
(2013) 11 IPAB CK 0001

In the Intellectual Property Appellate Board

Case No : ORA/123/2008/TM/KOL & ORA/129 TO 133/2008/TM/KOL & ORA/136/2008/TM/KOL

M/s. Taegu Tec Limited Also carrying on business in India
through its subsidiary namely M/s. Taegu Tec India Private
Limited

APPELLANT

Vs

Rikhab Chand Jain Trading as M/s. T.T. Industries

RESPONDENT

Date of Decision : 21-11-2013

Acts Referred:

Trade Marks Act, 1999 — Section 9, 11(9)(i), 11(9)(ii), 11(9)(iii), 11(9)(iv)(a), 11(9)(iv)(b), 11(9)(iv)(b), 11, 11(10)(ii), 11(6), 11(2)(a), 11(6), 18, 29(4), 46, 46(1), 46(1)(a), 47, 56, 56(2), 57, 57(2)

Citation : (2013) 11 IPAB CK 0001

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

Bench : Division Bench

Advocate : Gautam Banerjee, Alok M. Saha

Final Decision : Allowed

Judgement

V. Ravi, Technical Member

1. The applicant herein are seeking the removal from the register the seven trade marks namely Appln. No. 666089 in Class 18; Appln. No. 666076 in Class 05; Appln. No. 666090 in Class 19; Appln. No. 666103 in Class 27; Appln. No. 666096 in Class 34; Appln. No. 666081 in Class 10 and Appln.

No. 66091 in Class 20 of the respondent. All the impugned marks have been filed on the same date by the respondent on 'a proposed to be used' basis

for a vast spectrum of goods available in the market falling in that particular class under the International Classification of goods which is something

that is beyond the resource management of any company thus setting the stage for a wondrous legal brawl. (in Hindi called 'Mara Mari'). It is the

applicants case that this attempt by the respondents is contrary to the intention of the Act and against the laws laid down by the Hon'ble Supreme

Court. The impugned trade marks are not distinctive both at the time of filing and its subsequent registration nor it has acquired distinctiveness till date.

The applicant, therefore, pray that the impugned marks be removed from the register forthwith for detailed reasons mentioned in the Statement of

Case accompanying the cancellation petition. The applicants main ground for seeking cancellation of the seven registered trade marks are summarized

below:--

â?¢ The applicant is a company incorporated in South Korea and carrying on business in India through its wholly own subsidiary Taegu Tec India Pvt.

Ltd.

â?¢ The applicants are carrying on the business of manufacturing various types of metal cutting tools and accessories under the trade mark TAEGU

TEC and TT which is sold in numerous countries throughout the world. They have manufacturing facilities as also local subsidiaries in 52 countries.

They are selling different products relating to metal cutting tools and related accessories falling in Class 1 & 7. The applicants are carrying on business

under the corporate name and trading style TAEGU TEC bearing the trade mark Taegu Tec and TT which is represented in stylish and distinctive

manner. The trade mark Taegu Tec and TT is used in 20 countries since September, 1998. It is registered in both Classes 1 & 7 in over 22 countries

and in India in Class 7 under No. 832337 which registration is valid, renewed and still subsisting. The applicants have spent enormous money in

research and development constantly innovating machine tools with cutting edge technology. The mark has acquired reputation and goodwill in India

by virtue of its use since 2000 and the goods sold by them is known as TAEGU TEC and demanded by the name TT. Thus the marks Taegu Tec and

TT are recognized as well known throughout the world and in India.

â?¢ It has come to the notice of the applicants who have entered the Indian market in a big way that the respondent/registered proprietor of the seven

impugned marks falling in various classes do not manufacture any of the products falling in the said classes and has not sold or marketed a single

product under the impugned marks despite obtaining registration thereof and have illegally secured registration of the logo TT in all 42 classes as

admitted by them in other proceedings without dealing in any of the goods (except those falling in Class 25) in respect of which it is registered.

¶ The applicant received a legal notice on 15.01.2002 from the respondent herein to cease and desist use of the trade mark TT and the respondent

later filed a suit in the Hon'ble Delhi Court and obtained an ex-parte order of injunction which has since been vacated.

¶ Although the respondent/registered proprietor are solely dealing with only goods falling in Class 25 (and that too largely in respect of hosiery

products) they have in fact secured registration in all 42 classes despite the fact they have simply no business, goods, infrastructure, or market or use

for sustaining the registration of the respondents seven impugned marks. The applicant who are expanding their business in India are facing numerous

oppositions from the respondent in respect of various applications filed by them despite not carrying on any business whatsoever in the Indian market.

