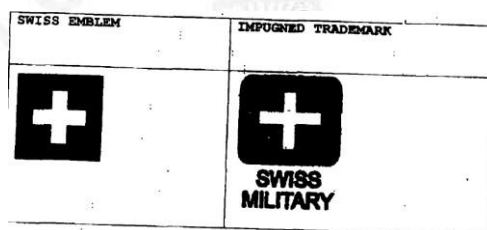
38. Further, given that SWISS MILITARY is not a registered geographical indication in India, I also reject the contention of the opponent that the impugned trademark amounts to falsely applying the trademark involving a wrongful indication of source/appellation/geographical indication, therefore, barred by the provisions of Sections 102, 103 of the Trade Marks Act, 1999.

39. Now, Article 6<sup>ter</sup> of the Paris Convention contains prohibitions concerning use, without authorization by the competent authorities, either as a trademark or as elements of

trademarks, of armorial bearing, flags, and other State emblems, of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them, and any imitation from a heraldic point of view.

40. The opponent contends that the Swiss emblem of Swiss Cross comprising of a white cross with vertical and horizontal arms of the same length on, and completely surrounded by, a red ground, is a heraldic emblem of the Swiss confederation. The impugned trademark comprising white cross on a black background is identical/substantially similar to/slavish imitation of the said Swiss emblem, therefore, prohibited under Article 6<sup>ter</sup> of the Paris Convention.

41. In order to appreciate the above contention raised by the opponent, the Swiss emblem and the impugned trademark are reproduced as under –



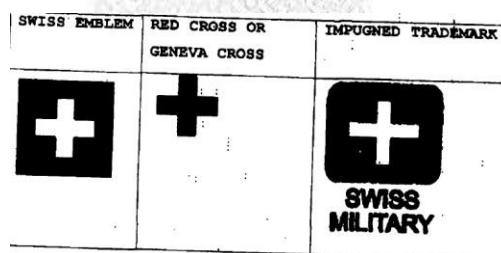
42. As could be seen, the Swiss emblem of Swiss Cross comprises of a white cross completely surrounded by a red ground in square shape. The vertical and horizontal arms of the cross are of the same length and width. On the other hand, the impugned trademark is a composite label in black and white color scheme. It comprises of a device of white cross surrounded by a black ground in square shape with rounded corners and underneath the word SWISS followed by the word MILITARY below it as prominent and essential feature of the mark. The vertical and horizontal arms of the cross used in the impugned trademark do not appear to be of the same length and width. Even if one compares the device of cross in the impugned trademark with the Cross in the Swiss emblem, the Swiss Cross has a particular symmetry and colour scheme which is completely different from the device of cross in the impugned trademark which is white in colour surrounded by black ground in square shape with rounded corners. Thus, not only after thoughtful consideration and comparison of two marks as a whole but also in the first impression, the two marks appear different from each other. The Ld. Counsel for the opponent has argued that in case the impugned trademarks in registered in black and white, as per section 10 of the Trade Marks Act, 1999, it would be deemed to be registered for all colors, therefore, color of the impugned trademark is not of much significance for the purpose of comparison of the marks. I do agree with the Ld. Counsel for the opponent to the extent he says that as per section 10, a mark if registered in black and white colour would be deemed to be

registered for all colors, however, it doesn't naturally follow from this that the mark would be deemed to be registered in every possible color scheme/combination of colors including the color scheme/combination of colors of the Swiss emblem. Thus, to my mind, the contention of the opponent that the impugned trademark comprising white cross on a black background is identical/substantially similar to/slavish imitation of the Swiss emblem of Swiss Cross, therefore, prohibited under Article 6ter of the Paris Convention doesn't hold good and is liable to be rejected.

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45. Another contention of the opponent as argued by the Ld. Counsel is that the registration of the impugned trademark is barred by the provisions of Section 12(a), (d) and (e) of the Geneva Conventions Act, 1960, respectively, prohibiting use of Red Cross or Geneva Cross, the Swiss emblems as well as any design or wording so nearly resembling to said designations or emblem as to be capable of being mistaken for or as referring to them.

46. In order to appreciate the above contention raised by the opponent, the Swiss emblem, the Red Cross or the Geneva Cross and the impugned trademark are reproduced herein below –



47. Having already held that the impugned trademark is different from the Swiss emblem of the Swiss Cross, for the same reasons, I hold that the impugned trademark as a whole as well as the device of white cross on black ground therein even separately, are different from the 'RED CROSS' or 'GENEVA CROSS'. Therefore, the provisions of Section 12(a), (d) and (e) of the Geneva Conventions Act, 1960 have no applicability in the present matter.

Mr. Anand submits that these findings are totally unsustainable in law, for the reasons already cited *supra*.

### Submissions of Mr. Akhil Sibal on behalf of Respondent 2

**36. Responding to the submissions of Mr. Anand, Mr. Sibal**


submits that the respondent is the prior user of the impugned mark and is using the mark since 1989, continuously. As against this, it is pointed out that the appellant has no registered trademark, similar to the impugned article, in India. All applications of the appellant, for registration of the ‘SWISS MILITARY’ marks, it is pointed out, are on –proposed to be used basis, and are pending with the Registry of Trade Marks. Besides, points out Mr. Sibal, all applications, including the international application filed by the appellant, have been filed after the registration of the impugned marks in favour of Respondent 2 in India.

**37.** Mr. Sibal also advances a preliminary objection to the reliance, by Mr. Anand, on promotional or advertising material to contend that Respondent 2 was promoting its goods, bearing the impugned mark, in such a fashion as to lure consumers into drawing an association between the goods and Switzerland, by, for example, showing the Swiss Alps in the background, or the Swiss flag in the foreground. He submits that this Court is presently hearing an appeal against an order allowing registration of the impugned mark and declining the objections of the appellant against such registration. The manner in which the marks are used, he submits, is not a factor which is relevant in this regard. Registration of a mark, he submits, cannot be allowed or refused depending on the manner in which the applicant for registration is making use of the marks.

Re. Sections 2(1)(i)(I) and 2(1)(i)(IV)(a) of the Trade Marks Act

**38.** Mr. Sibal refutes the allegation of Mr. Anand that the impugned mark amounts to a –false trade description within the

meaning of Section 2(1)(i)(I) of the Trade Marks Act. He also draws attention, in this context, to the definition of –trade description as contained in Section 2(1)(za)(iv)<sup>20</sup>. In view of these definitions, Mr.

Sibal submits that the impugned mark, i.e. , must inherently and unequivocally indicate, to the customer, that the goods, on which the mark figures, were made in Switzerland. The finding to the contrary, in the impugned order is, he submits, unexceptionable. Even if the impugned mark were to suggest some possible Swiss connection, he submits that it does not indicate, in any manner, that the goods were made in Switzerland. Inasmuch as Section 9 contains absolute grounds for refusing registration, its provisions have to be strictly construed. He submits that it would be unrealistic to presume that the consuming public would, because of the use of the impugned marks by Respondent 2, deem the goods, on which they are used, to emanate from the Swiss defence forces. The aspect of –false trade description, he submits, has to be examined from the perspective of an Indian consumer of average intelligence. He echoes the observation, in the impugned order, that defence forces, of any country, are held in high esteem and respect and submits, therefore, that the general public would never accept the fact that the armed forces of Switzerland would be engaged in trading or business activities. If Mr. Anand’s submissions were to be accepted, Mr. Sibal submits that marks such as ‘PETER ENGLAND’ and ‘AMERICAN TOURISTER’ would become unregistrable.

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<sup>20</sup> (za) –trade description means any description, statement or other indication, direct or indirect, -

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(iv) as to the place or country in which or the time at which any goods or services were made, produced or provided, as the case may be;



39. Besides, submits Mr. Sibal, the impugned mark could be regarded as a –false trade description|| only if, inherently and *per se*, the mark, represented that the goods on that which it is affixed were manufactured in Switzerland. No material to so suggest, he submits, is forthcoming, especially apropos textiles, with respect to which registration has been granted to the impugned mark.

40. Without prejudice, Mr. Sibal submits that there does, in fact, exist a connect between the impugned mark and Switzerland, as (i) Respondent 2 is based in Switzerland, (ii) the mark was initially adopted by the Boegli family, which was based in Switzerland, who later assigned rights in respect of the mark to Respondent 2 *vide* assignment deed dated 13<sup>th</sup> December 2014, (iii) Ashok Sawhney, the Non-Executive Director of Respondent 2 started his career in Switzerland and (iv) refills, for the goods or Respondent 2, were manufactured in Switzerland.

41. In any case, submits Mr. Sibal, even if the impugned mark were to amount to a –false trade description||, that does not constitute a ground to refuse it registration either under Section 9 or Section 11. The consequences of registration of a mark which is a false trade description, he points out, are to be found in Sections 103<sup>4</sup> and 104<sup>21</sup>


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<sup>21</sup> **104. Penalty for selling goods or providing services to which false trade mark or false trade description is applied.** – Any person who sells, lets for hire or exposes for sale, or hires or has in his possession for sale, goods or things, or provides or hires services, to which any false trade mark or false trade description is applied or which, being required under Section 139 to have applied to them an indication of the country or place in which they were made or produced or the name and address of the manufacturer, or person for whom the goods are manufactured or services provided, as the case may be, are without the indications so required, shall, unless he proves,—

- (a) that, having taken all reasonable precautions against committing an offence against this section, he had at the time of commission of the alleged offence no reason to suspect the genuineness of the trade mark or trade description or that any offence had been committed in respect of the goods or services; or
- (b) that, on demand by or on behalf of the prosecutor, he gave all the information in his power with respect to the person from whom he obtained such goods or things or services; or
- (c) that otherwise he had acted innocently,

of the Trade Marks Act.

Re. Section 9(1)(b)<sup>5</sup>


42. Mr. Sibal would contend that the appellant is estopped from invoking Section 9(1)(b)<sup>5</sup>, as it has itself applied for registration of the word mark SWISS MILITARY<sup>6</sup> and the device mark  SWISS MILITARY. He submits that Section 9(1)(b)<sup>5</sup> engrafts an absolute proscription against registration, which is not dependent on the identity of the applicant. He relies, for this purpose, on *Indian Hotels Co. Ltd v. Jiva Institute of Vedic Science & Culture*<sup>22</sup>.

43. On merits, Mr. Sibal emphasises the word –exclusively, figuring in Section 9(1)(b)<sup>5</sup>. He submits that the proscription in Section 9(1)(b)<sup>5</sup> applies only to marks which –consist *exclusively* of marks or indications which may serve in trade to designate the geographical origin of the goods. The impugned mark, he submits, does not consist exclusively of marks or indications which designate the geographical origin of the goods on which it is used, as it is a composite mark with a black and white cross and the words SWISS MILITARY<sup>6</sup>. He submits that the appellant has led no evidence to establish that the red and white cross () or the words SWISS MILITARY<sup>6</sup> serve in trade, in India, to designate the geographical origin of textiles, on which they are used. The impugned order, therefore, is correct in holding that they are fanciful when used in relation to textiles. Additionally, as the grant of registration to the

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be punishable with imprisonment for a term which shall not be less than six months but which may extend to three years and with fine which shall not be less than fifty thousand rupees but which may extend to two lakh rupees

<sup>22</sup> 2008 SCC OnLine Del 1758 : (2008) 37 PTC 468 (DB)

impugned device mark  is subject to the disclaimer that no exclusivity would be claimed in respect either of the black and white cross or of the 'SWISS MILITARY' phrase that figures below it, Section 9(1)(b) would not apply.

