

(2012) 05 IPAB CK 0014

In the Intellectual Property Appellate Board

Case No : ORA /151/2011/TM/DEL

M/s ORAS Oy., Isometsantie 2, P.O. Box No. 40, F1-26100 APPELLANT
Vs

Pradeep Khandelwal, Trading As M/S Bazarilal Pradeep Kumar, RESPONDENT
3754, Chawri Bazar, Delhi 110006

Date of Decision : 18-05-2012

Acts Referred:

Trade Marks Act, 1999 — Section 11, 11(3), 12, 18, 21, 47

Citation : (2012) 05 IPAB CK 0014

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

Bench : Division Bench

Final Decision : Allowed

Judgement

S. Usha, J

1. Original Rectification Application is filed for removal of the trade mark registered under No. 1224394 in Class 11 under the provisions of the Trade

Marks Act 1999 (in short 'the Act'). The applicant is engaged in the business of manufacture, distributor and sale of wide range of apparatus for

water supply & sanitary purpose including mixer taps for water pipes such as thermostatic mixers, bath/shower mixers and kitchen sink mixers,

plumbing parts and fittings, apparatus for heating and drying, Washing machine valves and coupling, brass and steel ball valves for district heating and

building industry, facets, various types of taps, viz: touch less taps, electronic faucets, various types of taps, viz: touch less taps, electronic faucets,

automatic faucets, thermostatic faucets, pressostatic faucets, single lever mixers, basin mixers, shower sets, shower panels, radiator valves, regulating

valves, throttle valves, pressure-balancing valves, pump valves, mixing valves, ball valves, safety valves, constant pressure valves, garden valves,

washing machine valve, Components and fitting for the afore mentioned products etc. and other allied/related products.

2 . The applicant company was founded in the year 1945. They adopted the trade mark Oras & started using the same since 1945. In the year 1977,

the applicant started using the trade mark in a stylized manner. They had been using the mark also in conjunction with other words/marks in various

style and artistic way. The word Oras forms essential part of the applicants name M/s Oras Qy. They also adopted Oras as an essential and mutual

part of its domain name i.e. www. Oras.com. By using the domain name in the course of trade & in relation to its business & products, it has built up

a valuable trade, goodwill & reputation thereunder.

3 . In order to obtain statutory rights in the said trade mark the applicant obtained registration in various countries of the world. They obtained

registration in Finland as of 01.04.1978. The applicant is the owner & proprietor of the Original artistic work of the label within the meaning of the

Indian Copyright Act.

4 . The applicants products are distributed in various parts of the world. Since adoption, the applicants have been continuously & extensively using the

trade mark without any interruption. The applicant had thus acquired a worldwide & global valuable trade & goodwill. The applicants maintain

excellent quality by applying the latest production techniques, marketing strategy and sales distribution. They have spent several millions Euros on the

publicity & promotion of the said trade mark.

5 . To the best of the applicants knowledge & information the respondent is also engaged in the same /similar business as that of the applicants. The

respondents have adopted the trade mark label Oras malafidely & dishonestly. They have also wrongly and malafidely obtained registration of the

impugned trade mark label "" "" under No. 1224394 in class 11 as of 19.08.2003. The adoption & registration of an identical mark for identical goods will

definitely cause confusion & deception among the public. The applicant is suffering & will contribute to suffer in case the impugned trade mark is not

rectified from the register. For these reasons, the applicant is a 'person aggrieved' and they have the locus to sustain & maintain the instant petition on

these grounds:-

- a) the impugned trade was wrongly applied for & wrongly obtained by the respondent;
- b) the respondent is guilty of playing fraud upon the Registrar; c) the respondents' date of use is wrongly given;
- d) the respondent has not used the impugned trade mark in relation to the goods for which registration was obtained;
- e) the respondent's use, if any, is tainted and is void abinitio;
- f) the illegal use of 8 months is not sufficient to grant registration;
- g) the impugned trade mark has not acquired distinctiveness;
- h) the respondents adoption is dishonest;
- i) the applicant is the prior adopter and user of the impugned trade mark;
- j) the respondents adoption is only to trade upon the applicants goodwill & adoption;
- k) the respondent is guilty of infringement of trade mark & copyright;
- l) the impugned trade mark is likely to cause confusion & deception;
- m) the impugned registration is in contravention of the provisions of Section 11 of the Act;
- n) the respondent is not entitled to any of the benefit of Section 12 of the Act;
- o) the respondent is not entitled to any of the benefit of Section 18 of the Act;
- p) the respondent has not used the trade mark for a period of more than 5 years and 3 months and is therefore the trade mark deserves to be rectified under Section 47 of the Act;
- q) the impugned trade mark is wrongly remaining on the register without sufficient cause;
- r) the impugned trade mark is registered contrary to the provisions of the Act;
- s) the impugned registration is illegal & void abinitio;
- t) in the interest of purity of the register the entry be removed;
- u) in the interest of justice, equity & good conscience the present petition be allowed.

6 . The service of notice of the rectification application on the respondent could not be made as the notice sent was returned with an endorsement as left without address"". The applicant, therefore, effected publication of notice as per directions of this Board. The publication was effected on

12/01/2012. There was no appearance for the respondents, they were set ex-parte and we heard the applicants on merits.

