

(2020) 07 IPAB CK 0006

In the Intellectual Property Appellate Board

Case No : ORA/108/2020/TM/DEL, ORA/117/2020/TM/DEL, M.P. No. 78/2020,
ORA/108/2020/TM/DEL, MP No. 79/2020 In ORA/117/2020/TM/DEL

F.K. Bearing Group Co. Ltd.

APPELLANT

Vs

Vinod Kumar And Ors.

RESPONDENT

Date of Decision : 10-07-2020

Acts Referred:

Trade Marks Act, 1999 — Section 11
Trade Marks Rules, 2002 — Rule 33, 37(2)

Citation : (2020) 07 IPAB CK 0006

Hon'ble Judges : Manmohan Singh, J; Dr. Onkar Nath Singh, Technical Membe

Bench : Division Bench

Advocate : Ajay Sahni, Ajay Amitab Suman, S.R. Chauhan

Final Decision : Dispose Of

Judgement

Manmohan Singh, J

Heard both the counsels. Counsel for the respondent No. 1 seeks two months time to file the counter statement. Let the same be done within two

months with an advance copy to the learned counsel for the applicant, who will file the response by next date of hearing. Parties are allowed to file the

written synopsis by next date of hearing. As regards interim application both the parties argued the matter.

In view of the facts mentioned above in the present case, the operation of the registration of the trade mark in question shall remain stayed. The

detailed order to follow.

1. We have already passed the interim order by separate order. The reasons are given now. As already stated that the respondent No. 1 has filed

reply to interim petition. It is claimed user since 2002. It is argued by the

counsel that the respondent No. 1 has also filed the rectification of registered trade mark of applicant's, who is the fabricated products of respondent No. 1.

2. It is not denied by the counsel for the respondent No. 1 that the prior user will hold the field and has a better rights between two rival marks.

3. We have heard both parties. Mr. Ajay Sahni has submitted that before the civil court, the respondent has filed the label of the application as claimed the label of respondent No. 1.

4. By this order, we propose to decide the interim applications filed by the applicant in both petitions. We are only concerned with the registration No.

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5. Case of the applicant

The Applicant, F.K. Bearing Group Co. Ltd., ever since its inception in 1969, has been engaged in the manufacturing and marketing of 'bearings' sold

under its trademark 'FK' which trademark was later in 1993 converted into the distinctive artistic logo since 1993 the Applicant has been

using its trademark FK/ and extensively throughout the world. The Applicant also owns and maintains its website www.fk-bearing.com

since 05.09.2001 which clearly shows the Applicant's use of its name/mark FK and a copy of the Who is Report obtained from www.who.is

evidencing the existence of the website www.fk-bearing.com since 05.09.2001 has been annexed with the Cancellation Petition and marked as

Annexure - A4 (Pgs. 143 - 146).

5.1. The Applicant is the registered proprietor of the trademark FK and/or than 80 countries of the world such as USA, EU, Australia,

Mexico, Singapore, New Zealand, Malaysia, Israel, China etc. amongst which countries the Applicant is also the registered proprietor of the

trademark India since 2004. That the trademark the Applicant is registered in India under No. 1329050 dated 30.12.2004 for

'bearings' and other bearing related goods in Class 07 and the Registration Certificate as issued by the Office of the Respondent No. 2 obtained from

the online records of the Respondent No. 2 is reproduced herein under:

5.2. That the Applicant has sold its high quality bearings continuously and extensively under its trademark FK/ at least since 1997

garnering a total sales for the said bearings for a value of more than Rs. 300

Crores. Sample copies of readily available sale invoices evidencing the sale of the Applicant's bearings under the trademarks FK/ since the year 1997 have been annexed with the Cancellation Petition and marked as Annexure - A7 (Colly) (Pgs. 159-262).