44. In this context, Mr. Sibal also invites attention to Section 11(2)(a)<sup>23</sup> of the Geographical Indications of Goods (Registration and Protection) Act, 1999 (–the GI Act). The restraints and restrictions to which Mr. Anand alludes, submits Mr. Sibal, would apply only to an application for registration under Section 11(1) of the GI Act, and not to an application under the Trade Marks Act.

45. Mr. Sibal also relies on an order dated 5<sup>th</sup> December 2019 of the Higher Regional Court at Hamburg which holds that the cross-shaped logo was not invariably associated with goods produced in Switzerland. The test, he reiterates, has to be that of the perception of the average consumer, who would not, by the mere use of the impugned mark, be drawn to presume that the goods on which they find place originated in Switzerland. Mr. Sibal also cites, in this context, a judgement of the High Court of Gujarat in *Sahkar Seeds Corpn. v. Dharti Seeds*<sup>24</sup> which held the logo 'Vadhiyar Bij' not to

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<sup>23</sup> 11. **Application for registration.** –

(1) Any association of persons or producers or any organisation or authority established by or under any law for the time being in force representing the interest of the producers of the concerned goods, who are desirous of registering a geographical indication in relation to such goods shall apply in writing to the Registrar in such form and in such manner and accompanied by such fees as may be prescribed for the registration of the geographical indication.



(2) The application under sub-section (1) shall contain –

(a) a statement as to how the geographical indication serves to designate the goods as originating from the concerned territory of the country or region or locality in the country, as the case may be, in respect of specific quality, reputation or other characteristics of which are due exclusively or essentially to the geographical environment, with its inherent natural and human factors, and the production, processing or preparation of which takes place in such territory, region or locality, as the case may be;

<sup>24</sup> 2017 SCC OnLine Guj 2577

be misleading as Vadhiyar, as a geographical area in Gujarat, was not known for the production of seeds (–*Bijll* being the vernacular equivalent of –seeds||).

Re. Section 9(2)(a)<sup>6</sup>

46. Section 9(2)(a)<sup>6</sup>, too, is not available to the appellant, according to Mr. Sibal, as the appellant's own licensees are using the marks 'Wenger' (  WENGER ) and 'Swiss Gear' ( SWISS  GEAR ) with a white cross on a red background (in relation to goods not manufactured in Switzerland, but in China, Hong Kong, etc, for which he has relied upon promotional material available on the internet. From the same material, Mr. Sibal points out that Wenger was taken over by the Victorinox group in 2005 and that Swiss Gear was owned by Wenger. He has, in context, referred to the Affidavit filed by the appellant before the learned Deputy Registrar of Trade Marks in support of its opposition to the application of Respondent 2 in which it is affirmed that the Swiss Government and Victorinox had concluded a licence agreement which allowed Victorinox to use the trade marks 'SWISS ARMY' or 'SWISS MILITARY'.

47. On merits, Mr. Sibal submits that Section 9(2)(a) would apply only where the mark, *by its very nature*, is confusing or deceptive. Given the principle of territoriality that attaches to trade marks – for which he cites *Toyota Jidosha Kabushiki Kaisa v. Prius Auto Industries Ltd*<sup>25</sup> – Mr. Sibal contends that the likelihood of deception or confusion has to be assessed on the basis of the inherent nature of the mark; not its use, and has to be tested in the Indian context

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<sup>25</sup> (2018) 2 SCC 1

keeping in mind the class of consumers who would purchase the goods in India. Indian consumers, submits Mr. Sibal, are unlikely to be deceived or confused, merely by the use of the impugned mark, that the goods on which they are affixed or found are manufactured by the military establishment in Switzerland. The appellant, he points out, has not cited any example of actual confusion having so arisen. The impugned mark cannot, he submits, be compared, for example, with a mark like 'SWISS MADE', which would unequivocally point to the goods having been made in Switzerland.

**48.** The findings, in the impugned order, on this issue, he submits are not, therefore, perverse, as would justify interference by this Court.

Re. Section 11(3)(a) – the Paris Convention, the Geneva Convention and the Geneva Conventions Act, 1996

**49.** As in the case of Sections 9(1)(b) and 9(2)(a), the appellant, argues Mr. Sibal, is also estopped from invoking Section 11(3)(a) of the Trade Marks Act as, despite having any approval from the Central Government, the appellant has itself applied for registration of the red and white cross device.

**50.** Mr. Sibal fundamentally disagrees with Mr. Anand's understanding of the phrase -any law in Section 11(3)(a) of the Trade Marks Act. He submits that, contextually read, the words -any law cannot be read as referring to any law in force in India, much less any law in force anywhere in the world. He predicates this argument on the following propositions:

(i) The words –in particular the law of passing off protecting an unregistered trade mark used in the course of trade, as well as clause (b) of Section 11(3) which refers to the –law of copyright, clearly indicate that the –law that the phrase –any law in Section 11(3)(a) encompasses must be a law relating to intellectual property, or involving intellectual property rights.

(ii) Section 11(3)(a) is subject to Section 11(5)<sup>26</sup>. Section 11(5) ordains that a mark shall not be refused registration under, *inter alia*, Section 11(3) unless an objection is raised in opposition proceedings by *the proprietor of the earlier trade mark*. Thus, the right to object under Section 11(3) is available only to the proprietor of an earlier trade mark. The appellant does not own any earlier trade mark. That apart, this specification indicates that the words –any law employed in Section 11(3)(a) relates to laws impacting proprietorial rights in an earlier trade mark. They cannot, therefore, be read so widely as to encompass statutes such as the Geneva Convention Act, which has nothing whatsoever to do with trade mark law.

(iii) The words –any law have to be read *noscitur a sociis* with the law relating to passing off and –copyright law. Mr. Sibal relies, for this purpose, on ***Rohit Pulp & Paper Mills v. Commissioner of Central Excise***<sup>27</sup>.

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<sup>26</sup> (5) A trade mark shall not be refused registration on the grounds specified in sub-sections (2) and (3), unless objection on any one or more of those grounds is raised in opposition proceedings by the proprietor of the earlier trade mark.

51. The Paris Convention, submits Mr. Sibal, has not been ratified by way of any law enacted under Article 253<sup>28</sup> of the Constitution of India; ergo, the petitioner cannot seek any relief on the basis thereof. He relies, for this purpose, on the judgement of the Supreme Court in *Ashwani Kumar v. U.O.I.*<sup>29</sup> He also relies on the decision of U.S. Court of Appeals in *International Café S.A.L. v. Hard Rock Café International Inc.*<sup>30</sup> which holds that the Paris Convention is not self-executing in nature without domestic legislation through which it can be implemented. To the same effect, he submits, is the decision of the U.S. Court of Appeals in *Empresa Cabana del Tabaco v. Culbro Corporation*<sup>31</sup>, which was affirmed in *I.T.C. Ltd v. Punchgini Ltd*<sup>32</sup>. In fact, points out Mr. Sibal, though the 13<sup>th</sup> Lok Sabha Debates advocated the elaboration of Clause 11(3)(a) of the Trade Marks Bill, 1999, to protect India's commitments under international conventions, this never happened.

52. Adverting next to the Geneva Convention and the Geneva Convention Act, Mr. Sibal submits that, unlike the Emblems and Names (Prevention of Improper Use) Act, 1950, which was specifically incorporated by reference in the Trade Marks Act, making marks which infringed the said Act non-registerable, no equivalent provision with reference to the Geneva Conventions Act was incorporated by the legislature. In the absence of any such specific incorporation, he submits that a trade mark could not be denied registration on the ground that grant thereof would violate the

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<sup>27</sup> (1990) 3 SCC 447

<sup>28</sup> 253. **Legislation for giving effect to international agreements.** – Notwithstanding anything in the foregoing provisions of this Chapter, Parliament has power to make any law for the whole or any part of the territory of India for implementing any treaty, agreement or convention with any other country or countries or any decision made at any international conference, association or other body.

<sup>29</sup> (2020) 13 SCC 585

<sup>30</sup> 252 F. 3d. 1274

<sup>31</sup> 399 F. 3d. 462

Geneva Conventions Act.

**53.** Section 12 of the Geneva Conventions Act, submits Mr. Sibal, is, moreover, not directed towards use of trade marks in particular. Article 53 of the 1<sup>st</sup> Geneva Convention, on the other hand, specifically refers to use of trade marks; however, Article 53 has not been made enforceable by the Geneva Conventions Act or by any other statute. Mr. Sibal relies, in this context, on Sections 2(a)<sup>33</sup>, 3(1)<sup>34</sup> and 3(3)(a)<sup>35</sup> of the Geneva Conventions Act. Conjointly read, he submits, it becomes clear that, of the various Articles in the Ist Schedule to the Geneva Conventions Act, Article 50 alone has been made enforceable. Article 53 is not, therefore, enforceable at law. Adverting to Section 12, Mr. Sibal submits that the Section does not incorporate an absolute prohibition, as use of the white-and-red cross representing the Swiss insignia is permissible, albeit with the approval of the Central Government.

**54.** Mr. Sibal next specifically addresses clauses (d) and (e) of Section 12 of the Geneva Conventions Act. In his submission, neither clause would, even on facts, apply. Section 12(d), he submits, does not apply because (i) the trade mark of which the

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<sup>32</sup> 482 F. 3d. 135

<sup>33</sup> 2. **Definitions.** – In this Act, unless the context otherwise requires, -

(a) –Conventions means the Conventions set out in the Schedules; and the First Convention, the Second Convention, the Third Convention and the Fourth Convention mean the Conventions set out in the First, Second, Third and Fourth Schedules, respectively;

<sup>34</sup> 3. **Punishment of grave breaches of conventions.** –

(1) If any person within or without India commits or attempts to commit, or abets or procures the commission by any other person at, a grave breach of any of the Conventions he shall be punished, -

(a) where the offence involves the wilful killing of a person protected by any of the Conventions, with death or with imprisonment for life; and

(b) in any other case, with imprisonment for a term which may extend to fourteen years.

<sup>35</sup> (3) For the purposes of this section, -

(a) a grave breach of the First Convention is a breach of that Convention involving an act referred to in Article 50 of that Convention committed against persons or property protected by that Convention;



impugned order allows registration contains a white cross on a black background, and not a red background and (ii) the arms of the cross are not of equal length, as noted by the learned Deputy Registrar. Section 12(e), he submits, applies only where the design is capable of being mistaken for the heraldic Swiss red cross. The impugned trade mark, in Mr. Sibal's submission, is not capable of being mistaken with the heraldic emblem of the Swiss confederation, especially as it is used with the words 'SWISS MILITARY'.

