

(2012) 01 IPAB CK 0001

In the Intellectual Property Appellate Board

Case No : M.P. No. 224/2008 In ORA 214/2007/TM/AMD And ORA/214/2007/TM/AMD

Crompton Greaves limited Registered office at CG House, 6th Floor, Dr. Annie Besant Road, WORLI, Mumbai-400030
Crompton Greaves Limited Registered Office At CG House, 6th Floor, Dr. Annie Besant Road, WORLI, Mumbai-400030

APPELLANT

Vs

Registrar Of Trade Marks, Mumbai-400037 And Madanlal Munshiram Aggarwal Trading As Hindustan Trading Corporation, "Liberty House", Mavdi Plot, Rajkot-360004

RESPONDENT

Date of Decision : 06-01-2012

Acts Referred:

Code Of Civil Procedure, 1908 — Section 11
Trade Marks Act, 1999 — Section 12(1), 105

Citation : (2012) 49 PTC 408 (IPAB)

Hon'ble Judges : Prabha Sridevan, J; S. Usha, J

Bench : Division Bench

Final Decision : Dismissed

Judgement

Prabha Sridevan, J

1 . This application has been filed for removal of trade mark "Crompton Greaves" Registration No. 433540 in class 7. The case of the applicant is as follows:-

The applicant is a market leader in a number of products in the electrical sector. The goods are exported to over 60 countries. The applicant is an undisputed leader in electrical and engineering goods, all sold in the name and style of Crompton. This mark is a coined mark by Col. Crompton whose company Crompton Parkinson Works is the first user of the mark. The applicant has succeeded to the above company's rights. The company has been using the word Crompton Greaves for all its products since 1965 either as Crompton or as Crompton Greaves both with and without Crompton Greaves logo. In 1966, the company altered its name to Crompton Greaves. It has registered the mark as

such for various goods in classes 7,8,9, 11 & 12. The details of the registration are given. The applicant is the prior adopter, user and proprietor of the mark. The applicant is a person aggrieved. The second respondent has copied the mark and the mark Crompton is similar / identical to the applicants mark and therefore, the mark should be removed from the register.

2 . The respondent in the counter stated that they have been dealing in Diesel oil engines and parts thereof under the mark Crompton for more than four decades. This mark was advertised in the Trade Mark Journal No. 952. They are also the registered proprietor of the label Crompton under No. 611572 as of 10.11.1993. The Impugned mark has been registered as of 7.02.1985. Crompton Parkinson limited filed an opposition and this was disallowed and the trade mark proceeded to registration by order dated 08.02.1996. Ms. Feroza Driver employee of the applicant company had filed an affidavit on 19.11.1991 in the said opposition proceedings. So the present applicants were aware of the use of the mark in 1991 itself. The appeal was filed before the Hon'ble Gujarat High Court and it was dismissed. According to the respondent, they have acquired valuable goodwill and reputation in respect of their goods under this mark. The applicant had acquiesced in their use and registration. The rectification has been filed beyond time. For 35 years, both have co-existed without any instance of confusion. The class of purchasers are different and the trade channels are also different. There is no dishonesty in adoption. The rectification petition should be dismissed.

3 . Both the counsel argued at length on the adoption and user of their respective marks. The learned counsel for the applicant took us through the long history of their company right from the time of Col. Crompton adopted this word. It is not necessary to deal with all this, considering the special circumstances of this case. The earlier opposition proceedings with regard to the same mark is an important feature of this case. The applicant is bound to explain the circumstances under which this rectification application can be maintained after those opposition proceedings were disallowed.

4 . We called for the record of the opposition proceedings from the Trade Mark Registry. In the evidence in support of opposition filed there by one Ms. Lois Jane Margaret Connor, it is stated that word "Crompton" forms the essential feature of the trading style of my company and its licensees in India viz. "CROMPTON GREAVES LIMITED". Therefore, the applicant herein stressed its right to the mark Crompton in the earlier proceedings. This evidence also states that the company adopted the trade mark in or about the year of incorporation, which is 1913 and that it is identified with the company and its licensees.

