

(2012) 06 IPAB CK 0010

In the Intellectual Property Appellate Board

Case No : OA/39/2009/TM/AMD

M/s. Godrej Sara Lee Ltd. Pirojshnagar, Eastern Express
Highway, Vikhroli, Mumbai Maharashtra

APPELLANT

Vs

M/s. Godrej Sara Lee Ltd. Pirojshnagar, Eastern Express
Highway, Vikhroli, Mumbai Maharashtra

RESPONDENT

Date of Decision : 25-06-2012

Acts Referred:

Trade Marks Act, 1999 — Section 9, 11, 12, 18

Citation : (2012) 52 PTC 404 (IPAB)

Hon'ble Judges : S. Usha, J;V. Ravi, Technical Member

Bench : Division Bench

Final Decision : Allowed

Judgement

S. Usha, J

1. Appeal arising out of the order dated 19.02.2009 passed by the Deputy Registrar of Trade Marks disallowing the opposition No.AMD-193048 and

allowing application No. 1249080 in Class 5 to proceed to registration under the provisions of the Trade Marks Act, 1999 (hereinafter referred to as

the 'Act'). The 1st respondent herein filed an application for registration of the trade mark TARJET (a label mark) in Class 5 under No. 1249080 on

12.11.2003 claiming user since 8.1.2001. The said application was advertised before acceptance in the Trade Marks Journal No. 1323 dated 6.

12.2004 at page 466 which was made available to the public on 7.3.2005. The appellants herein opposed the registration stating that their trade mark

JET"" has become very popular among consumers and trade by virtue of long and continuous use. The respondent's adoption is dishonest and it is

calculated to pass off their goods as that of the appellants/opponents.

2 . The 1st respondent filed their counter statement stating that they adopted and used the trade mark ""TARJET"" since 2001 in respect of pesticides, insecticides, disinfectants which are related to agriculture. They adopted the trade mark after conducting a market survey. The marks are different and also the goods.

3. The learned Registrar held that the mark ""TARJET"" has no direct reference to the character and quality of goods and therefore does not fall within the ambit of Section 9 of the Act. The appellant's trade mark is ""JET"" and the respondent's trade mark is ""TARJET"". The respondent has coined the mark ""TARJET"" by adopting the different words. The class of customers and the goods are different hence rejected the objection under Section 11 of the Act. The registration was granted under Section 12 of the Act as the respondents had proved bonafide concurrent use.

4 . The respondent before adopting the impugned trade mark conducted a market survey. The mark is coined and is not similar with the trade mark JET"". The goods are different. The objection under Section 18 of the Act was therefore rejected. The opposition was therefore dismissed and the application was allowed to proceed to registration.

5. Aggrieved by the said order, the appellant filed the instant appeal on the ground that they are engaged in the business of manufacturing and marketing of variety of goods including mosquito repellants in the form of mats, coils and liquids. The appellant is one of the largest manufacturers of mosquito repellants in India. The appellants JET brand is very popular amongst the customers and in the trade. The appellant is the registered proprietor of the trade mark JET.

6. The appellant filed the appeal on the ground that the registration of the impugned trade mark would cause confusion among the consuming public.

The Registrar wrongly held that the trade mark JET and TARJET are phonetically different. The Registrar erroneously held that the trade mark

TARJET has no direct reference to the goods. The appellant's mark is for household goods whereas the respondent's mark is for agricultural products. The decisions were not considered by the Registrar. The Registrar failed to consider the fact that the appellants were prior in adoption and use.

7. The respondent filed their counter statement stating that they honestly coined

and bonafidely adopted the trade mark TARJET since 1.8.2001. After a market survey the respondents adopted the trade mark as there was no deceptively similar trade mark available in the market. The respondent's trade mark is distinctive and capable of being distinguished. Their trade mark has acquired very high reputation and goodwill in the market. They have spent huge amounts to advertise and popularize their goods bearing the said trade mark. Their sale turnover runs to several crores of rupees. The registration would not be in contravention of the provisions of the Act.

8 . We have heard Shri M.R. Nair, Counsel for the appellant and Shri Akshay Vakil, Counsel for the respondent on 9.4.2012.

9. The learned Counsel for the appellant submitted that the appellant's mark is ""JET"" and the respondent's mark is ""TARJET"". The appellants have been using the trade mark JET since 1984 whereas the respondents have adopted and used the trade mark TARJET since 2001 only to trade upon the appellant's use and goodwill. The respondent has no reason for adopting the trade mark ""TARJET"". The reason given for JET is that it is a dictionary word which means spray but no explanation for the word TAR.