Order dated 7<sup>th</sup> April 2022 of the Cancellation Division of the European Union Intellectual Property Office (EUIPO)

**55.** In fact, submits Mr. Sibal, all the grounds on which the appellant seeks rectification of the Register in the present case by removal of the impugned mark therefrom, were raised by the appellant before the Cancellation Division of the EUIPO, and discredited by the EUIPO *vide* order dated 7<sup>th</sup> April 2022, against which the appellant has not appealed. The mark under challenge in that case was 'SWISS MILITARY by PSM', but the use of the words '-by PSM', he submits, would make no difference to the ratio of the said decision. The appellant cannot, therefore, he submits, re-agitate these issues all over again before this Court.

Re. Section 144 of the Trade Marks Act

**56.** The reference to '-trade usage' in Section 144<sup>8</sup> of the Trade Marks Act, submits Mr. Sibal, is intended to ascertain whether, owing to usage of the mark by other persons, it has become common to the trade, generic or wanting in distinctiveness. The expression is not intended to embrace the manner of usage of the mark by its

proprietor. No evidence of trade usage of the impugned mark in India, he submits, has been provided by the appellant. The judgements, on which Mr. Anand relies in this context, he submits, were rendered in the context of infringement claims, or relative grounds for refusal of registration, and not in the context of the absolute grounds envisaged by Section 9. Besides, as the application of Respondent 1 was on a –proposed to be used basis, prior usage became irrelevant.

Re. allegation of fabrication of invoices

57. Mr. Sibal, closing his submissions, addressed the allegation of Mr. Anand that Respondent 2 had relied on a fabricated invoice in support of its application seeking registration of the impugned mark. He points out that the allegation is predicated solely on the reference, in the said invoice, to the ₹ symbol to denote the Indian Rupee, allegedly before the symbol had been officially notified by the Government. He first submits that no such contention was ever advanced by the appellant before the learned Deputy Registrar of Trade Marks in support of its opposition and cannot, therefore, be raised by the appellant for the first time in the present appeal. It is for this reason, points out Mr. Sibal, that the impugned order returns no finding on this aspect. In any event, as the application for registration of the mark, by the respondent, was on a –proposed to be used basis, this aspect was irrelevant. He clarifies that the use of the ₹ symbol was only due to the software used by his client. In any event, he points out that, apart from the said invoice, Respondent 1 had filed several other invoices to evidence sale of the products using the impugned mark during the period 2015 to 2017, apart from sales

figures certified by the Chartered Accountant.

**58.** Where, thus, the application for registration of the mark is not susceptible to rejection either under Section 9 or under Section 11 of the Trade Marks Act, Mr. Sibal submits that its registration is mandatory, and no discretion vests with the learned Deputy Registrar in that regard.


Mr. Anand's submissions in rejoinder

**59.** Mr. Anand submits, first, in rejoinder, that the EUIPO order dated 7<sup>th</sup> April 2022 would not apply because, unlike the law that applied in that case, under the Trade Marks Act in India, the onus to prove that the impugned mark does not create confusion or deception is on the applicant seeking its registration, whereas the onus to prove that a mark infringes an existing mark is on the plaintiff alleging infringement. He underscores the finding, of the EUIPO, that –potential deception unconnected to the quality of the goods/services provided under the mark, and which does not impact consumer protection, cannot lead to deceit under Article 7(1)(g) EUTMR. The position in Indian law, he points out, is different, as the test is –likelihood to result in confusion or deception, not actual deceit. Besides, in that case, the impugned mark was ‘SWISS MILITARY BY PSM’, which was different from the impugned mark in the present case. Again, the impugned mark in the EUIPO order did not make use of the cross, unlike the impugned mark before this Court. Drawing attention to the findings in the EUIPO order, Mr. Anand points out that the EUIPO, in that case, specifically held that –the expression ‘SWISS MILITARY’ in conjunction with ‘BY PSM’ rules out any connection to the Swiss Army or Swiss military

standards. Mr. Anand also points out that the EUIPO order does not consider the effect of the Geneva Convention Act, which applies only to India.

60. For the proposition that the manner of use, by Respondent 1, of the impugned mark was also relevant, Mr. Anand relies on *Amritdhara Pharmacy*<sup>15</sup>, *Louis Vitton Malletier*<sup>9</sup> and the judgement of the Queens Bench of the Court of Appeal in *Specsavers International Healthcare Ltd v Asda Stores Ltd*<sup>36</sup>.

61. Apropos Section 9(2)(a)<sup>6</sup>, Mr. Anand submits that deception or confusion could arise for any reason, which might or might not have any element of comparison with another mark. Switzerland being a well known confederacy, Mr. Anand submits that there is every likelihood of an unwary consumer in India linking the goods, on

which the impugned  is to be found, with Switzerland. Mr. Anand once again invokes, for this purpose, Section 57(8)<sup>19</sup> of the Evidence Act. The Court, in such cases, submits Mr. Anand, is required to envisage a market place and visualize what would happen if the goods, bearing the impugned mark, were sought to be sold there.

62. The principle of territoriality, submits Mr. Anand, would not apply in a case such as this. He seeks to distinguish *Toyota Jidosha Kabushiki Kaisa*<sup>25</sup> on the ground that, in that case, the defendant disclaimed all knowledge whereas, in the present, Respondent 1 has itself promoted the impugned mark in a manner to create an obvious association with Switzerland and also sought a licence from the

appellant.

**63.** Apropos Mr. Sibal's submission that the appellant's licencees were using a white cross on a red background as a logo for goods manufactured in China, Mr. Anand submits that this material was never cited before the learned Deputy Registrar and does not, therefore, form any part of the impugned order.

#### Mr. Sibal in surrejoinder

**64.** In surrejoinder, besides reiterating the submissions already advanced by him earlier, Mr. Sibal submits, with regard to Mr. Anand's repeated emphasis on the fact that Respondent 1 had sought a licence from the appellant, that the licence was sought for timepieces, with which Switzerland has an indelible association and reputation. The goods under consideration in the present case, *per contra*, he submits, are textiles.

#### **Analysis**

##### A Preliminary Observation

**65.** The right to have a trade mark registered is a valuable commercial right. Registration confers manifold rights and privileges under the Trade Marks Act. These rights and privileges operate *in rem* and against the whole world.<sup>37</sup> They are non-negotiable. Registration of a trade mark not only confers valuable brand value and goodwill, thereby promoting the goods and their

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<sup>36</sup> [2012] EWCA Civ 24

<sup>37</sup> Refer *Vidya Drolia v. Durga Trading Corporation*, (2021) 2 SCC 1

reputation in the market, but also restricts the rights and privileges of all others who, even unintentionally, may be using a confusingly similar mark. The right to registration must, therefore, be sedulously guarded. Any provision which abrogates, or even curtails, the right to registration of a mark as a trade mark has, therefore, to be strictly construed. The right of registration to a mark cannot be denied on fanciful apprehensions.

**66.** On the flip side, the Court is also required to be mindful of the proscriptions statutorily engrafted in Sections 9 and 11 of the Trade Marks Act. Where a mark is statutorily non-registerable under the said provisions, the Court cannot, by interpretative calisthenics, compel the Registrar to register it. The prohibitions against registration, as contained in Sections 9 and 11, have a public purpose to serve. They serve to counter-balance the rights of the industry and the rights of the consumer public. Confusion or deception of the consumer is completely impermissible in law. Howsoever innocent the user of the confusing mark may be, no equities lie in his favour. These considerations, too, therefore, have to guide the approach of the Court.

**67.** The Court is, therefore, required to strike, in such cases, a delicate balance while arriving at its conclusion.

I. Is the impugned mark a -false trade description||? If so, is it non-registerable?

**68.** Examination of these aspects would decide the submissions of both sides with respect to Sections 2(1)(i)(I) and 2(1)(za)<sup>2</sup> as well as

Section 9(2)(a)<sup>6</sup> of the Trade Marks Act.

**69.** The impugned order does not address these issues.

**70.** Mr. Anand submits that the impugned mark is non-registerable, as it amounts to a –false trade description. Mr. Sibal, *per contra*, contends that the impugned mark is not a –false trade description and that, even if it were, it does not, by consequence, become non-registerable *per se*, as the consequences of registering a false trade description are to be found in Sections 103<sup>4</sup> and 104<sup>22</sup> of the Trade Marks Act.

**71.** Are –false trade descriptions non registerable?

**72.** Where Section 2(1)(za)(iv)<sup>20</sup> applies, the answer, to my mind, has to be in the affirmative.

**73.** Section 2(1)(i) of the Trade Marks Act includes, in the definition of –false trade description, –a trade description which is untrue or misleading in a material respect as regards the goods or services to which it is applied. The provision goes on to clarify that trade marks, or parts of trade marks, could also be –false trade descriptions. –Trade description is defined, in Section 2(1)(za)(iv), as meaning –*any description, statement or other indication, direct or indirect, as to the place or country in which or the time at which the goods or services were made, produced or provided*. This includes, as per Section 2(1)(za), –any ... description which is likely to be misunderstood or mistaken for all or any of the said matters. Among the –said matters is, obviously, the place or country where

the goods are made. Section 9(2)(a) absolutely prohibits registration of a mark if –it is of such nature as to deceive the public or cause confusion. A trade description which is untrue or misleading in a material respect regarding the goods to which is applied is a false trade description. The country of manufacture of goods is certainly a –material respect, within the meaning of Section 2(1)(i)(I). If a trade mark is untrue or misleading regarding the country of origin of the goods on which it is used, there is no reason to believe that it would not deceive the public or cause confusion, as the intent to deceive or cause confusion can be read into the very use of the mark. One may, in this context, borrow the following well-known aphorism of Lindley, LJ in *Slazenger & Sons v. Feltham & Co.*<sup>38</sup>:

–One must exercise one's common sense, and, if you are driven to the conclusion that what is intended to be done is to deceive if possible, I do not think it is stretching the imagination very much to credit the man with occasional success or possible success. Why should we be astute to say that he cannot succeed in doing that which he is straining every nerve to do?!

Any description, statement or other indication, direct or indirect, as to the country of manufacture or production of goods, contained in the trade mark affixed on the goods would, therefore, be a –false trade description and, inasmuch as the mark would be of a nature which would deceive the public or cause confusion, would also be ineligible for registration under Section 9(2)(a).

**74.** A mark which is a –false trade description within the meaning of Section 2(1)(za)(iv) is, therefore, non-registerable.

**75.** Is, then, the impugned mark a –false trade description within

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<sup>38</sup> (1889) 6 RPC 531



the meaning of Section 2(1)(za)(iv) of the Trade Marks Act?

**76.** Any description, statement, or other indication as to the place or country where the goods were made or produced, as contained in a trade mark, would be a –trade description<sup>||</sup> within the meaning of Section 2(1)(za). The description may be direct or indirect. The definition would also encompass any description which is likely to be misunderstood or mistaken for an indication regarding the place or country where the goods are made or produced.

**77.** Much turns, in my view, on the words –direct or indirect<sup>||</sup>. The legislature, classically, does not engage in superfluity or tautology<sup>39</sup>. The words –direct or indirect<sup>||</sup> have, therefore, to be regarded as deliberately included. They connote, in the context of Section 2(1)(za)(iv), not merely a direct, but also an indirect description, statement or other indication, in the trade mark, regarding the place or country or manufacture or production of the goods. If, therefore, the trade mark even *indirectly indicates* the country of manufacture of the goods, it is a –trade description<sup>||</sup> within the meaning of Section 2(1)(za)(iv).

