

(2011) 10 IPAB CK 0009

In the Intellectual Property Appellate Board

Case No : M.P. No. 125/2008 In OA/51/2008/TM/KOL And OA/51/2008/TM/KOL

M/s. E. Tjellesen A/s Blokken 81 Dk-3460 Birkerød Denma APPELLANT
Vs

Reba Dass Trading As M/S. Dolphin Aromatics 39, Rai RESPONDENT
Bahadur Road Kolkata - 700 034, West Bengal And Deputy
Registrar Of Trade Marks Trade Marks Registry Kolkata

Date of Decision : 31-10-2011

Acts Referred:

Trade Marks Act, 1999 — Section 11, 11(10), 12, 18(1)

Citation : (2011) 10 IPAB CK 0009

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

Bench : Division Bench

Final Decision : Disposed Of

Judgement

S. Usha, J

1. The above appeal arises out of the Order dated 28.02.2007 passed by the Deputy Registrar of Trade Marks dismissing the application No. KOL-

182914 and allowing the application No. 1103477 in class 3 to proceed to registration under the provisions of the Trade Marks Act, 1999 (hereinafter referred to as the Act).

2. The brief facts of the case are:-

The appellants herein are the opponents before the Registrar of Trade Marks opposing the registration of the trade marks and the appellants are the

respondents herein. The 1st respondent herein filed an application for registration of the trade mark ""Josh"" (a label mark) under application No.

1103477 in class 3 in respect of floor cleaner, soap of all kinds, perfume, cosmetics oil, hair lotion, cosmetics and agarbatti. The said application was

filed on 09.05.2002 claiming user since 10.01.1999. The application was

advertised before acceptance in the Trade Mark Journal No. 1311 dated 16.01.2004 at page 43.

3 . The appellant herein filed their notice of opposition opposing the registration on the ground that they are globally reputed company and a market leader in the field of cosmetics and personal care products and are using the trade mark GOSH since the year 1976 world wide and the same is registered in several countries. In India they obtained registration as of 01.04.1977. The appellants have also filed application in India for registration of the Trade marks 'House of GOSH' and 'Nothing by GOSH' under Nos. 672477 and 672476 which was pending registrations.

4. The trademark ""GOSH"" is exclusively associated and identified with the appellants due to wide use of promotional activities. The impugned trade mark is deceptively similar to that of the appellants' trademark and is likely to cause confusion and deception and therefore prohibited for registration under section 11 and 12 of the Act.

5. The appellant's trade mark ""GOSH"" is a well known trade mark and the impugned trade mark registration is prohibited under Section 11 (10) of the Act. The 1st respondent's adoption is only to trade upon the goodwill and reputation earned by the appellant and therefore cannot claim to be the proprietor of the mark under Section 18 (1) of the Act.

6. The 1st respondent filed their counter statement to the notice of opposition stating that the impugned trade mark is being used by them since the year 1999 and there has not been any instances of confusion or deception by long use and denied the other contentions made in the notice of opposition.

7 . The Deputy Registrar heard both and passed the impugned order with a finding that the rival marks are not deceptively similar and when the marks are not deceptively similar, the question of deception and confusion does not arise. The appellants though claim to be prior in use have not substantiated the same. The 1st respondents have claimed user since 1999 and are therefore entitled to claim the right of proprietorship. The impugned trade mark was therefore allowed to be registered.

8. The appellants being aggrieved by the said order are before us on appeal on the grounds:

- (a) that the Registrar failed to appreciate that the appellant is a globally reputed company;
- (b) that the 2nd respondent failed to consider the fact that both the marks are identical;
- (c) that the 2nd respondent failed to appreciate that the 1st respondents has submitted forged evidence in support of its claim of use;
- (d) that the Registrar has failed to consider the appellant's evidence;
- (e) that the Registrar has wrongly held that the rival marks are not deceptively similar;
- (f) that the Registrar has wrongly taken a narrow view by restricting himself to the conflict of the impugned mark ""JOSH"" only with the registered trade mark ' Nothing by Gosh and House of Gosh' and failed to consider the scope of confusion of the impugned mark Josh with the mark 'Gosh'; and
- (g) that the impugned trade mark is erroneous, contrary to settled principles of law and is liable to be set aside.

9 . The 1st respondent were received with the notice of the appeal but have not entered appearance through any pleader nor have they filed counter

statement till the date of hearing. They were not present and therefore we proceed to hear the appellants, setting the respondents ex-parte.

10. We have heard Ms. L. Bhaswati Singh, counsel for the appellant.

11. The Learned Counsel for the appellants submitted that they adopted the trade mark ""GOSH"" as early as 1976. They had the trade mark registered

as of 1-4-1977 in Denmark. In 1981, they obtained registration in United States of America. In India, the appellants use is since the year 2001 which is

evidenced by the invoice dated 14-08-2001. The rival marks GOSH and JOSH are similar and the goods are identical.

12. The appellants counsel then relied on few judgments viz.,

MANU/MH/0069/2007 --Encore Electronics Ltd. Vs. Anchor Electronics and Electricals Pvt. Ltd.

2006 (33) PTC 718 (IPAB) --Reckitt & Colman of India Limited Vs. Charmy Industries & Anr.

MANU/IC/0076/2009 - Mr. Baldev Singh Trading as Madaan Plastic Industry Vs. Registrar of Trade Marks, Trade Marks Registry and Casio

Keisaniki Kabushiki Kaisha (Also Trading as Casio Computer Co. Ltd.)

MANU/DE/0800/2009 - Gandhi Scientific Company Vs. Mr. Gulshan Kumar AND

Mr. Gulshan Kumar Vs. Gandhi Scientific Company.

13. We have considered the appellants arguments and have gone through the entire records for deciding the appeal. The appellants main contention

was that the trade mark GOSH and JOSH are deceptively similar and would cause confusion as they were the prior users since 1977. We are unable

to accept this contention as the appellants though have produced registration certificate from Denmark and other places. The mark on the Registrar

will not prove the use. The invoice filed by appellant is dated 14-08-2001 in India. Therefore the use of trade mark in India can be only from the year

2001. The appellants have also admitted the trade mark used by them are ""Nothing by Gosh"" and ""House of Gosh"" which are registered and it is not

the word Gosh.

14. The appellants use has not been for long in India except the 1st invoice dated 14-08-2001. The 1st respondent's claim is from the year 1999. We

cannot accept the appellants arguments that the respondents have filed forged evidence. The Challans dated 28-05-2001 and 13-09-2001 can be taken

to prove their use as these Challans are prior to the date of application for registration i.e. on 09.05.2002. The 1st respondent has proved their use

prior to the date of application for registration.

15. In the instant case, we do not think the rival marks are deceptively similar. The appellants' sales in India has been subsequent to the 1st

respondent's use. When we hold the marks are not deceptively similar the question of confusion and deception does not arise. It is also pertinent to

mention here that the appellants have filed certain advertisements, where it is mentioned as Nothing by Gosh, Nothing less, Sweet nothing, Next to

Nothing, Nothing (r) Yet, Nothing Blue etc., where Gosh is not mentioned. These advertisements are only of the year 2002 & 2004 which will be of

no help to the appellants.

16. The other issue as to well known mark, the appellants have failed to prove the same. They failed to prove trans-border reputation. As held by the

Apex Court, mere registration of the mark will not prove use. The appellants have not filed any documents/evidence before the Registrar or before us

to prove user since 1977.

17. In view of the above findings, we dismiss the appeal upholding the order of the Registrar with no order as to costs. The Miscellaneous Petition No.

125/2008 stands closed.