7 . The learned counsel for the applicant reiterated the entire facts of the case as stated in the application for rectification. The counsel then relied on few judgements.

1. 2005 (30) PTC 385 (Mad-DB)--""Jolen Inc., Vs. Shobanlal Jain and Others"" - an identical copy of the mark with the artistic work is only to trade upon the goodwill & reputation earned by the applicant.

2. 1997 PTC (17) High Court of Delhi IA. No. 5895/86 in Suit No. 2222/86 --""Revlon Inc. Vs Sarita Manufacturing Co.""-No reason given by the respondent for the adoption of an identical trade mark.

3 . AIR 1995 Del 300 --""N.R. Dongre and others Vs. Whirlpool Corporation and others""- The knowledge and the awareness of the goods of a foreign trade and its trade mark can be available at a place where goods are not being marketed & consequently not used.

4. 2004 (28) PTC 585 (SC) --""Milment Oftho Industries & Others Vs Allergan Inc.""-The mere fact that the respondents have not used the mark in India would be irrelevant if they first in the world market.

8 . The counsel finally prayed that the rectification application be allowed with a direction to the Registrar to remove/cancel the trade mark.

9. We have heard & considered the arguments and have gone through the pleadings & documents.

10 . The application for rectification has been filed on the ground that the respondents have not used the trade mark for a period of more than 5 years and 3 months and that the adoption of an identical trade mark is dishonest amongst other grounds. The marks are identical for identical goods.

11 . We shall first deal with the issue of a person aggrieved. The application for rectification can be filed by a person aggrieved as per the provisions of the Act for rectification unlike an opposition proceedings which can be filed by any person as person under Section 21 of the Act.

12. The term ""Person aggrieved"" has been defined by Lord Herschell in Powell's case; Wherever it can be shown, as here, that the Applicant is in the same trade as the person who has registered the Trade Marks, and wherever the Trade Mark if remaining on the register, would or might limit the

legal rights of the Applicant, so that by reason of the existence of the entry on

the register he could not lawfully do that which, but for the existence of the entry on the register he could not lawfully do that which, but for the existence of the mark upon the register, he could lawfully do, it appears to me he has a locus standi to be heard as a person aggrieved.

13. The applicants herein are engaged in the same trade and are likely to be injured by the impugned registration. The applicants have adopted and used the trade mark since 1945 and have started using the trade mark label since 1977. The respondents claim user since 04.01.2003 as seen from the Trade Marks Journal advertisement which is definitely subsequent to that of the applicants. The label mark which has an artistic work in the trade mark Oras is written in a stylish manner and the respondent has copied the entire artistic work which is contrary to law. Considering these facts, we are of the view that the applicant is a person aggrieved.

14. A trade mark may be removed on the ground that on the date of the registration, the use of the mark would cause confusion and the registration is in contravention of the provisions of the Act. In the instant case, the marks are given below:

Applicants' mark Respondents' mark

15. When we look at both the marks, the marks are identical. The goods in respect of which, the applicants & the respondents are dealing are also the same. The artistic work is the same. The registration is therefore, in contravention of Sub Section 3 of Section 11 of the Act. The respondents are out only to make profit out of the goodwill & reputation earned by the applicants. The respondents are passing off their goods as that of the applicants as well infringing the copyrighted artistic work of the applicants.

16. We shall now deal with the adoption of the infringed trade mark by the respondents. Hereinabove, we have seen both the label marks. The word consists of the letters o, r, a & s. All the letters are small letters. The letter "r" is written in a stylish manner which looks like a "tap" as it is used for the goods - apparatus for water supply. The respondents have not appeared before us to give any explanation for the adoption. Assuming the respondent had adopted the trade mark for some reason or other, we cannot accept the adoption of the label mark to be honest. The respondents impugned trade mark is a slavish copy of the applicants trade mark. The adoption by the respondent is only to make profit out of the reputation & goodwill earned by

the applicant. The adoption, therefore, cannot be said to be honest.

17. As regards the date of user, even though the respondents are not before us, on perusal of the Trade Marks Journal Publication, it is an admitted

fact, that the respondents use is since, 2003 which is subsequent to that of the applicants use. The applicants rights are, therefore, to be protected.

18. The impugned trade mark adoption of which is proved to be dishonest and that the registration is in contravention of the provisions of the Act and

is an entry wrongly remaining on the Register.

19. The applicants have admitted that they have just come to Indian Market. They further stated that no action was initiated against the respondents

as they were not available in the market. The notice sent to the respondent was returned un-served with an endorsement as ""left without address"".

Considering all these facts, we assume that the respondents though have obtained registration are not in the market and therefore are not using the

trade marks.

20. Even though the applicants have stated that they have entered the Indian market only recently, we are granting their prayer. The reason is that not

only the trade mark has been copied but even the artistic work is copied. In view of the above findings, we allow the rectification application with a

direction to the Registrar of Trade Marks to remove the trade mark registered under No. 1224394 in Class 11 with no order as to costs.