**78.** –Indirect<sup>||</sup> is defined, in P. Ramanatha Aiyar's Advanced Law Lexicon, as –describing something that is associated with, but not immediately connected to, something else; something at one removal<sup>||</sup>. The expression –direct or indirect<sup>||</sup>, as used in Section 2(1)(za), has to be read in conjunction with the inclusive part of the definition which, as used in the provision, is essentially clarificatory

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<sup>39</sup> Refer Dilbagh Rai Jerry v. U.O.I., AIR 1974 SC 130; C.I.T. v. R.M. Amin, (1977) 1 SCC 691; Umed v. Raj Singh, (1975) 1 SCC 76

in nature. By virtue of clause (c) of the –inclusive part of the definition of –trade description in Section 2(1)(za), any description –which is likely to be misunderstood or mistaken for the country of manufacture or production of the goods would also be a –trade description. If, therefore, the country of manufacture or production thus suggested by the use of the mark on the goods is not, in fact, their country of manufacture or production, the mark would be a –false trade description as defined in Section 2(1)(i)(I).

**79.** The words –likely to be misunderstood or mistaken as used in clause (c) of the inclusive part of the definition in Section 2(1)(za) and the phrase –untrue or misleading as used in Section 2(1)(i)(I) read with the expression, directly call, into application, the decision in *National Sewing Thread Co. Ltd v. James Chadwick & Bros*<sup>40</sup>, which dealt with Section 8<sup>41</sup> of the erstwhile Trade Marks Act, 1940, which, to an extent, is a combination of clauses (a) and (c) of Section 9(2) of the present Trade Marks Act, and also forbears registration of marks which are –likely to deceive or cause confusion. The learned Registrar of Trade Marks had, in that case, come to the conclusion, independent of any comparison of marks or goods, that, as the mark of which the respondent (before the Supreme Court) desired registration was likely to deceive or cause confusion, it could not be registered. The Supreme Court explained the legal position, on this aspect, thus (in para 22 of the report):

–22. The principles of law applicable to such cases are well settled. The burden of proving that the trade mark which a person seeks to register is not likely to deceive or to cause confusion is upon the applicant. It is for him to satisfy the Registrar that his

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<sup>40</sup> AIR 1953 SC 357

<sup>41</sup> –No trade mark nor part of a trade mark shall be registered which consists of, or contains, any scandalous design, or any matter the use of which would by reason of its being likely to deceive or to cause confusion or otherwise, be disentitled to protection in a court of justice. I

trade mark does not fall within the prohibition of Section 8 and therefore it should be registered. Moreover, in deciding whether a particular trade mark is likely to deceive or cause confusion that duty is not discharged by arriving at the result by merely comparing it with the trade mark which is already registered and whose proprietor is offering opposition to the registration of the mark. *The real question to decide in such cases is to see as to how a purchaser, who must be looked upon as an average man of ordinary intelligence, would react to a particular trade mark, what association he would form by looking at the trade mark, and in what respect he would connect the trade mark with the goods which he would be purchasing.*¶

(Emphasis supplied)

The above passage was cited, with approval, in *Nandhini Deluxe v. Karnataka Co-operative Milk Producers Federation Ltd*<sup>42</sup>.

80. In this context, the intellectual attributes of the man of –average¶ or –ordinary¶ intelligence stand delineated in the following passage from the decision of the High Court of England and Wales in *Compass Publishing B.V. v. Compass Logistics Ltd*<sup>43</sup>, which was approvingly cited and relied upon, by a coordinate Bench of this Court, in *The Coca-Cola Co. v. K.M. Salim*<sup>44</sup>:

–The test for likelihood of confusion has been considered in a number of ECJ decisions, including *Sabel BV v. Puma AG*<sup>45</sup>. The likelihood of confusion must be appreciated globally, taking account of all relevant factors. It must be judged through the eyes of the average consumer of the goods or services in question. *That customer is to be taken to be reasonably well informed and reasonably circumspect and observant, but he may have to rely upon an imperfect picture or recollection of the marks. The court should factor in the recognition that the average consumer normally perceives a mark as a whole and does not analyse its various details.* The visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components. Furthermore, if the association between the marks causes the public to wrongly believe that the respective

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<sup>42</sup> (2018) 9 SCC 183

<sup>43</sup> (2004) RPC 41

<sup>44</sup> 208 (2014) DLT 432

<sup>45</sup> (1998) RPC 199

goods come from the same or economically linked undertakings,  
there is a likelihood of confusion.¶

(Emphasis supplied)



**81.** Mr. Sibal repeatedly submitted that Section 9(2)(a) of the Trade Marks Act would be attracted only if the impugned mark *is of such nature* as to deceive the public or cause confusion. He is right, and I agree with him. Section 9(2)(a) does not allow the Court to travel outside the mark itself. The mark, *by its nature*, should deceive or cause confusion.

**82.** At the same time, the person who should be likely to be deceived or confused under Section 9(2)(a), or who may misunderstand the trade description within the meaning of clause (c) of the inclusive part of the definition of –trade description¶ in Section 9(1)(za), or who may be –misled¶ under Section 9(1)(i)(I), is a person of –ordinary intelligence¶, who –is to be taken to be reasonably well informed and reasonably circumspect and observant¶. In this context, the class of consumers who are likely to purchase the goods on which the mark is to be affixed is another relevant consideration, as held in *Amritdhara Pharmacy*<sup>15</sup> and *Mahendra & Mahendra Paper Mills Ltd v. Mahindra & Mahindra Ltd*<sup>46</sup>. The goods on which the impugned mark is used are generally purchased by the middle or upper middle class consumer in India.

**83.** Though the words ‘\_SWISS MILITARY’ when used either by themselves or in conjunction with the red and white cross may not provide any *direct* indication regarding the country of origin of the goods as would be likely to be misunderstood or mistaken as such,

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<sup>46</sup> (2002) 2 SCC 147

when the words ‘SWISS MILITARY’ are used in conjunction with the red-and-white cross , thus, any customer of average intelligence – which would presume knowledge of the fact that the red-and-white cross is the indicia of the Swiss confederation – would regard the mark as indicating that the goods are of Swiss origin. The  mark would, therefore, be an *indirect* trade description regarding the country where the goods, bearing the mark, are manufactured or produced. The *Slazenger*<sup>38</sup> principle would also directly apply in such a case. Respondent 1 having used not only the white cross-on-red background indicia but also the words ‘SWISS MILITARY’ below it, there is no justification for the Court to presume that the public would *not* be compelled into believing that the goods were made or manufactured in Switzerland. The impugned mark, therefore, *by its very nature*, has the potential to deceive or, at the very least, cause confusion.

**84.** The impugned order, in my opinion, goes completely off-tangent in extolling the virtues of the military establishment and holding, as a sequitur, that the average consumer would not regard goods such as textiles as originating from the Swiss army or the Swiss military forces, irrespective of the use of the impugned mark thereon. The virtues of the military arsenal of any country, though undeniably worthy of respect and reverence, have nothing whatsoever to do with the controversy at hand. Section 9(2)(a) does not expound on the *nature* of deception or confusion that it envisages. So long as the mark is of such nature as to deceive or confuse, it cannot be registered. The proscription is absolute. Read in conjunction with Sections 2(1)(i)(I) and clause (c) of the inclusive part of Section

2(1)(za), if the impugned mark deceives, or confuses, the average consumer into mistaking the goods to be manufactured or produced in Switzerland, i.e., of Swiss origin, it is immediately hit by Section 9(2)(a), as the goods are, admittedly, *not* of Swiss, but of Chinese, origin. Whether the average consumer would regard the goods as made or manufactured by the Swiss *army*, or the Swiss *military establishment* is, therefore, irrelevant. What has to be seen is whether the average consumer – with the intellectual abilities attributed to him by *Compass Publishing*<sup>43</sup> – would be deceived, or confused, into believing the goods to have been *manufactured or produced in Switzerland*, not *manufactured or produced by the Swiss army*.

85. –Deception|| and –confusion|| are different concepts, and, on the distinction between the two, the following exordium of Lord Denning in *Parker-Knoll Ltd v. Knoll International Ltd*<sup>47</sup> (cited, with approval by the Supreme Court, in, *inter alia*, *F. Hoffmann-La Roche & Co. v. Geoffrey Manner & Co. Pvt Ltd*<sup>48</sup>) has become *locus classicus*:

–Secondly, 'to deceive' is one thing. To 'cause confusion' is another. The difference is this: When you deceive a man, you tell him a lie. You make a false representation to him and thereby cause him to believe a thing to be true which is false. You may not do it knowingly, or intentionally, but still you do it, and so you deceive him. But you may cause confusion without telling him a lie at all, and without making any false representation to him. You may indeed tell him the truth, the whole truth and nothing but the truth, but still you may cause confusion in his mind, not by any fault of yours, but because he has not the knowledge or ability to distinguish it from the other pieces of truth known to him or because he may not even take the trouble to do so.||

I may usefully profit from the following clear understanding of the difference between –confusion|| and –deception||, *vis-à-vis* use of a

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<sup>47</sup> 1962 RPC 265

<sup>48</sup> (1969) 2 SCC 716

mark in the course of trade, from the judgement of a Division Bench of this Court in *Shree Nath Heritage Liquor*<sup>11</sup>:





-6. When a person knows that the mark in question does not originate from the senior user but the senior user is called to mind, then it's a step before confusion. If on the other hand, the consumer is in a state of wonderment if there's a connection, this is confusion. Further, if this consumer then purchases the junior users product, this is then deception.

Though this explanation is in the context of confusion between the marks used by a -junior and a -senior user, it would hold equally true on the aspect of distinction between confusion and deception in general. A person is confused when he does not know which is A and which is B. He is deceived when he is made to believe A to be B or B to be A. That, plainly, is the distinction.

**86.** Once this distinction is also borne in mind, the conclusion is obvious. The impugned mark, which not only uses the  Swiss insignia, but also the words -**SWISS MILITARY** below it, would clearly, at the very least, confuse the consumer of average intelligence into assuming the goods to have been manufactured or produced in Switzerland. The mark would, thereby, be a -false trade description and be ineligible to registration within the meaning of Section 2(1)(i)(I) as well as be rendered ineligible to registration under Section 9(2)(a) of the Trade Marks Act.

**87.** The observations, in the impugned order, that the impugned mark has rounded corners, and that the arms of the cross as used in it do not *appear* to be of the same length, fail to commend acceptance. To a person who views the mark as affixed on goods, these distinctions pale into significance. Mr. Sibal, in his arguments,

acknowledged the fact that the impugned mark, in a red-and-white combination, was actually registered in favour of Respondent 2 albeit for other items, and that it was using the said mark. Mr. Anand has drawn my attention to the actual use of the said mark, *inter alia* on a backpack, the photograph of which is to be found in para 24 *supra*. The mark, as actually used, does not make apparent, to the person viewing the mark, any difference in the lengths of the arms of the white cross, or any roundness in the edges of the corners of the square. In fact, para 7 of the affidavit filed by Respondent 2 in support of its application for registration acknowledges that Respondent 2 is the owner and proprietor –of *the said trademark/label which is duly registered in India under the Trade Mark Act, 1999* and proceeds to furnish a tabular statement of the said registration, which states that Respondent 1 holds registrations of

- (i) the mark  for key chains,
- (ii) the mark  for pens,
- (iii) the mark  for school bags, back packs, cross bags, soft luggage, travelling bags, purses, etc. and
- (iv) the mark  for leather and leather imitations, animal skins, hides, trunks, umbrellas, etc.

