
(2004) 10 IPAB CK 0005

In the Intellectual Property Appellate Board

Case No : P.A. No. 127/2003/TM/DEL (CM(M) 366/1996)

Babulal G. Jain

APPELLANT

Vs

Golden View Electrical Industries Pvt. Ltd. And Anr.

RESPONDENT

Date of Decision : 27-10-2004

Acts Referred:

Trade And Merchandise Marks Act, 1958 — Section 9, 11, 11(a), 11(e), 12(1), 12(3), 18(1), 18(4)

Trade Marks Act, 1999 — Section 100

Citation : (2005) 30 PTC 508 (IPAB)

Hon'ble Judges : S. Jagadeesan, J;Raghubir Singh, J

Bench : Division Bench

Advocate : S.K. Bansal, M.K. Miglani

Final Decision : Dismissed

Judgement

S. Jagadeesan, J

1. The appeal is directed against the order of the Assistant Registrar of Trade Marks Delhi, dated 4.7.1996, rejecting the application of the appellant

for registration of the trade mark TOWER KING'.

2. Shri Babulal G. Jain, trading as M/s. Adinath Cable, filed an application No. 493478 B for registration of the trade mark POWER KING in respect

of PVC insulated wires and cables included in class 9 of the Fourth Schedule of the rules framed under the Trade and Merchandise Marks Act, 1958

(hereinafter referred to as the Act). The said application was duly advertised before acceptance in the Trade Marks Journal No. 1074, dated 1.3.1994

at page 1243. The first respondent, M/s. Golden View Electrical Industries Pvt. Ltd., filed notice of their intention to oppose the registration of the

impugned mark on 26.4.1994 on the ground that the impugned mark is violative

of Sections 9, 11(a), 11(e), 12(1), 12(3), 18(1) and 18(4) of the said Act. On 10.2.1995, the appellant filed their counter statement denying the averments of the first respondent herein in their notice of opposition. The first respondent, on 21.4.1995, filed evidence in support of their opposition by way of an affidavit dated 19.4.1995 in the name of Shri Satish Kumar Chadha, Managing Director of the first respondent company alongwith the photo copies of documents Exhibits A-1 to A-198. The appellant filed their evidence on 31.5.1995, by way of an affidavit dated 3.5.1995 in the name of Shri Babulal G. Jain, alongwith photo copies of the documents Exhibits 1 to 12. On 30.6.1995, the first respondent filed their reply evidence by way of an affidavit of their Managing Director. The matter was listed for hearing by the Assistant Registrar on 16.8.1995 on which date, the Assistant Registrar of Trade Marks heard the respective counsel of either party and ultimately, under the impugned order allowed the opposition No. DEL-8650 of the first respondent herein and refused the registration of the application No. 493478 B of the appellant herein.

3. The Assistant Registrar of Trade Marks, in the impugned order had specifically mentioned that the first respondent confined the dispute only with regard to issues in respect of Sections 9, 11(a), 12(1) and 18(1) of the Act. The Assistant Registrar had taken up the issue with regard to Section 11(a) of the Act and found that the first respondent has acquired a reputation and goodwill of their trade mark POWER KING in respect of their goods mainly being electric alternators and A.C. generating sets since 1973. He also found that though the appellant's goods falls under class 9 and the first respondent's goods falls under class 11 and the description of the goods are distinct, still, the goods of the appellant is having trade connection with that of the goods of the first respondent and as such, the registration of the appellant's mark would cause confusion and deception in the minds of the consumers as well as in the trade and consequently, upheld the objection under Section 11(a) of the Act.

4. While dealing with the objection under Section 12(1), the Assistant Registrar relied upon the statement of the first respondent about the existence of the already registered mark under No. 317198 B in class 9 in respect of wires, cables, electrical switches, electrical fittings, coil holders, plugs, adopters, connectors, etc. which stood in the name of third party and held that

the prohibition under Section 12(1) is attracted. So far as the objection under Section 12(3) is concerned, the Assistant Registrar held that the first respondent's mark was in use since 1975 whereas the appellant adopted the identical trade mark only in the year 1985 and as such, the appellant has adopted the impugned trade mark with full knowledge of the existing trade mark of the first respondent. Hence, there is no bona fide in the adoption and consequently the appellant is not entitled for the registration of the mark under Section 12(3). The Assistant Registrar further upheld the objection under Section 9 of the Act following the reason to uphold the objection under Section 11(a) of the Act. He also found that the appellant is not the proprietor of the trade mark as they adopted the first respondent's trade mark dishonestly and consequently the objection under Section 18(1) of the Act was also upheld and the application for registration was rejected. Aggrieved by the same, the appellant has preferred the appeal in CM (M) 366/1996 on the file of the Hon'ble High Court of Delhi which stood transferred to this Appellate Board by virtue of Section 100 of the Trade Marks Act, 1999 and numbered as TA/127/2003/TN/DEL.

5. We have heard Shri S.K. Bansal, the learned counsel for the appellant and Shri M.K. Miglani, the learned counsel for the first respondent.

6. The learned counsel for the appellant contended that the appellant has sought the registration of the impugned mark only in respect of PVC

insulated wires and cables falling under class 9 of the Fourth Schedule claiming the user from 1.4.1983. The first respondent's goods admittedly being

electric alternators and A.C. generating sets falling under class 11. The goods are not the same or of the same description. Consequently, there cannot

be any confusion or deception in the minds of the consumers as well as in the trade. The trading channel of the appellant's goods is also different from

that of the first respondent. So far as the other existing registered mark of the third party is concerned, it is not open to the first respondent to rely

upon such material, especially, when the proprietor of the said registered trade mark had not chosen to oppose the registration of the impugned mark.

