

(2009) 08 IPAB CK 0007

In the Intellectual Property Appellate Board

Elsonic Santo Corp. (Earlier Called Bhatt Electronics)	APPELLANT
Vs	
Siemens Limited Rep. By Its Managing Director	RESPONDENT

Date of Decision : 21-08-2009

Acts Referred:

Trade And Merchandise Marks Act, 1958 — Section 9, 11, 11(a), 11(e), 12, 12(1), 18, 18(1), 18(4), 46, 46(1), 56(2)
Trade Marks Act, 1999 — Section 100

Citation : (2009) 08 IPAB CK 0007

Hon'ble Judges : S. Usha, J; Syed Obaidur Rahaman, Technical Member

Bench : Division Bench

Final Decision : Dismissed

Judgement

S. Usha, J

1 . The instant appeal arises out of the order dated 15th April, 2002 partly allowing the application for rectification and restricting the registration for the goods ""Electronic Alarms"" in class 9 vide application No. 317843B, under the provisions of the Trade and Merchandise Marks Act, 1958 (in short the Act).

2. The brief facts of the case are:

The appellant herein is the registered proprietor of the trade mark ""Electronic Watchdog"" a label mark registered under No. 317843B in class 9 in

respect of ""Electronic Apparatus and Instruments"". The respondent herein filed the application for rectification on the grounds that:

a) the trade mark ""Electronic Watchdog"" under No. 317843B was wrongly registered and was wrongly remaining on the register and that the

registration was in contraction of the provisions of Section 9, 11, 12, 18 & 46 of the Act;

b) that trade mark was registered without sufficient cause and was wrongly remaining on the register;

c) the registration has been obtained by committing fraud;

d) the impugned trade mark is descriptive and ought not to have been registered under the provisions of Section 9 of the Act;

e) the registration has been obtained for ""electronic apparatus and instruments whereas the registered proprietor had been using the said trade mark

only in respect of electronic alarm and as such is disentitled to protection in law, is therefore prohibited under Section 11 (e) of the Act;

f) the registration was prohibited under Section 12(1) of the Act as there were several conflicting marks on the register as on the date of impugned

application for registration;

g) the registration of conflicting marks in respect of electronic apparatus and instruments and electronic alarms prohibits registration of the impugned

applications under Section 18(1) of the Act;

h) the registered proprietor is not using the impugned trade for electronic apparatus except for electronics alarms for a period of 5 years and one

month or more and therefore registration ought to be cancelled as per the provisions of Sections 56(2) and Section 46 of the Act;

i) the applicant for rectification is using the expression watchdog for his advertisement in respect of 'Circuit Breakers'" for which a cease and desist

notice was issued to the registered proprietor. The applicant therefore is an aggrieved person;

j) the Registrar ought to have refused registration by exercising the discretion vested in him as per the provisions of Section 18(4) of the Act.

3. The appellant herein filed their counter statement denying the material allegation and made in the application for registration. They denied the

allegation that the trade mark ""Electronic Watchdog"" described the character and quality of the goods in respect of which it was registered. For the

word ""Electronic"" - a disclaimer condition was imposed. The word ""Watchdog"" is an expression used for an animal and not for the products

manufactured, marketed or sold under the brand name for ""Electronic Watchdog"" and the electronic products so described do not look physically or

otherwise life breathes like an animal. Therefore the mark was registerable under the provisions of Section 9 of the Act. They also denied the

avermment that the registration was obtained by fraud and was wrongly remaining on the register without sufficient cause. They denied the statement

that the impugned trade mark was used only in respect of electronic alarms and stated that it was used for a wide range of products.