These marks are identical to the impugned mark. As such, the stress, in the impugned order, on the –rounded corners of the impugned mark is really superficial. Respondent 2 has had the same mark registered separately for various classes of goods. Mr. Sibal acknowledges that these registrations include registrations for the mark in the red-and-white colour combination. The learned Deputy Registrar, unfortunately, has erred in failing to notice these facts.








88. It is important, at this point, to advert to the observations of the learned Deputy Registrar on Section 10(2) of the Trade Marks Act, contained in para 42 of the impugned order. At the cost of repetition, they may once again be reproduced thus:

-The Ld. Counsel for the opponent has argued that in case the impugned trademarks is registered in black and white, as per section 10 of the Trade Marks Act, 1999, it would be deemed to be registered for all colors, therefore, color of the impugned trademark is not of much significance for the purpose of comparison of the marks. *I do agree with the Ld. Counsel for the opponent to the extent he says that as per section 10, a mark if registered in black and white colour would be deemed to be registered for all colors, however, it doesn't naturally follow from this that the mark would be deemed to be registered in every possible color scheme/combination of colors including the color scheme/combination of colors of the Swiss emblem.*


(Emphasis supplied)




To my mind, the italicized words in the afore-extracted passage from the impugned order return two mutually contradictory findings. In the first breath, the learned Deputy Registrar agrees that the registration of the impugned mark without limitation of colour would deem it to be registered *for all colours*. In the very same breath, he goes on to observe that it would not naturally follow that the mark would be deemed to be registered *in every possible colour scheme/combination of colours*. This distinction, between -all colours and -every possible colour scheme/combination of colours, to my mind, is too facile to pass legal muster. In any event, in the present case, there is only one colour involved, apart from black and white, which is red.

Once, therefore, the  mark stood registered for all colours, it also stands registered for use by substituting the black with a red background.

89. Further, the use, by Respondent 2, of the **-SWISS MILITARY** logo immediately below the white and red cross would dispel any chance of the impugned mark being distinct or distinguishable from the  Swiss insignia. Even if the  mark, with slightly rounded corners, were to be distinguishable from the mark with sharp corners, the use of the **'SWISS MILITARY'** logo below the mark would efface any impression made by that slight distinction. The  mark, even if its corners were not as pointed, when used with the **'SWISS MILITARY'** logo immediately below it, is bound, by its very nature, to create confusion in the mind of the ordinary customer regarding the origin of the goods. To my mind, this is obvious. An average consumer would be bound to presume, absence conscious knowledge to the contrary, that the goods bearing the  **SWISS MILITARY** logo are of Swiss origin, even if, *arguendo*, he were not to think that they originated from the Swiss military establishment specifically.





90. Though it is not necessary to do so, I may also observe that the finding, in the impugned order, that the average consumer would not assume the goods, on which the impugned mark would be affixed, to have originated from the Swiss military establishment, is no more than the *ipse dixit* of the learned Deputy Registrar, unsupported by any material whatsoever. It cannot, therefore, be sustained. The engaging, by military establishments, in trade, is not an unknown phenomenon; neither is it proscribed by law, at least in India. For that matter, prisons and penitentiaries are also not known to be ordinarily engaging in trade; nonetheless, we are aware of the Tihar Jail in Delhi regularly marketing all varieties of goods, including textiles and

garments, under the 'TJ' logo. Besides, the appellant has itself applied for registration of the  SWISS MILITARY device mark and the 'SWISS MILITARY' word mark for a variety of goods in a variety of classes, on -proposed to be used on a basis. The applications are on record. It cannot, therefore, be presumed that the appellant would not engage itself in manufacturing or trading activities. In any event, the learned Deputy Registrar could not have returned such a finding with no evidence, whatsoever, to support it.

91. For that matter, I do not see why, in facts such as these, the *Slazenger*<sup>38</sup> principle should not apply by analogy. There is no explanation, whatsoever, forthcoming for Respondent 1 choosing to use, in its trade marks, the red-and-white cross-and-square Swiss insignia, or the words „SWISS MILITARY“. The use of the  red-and-white cross-and-square Swiss insignia is not a right conferred on everyone, under Swiss law. The intent to confuse is obvious. The military establishment of a country would, by right, be entitled to use its official insignia. The use of the  insignia, therefore, imbues the mark with a veneer of officialdom. The use of , with „SWISS MILITARY“ below it, therefore, appears to be a clear attempt to confuse the unwary purchaser into drawing an association with the Swiss military establishment and the goods on which the mark is affixed. Applying *Slazenger*<sup>38</sup>, there is no reason for the Court to presume that the attempt of Respondent 2 would not be successful. To disclaim any possibility of confusion or deception on the ground that the corners of the square are not sharp but curved, or based on the comparative lengths of the two arms of the white cross would, to my mind, be mere hairsplitting. The average consumer can hardly be

expected to notice such fine details, especially where the mark is embossed or depicted on textiles. The likelihood of confusion or deception remains.

**92.** The impugned mark is, therefore, ineligible for registration under Section 2(1)(i)(I) read with Section 9(2)(a) of the Trade Marks Act.

**93.** Mr. Sibal had sought to contend that, as the appellant's licensees were using the  **WENGER** and **SWISS**  **GEAR** marks for goods which were not produced in Switzerland, the appellant was estopped from invoking Section 9(2)(a). I am unable to agree. In the first place, the proscription under Section 9(2)(a) is an *absolute* proscription, independent of the identity of the objector. Secondly, even on facts, the two marks cited by Mr. Sibal cannot estop the appellant from maintaining the present appeal. The reason is obvious from a glance at the marks. The  **WENGER** mark has -WENGER|| accompanying the white and red cross, thereby clearly displaying the identity of the licensee. The **SWISS**  **GEAR** mark does not even have a white and red cross. These cases, therefore, are not similar to the case of Respondent 2. They cannot, therefore, estop the appellant either from objecting to the impugned proposed mark of Respondent 2, or maintaining the present appeal.

## II. Section 144<sup>8</sup> of the Trade Marks Act


**94.** Mr Anand sought to rely on the manner in which Respondent 1 was advertising and promoting the goods on which the impugned mark was being used. He drew my attention to the advertisements of Respondent 1 which showed the Swiss flag and the snow clad Alps in

the background. Though Mr. Sibal opposed the reliance on the advertisements and promotional material on the ground that the proscription under Section 9(2)(a) applied only where the mark itself was –of such nature as to deceive or cause confusion, Mr. Anand relied on Section 144<sup>8</sup> to justify reference to the manner in which the mark was being advertised and promoted by Respondent 1 as a factor which was required to be borne in mind even when examining the entitlement of the mark to registration in the face of Section 9(2)(a)<sup>6</sup>.

**95.** I find myself in agreement with Mr. Sibal.





**96.** Section 144<sup>8</sup> requires the Registrar, in any proceeding relating to a trade mark, to admit evidence –of the usage of the trade concerned and of any relevant trade mark or trade name or get up legitimately used by other persons. The reference to the –usage of the trade concerned, when seen in conjunction with the immediately succeeding expression –any relevant trade mark or trade name or get up legitimately used by other persons obviously refers to the manner in which the trade mark, forming subject matter of the proceedings, is used *by the trade*. Usage of the trade is a factor which, in intellectual property law, especially in trade mark law, is relevant only while examining whether the mark would infringe any other existing mark, or result in the consuming public being confused or deceived into believing the goods of the proprietor of the trade mark to be the goods of another, prior user.

**97.** Respondent 2 had, in the present case, applied for registration of the impugned mark on a –proposed to be used basis. The impugned order also grants registration of the mark in favour of

Respondent 2 on a –proposed to be used basis|| in respect of textile items. The appellant does not seek to contend that, prior to the impugned order, Respondent 2 had been using the impugned mark for textile items. The manner in which Respondent 2 may have been utilising the  mark in respect of which it held other subsisting registrations for other items cannot, therefore, constitute a factor to be legitimately taken into consideration by the learned Deputy Registrar while adjudicating on the application forming subject matter of consideration in the present proceedings.

98. I am not inclined, therefore, to take into consideration the advertisements and promotional material of Respondent 2 with respect to the use of the impugned mark of other items, for which it holds separate registrations. Section 144 of the Trade Marks Act does not, in my opinion, justify any such exercise.

**III. Re: Section 9(1)(b)<sup>5</sup>**

99. Mr. Sibal sought to contend that the appellant was estopped from invoking Sections 9(1)(b) of the Trade Marks Act as the appellant had itself applied for registration of the word mark **‘SWISS MILITARY’** as well as the device mark  **SWISS MILITARY** and relies, for this purpose, on *Indian Hotels*<sup>22</sup>. Insofar as the impugned  **SWISS MILITARY** is concerned, the argument has no merit, as the  **SWISS MILITARY** and  **SWISS MILITARY** marks are different.

**100.** Mr. Anand sought to contend that the impugned mark was not eligible for registration in view of Section 9(1)(b) of the Trade Marks Act. Section 9(1)(b) absolutely prohibits registration of trade marks –which consist exclusively of marks or indications which may serve in trade to designate, *inter alia*, the geographical origin of the goods. Mr. Anand’s submission is that the impugned mark, which combines the white cross on a red background and the words –Swiss Military below it, serves in trade to designate the geographical origin of the goods on which the mark is affixed.

**101.** Mr. Anand has also relied, in this context, on the guidelines contained in the Manual of Trade Marks and the Registry of Trade Marks relating to the registrations of Trade Marks which indicate the geographical origin of the goods. According to Mr. Anand, under the said Trade Mark Manual, a trade mark which is the name of a large and well-known country cannot be registered at all. Switzerland being a large, well-known and well populated country, Mr. Anand submits that the guidelines contained in the Manual on Trade Marks completely proscribe registration of the words **SWISS MILITARY** as a trade mark.

**102.** Mr. Sibal relies, *per contra*, on the GI Act and the provisions contained therein for registration of a mark denoting the geographical origin of the goods. He submits that the establishment of a connection between the mark and the place of origin of the goods on which the mark is to be affixed is a pre-requisite under the GI Act, and not under the Trade Marks Act. He further submits that the words –Swiss Military cannot, by any stretch of imagination, be regarded as denoting the geographical origin of the goods on which the impugned

mark is to be affixed. He seeks to contradistinguish the impugned mark, for this purpose, with, for example, the –Made in Switzerland on –Swiss made marks. Section 9(1)(a), according to Mr. Sibal, apply to such latter marks, which unequivocally point towards the geographical origin of the goods, and not to a mark such as –Swiss Military.