Further, he contended that the Assistant Registrar is not correct in finding that there is trade connection between the appellant's goods and the first

respondent's goods. There is absolutely no trade connection between the two. He also relied upon a number of judgments in support of his contention

that when the goods are different, the identical mark can be registered as there is no possibility of confusion or deception. Even assuming that there is some trade connection by which the appellant's goods is of the same description as that of the first respondent's goods, still, the impugned mark is entitled to be registered under Section 12(3) of the said Act. The Assistant Registrar is not correct in finding that the appellant adopted the impugned mark with the knowledge of the existence of the first respondent's mark, especially, when there is no evidence to that effect and consequently the impugned order is liable to be set aside.

7. On the other hand, the learned counsel for the first respondent contended that the Assistant Registrar has taken into consideration all the materials available on record and found that the impugned mark cannot be registered as the same is violative of Sections 9, 11(a), 12(1) and 18(1) of the Act. So far as the reliance placed on the third party's registered mark is concerned, he submitted that the registration of the trade mark being of public interest, any one can bring to the notice of the registering authority about the existence of the other registered marks in the register so that the Registrar can take care to consider the issue of registration of the impugned mark. It is not necessary that only the proprietor of the registered mark has to object and as such, the reliance placed by the Assistant Registrar is not vitiated. When the first respondent had acquired a reputation and goodwill through its trade mark, even though there is no trade connection or the goods are not similar, still, the impugned mark cannot be registered as it may create confusion in the minds of the consumers or the public or the trade with regard to the source of manufacture. On this ground also, the impugned mark cannot be registered and hence, no interference is called for in the appeal.

8. We have carefully considered the above contentions of both the counsel.

9. The main contention of the learned for the appellant is that the impugned mark sought to be registered is in respect of goods falling under class 9 of the Fourth Schedule in the Rules framed under the Act, whereas, the first respondent's goods fall under Section 11 and as such, the goods are not the same or of the same description. When the goods are not the same or of the same description, there cannot be any confusion or deception as the origin being totally different and distribution is also through different source. In support of his contention, he also referred to some of the judgments

wherein it has been held by various Courts that when the goods are of different kind, there cannot be any confusion and a similar trade mark can be

registered. When we consider those judgments, we must also keep in mind the principles laid down by various Courts including the Supreme Court of

India for which we would refer to a few judgments hereunder:

In AIR 1969 Bombay 24 Sunder Paramanand Lalwani and Ors. v. Caltex (India) Ltd, .the Bombay High Court held that the name 'Caltex' cannot be

permitted to be registered in connection with the applicant's watches on the ground that a large number of persons if they say or heard about the mark

'Caltex' in connection with the applicant's watches, would be left to think that watches were in some way connected with the opponents who were

dealing in petrol and various oil products with the mark 'Caltex'.

In a case reported in AIR 1983 Punjab and Haryana 418 Banga Watch Company, Chandigarh v. N.V. Philips Eindhoven, Holland and Anr .the

learned Judge of the Punjab & Haryana High Court held that the trade mark 'PHILIPS' was used extensively with respect to radios. Use of the

identical mark 'Philips' with respect to timepieces, wall clocks which are available across the same counter will lead to passing-off. It is immaterial that

the goods belong to different classes as they are available across the same counter.

In AIR 1994 Delhi 239 Daimler Benz Aktiengesellschaft v. Hybo Hindustan the High Court of Delhi held that the trade mark 'BENZ' was extensively

used with respect to automobiles. The use of an identical mark 'Benz' with respect to undergarments will lead to confusion in the market, although the

manufacturers of Mercedes Benz cars were neither manufacturing nor selling garments or underwear apparels. The said judgment of the learned

single Judge was confirmed by the Division Bench of the same High Court and also confirmed by the Supreme Court.

The Delhi High Court in the case of Honda Motors Company Limited v. Charanjit Singh and Ors., 2003 (26) PTC 1 (De lh)ad held that the plaintiff's

mark Honda has acquired a global goodwill and reputation and the said name is associated with the plaintiff established in the field of automobiles and

power equipments and as such the same trade mark has acquired goodwill and reputation, the use of the said trade mark by the defendant was for

their product pressure cooker, does mislead the public to believe that the

defendant's business and goods are that of the plaintiff and such user by the defendants is also diluted and deface the goodwill and reputation of the plaintiff.

10. The above principles are on two grounds. One is as laid down by the Supreme Court of India in the case of Power Control Appliances and Ors. v.

Sumeet Machines Pvt. Ltd. and Ors., 1995 PTC 16 5 that it is a settled principle of law relating to trade mark that there can be only one mark, one

source and one proprietor. It cannot have two origins. The other being that one cannot be permitted to make profit out of the goodwill and reputation

built up by the other. In the case on hand, it is clear that the first respondent is using the trade mark POWER KING in respect of their goods electric

alternators and A.C. generating sets. If the same trade mark, which is not disputed, is permitted to be registered by the appellant in respect of their

goods, then, it would create confusion in the minds of the consumers that there is some subtle association between the activities of the appellant and

the first respondent. In other words, it would lead the public to believe that the goods of the appellant are manufactured by the first respondent.

Hence, on the above principle, we are of the view that the Assistant Registrar has rightly upheld the objection of the first respondent under Section

11(a) of the Act. In view of this, there is no need to discuss the issue under Section 12(3) of the Act, as it is admitted that the appellant has adopted

the impugned trade mark in the year 1985, whereas the first respondent is using the same since 1973 and the adoption by the appellant is long after the

use by the first respondent and as such, no question of bona fide concurrent use also arises.

11. Consequently, we do not find any merit in the appeal and accordingly, the appeal is dismissed. No costs.