5 . There is another evidence in support of opposition signed by Ms. Feroza Driver. She is a legal officer of Crompton Greaves Limited, the applicant therein. It is stated in paragraph (2) "I am aware that Crompton Parkinson Limited of England are registered proprietors of the trade mark "Crompton". There is yet another evidence in support of opposition filed by one Mr. Arun Majumdar who is

Law Executive of Crompton Greaves Limited and speaks of the opposition proceedings. On the basis of this evidence, the opposition proceedings were heard. There was a detailed order. The entire evidence was considered and the Assistant Registrar of Trade Marks by order dated 08.02.1996 found that all the affidavits filed by the opponents are faulty and that the opponents have not established that the mark applied for by the applicants will cause confusion. The goods covered under the rival marks are totally different. The Assistant Registrar on a perusal of all the documents namely, the Bill books of the applicant (the respondent herein) since year 1973 found that there was honest and concurrent user. Therefore, the mark proceeded to registration. Against this the opponent (the licensor of the applicant herein) admittedly filed appeal No. 10 of 1996. This was dismissed for non-prosecution on 08.10.2002 by the Hon'ble Gujarat High Court.

6 . We have gone through the annual reports, certificate of registration etc. filed by the applicant herein. We need to look into it only if we are satisfied with the conduct of the applicant herein. The learned counsel appearing for the applicant tried to explain how the Law Executive of the applicant could not have bound the applicant by any statement made in the opposition proceedings. It is not only Ms. Feroza Driver's evidence in opposition, there is evidence of Mr. Lois Jane Margaret Connor and also Mr. Majumdar's. All of them have categorically stated that the applicant is a licensee of the mark Crompton from the opponent in the earlier proceedings. All the grounds that are stated in the present rectification proceedings were raised by the applicant's licensor and/ or parent company and they were rejected. It would be a mockery of justice to require the respondent to fight the battle all over again after a period of time. When the right to the mark gets transferred either by act of parties or by operation of law, the applicant must be deemed to have knowledge of the existence of the respondent from 1991, the date on which their law officer signed the evidence in support of opposition or at least from 1996, the date of the order. In 2002, the appeal was dismissed and the order shows that the counsel for the respondent herein had appeared before the Hon'ble Gujarat High Court after due notice. Even thereafter, the applicant has taken five years to file this rectification application. In *Khoday India Ltd. Vs Scotch Whisky Association and Ors* the Supreme Court was of the opinion that the explanation offered for the delay was hollow. The applicant had allowed the respondent to grow in strength from 1996. Even in 1996, the opponent could not show that there was instance of confusion. Before us there is no reference to the earlier proceedings in the present rectification application. We expect a company of such a repute as the applicant to place all the facts before the Court and seek proper relief. Instead, they have given explanations regarding the earlier proceedings only after it was pointedly raised in the counter. It is a matter of public policy that there must be finality to decisions. This is the principle on which Section 11 CPC is founded. While it may be argued that this cannot be strictly applied to opposition proceedings and the rectification application, in the present facts, on the ground of public policy we will not

entertain this application.

7. We are fortified by the judgment AIR 1973 Mys 74 - K.R. Chinnakrishna Setty and Ors. Vs. Sri Ambal and Co. where the Division Bench held as follows:

9. We are of the opinion that there is no substance in the above sub-mission. Even though the scope of the enquiry held by the Assistant Registrar on an application filed for the registration of the mark of a Party is of a limited nature, a decision given in that case cannot be treated as being totally irrelevant for purposes of deciding a suit under Section 105 of the Act, the concerned authority or Court has to decide whether the mark whose registration is sought or the offending mark possesses a deceptive similarity with a registered trademark. If a mark cannot be registered on the ground that it contravenes Section 12(1) then it follows that the user of the said mark will have to be restrained also in a suit filed under Section 105. In such a situation, if a decision is given in an earlier proceeding between the same parties there is little reason for holding that the said decision would not operate as res judicata in a proceeding under Section 105 of the Act in which the same question arises for consideration. The above view receives support from the decision of the Supreme Court in Raj Lakshmi Dasi v. Banamali Sen, 1953 4SCR 154. It is no doubt true that the earlier decision in this case is not one rendered in a suit and the same cannot be brought strictly within the four corners of Section 11, Civil P. C. Section 11. Civil P. C. as explained by the Supreme Court in the above decision is not exhaustive but only deals with one aspect of the general rule of res judicata. If the case can be brought within the scope of the general rule of res judicata, the decision in the earlier proceeding can still be used as a bar in a subsequent proceeding notwithstanding the fact that the earlier decision does not satisfy all the requirements of Section 11, Civil P. C.

8. This has been followed in 1980 IPLR 80 Bridgestone Tyre Company Ltd. & Anr. Vs. Bridgestone Company Private Ltd. & Anr.

9 . In the present case, the appeal has also been dismissed by the Hon'ble Gujarat High Court.

10 . On the grounds of acquiescence, laches, finality of the earlier decision, and withholding of material facts, ORA dismissed with cost of Rs. 10,000/-. The Miscellaneous Petition becomes infructuous.