**103.** Having heard learned Counsel, what is immediately apparent from a reading of Section 9(1)(b) of the Trade Marks Act is that the consumer or customer is a stranger to the said provision. The impression of the mark on the consumer, or any other third person, is irrelevant, where Section 9(1)(b) is concerned. Section 9(1)(b) is only concerned with what the mark serves to designate in trade. It applies to marks which serve, in trade, to designate, *inter alia*, the geographical origin of the goods (to the extent the provision concerns the controversy at hand).

**104.** Unlike Section 9(2)(a), therefore, Section 9(1)(b) is concerned with what the applicant seeking registration of the mark intends to convey. The word –geographical origin, finding place in the company of the words –kind, –quality, –quantity, –intended purpose, –values, and –time of production, is required to be interpreted *noscitur a sociis* and *ejusdem generis* with the said expressions. They obviously refer to the normal recitals contained on packages giving particulars of the goods. In the company of these expressions, a mark can be said to –designate the geographical origin of the goods only where it unequivocally does so. Section 9(2)(a), would stand attracted even in a situation in which the mark, though it does not unequivocally indicate the geographical origin of the goods,



may confuse the public into assuming or believing such an origin. *Per contra*, Section 9(1)(b) would apply only where the mark serves, in trade, to designate the geographical origin of the goods.

**105.** In this context, the use of the word –designate is also of some importance. P. Ramanatha Aiyar in his Advanced Law Lexicon, defines the word –designate thus:

–To call by a distinctive title; to point out a thing by distinguishing it from others; to express or declare; to indicate by description or by something known and determinate, to point out, or mark by some particular token; to specify.

–Designation, therefore, involves specific identification, with a declaratory component. The word –designate is far more specific than the word –indicate. Designation involves a positive act done by the person who designates. Additionally, it involves the intent to so designate. It is only, therefore, where the trade mark, of which registration is sought, consists exclusively of marks or indications which are intended to identify the geographical origin of the goods *in trade*, that the mark becomes non-registrable under Section 9(1)(b) (to the extent it is relevant for our purpose).

**106.** Read thus, it cannot be held that the use of the white cross on a red background, or the ‘SWISS MILITARY’ logo below it, serves in trade to designate the geographical origin of the goods as being Switzerland. The possibility of such a mark confusing or deceiving the public into believing that the goods are of Swiss origin when, in fact, they are not, may fatally imperil the entitlement of the mark to registration in view of Section 9(1)(a) of the Trade Marks Act; Section 9(1)(b) would not, however, stand attracted on that ground.

107. In that view of the matter, I do not deem it necessary to advert to the Guidelines issued by the Trade Mark Registry for registration of marks which indicate the geographical origin of goods. In any event, the applicability of the said guidelines seems questionable, as they refer to use of names of places, countries, rivers, etc., as trademarks, and do not seem to apply to the use of a mark such as –Swiss Military. The decision in *Imperial Tobacco*<sup>10</sup>, on which Mr. Anand relies, too, concerns itself with the entitlement, to registration, of the word ‘\_Shimla’, which is the name of a place.

108. Section 9(1)(b) of the Trade Marks Act, therefore, does not render the impugned mark ineligible for registration as a trade mark.

**IV. Re: Section 11(3)(a)**<sup>7</sup>

109. Much emphasis was placed, by Mr. Sibal, on the fact that, while the grounds for refusal of registration envisaged by Section 9 were –absolute grounds those envisaged by Section 11 were –relative grounds. His submission is that –relative grounds would refer to grounds which consider the mark, of which registration is being sought, in relation to some other mark. Adverting specifically to Section 11(3)(a), Mr. Sibal seeks to submit that the words –by virtue of any law with which the said provision commences, have to be read in the context of Section 11 as a whole and also *noscitur a sociis* with the words –law of passing off and the –law of copyright which find place in Clauses (a) and (b) of Section 11(3). He has also pressed into service, in this context, Section 11(5)<sup>26</sup> of the Trade Marks Act.

110. Mr. Anand contends, *per contra*, that the words –by virtue of any law are wide and all encompassing. The mere fact that the law of passing off has been particularized after the said expression in Section 11(3)(a) cannot, in his submission, narrow the sweep and ambit of the words –any law. –Any law, in Mr. Anand’s submission, would refer precisely to –any law, meaning any law in force for the time being in India. The Geneva Convention Act is also, therefore, according to him, one of the laws which would stand embraced by the expression –any law as used in Section 11(3)(a).

111. I must confess that the submissions of Mr. Anand did initially appeal to me. On a deeper analysis of Section 11, however, I find myself in agreement with Mr. Sibal.

112. Section 11(3)(a), I may note, is a very unhappily worded provision. It is lacking in precision, which is one of the most essential attributes of good legislation. I have, however, to interpret the provision as it stands.

113. If one were to accept Mr. Anand’s submission, the words –by virtue of any law would encompass every law applicable in the territory of India. In that event, the Geneva Convention Act would also be one such law.

114. In its recent judgment in *Renaissance Hotel Holdings Inc. v. B. Vijaya Sai*<sup>49</sup>, a Bench of three Hon’ble Judges of the Supreme Court has, in the context of a trade mark dispute, referred to certain important principles of interpretation of statutes, which courts are

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<sup>51</sup> (1980) 4 SCC 507

required to bear in mind in such cases. Paras 65 to 68 of the report read thus:

-65. We find that the High Court has failed to take into consideration two important principles of interpretation. The first one being of textual and contextual interpretation. It will be apposite to refer to the guiding principles, succinctly summed up by Chinnappa Reddy, J., in the judgment of this Court in ***RBI v. Peerless General Finance & Investment Co. Ltd.***<sup>50</sup>:

-33. Interpretation must depend on the text and the context. They are the bases of interpretation. One may well say if the text is the texture, context is what gives the colour. Neither can be ignored. Both are important. *That interpretation is best which makes the textual interpretation match the contextual.* A statute is best interpreted when we know why it was enacted. With this knowledge, the statute must be read, first as a whole and then section by section, clause by clause, phrase by phrase and word by word. If a statute is looked at, in the context of its enactment, with the glasses of the statute-maker, provided by such context, its scheme, the sections, clauses, phrases and words may take colour and appear different than when the statute is looked at without the glasses provided by the context. With these glasses we must look at the Act as a whole and discover what each section, each clause, each phrase and each word is meant and designed to say as to fit into the scheme of the entire Act. *No part of a statute and no word of a statute can be construed in isolation.* Statutes have to be construed so that every word has a place and everything is in its place. It is by looking at the definition as a whole in the setting of the entire Act and by reference to what preceded the enactment and the reasons for it that the court construed the expression -Prize Chitl in ***Srinivasa Enterprises v. U.O.I.***<sup>51</sup>, and we find no reason to depart from the court's construction.

66. It is thus trite law that while interpreting the provisions of a statute, *it is necessary that the textual interpretation should be matched with the contextual one.* The Act must be looked at as a whole and *it must be discovered what each section, each clause, each phrase and each word is meant and designed to say as to fit into the scheme of the entire Act. No part of a statute and no word of a statute can be construed in isolation.* Statutes have to be construed so that every word has a place and everything is in its place. As already discussed hereinabove, the said Act has been enacted by the legislature taking into consideration the increased

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<sup>50</sup> (1987) 1 SCC 424

<sup>51</sup> (1980) 4 SCC 507

globalisation of trade and industry, the need to encourage investment flows and transfer of technology, and the need for simplification and harmonisation of trade mark management systems. One of the purposes for which the said Act has been enacted is prohibiting the use of someone else's trade mark as a part of the corporate name or the name of business concern. If the entire scheme of the Act is construed as a whole, it provides for the rights conferred by registration and the right to sue for infringement of the registered trade mark by its proprietor. The legislative scheme as enacted under the said statute elaborately provides for the eventualities in which a proprietor of the registered trade mark can bring an action for infringement of the trade mark and the limits on effect of the registered trade mark. *By picking up a part of the provisions in sub-section (4) of Section 29 of the said Act and a part of the provision in sub-section (1) of Section 30 of the said Act and giving it a textual meaning without considering the context in which the said provisions have to be construed, in our view, would not be permissible.* We are at pains to say that the High Court fell in error in doing so.

67. *Another principle that the High Court has failed to notice is that a part of a section cannot be read in isolation.* This Court, speaking through A.P. Sen, J., in **Balasinor Nagrik Coop. Bank Ltd. v. Babubhai Shankerlal Pandya**<sup>52</sup>, observed thus :

*-4. ... It is an elementary rule that construction of a section is to be made of all parts together. It is not permissible to omit any part of it. For, the principle that the statute must be read as a whole is equally applicable to different parts of the same section.¶*

This principle was reiterated by this Court in **Kalawatibai v. Soiryabai**<sup>53</sup>:

*-6. ... It is well settled that a section has to be read in its entirety as one composite unit without bifurcating it or ignoring any part of it."*

68. Ignoring this principle, the High Court has picked up clause (c) of sub-section (4) of Section 29 of the said Act in isolation without even noticing the other provisions contained in the said sub-section (4) of Section 29 of the said Act. Similarly, again while considering the import of sub-section (1) of Section 30 of the said Act, the High Court has only picked up clause (b) of sub-section (1) of Section 30 of the said Act, ignoring the provisions contained in clause (a) of the said sub-section (1) of Section 30 of the said Act.¶

(Emphasis supplied)

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<sup>52</sup> (1987) 1 SCC 606

<sup>53</sup> (1991) 3 SCC 410

115. The interpretation of a statutory provision must, therefore, be informed by text and context alike.

116. In that view of the matter, it may be erroneous on the part of the court to interpret the expression –by virtue of any law<sup>54</sup>, as it figures in Section 11(3)(a) of the Trade Marks Act, in isolation, and *de hors* the rest of the clause, the accompanying clause 11(3)(b) and the remaining sub-sections of Section 11. The expression has to be understood in the backdrop of Section 11 as a whole, and the various sub-sections of which the section is constituted.

117. Let us, then do so, and see what emerges.

118. The various proscriptions against registration of a trade mark, in Section 11, are to be found in sub-sections (1), (2) and (3)<sup>54</sup> thereof.

119. Section 11(1) prohibits registration of a mark if, because of its identity with an earlier trade mark and similarity of goods or services covered thereby, or because of its similarity to an earlier mark and identity of similarity of goods or services covered thereby, there exists

<sup>54</sup> 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.
- (2) A trade mark which –
- (a) is identical with or similar to an earlier trade mark; and
  - (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered in the name of a different proprietor,
- shall not be registered if or to the extent the earlier trade mark is a well-known trade mark in India and the use of the later mark without due cause would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trade mark.
- (3) A trade mark shall not be registered if, or to the extent that, its use in India is liable to be prevented –
- (a) by virtue of any law in particular the law of passing off protecting an unregistered trade mark used in the course of trade; or

a likelihood of confusion on the part of the public. The sub-section clarifies that, within the ambit of –confusionll would be included the likelihood of association with the earlier trade mark.

**120.** Section 11(2) protects earlier –well-known trade marksll, within the meaning of Section 2(1)(zg)<sup>55</sup> of the Trade Marks Act. Where an earlier trade mark is a well-known trade mark within the said definition, a later trade mark, which is identical or similar to the earlier trade mark, cannot be registered, if the use of such later mark would take unfair advantage of, or be detrimental to the distinctive character or repute of, the earlier well-known trade mark.

