
(2012) 10 DEL CK 0287
In the Delhi High Court
Case No : Writ Petition (C) 2589 of 2011

Gopal Kishan

APPELLANT

Vs

UOI and Another

RESPONDENT

Date of Decision : 08-10-2012

Acts Referred:

Constitution of India, 1950 — Article 226
Trade Marks Act, 1999 — Section 100

Citation : (2012) 9 AD 404 : (2012) 132 DRJ 552 : (2013) 53 PTC 603

Hon'ble Judges : Vipin Sanghi, J

Bench : Single Bench

Advocate : Mohan Vidhani, Ms. Minakshi K. Jain and Mr. Rahul Vidhani, for the Appellant; Ajay Verma, Advocate for the Respondent No. 1/UOI, for the Respondent

Final Decision : Dismissed

Judgement

Vipin Sanghi, J.—The present petition has been preferred under Article 226 of the Constitution of India to assail order dated 16.12.2010 of the Intellectual Property Appellate Board (hereinafter referred to as the "IPAB") passed in TRA/22/2005/TM/DEL, whereby the rectification application filed by the petitioner, for removal of the trade marks of respondent No. 2 registered under the provisions of the Trade & Merchandise Act, 1958 (hereinafter referred to as the "Act"), has been dismissed. The above rectification application was initially filed before this Court in C.O. 7/2003, and pursuant to Section 100 of the Trade Marks Act, 1999, the same was transferred to the IPAB.

2. The petitioner sought removal of the trade marks registered under Nos. 310536, 355435, 355436 and 487215, all in class 9 under the Act. All these marks contained the word mark "STANDARD". The challenge to these registrations was premised on the submission that the word "STANDARD" is a word of common English language; is highly laudatory, and; is incapable of ever acquiring distinctiveness even after the long use thereof. It was also argued that

the word "STANDARD" cannot acquire secondary meaning in favour of anyone including the respondent No. 1, even after long continuous use thereof as the same cannot lose its primary meaning.

3. The IPAB by its impugned order rejected the application of the petitioner on the following grounds:

A. The trade mark "STANDARD" has acquired distinctiveness and a secondary meaning on account of its long and continuous use over a period of time since 1958, and therefore is capable of being registered.

B. The claim of the petitioner that the trade mark is generic has no basis on account of the fact that the petitioner itself is a registered proprietor of the trade mark "MAX STANDARD", claiming its user since 1979 to 1992, which was later on changed to "MS STANDARD" from 1992 onwards. The IPAB has invoked the principle laid down in the "DIMMER DOT" case i.e. Automatic Electric Ltd. Vs. R.K. Dhawan & Anr., (1999) 77 DLT 292.

C. The petitioner had failed to establish that the marks of respondent No. 2 are likely to cause confusion. Further, the marks of the respondent No. 2 were registered prior to that of the petitioner. In view of the settled principle of law that prior approval prevails over the subsequent registered proprietor, the user of the respondent No. 2 prevails over that of the petitioner. Therefore, confusion would be on account of use of mark by the petitioner and the same could cause loss to respondent No. 2.

D. The claim of the petitioner that the marks of respondent No. 2 had been registered without sufficient cause cannot but fail, since the issue of non-user of the marks by Respondent No. 2 does not arise in the present case (as the user of the mark STANDARD by Respondent No. 2 dates back to 1958), and also since the mark of respondent No. 2 is distinctive and the mark "STANDARD" has acquired a secondary meaning.

4. The petitioner assails the impugned order primarily on the ground that the IPAB erred in holding that respondent No. 2 had been using the marks in question since the year 1958. It is submitted by the petitioner that evidence of such user had not been led by respondent No. 2 and the finding of the IPAB is against the record. Reliance is placed on the pleadings before the IPAB.

5. It is also submitted that the IPAB erred in holding that since respondent No. 2 was using the trademark prior in point of time as compared to the subsequent use by the petitioner, the same would cause loss to respondent No. 2. By observing so, the IPAB exceeded its jurisdiction since the same was not in issue before it.

6. Having perused the record and heard Learned Counsel for the petitioner, I find no merit in the present petition and I am inclined to dismiss the same.

7. No doubt, the petitioner, in response to the reply of respondent No. 2 before

the IPAB disputed the claimed user of the mark "STANDARD" since the year 1958, and required respondent No. 2 to produce proof of its user from the year 1958 but that, to my mind, makes no difference. Respondent No. 2, it appears, led evidence of its user of the mark "STANDARD" as the case of respondent No. 2 in the affidavit by way of evidence filed before the IPAB was that it had been using the mark "STANDARD" since the year 1958. Respondent No. 2 has disclosed that it is one of the leading manufacturers of wide range of electrical equipments under the name "LT Switchgears and Fusegears". It is supplying its equipment to a number of government undertakings, corporate houses and industrial units such as the Indian Railways, National Thermal Power Corporation (NTPC), Bharat Sanchar Nigam Limited (BSNL), steel plants, etc.

8. Pertinently, the petitioner has chosen to selectively file the documents annexed to the said affidavit by way of evidence before this Court. The invoices produced by respondent No. 2 have not been filed. Therefore, I am not inclined to examine the issue of fact determined by the IPAB on the basis of the evidence laid before it.

9. Even if the user of the respondent No. 2 is accepted not to be since 1958, but since 1967 onwards - as was allegedly claimed when the respondent No. 2 sought registration of its mark on 02.12.1975 vide an application No. 310536, the same is of sufficient vintage to conclude that the mark "STANDARD" had acquired distinctness and a secondary meaning on account of its long and continuous use over a period of time. The registration was granted with the condition that the respondent No. 2 shall not have the right to the exclusive use of the word "STANDARD" and "India". In view of the aforesaid, I find no merit in this petition and the same is dismissed.