5.3. The Respondent No. 1 was an earlier agent/distributor of the Applicant engaged in the resale of the Applicant's products bearing the trademark

FK/ the impugned registration of the Respondent No. 1 for the identical trademark respect of identical/similar goods as that

of the Applicant came as a shock to the Applicant when the Applicant learnt that the Respondent No. 1 had managed to obtain the said registration

behind the back of the Applicant. The impugned identical trademark the Respondent No. 1 registered under No. 1989336 in respect of

identical/similar goods, claims a false use since 2009 which use is also 5 years subsequent to the date of registration of earlier trademark

the Applicant and the two competing trademarks of the Applicant and the Respondent No. 1 as registered by the Office of the Respondent No. 2 are

reproduced hereunder:

Trade Marks Journal No. 1723 - 0 dated 14.12.2015 where the Respondent No. 1's impugned registered trademark been advertised is

obtained from the online records of the Respondent No. 2 is reproduced herein under:

1. That although the Applicant has filed along with the Cancellation Petition sample invoices which clearly establish that the Respondent No. 1 was an

earlier agent/distributor of the Applicant engaged in the resale of the Applicant's 'bearings' sold under the trademark FK/ was only very

recently that the Applicant stumbled upon a few additional invoices where the Respondent No. 1 has procured the goods of the Applicant bearing the

trademark FK/ as early as 1999. Some of the said invoices were inadvertently overlooked on account of the fact that the Respondent

No. 1 was earlier also procuring goods in the name of its body incorporate being Vinod Kumar Garg Marketing Pvt. Ltd. in which Company the

Respondent No. 1 was a director and which was subsequently struck off from the Register of Companies. The Applicant immediately shared copies

of such invoices with its attorney through E-mail dated 09.07.2020 and the said E - mail along with the copies of the invoices are collectively annexed

hereto and marked as Annexure - 1 (Colly). A copy of the master data evidencing the Respondent No. 1 to be a director in the said Vinod Kumar

Garg Marketing Pvt. Ltd. is also annexed hereto and marked as Annexure - 2.

5.4. The impugned registered trademark the Respondent No. 1 had been obtained due to an error apparent on the face of the record in

as much as while examining the said impugned trademark the Respondent No. 1, the Office of the Respondent No. 2 had failed to cite

the earlier identical trademark the Applicant registered in respect of identical/similar goods, thereby making the said examination

violative of the provisions of Section 11 of the Trade Marks Act, 1999 read with the provisions of Rule 33 of the Trade Marks Rules, 2017 (Earlier

Rule 37 (2) of the Trade Marks Rules, 2002).

5.5. It is a settled principle of law that under the provisions of Rule 37 (2) of the Trade Marks Rules, 2002 (Now Rule 33 of the Trade Marks Rules,

2017) read with Section 11 of the Trade Marks Act, 1999 the Office of the Respondent No. 2 is obliged to cause a search to be made amongst the

registered/pending trademarks for the purpose of ascertaining whether there exist on record any earlier identical/similar trademarks to the mark sought

to be registered in respect of identical/similar goods and that where the subsequent mark is registered in contravention to the said provisions then the

effect of such registrations are liable to be stayed. [Zee Telefilms Ltd. and Anr. Vs. Asia Today Ltd. and Ors. 2007 (34) PTC 467 (Del)] [Gulf Gate

Hair Care Hair Fixing Pvt. Ltd. Vs. M/s. Brothers Gulf Gate Hair Care Centre ORA/194/2010/TM/CH] [Sriram Arya HUF Vs. Dinesh Shahi

ORA/298/2014/TM/DEL]

Findings

6. It is evident from the record and facts stated above, prima facie, it appears that the applicant is the prior user and prior adopter. The logo F.K.

appears to have been adopted by the applicant from their corporate name. As per admission of the respondent No. 1 itself that it has been using the

mark since 2000. The user claimed by the respondent No. 1 while obtaining registration as 2009. The reply filed by the respondent No. 1 does not help

his case in view of earlier use of the applicant on Government record.

7. The user of the applicant is since 1969. There is a sufficient material available on record. On the face of admission of the respondent No. 1, the

applicant is the prior user.

8. The provisions of Rule 33 of the Trade Marks Rules, 2017 (Earlier Rule 37 (2) of the Trade Marks Rules, 2002) has not been complied with by the

respondent No. 2 who failed to cite the registered trade mark of the applicant in the examiner reports. Thus, the applicant is able to make out a strong

prima facie case in its favour and against the respondent No. 1.

9. Thus, till the rectification petition is finally decided, the operation of two registrations of respondent No. 1 of 3318333 in class 12 shall remain

stayed.

10. Both interim applications are disposed of.