4. On completion of the formal procedures, the matter was heard and decided by the Registrar. The grounds of rectification were under the provision

of Sections 9, 11(e), 12(1), 18(1) and 46 of the Act. The Registrar had passed the impugned order on the findings that:

a) the applicant for rectification ie. the respondent is a person aggrieved as they are also manufacturing the goods namely ""Circuit Breakers"" which

fall in the same classification of goods;

b) the impugned trade mark was capable of distinguishing the goods in respect of which the same was registered and the expression ""Watchdog"" is an

expression used for an animal and not for the products. Therefore objection under Section 9 rejected;

c) the conflicting marks cited by the respondent/applicant for rectification is

of no relevance and is no deceptively similar to that of the impugned trade marks ""Electronic Watchdog"" and the objection raised under Section 12(1)

of the Act is therefore rejected;

d) the registered proprietor though claims to have obtained registration for all goods falling that class, failed to prove use of the goods except for

electronic alarm and therefore the objection under Section 46(1) of the Act is partly allowed;

e) the provisions of the Section 11(a) is not applicable and the objection under Section 11(e) of the Act is rejected as the conflicting trade marks are

different and dissimilar;

f) the objection under Section 18(1) of the Act is rejected, in view of the finding that although the registered proprietor has not proved use for the wide

range of products, but has used the mark in respect of ""Electronic Alarm"" and the registration is also limited to there goods alone;

g) the registration is restricted in relation to the goods to read as ""Electronic Alarm"" only.

5 . Aggrieved by the said order the appellant/registered proprietor filed an appeal before the Hon'ble High Court of Karnataka in MFA-5253/02 and

the same was transferred to this Appellate Board in view of the provisions of

Section 100 of the Trade Marks Act, 1999 and re-numbered as TA/1/2009/TM/CH.

6. The Memorandum of grounds of appeals are:

i) the impugned order is not in accordance with law and the same is opposed to law.

ii) the authority has not given opportunity to the appellant to place materials to substantiate his objections.

iii) the Deputy Registrar has taken the application for enquiry and the order ought to have been passed by the Deputy Registrar and not the Assistant

Registrar.

iv) The authority failed to take note of the fact that the objection by the respondent is time barred.

v) The respondent has not opposed at the time of registration and this application for rectification is belated and ought not be entertained.

vi) The authority did not follow the procedure as required under law in deciding the dispute.

7 . The matter came for hearing on 21st July, 2009, Shri K.C. Bhatt appeared in person and none appeared for the respondents. The party re-iterated what was stated in the grounds of appeal.

8 . We have gone through the pleadings and the documents filed by the parties concerned before the Registrar in the opposition proceedings.

9 . The issues that arises for consideration is whether the appellant for rectification/respondent is a person aggrieved for registration and whether the registration is in contraction of the provision of Sections 9, 11, 18 and 46 of the Act.

10. Persons who are in some way or the other substantially interested in having the mark removed from the register or would be substantially

damaged if the marks remained on the register are persons aggrieved. In the instant case, the respondent is manufacturing ""Circuit Breaker"" which

also falls in the same class of goods and the respondent is using the word ""Watchdog"" as a description in relation to his goods. In such circumstances

the respondent is a person aggrieved and has a locus standi to file the rectification application. The order of the Registrar to this issue is therefore upheld.

11. The other issue as to the objection under Section 9 of the Act, the registrar has held that the word Electronic Watchdog was registered with a condition of disclaimer of the word Electronic and as such the word "Watchdog" has no direct reference to the goods to which it is used. The word "Watchdog" refers only to an animal and not to the electronic goods in which the appellant is dealing. The objection under Section 9 of the Act by the respondent is rejected and the issue is decided in favour of the appellant.

12. The other objection was under the provision of Section 12(1) of the Act. The respondents had objected to on the ground that there were series of marks registered which were deceptively similar to the impugned trade mark. On perusal of the marks, we are also of the view that these marks are no way similar to the impugned trade mark. The conflicting marks cited by the respondent are "Electrola, Electrols and Nite Dog". A mark is deceptively similar to another trade mark if it so nearly resembles the other so as to cause confusion or deception. In the case on hand, there is no possibility of confusion or deception and the objection under Section 12(1) is also dismissed upholding the finding of the Registrar.

13. The next issue is non use of the goods bearing the trade mark "Electronic Watchdog". From the records, it is seen though the appellant has obtained registration for the goods like Electronic Apparatus and Instruments, the appellant has been selling only Electronic Alarms. In view of the above, we find that the Registrar was correct in restricting the registration in respect of Electronic goods.

14. In view of the above, we do not find any infirmity in the order of the Assistant Registrar. There is no merits in the appeal. Accordingly, appeal is dismissed upholding the order of Registrar dated 15th April, 2002. There shall be no order as to costs.