10. The respondents though state that they made a market survey, no evidence has been produced before the Registrar. In fact the Registrar has considered and observed in the impugned order that a market survey was conducted but the respondent has not produced any evidence. There is no evidence to prove their statement of search conducted in the Trade Marks Registry. The adoption is dishonest and therefore is not the proprietor of the trade mark.

11. The Counsel then relied on an unreported judgment of the Bombay High Court in Miscellaneous Petition No. 3 of 1992 - Marion Merrell Dow Inc., Petitioners Vs. Unichem Laboratories Ltd., T.R. Subramanian, R. Ravi, Respondents and submitted that if a person had copied somebody else's mark cannot be said to be the proprietor of the trade mark, then even if it is a coined or invented word the applicants cannot seek registration under Section of the Act. The Counsel pointed out to the invoices and submitted that the invoice is dated 8.8.2003 whereas the L.S.T. number is dated 20. 9.2003 which only creates a doubt as to its veracity. The application for change of company name was made on 1.9.2003 but the invoice dated 8.8.2003 is in the name of the changed name which is again not a valid evidence.

12. The Counsel then relied on few judgments, namely -

(i) 1982 PTC 321 - Sharda Machinery Corporation, Delhi - Appellants Vs.R.S. Sewing Machine Co., Bassi Pathanan, Respondents

(ii) 1887 RPC Vo.IV. No. 8 decided by Courts of Law in the United Kingdom, Chancery Division - The Sanitas Company, Plaintiff Vs. Condy,

Defendant

(iii) 1980 RPC (9) 237 - In the Trade Marks Registry - DA VINCI Trade Mark

(iv) 1937 RPC Vol.LIV (7) - Chancery Division - Macleans Ltd., Vs. J.W. Lightbown and Sons, Ltd., and in the matter of a Trade Mark ""MAC"" No.

458,654

(v) 1997 PTC (17) - Induss Food Products Equipments Ltd., Petitioner Vs. Rani Sati Ice-cream Pvt. Ltd., Respondents

(vi) 1996 PTC (16) - American Home Products Corpn., Wyeth Lab. Ltd., Petitioner Vs. Lupin Lab Ltd., Respondents

(vii) 2012 (49) PTC 330 (Del.) - Piruz Khambatta & anr., Plaintiffs Vs. Soex India Pvt. Ltd. & Ors., Defendants

13. In reply, the Counsel for the respondent submitted that the goods are different, the trade channels are different and the quantity also differs, so the possibility of confusion does not arise. The Counsel then submitted that the marks are to be compared as a whole and relied on the judgment reported

in 1982 (2) PTC 335 (SC) - F. Hoffmann La Roche and Co. Ltd., Appellants Vs. Geoffry Manners and Co. Pvt. Ltd., Respondents. The Counsel

further submitted that the mark is not descriptive and therefore Section 9 of the Act is not applicable. The Counsel finally submitted that the impugned

order was correct and prayed that the appeal be dismissed and the application be allowed to proceed to registration.

14. We have considered the arguments of both the Counsel and have gone through the pleadings and documents.

15. The respondent's main contention was that the trade mark was a coined word and there was no similarity between the rival marks. The

respondents are stated to have coined the trade mark by joining the words, that is, ""TAR"" and ""JET"". The meaning for ""JET"" is to spray but no answer

for ""TAR"". If we are to take the word ""JET"" to mean to spray then it is said to be descriptive of the goods. The goods are pesticides, insecticides etc.

When there is no clear explanation to say it is a coined or invented word then it

cannot be said to be an invented word. If it is not an invented word

then the applicant/respondent herein cannot be said to be the proprietor of the mark.

16. The burden of proving confusion is always upon the applicant for registration in an opposition proceedings. The applicant, that is, the respondent

herein is to satisfy that the registration of the impugned trade mark will not cause any confusion. The applicant has not satisfied the same.

17. As regards the invoices, the L.S.T. No. which is subsequent to the date of the invoice cannot be accepted to be a valid document to consider the

use. The other issue is that the licence has been granted for the mark ""TARGET"". We also see some of the invoices bear the trade mark TARGET.

Assuming the respondents to have adopted both the trade marks - TARGET and TARJET, but the licence is granted only for TARGET and not

TARJET. The use of the trade mark ""TARJET"" could be only to trade upon the goodwill of the appellants. The adoption cannot therefore be said to

be bonafide.

18. The appellants have been using the trade mark since the year 1984 whereas the respondents adopted the trade mark only since 2001. The rights of

the earlier user ought to be protected. For the reasons stated above, the appeal OA/39/2009/TM/AMD is allowed and the impugned order is set aside.

There shall be no order as to costs.