Thus for instance, the respondent/registered proprietor herein filed opposition to trade mark applications no 832336, 832338 and 832339 and yet it has

failed to disclose any document in support of its alleged use in class 20. Similar is the case of several other oppositions which are awaiting adjudication

in the trade marks registry.

¶ It is clear from the above that the registered proprietors have no bona fide intention to use the impugned seven registered trade marks and have

secured its registration solely with the intention to block the marks and to take unjust advantage of the provisions of the Act. A trade mark can be kept

alive in the register perpetually only by its use in the Indian market. The applicant submits that registration of all these seven impugned marks have

been obtained in bad faith. The registration of the impugned marks are contrary to the provisions of section 9, 11 and 18 of the Act and disentitled to

protection under the law. The applicants therefore pray that all the seven impugned marks may be forthwith removed from the register as they are

wrongly remaining in the register and without sufficient cause.

2. The case of the respondent/registered proprietor is briefly as follows:--

¶ The respondent has been carrying on business in India under the trading style TT Industries since 1968 bearing the trade mark"". This trade

mark is the House Mark and is the principal trade mark of the respondent and their entire business revolves around it. The impugned mark has been

used since 1964 by the predecessor in interest of the respondent namely M/s. Tarun Textiles Pvt. Ltd., The respondents submit that they were the first in adopting and using the impugned trade mark in relation to the products in which it is embossed and therefore it has acquired a secondary meaning. The impugned mark is unique to the respondent with the monogram TT depicted within an onion like device registered in all classes in India.

In view of its expanding business, the respondent formed a public limited company styled TT Limited (formerly known as Tirupathi Text Knit Limited) and under the said corporate banner have achieved great success. The respondent have entered into a License User Agreement with TT Limited permitting the use of the trade mark TT for various goods in India and abroad. In the course of trade the respondents have also adopted various other similar trade marks such as "T Tex", "TTT", "TTI", "TITI", "TEE TEE" etc. In view of the diversification of its business, the respondents have secured registration of the trade mark "TT" in more than 150 applications in all 42 classes. They also own at least 25 copyright registrations which are still valid and subsisting. The trade mark "TT" has become synonymous with the respondents business and enjoys enormous goodwill due to huge publicity over the last 40 years made by the respondent.

¶ The impugned mark has also been registered in neighbouring countries like Pakistan, Bangladesh, Sri Lanka and Nepal and also widely acclaimed internationally in many other countries due to export of respondents goods. It is the practice of the respondent to initiate legal proceedings against any person who seeks to imitate and or use the monogram "TT" to safeguard its interest. They have filed many infringement proceedings in different civil and criminal forums all over India. They have also initiated opposition proceedings against many applicants before the Registrar of Trade Marks.

In fact the applicants application for registration of the trade mark TT, Taegu Tec in Class 1 under No. 832338 was refused by the Registrar holding that the applicants herein are not the proprietor of the trade mark TT. The respondent has refuted the alleged claim of Taegu Tec and TT being internationally well known. All the claims and contentions made by the applicants are denied and disputed as purely motivated and self serving. The statement of the applicant that Taegu Tec TT are used in India since 2000 are wrong, baseless and they relied on concocted documents. In application

No. 832339 in Class 7 which was opposed by the respondent herein, the applicant failed to establish any user of the trade mark TT till 2003 in any part of the world. The purported registration of the applicant under No. 832337 in class 7 was obtained by the applicant unlawfully by misrepresenting facts before the Registrar. The use of the trade mark TT by the applicant, if any, are commercially unfair, unlawful and through unauthorized channels. The respondents state that a company which was born in 1998 having sporadic sales of their product for metal cutting tools bearing a falsified trade mark are making bogus claims of their mark being well known. Such claims are totally hollow, wild, preposterous, extravagant and manifestly superfluous. The applicants are somehow determined to filch the established proprietary right of the respondents trade mark"" ". Due to the adamant attitude of the applicants the respondent filed a suit before the Hon'ble Delhi Court which restrained the applicants from using the trade mark TT. However, due to technical reasons, more specifically the absence of the learned counsel appearing on behalf of the respondent, the injunction order was vacated and the respondent therefore filed a fresh application for injunction and the matter is now sub-judice. The applicants are trying to restrict the respondent's business under the impugned mark solely to class 25 which is against real state of affairs of the respondent's company. The respondent have been forced to file oppositions against the applications filed by the applicant under No. 832338 and 832339 which have been severally and independently decided by the two different Registrars refusing both the applications. Applicants are not 'aggrieved person' since they have no subsisting interest in the trade mark TT and it does not have any locus standi to file the impugned cancellation petition. All the grounds raised by the applicants are flimsy, unfounded, untenable, disputed, sham, improper and unsustainable in law. The entire petition is frivolous, ill precise and ill founded based on malicious and reckless allegations and whimsical claims. The respondent submits that the trade mark"" " has acquired secondary significance and is capable of distinguishing the goods of the respondent and the question of distinctiveness cannot be reopened in the instant proceeding. They further state that the impugned mark is well and truly covered within the definition of well known trade mark in view of the vast and overwhelming presence of the impugned mark for the last 40 years. The entire petition is unwarranted, unsustainable, untenable both in facts