**121.** Section 11(3) prohibits registration of a trade mark if its use in India is liable to be prevented either –by virtue of any law in particular the law of passing offll or –by virtue of law of copyrightll.

**122.** All proscriptions against registration of a trade mark, in Section 11, therefore, refer to handicaps on registration *in the light of earlier existing intellectual property*. Clearly, they are intended at protecting existing intellectual property, essentially either from infringement or from passing off.

**123.** This becomes starkly apparent when one reads Sections 9 and 11 in juxtaposition. The proscriptions envisaged by the various clauses of Section 9 are *absolute*, and do not involve comparison with any other existing mark, or any element of competing intellectual

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(a) by virtue of law of copyright.

<sup>55</sup> (zg) –well-known trade markll, in relation to any goods or services, means a mark which has become so to the substantial segment of the public which uses such goods or receives such services that the use of such mark in relation to other goods or services would be likely to be taken as indicating a connection in the course of trade or rendering of services between those goods or services and a person during the mark in relation to the first-mentioned goods or services.

property interests. Registration, under Section 9, is proscribed, of marks

- (i) which are devoid of any distinctive character (*vide* Section 9(1)(a)),
- (ii) 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 other characteristics of the goods (*vide* Section 9(1)(b)),
- (iii) which consist exclusively of marks which are customary to the trade, i.e. are *publici juris* (*vide* Section 9(1)(c)),
- (iv) which are *of such nature* as to deceive the public or cause confusion (*vide* Section 9(2)(a)),
- (v) which contain or comprise of any matter likely to hurt religious susceptibilities (*vide* Section 9(2)(b)),
- (vi) which comprise or contain scandalous or obscene matter (*vide* Section 9(2)(c)),
- (vii) the use of which is prohibited under the Emblems and Names (Prevention of Improper Use) Act, 1980 (*vide* Section 9(2)(d)), or
- (viii) which consist exclusively of
  - (a) the shape of goods resulting from the nature of the goods themselves (*vide* Section 9(3)(a)),
  - (b) the shape of goods which is necessary to obtain a technical result (*vide* Section 9(3)(b)), or
  - (c) the shape which gives substantial value to the goods (*vide* Section 9(3)(c)).



In each case, therefore, the proscription under Section 9 relates to the *character of the mark itself, vis-à-vis* the goods on which it is used. If the mark, by its very nature and on its own, suffers from any of the disqualifications envisaged by Section 9, it cannot be registered. No occasion arises, therefore, under Section 9, to refer to any other mark. Mr. Sibal is, therefore, correct in his submission that the likelihood of deception and confusion envisaged by Section 9(2)(a), too, has to be an attribute of the mark itself and seen on its own, and not in comparison with, or *vis-à-vis*, any other mark. It is for this reason that the clause employs the expression –by its very nature

**124.** Section 9, therefore, applies to inherent attributes of the applicant mark, of its own, whereas Section 9 applies to attributes of the mark *vis-à-vis* existing marks of others. Ergo, Section 9 contains –absolutell grounds to refuse registration, whereas Section 11 contains –relativell grounds to do so.

**125.** Even read in the context of Sections 11(1) and 11(2) and the other clauses of Section 11(3), or *vis-à-vis* Section 9, therefore, the words –by virtue of any law, as used in Section 11(3)(a), would appear to apply only to law which relates to protection of existing intellectual property of others.

**126.** Section 11(5), on which Mr. Sibal rightly relies, sets the issue, in a way, at rest.

**127.** Section 11(5) is couched in mandatory terms, as is apparent from the use of the word –shall. It states that registration of a mark –shall not be refused ... on the grounds specified in sub-sections (2)

and (3) unless the proprietor of *-the* earlier trade mark opposes the registration on one or more of the grounds envisaged by Sections 11(2) and 11(3). The right to refuse registration of a mark under Section 11(3), therefore, is subject to the pre-condition envisaged by Section 11(5) applying. It is only where the proprietor of an earlier trade mark objects to registration of the proposed mark on one of the grounds envisaged by Sections 11(2) and 11(3), in appropriate opposition proceedings, that registration of a mark can be refused under either of the said provisions.

**128.** This places the matter beyond pale of doubt. The pre-condition for Sections 11(2) and 11 (3) to apply, as statutorily engrafted in Section 11(5), requires an opposition by a proprietor of an earlier trade mark. The proprietor of the earlier trade mark has, therefore, to object to registration of the proposed mark on the ground (i) that it is identical with or similar to an earlier well-known trade mark, (ii) the use of the mark in India is liable to be prevented by any law, in particular the law of passing off or (iii) the use of the mark in India is liable to be prevented by the law of copyright.

**129.** The legislative intent, clearly, is to balance the right of an applicant seeking registration of the later mark, with the intellectual property rights which vest in the proprietor of the earlier mark.

**130.** This conclusion is also supported by the use of the particular article *-the* used in the expression *-the* earlier trade mark in Section 11(5). The use of the article *-the* indicates that all proscriptions in Sections 11(5) (2) and (3) are intended to apply to proprietorial rights vesting in the proprietor of an earlier trade mark.

131. The words –any law, as employed in Section 11(3)(a), would also, therefore, have to be understood in this background. They cannot be understood as referring to any law in force in India, which has nothing to do with intellectual property rights vesting in the proprietor of any earlier mark.

132. As Mr. Sibal correctly submits, if the word –any law, finding place in Section 11(3)(a) is to embrace all laws in force in India, the proscription would cease to be –relativell, and would become –absolutell. It would, then, appropriately have to find place in Section 9, not in Section 11. Additionally, if such were the interpretation, it would be illogical to restrict the right to object to registration, on that ground, only to proprietors of earlier trade marks, as Section 11(5) ordains. The fact that Section 11(3) applies only where an objection to registration, on the grounds envisaged in the said sub-sections, is raised by the proprietor of an earlier trade mark, indicates that the provision does not envisage an absolute ground to refuse registration, but envisages, instead, an objection predicated on the prejudice suffered by the intellectual property rights of the proprietor of *the earlier trade mark*.

133. It is not necessary, therefore, for me to venture into *noscitur a sociis* territory as, even read in conjunction with Section 9 and the other provisions of Section 11, in the light of the principles enunciated in paras 66 to 68 of *Renaissance Hotels Holdings*<sup>49</sup>, the words –by virtue of any law, as employed in Section 11(3)(a), cannot be extended to embrace every law applicable in the territory of India. Their sweep has to be restricted to laws which impact proprietorial

intellectual property rights vested in the proprietor of an earlier trade mark, as is specifically ordained by Section 11(5).

**134.** The 13<sup>th</sup> Lok Sabha debates, on which both sides placed reliance, fortify the conclusion. Despite a specific recommendation, in the Debates, to further elaborate Clause 11(3)(a) of the Trade Marks Bill – which metamorphosed into Section 11(3)(a) of the Trade Marks Act after Presidential sanction – to protect India's commitments under the Universal and Berne Copyright Conventions, and its obligations under the TRIPS agreement, these suggestions were never acted upon. The legislative intent was always, therefore, to restrict the proscriptions against registration to the intellectual property rights available under intellectual property legislation in India.

**135.** In that view of the matter, the learned Deputy Registrar cannot be faulted in declining the objection of the appellant against registration of the impugned mark, predicated on Section 11(3) of the Trade Marks Act.

**136.** Besides, and even otherwise, Mr. Sibal is also correct on facts in pointing out that the appellant is not a proprietor of an earlier trade mark. Clearly, therefore, in view of Section 11(5), the registration of the impugned mark, as sought by the Respondent 2, could not have been refused by the learned Deputy Registrar under Sections 11(2) or 11(3) *at the instance of the appellant*.

V. Power of the learned Deputy Registrar to consider other laws

137. I have held, earlier, that the words –any law, in Section 11(3)(a) cannot extend to statutes which do not involve considerations of intellectual property rights of others and that, therefore, the Geneva Conventions Act does not fall within the parenthetic embrace of the phrase –any law. But what if the use of the mark, of which registration is sought, is absolutely proscribed by some other law, as the German Conventions Act does in the present case, according to Mr. Anand? Can the Registrar register a mark the use of which stands statutorily proscribed elsewhere?

138. The answer, in my view, has to be in the affirmative. The Registrar of Trade Marks is appointed under Section 3(1)<sup>56</sup> of the Trade Marks Act, and the learned Deputy Registrar, who has passed the impugned order, has apparently been empowered to do so by the Act. In either case, the appointment of the officer is –for the purposes of this Act. In *M.A. Kochu Devassy v. State of Kerala*<sup>57</sup>, the Supreme Court held that the expression –\_for the purposes of the Act‘ surely means for the purposes of all and not only some of the provisions of the Act. The expression –for the purpose of the said Act was understood, in *Ashok Leyland Ltd v. State of Tamil Nadu*<sup>58</sup> as –for the purpose of all the provisions of the said Act.

139. The power and authority of the learned Registrar, therefore, stand circumscribed by the provisions of the Trade Marks Act. He is appointed for discharging functions under the Act, and is the administrative, and quasi-judicial, modus for grant of registration to

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<sup>56</sup> 3. **Appointment of Registrar and other officers.** –

(1) The Central Government may, by notification in the Official Gazette, appoint a person to be known as the Controller-General of Patents, Designs and Trade Marks, who shall be the Registrar of Trade Marks for the purposes of this Act.

<sup>57</sup> (1979) 2 SCC 117 : AIR 1979 SC 358

trade marks and performing all functions ancillary thereto. The sphere of his authority, in the matter of refusal of registration cannot, therefore, extend beyond Sections 9 to 16 of the Trade Marks Act, of which Sections 9 and 11 contain the absolute and relative grounds on which registration can be refused. Section 23(1)<sup>59</sup> mandates that, where the registration of the mark has been opposed and the opposition has been decided in favour of the applicant, the mark *shall* be registered. No discretion vests in the learned Deputy Registrar, once the opposition is decided in favour of the applicant seeking registration.

**140.** Though, therefore, the Trade Marks Act does not contain any express proscription against the learned Deputy Registrar travelling outside its scope in search of any other possible statutory fetters on registration, it is clear that, holistically read, the Trade Marks Act forms a composite and self-contained code, in the matter of registration. The learned Deputy Registrar has, therefore, to limit the scope of inquiry, into the entitlement of the proposed mark to registration, to the considerations that find place in the Trade Marks Act, and cannot travel outside it.

#### VI. Section 12 of the Geneva Convention Act, independently seen

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<sup>58</sup> (2004) 3 SCC 1 : AIR 2004 SC 2836

<sup>59</sup> 23. **Registration.** –

(1) Subject to the provisions of Section 19, when an application for registration of a trade mark has been accepted and either—

(a) the application has not been opposed and the time for notice of opposition has expired; or

(b) the application has been opposed and the opposition has been decided in favour of the applicant,

the Registrar shall, unless the Central Government otherwise directs, register the said trade mark within eighteen months of the filing of the application and the trade mark when registered shall be registered as of the date of the making of the said application and that date shall, subject to the provisions of Section 154, be deemed to be the date of registration.

