
(2015) 08 IPAB CK 0003

In the Intellectual Property Appellate Board

Case No : ORA/103/2008/TM/KOL

Auto Pins (India) Ltd

APPELLANT

Vs

S.R. Springs Pvt. Ltd. And Ors

RESPONDENT

Date of Decision : 13-08-2015

Acts Referred:

Trade Marks Rules, 2002 — Rule 37(2)

Citation : (2016) 65 PTC 380 (IPAB)

Hon'ble Judges : K.N. Basha, J; Sanjeev Kumar Chaswal, Technical Member

Bench : Division Bench

Advocate : Amarjit Singh

Judgement

K.N. Basha, J

ORDER (No. 174 of 2015)

1. Mr. Amarjit Singh, learned counsel for the applicant is present before us today. As the respondent herein was called continuously absent, we ordered substituted service by paper publication and the same was completed by the applicant as per copy of the paper publication along with the communication dated 11/08/2015 of the learned counsel of the applicant. In spite of the paper publication, even today the respondent neither appeared in person nor through any advocate. Accordingly, the respondent herein is set ex parte and the matter is heard on merits. This application is preferred by the applicant seeking for the relief of rectification of the impugned trade mark of the first respondent herein namely "SRICO" under trade mark application No. 636188 B in class 12. The applicant has raised several grounds in the application including the procedural irregularities and as well as the grounds on merits more particularly in respect of the prior adoption, prior use, and prior registration of their mark than that of the impugned trade mark by the first respondent herein.

2. In this matter, as we have already pointed out that the first respondent herein has not only remained absent continuously but also not filed any counter

disputing the claims and grounds taken by the applicant seeking for relief of the rectification of the impugned trade mark. However, we have to consider the matter on merits.

3. Mr. Amarjit Singh, the learned counsel for the applicant would vehemently contend that the impugned trade mark is not only wrongly registered but also is wrongly remaining in the Register. It is pointed out that the applicant has adopted, coined and continuously used their trade mark "SIROCCO" right from the year 1953 and they got their first registration as early as 28/12/1953.

4. The learned counsel for the applicant would place reliance on the documents filed by them in respect of their various registrations under Exhibit 'A' to Exhibit 'U' which are the documents that would reveal their use and certificate of registration of their trade mark. It is contended that the impugned trade mark was registered as per the application of the respondent herein dated 08/08/1994 in respect of the impugned trade mark "SRICO" which is phonetically and visually similar to that of the trade mark of the applicant. It is further contended that the registration of the trade mark by the first respondent herein itself is dishonest as they have resorted to registration knowing fully well about the prior adoption and use of the registration, reputation and goodwill earned by the applicant in respect of their trade mark "SIROCCO".

5. The learned counsel would also place reliance on the other documents filed by them namely statement of their sales as well as their invoices etc. Therefore, it is contended that in view of the above said materials annexed by the applicant the impugned trade mark is liable to be rectified.

6 . We have carefully considered the contentions of the learned counsel for the applicant and also gone through the entire materials available on record.

7 . At the outset it is to be stated that the applicant has coined, adopted and uninterruptedly used their trade mark 'SIROCCO" right from the year 1953 till date. It is pertinent to note that they got their first registration in the year 1953 itself. In order to establish the said claim the applicant produced several documents more particularly Exhibit 'A' to Exhibit 'U'. It is also seen that the applicant also produced other relevant documents namely, their statement of sales details and the sales invoices including the invoices relating to publicity in the leading Newspapers of the country. As far as the impugned trade mark is concerned, it is seen that the first respondent has submitted their application for registration of the impugned trade mark only on 08/08/1994 under the trade mark registration No. 636188 in class 12. Their own documents make it crystal clear that the applicant is the prior adopter and prior user and they got even the prior registration in respect of their trade mark 'SIROCCO".

8 . We are also constrained to state that from the materials available on record, it is not revealed that whether the first respondent has filed any search application in order to find out whether any similar trade mark as that of the impugned trade mark has been registered by the Registry. The materials also

does not disclose any step taken even by the Registrar in respect of such a search. At this juncture it is relevant to quote Rule 37(2) of the Trade Marks Rules, 2002 hereinafter referred to as the Rules. Rule 37(2) reads hereunder:-

37. Acknowledgement and search:--(2) Upon receipt of the application for registration of trade mark, the Registrar shall cause a search to be made amongst the registered trade marks and amongst the pending applications for the purpose of ascertaining whether there are on record in respect of the same goods or services or similar goods or services any mark identical with or deceptively similar to the mark sought to be registered and the Registrar may cause the search to be renewed at any time before the acceptance of the application but shall not be bound to do so.

9. The reading of the above said provision makes it crystal clear that it is incumbent on the Registrar to cause a search upon receipt of application for registration of a trade mark and the said provision is undoubtedly a mandatory provision and the non-compliance of the same would vitiate the entire proceedings culminating into the grant of registration certificate. As far as the instant case is concerned, we are unable to get any material available on record to show that the Registrar of Trade Marks has complied with the said mandatory provision and on this ground alone the application is liable to be allowed for rectification.

10. The yet another aspect to be considered is the deceptive similarity in respect of the impugned trade mark and the trade mark of the applicant. It is to be stated that the trade mark of the applicant is "SIROCCO" and the impugned trade mark is "SRICO". In our considered view, the impugned trade mark is phonetically and visually similar to that of the trade mark of the applicant. It is also pertinent to note that the trade mark of the applicant as well as the trade mark of the first respondent has been used for the same class of goods namely under class 12 and the goods are also of the same description. Therefore, it is crystal clear that allowing the impugned trade mark would cause chaos and confusion among the consumers which would certainly affect the reputation and goodwill of the applicants goods under the trade mark "SIROCCO".

11 . Lastly it is seen from the latest website extract dated 11/08/2015 that the impugned trade mark was registered only upto 08/08/2008 and we are not sure whether it has been renewed further. In view of the above said reasons the ORA is allowed. Consequently, the impugned trade mark "SRICO" under trade mark application No. 636188 B in class 12 is hereby ordered to be rectified and the Registrar of Trade Mark namely the second respondent herein is directed to remove the said trade mark from the Register within four weeks from the date of receipt of the order copy of this Bench.