and law. The instant rectification proceedings cannot be entertained as it is totally unlawful, oppressive and aimed with the sole aim of embarrassing the respondent.

3. The matter was listed for hearing on 14.06.2013. We have heard the detailed arguments of both the learned counsel, gone through the pleadings and records.

4. APPELLANTS RELIED ON THE FOLLOWING AUTHORITIES:

1. (23) Extra territorial reputation of a mark was also recognised in the matter of Vitamins LD'S Application 1956 R.P.C. 1. In that case the

respondent applied for registration of mark ""Pabalate"" in respect of pharmaceutical substance. This was opposed by the appellant, an American

Corporation, on the ground that the said mark stood registered in their favour in various countries and the same was advertised extensively in Medical

Journals which had circulation in the United Kingdom as well. The American Company however did not have any user of the trade mark in United

Kingdom as no sale of the goods had been made under the said mark by them in that country. Despite the lack of user in England it was held that the

application of the respondent should not be permitted to proceed having regard to the fact that the advertisements of pharmaceutical substances were

reaching in that country. In this regard it was observed as follows:--

..... Having regard to the fact that the evidence discloses a genuine business on the part of the Appellants in their country of origin and that

advertisements of such goods are reaching this country and appearing in libraries or places of reference to which medical men may resort, it seems to

me that I am bound to consider the possibility that, with the passage of time, some conflict may occur between the use of the mark by the present

Respondents and the advertisement and user of the mark overseas by the present appellants. Having regard to the international character which

medicine and the allied sciences have assumed and are increasingly assuming over the last two decades, it seems to me that the Court must be

particularly careful to see that in exercising its discretion under the Act the public interest is not in any way imperilled. For my part I am not satisfied

that, in allowing it to be used by manufacturers in this country as a brand name for a pharmaceutical substance a word which is in fact used by an

American Corporation in respect of the same material and advertised in journals,

which on the evidence are received into this country and referred to, the public interest will be best served by permitting registration. Accordingly, on both those grounds it seems to me that it is my duty to indicate that in the light of' the fuller consideration which the matter has received in this Court the application should not be permitted to proceed.'" A product and its trade name transcends the physical boundaries of a geographical region and acquires a trans border or overseas or extra territorial reputation not only through import of goods but also by its advertisement.

2. "'Vishnudas trading as Vishnudas Kishendas v. Vazir Sultan Tobacco Co. Ltd.'" - 1996 PTC (16)

In our view, if a trader or manufacturer actually trades in or manufactures only one or some of the articles coming under a broad classification and such trader or manufacturer has no bona fide intention to trade in or manufacture other goods or articles which also fall under the said broad classification, such trader or manufacturer should not be permitted to enjoy monopoly in respect of all the articles which may come under such broad classification and by that process preclude the other traders or manufacturers to get registration of separate and distinct goods which may also be grouped under the broad classification. If registration has been given generally in respect of all the articles coming under the broad classification and if it is established that the trader or manufacturer who got such registration had not intended to use any other article except and articles being used by such trader or manufacturer, the registration of such trader is liable to be rectified by limiting the ambit of registration and confining such registration to the specific article or articles which really concern the trader or manufacturer enjoying the registration made in his favour. In our view, if rectification in such circumstances is not allowed the trader or manufacturer by virtue of earlier registration will be permitted to enjoy the mischief of trafficking in trade mark. Looking to the scheme of the registration of trade mark as envisaged in the Trade Marks Act and the Rules framed thereunder, it appears to us that registration of a trade mark cannot be held to be absolute, perpetual and inviolable under all circumstances.