**141.** The above conclusion would stand fortified even by Section 12 of the Geneva Conventions Act itself. What Section 12 proscribes is *use* of the heraldic emblem of the Swiss confederation. There is a statutory distinction between *registration* and *use* of a trade mark. Use follows registration. Section 28(1)<sup>60</sup> of the Trade Marks Act makes this clear. The proprietor of a registered trade mark is, by Section 28(1), invested with the right to use it. Section 12 of the Geneva Conventions Act, therefore, affects, if at all, the *right to use* the mark, not the right to have it registered. The right to registration stands circumscribed by the Trade Marks Act, which remains a complete code in that regard. If the right to use the mark, once registered, is subject to some other statutory proscription, that proscription operates outside the peripheries of the Trade Marks Act. If such a proscription exists, and the proprietor of the trade mark violates it, the violation may well invite sanctions as envisaged by the proscribing statute. The right to registration of the mark is unaffected by any such proscription. The learned Deputy Registrar, and, consequently, this Court which is sitting in appeal over the decision of the learned Deputy Registrar, is not required to venture into that territory, as it is concerned only with the entitlement of the impugned mark to registration, and not to the entitlement of Respondent 2 to use the mark, once registered if at all.



**142.** To my knowledge, there does not exist, outside the Trade Marks Act, any proscription against registration of a trade mark. Nor has Mr. Anand invited my attention to any such proscription.


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<sup>60</sup> 28. **Rights conferred by registration.** –

(1) Subject to the other provisions of this Act, the registration of a trade mark shall, if valid, give to the registered proprietor of the trade mark the exclusive right to the use of the trade mark in relation to the goods or services in respect of which the trade mark is registered and to obtain relief in respect of infringement of the trade mark in the manner provided by this Act.

VII. Other Issues

143. The impugned order of the Learned Deputy Registrar allows the registration of the impugned  mark without limitation of colour. By application of Section 10(2) of the Trade Marks Act, therefore, it also registers the mark with a white cross on red background, as . To that extent, the impugned order is not sustainable, as

- (i) the  mark, when used for goods of Chinese origin, would amount to a -false trade description within the meaning of Section 2(1)(i)(IV), and would therefore be ineligible to registration, and
- (ii) the mark would additionally be ineligible to registration under Section 9(2)(a) of the Trade Marks Act.

VII.1 Re. Tax Invoice dated 12<sup>th</sup> July 2008

144. Relying on Cabinet Circular dated 15<sup>th</sup> July 2010, which officially notified the ₹ symbol for the Indian Rupee, Mr. Anand sought to contend that Tax Invoice dated 12<sup>th</sup> July 2008 was fabricated, as it used the said ₹ symbol two years prior thereto. The submission, though seemingly fragile, is not without significance. The only response of Mr. Sibal, to this submission, was that the software used by Respondent 1 was employing the ₹ symbol for the Indian Rupee. In fact, web research reveals that the ₹ sign was shortlisted from the entries received pursuant to a contest for submitting entries for a new symbol for the Indian Rupee announced by the Indian Government on 5<sup>th</sup> January 2009. Out of 3331 responses received, five were shortlisted, from which the ₹ symbol was selected in a meeting held of the Union Council of Ministers held



on 15<sup>th</sup> July 2010. Respondent 2 would, therefore, have to explain, satisfactorily, how the Tax Invoice, bearing the ₹ symbol, came to be issued by it on 12<sup>th</sup> July 2008.

**145.** Respondent 2 has failed to do so. Though the point was raised before the learned Deputy Registrar, albeit in written submissions after conclusion of hearing, no reply, to the point, was provided by Respondent 2. The point has again been urged in these proceedings by the appellant, and the only explanation forthcoming, from Respondent 2, is that it was a feature of the software used by it. The reply is thoroughly unsatisfactory. The developers of the software cannot be presumed to be blessed with the gift of clairvoyance, to be able to divine the symbol that would be adopted for the Indian rupee even before suggestions for suitable symbols were invited by the Government from the public.

**146.** *Prima facie*, therefore, Respondent 2 has failed to satisfactorily rebut the appellant's contention regarding the Tax Invoice dated 12<sup>th</sup> July 2008. The submission, of Respondent 2, that the contention was irrelevant as it had applied for the impugned mark on a –proposed to be used basis is obviously without merit. Submission of a fabricated document for having a mark registered would *ipso facto* disentitle the applicant to registration. The matter cannot be wished away by referring to any number of other invoices which Respondent 2 might have submitted in support of its application for registration. One single fabricated document is itself sufficient to reject the application. No benefit, in law, can enure in favour of a fabricator. The hands of one who seeks a benefit, which the law provides, have to be clean.


147. Having said that, I do not deem it appropriate to use this factor as determinative of the issue in controversy, as it was, in fact, raised by the appellant only after hearing before the learned Deputy Registrar had concluded, in written submissions. Had it been raised during the proceedings before him, Respondent 2 would have had a chance to rebut the allegation. That opportunity not having been extended to Respondent 2 before the impugned order came to be passed, and, as I find the impugned mark ineligible to registration on other grounds, the matter is laid to rest with the above *prima facie* observations.


VII.2 Re. Copyright Registration of Respondent 1 dated 29<sup>th</sup> April 2005

148. The genuineness, or otherwise, of Copyright Registration No. A-71091/2005, held by Respondent 1, is completely irrelevant to the issue at hand. I do not intend, therefore, to address the submissions of Mr Anand in that regard.

VIII. The black-and-white cross with 'SWISS MILITARY' (the mark)



149. Can it, then, be said that the impugned mark, if used in a black-and-white format, i.e. as , is registerable?

150. I have held the  mark not to be available for registration as a trade mark under the Trade Marks Act, by virtue of Section 9(2)(a) thereof. Would Section 9(2)(a) not be breached if the mark were in

black-and-white?

151. The answer should be obvious.

152. Section 9(2)(a) uses the words –of such nature as to deceive the public or cause confusion. I have already held that the impugned mark, when used in a red-and-white colour format, is of such nature as to confuse the public into linking the goods, on which the mark figures, with Switzerland; in other words, of presuming the goods to be of Swiss origin.

153. This impression is not attributable solely to the red-and-white colour scheme of the mark. The words ‘**SWISS MILITARY**’ have a large part to play in the impression that the mark would carry. It would be folly to analogize a mark such as ‘**SWISS MILITARY**’ with a mark such as, for example, ‘**PETER ENGLAND**’ which, as a phrase has no etymological meaning at all, so that it becomes instantly fanciful, and can, therefore, be kept out of the reckoning. ‘**SWISS MILITARY**’, however, conjures up an instant mental picture of the Swiss military establishment. A mental connection with Switzerland is, therefore, inevitably made. That, by itself, satisfies the requirement of –causing confusion envisaged by Section 9(2)(a).

154. The *Slazenger*<sup>38</sup> principle would also equally apply here. There is no explanation for the adoption, by Respondent 2, of the ‘**SWISS MILITARY**’ moniker. The use of the word ‘**MILITARY**’ is seriously prejudicial to the case of Respondent 2. It is not a word lightly used, or, for that matter, to be lightly used. The pleadings of Respondent 2 do not throw light on the motivation for adoption of the

said phrase as a trade mark. Being such an unusual use, the mark is bound, in the perception of the ordinary consumer, to suggest a link to the Swiss official establishment; and, perhaps, even to the Swiss military establishment. In the absence of any material to suggest that there was an absolute embargo on the Swiss military establishment using the **SWISS MILITARY**‘ appellation on goods put up for trade, the learned Deputy Registrar was not, in my view, justified in presuming that persons would never connect the goods, on which the mark figures, with the Swiss military establishment.




**155.** If, for example, backpacks bearing the words **INDIAN AIR FORCE**‘ were to be seen by persons outside India, it is obvious, to my mind, that they would presume a link with the Indian Air Force, whether the words were, or were not, accompanied by the official Indian Air Force insignia. The words **INDIAN AIR FORCE**‘, like the words **SWISS MILITARY**‘ carry their own solemn connotation. It is not easily that the ordinary person – who, as already noted, is a person who is aware and capable of discrimination – is likely to presume that the expression **SWISS MILITARY**‘ is being used for ordinary commercially traded goods – as, however, they are – unconnected with the Swiss military establishment.

**156.** In fact, the exception that the Swiss military establishment has, as the appellant in this case, taken to the use of the impugned mark by Respondent 2, speaks for itself.

**157.** Even if used in a black and white format, therefore, the impugned mark would be ineligible for registration, in view of Section 9(2)(a) of the Trade Marks Act, as it is of a nature which



would cause confusion in the mind of the public.

### The Sequitur

158. The impugned order dated 25<sup>th</sup> July 2022, insofar as it allows the registration of the  mark in respect of textiles without limitation of colour, cannot sustain, whether the mark be used in a red-and-white or a black-and-white format. In other words, both  and  would be ineligible for registration as trade marks. The impugned order cannot, therefore, sustain in law.


### CA(COMM.IPD-TM) 158/2022

159. The mark of Respondent 2 of which the impugned order dated 25<sup>th</sup> July 2022, passed by the learned Deputy Registrar of Trademarks allows registration is “SWISS MILITARY” simpliciter, without any cross, either black and white or red and white.



160. Mr. Anirudh Bakhru appears on behalf of Respondent 2 in this appeal. While adopting the submissions of Mr. Sibal in CA (COMM. IPD-TM) 158/2022 in all other respects, he submits that there are two distinguishing features in this case. The first is that, as the mark does not use the official Swiss  insignia, so that there can be no question of Section 11(3)(a), read with the Geneva Conventions Act, applying. The second is that the “SWISS MILITARY” mark, independently and unaccompanied by the red and white  cross, is unlikely to

deceive or confuse the consumer, thereby ruling out the applicability of Section 9(1)(b) and 9(2)(a) as well.

161. I agree with Mr. Bakhru, but only in part. Section 11(3)(a) would not apply to the present case.

162. The observations and findings returned by me with respect to the applicability of Section 9(2)(a) to the  mark, as contained in paras 153 to 160 *supra*, would apply *mutatis mutandis* to the **SWISS MILITARY** mark impugned in this appeal. The use of the **SWISS MILITARY** appellation, even by itself and *sans* any accompanying embellishments or emblems, has the clear propensity of creating confusion in the mind of the public, regarding the origin of the goods on which the mark is used. The -confusion factor is the use of the appellation **SWISS MILITARY**, and not a black and white cross, though the use of the black and white cross may add to the confusion. Section 9(2)(a) would, therefore, apply even if the mark **SWISS MILITARY** is used without the accompanying black and white cross.

## Conclusion

163. Accordingly, the impugned orders dated 25<sup>th</sup> July 2022 are quashed and set aside. It is held that the marks ,  and **SWISS MILITARY** are all ineligible for registration in respect of textiles, as claimed by the respondent. Application numbers 1944698 and 969178 filed by the respondent before the learned Registrar shall stand rejected.

164. Appeal numbers CA(COMM.IPD-TM) 158/2022 and CA(COMM.IPD-TM) 159/2022 stand allowed accordingly with no orders as to costs.

**C.HARI SHANKAR, J**

**JANUARY 4, 2023**

rb/AR/dsn