3. "'Infosys Technologies Limited v. Jupiter Infosys Limited and another'" - (2011) 1 SCC 125

Held: To be an aggrieved person under Section 46, the person making the

application must be one whose interest is affected in some possible way; it must not be a fanciful suggestion of grievance. A likelihood of some injury or damage to the applicant by such trade mark remaining on the register may meet the test of locus standi.

4: ""M/s. Osaka Pharma Pvt. Ltd. v. Win-Medicare Limited ""- IPAB Order No. 247/2010 dated 16.12.2010

In an application for revocation/rectification, the main issue to be considered is to see if the applicant for rectification is a person aggrieved to file and

maintain an application. Aggrieved person is a person who really is affected by the wrong entry on the register of trade marks. The term aggrieved

person has been defined by the Supreme Court in *Hardie Trading Ltd. & Anr. v. Addison Paint & chemicals Ltd.* - 2003 (27) PTC 241 (SC)"" But if

the ground for rectification is merely based on non-user i.e. under section 46 of the Act, that is not really on account of any public mischief by way of

an incorrect entry. The non-user does not by itself render the entry incorrect but it gives a right to a person whose interest is affect to apply for its

removal. An applicant must therefore show that ""in some possible way he may be damaged or injured if the trade mark is allowed to stand; and by

'possible' it is meant possible in a practical sense, and not merely in a fantastic view..... All cases of this kind, where the original registration is not

illegal or improper, ought to be considered as questions of common sense, to a certain extent, at any rate; and the applicants ought to show something

approaching a sufficient or proper reason for applying to have the trade mark expunged. It certainly is not sufficient reason that they are at

loggerheads with the respondents or desire in some way to injure them.

5: ""Dharam Dutt and others v. Union of India and Others"" - (2004) 1 SCC 712

The decision of the learned Single Judge was not left unchallenged. In fact, the correctness of the judgment of the learned single-Judge was put in

issue by the Union of India by filing an intra-court appeal. Filing of an appeal destroys the finality of the judgment under appeal. The issues determined

by the learned Single Judge were open for consideration before the Division Bench. However, the Division Bench was denied the opportunity of

hearing and the aggrieved party could also not press for decision of the appeal on merits, as before the appeal could be heard it was rendered

infructuous on account of the Ordinance itself having ceased to operate. The

Union of India howsoever it may have felt aggrieved by the pronouncement of the learned single-Judge had no remedy left available for it to pursue. The judgment of the Division Bench refusing to dwell upon the correctness of the judgment of the Single Judge had the effect of leaving the matter at large. Upon the lapsing of the earlier Ordinance pending an appeal before a Division Bench, the judgment of the Single Judge about the illegality of the earlier Ordinance cannot any longer bar this Court from deciding about the validity of a fresh law on its own merits even if the fresh law contains similar provisions.

6: ""American Home Products Corpn. v. Mac Laboratories Pvt. Ltd., "" - AIR 1986 -SCC 137

Trade Marks Act (5 of 1940), Ss. 14(1), 39(2) - Trade and Merchandise Marks Act (43 of 1958), Ss. 18, 46(1)(a)(b) and 48 _ Removal of trade mark

from register under S. 46(1)(a) - Burden of proof on applicant - Not only non-user of trade mark for requisite period but also absence of bona fide

intention to use at the time of application for registration has to be proved -- Intention to use trade mark takes in not only proposed user by proprietor

but user through registered user also. (1971) 75 Cal WN 118 Reversed.

5. Following authorities were relied on by the respondent:

1. ""Lever Brothers, Port Sunlight, Ltd. V. Sunwite Products, Ltd. "" - RPC [Vol. LXVI] - 1949, 66, RPC 84

The Plaintiffs were proprietors of the mark ""Sunlight"", registered in 1884 in Class 3 in respect of soap, substances for laundry use, detergents and

certain cosmetic goods. At the beginning of 1946 the Defendants commenced to use the mark ""Sunwite"" on a soapless detergent powder. The

Plaintiffs sued for infringement, and the Defendants counterclaimed to rectify the Register by striking out goods other than soap, on the ground of non-

user. The Plaintiffs' mark had been used on a large sale but on soap only.

Held (1) That the mark had been infringed.

(2) That the specification of goods ought not to be amended to exclude detergents or substances for laundry use.

(3) That the cosmetic goods within the specification were not of the same description as soap, and that, subject to the general discretion of the Court,

they might be liable to exclusion.

(4) The Defendants were not persons aggrieved by the registration in respect of those goods, and were not, therefore, entitled to claim their exclusion

from the Plaintiffs' registration.

2. ""Hardie Trading Ltd. And Anr. v. Addisons Paint And Chemicals Ltd."" - 2003 (27) PTC 241 (SC)

Held: Under section 46(1), the use may be other than physical. It may be in any other relation to the goods. Given this statutory meaning there is no

reason to limit the user to use on the goods or to sale of goods bearing the trade mark.

In the latter case the locus standi would be ascertained liberally, since it would not only be against the interest of other persons carrying on the same

trade but also in the interest of the public to have such wrongful entry removed.

But if the ground for rectification is merely based on non-user i.e. under Section 46 of the Act, that is not really on account of any public mischief by

way of an incorrect entry. The non-user does not by itself render the entry incorrect but it gives a right to a person whose interest is affected to apply

for its removal. An applicant must therefore show that in some possible way he may be damaged or injured if the Trade Mark is allowed to stand; and

by ""possible"" I mean possible in a practical sense, and not merely in a fantastic view..... All cases of this kind, where the original registration is not

illegal or improper, ought to be considered as questions of common sense, to a certain extent, at any rate; and I think the Applicants ought to show

something approaching a sufficient or proper reason for applying to have the Trade Mark expunged. It certainly is not sufficient reason that they are

at loggerheads with the Respondents or desire in some way to injure them.

3. ""Kabushiki Kaisha Toshiba v. TOSIBA Appliances Co & Ors."" - 2008 (37) PTC 394 (SC)

Trade and Merchandise Marks Act, 1958.

Sections 46 & 56 - Jurisdiction to remove the registered mark - trade mark TOSHIBA in which TO' was taken from the Tokyo and 'SHIBA' was

taken from word Shibaura - Acquired about 35 trade mark registrations in India - Respondent using the trademark TOSIBA in respect of electrical

goods - Term Person aggrieved' is different in the context of Section 46 and 56 - Section 46 speaks of a private interest while Section 56 speaks of a

public interest - Only because respondent had not been able to prove one of the

grounds, namely, applicability of Section 56 of the Act, he does not

lose the locus - If the trade Mark is allowed to stand, the person who suffer damage or the injury is the person aggrieved - impugned judgment set aside.

The concept of the term 'person aggrieved' is different in the context of Section 46 and 56. Section 46 speaks of a private interest while Section 56

speaks of a public interest. Respondent filed a composite application. Registrar did not think it fit to consider the case from the point of view of public

interest and confined the case to Section 46 of the Act, as would appear from the fact that while sustaining the respondent's objection under Section

46(1) and (b) on the ground that the same had not been used by the appellant for the last twenty years, it was observed: ""Having held that Section

46(1)(a) is a bar to the continuation of the impugned mark on the Register as above, I hold that the entry in respect of those goods for which the

Registered Proprietors could not prove their user of the Registered Trade Mark 273758 was wrongly made in the Register and is wrongly remaining

on the Register under Section 56(2) of the Act.

6. GIST OF APPLICANT'S ARGUMENTS:

The applicant state that they came to India in 1998. It is a South Korean company. It has started business in respect of goods falling in Class 1 and 7

but are facing legal hurdles from the respondents who have registered their trade marks in all classes but in fact are only dealing in Class 25 goods.

The respondent are misusing these registration to initiate infringement action under Section 29(4) against everyone. The impugned mark is sought to be

removed from the register under Section 47 and 57 of the Act as it is wrongly registered and without sufficient cause. In view of the ratio in Vazir

Sultan's case, all the seven impugned trade marks have to be expunged from the register.

7. GIST OF RESPONDENT'S ARGUMENTS:

a. The impugned mark is registered in 42 classes under the International Classification of Goods and Services. (NICE CLASSIFICATION). There is

no dispute on use of the impugned marks since 1964 by the respondent. They also hold 25 copyright registrations. The respondents are in business of

manufacturing hosiery and textile goods. They are expanding their business. They have entered into License Agreements with many third parties.

There are judicial rulings recognizing respondent's trade mark is well known. They have filed copious evidence to demonstrate use of their mark. They have set up ""T.T. Garment Park"" which is like a mall and everything under the Sun is sold or available there. The Board should apply the 'Wonder test' in comparing the competing marks. The applicant are not an aggrieved person. The respondent are entitled to the benefit Section 29(4) by virtue of Section 11(6) of the Act. The respondent's registration certificates were issued in 2005. The applicant have filed 16 rectification petitions in all out of which 7 cases have now been posted for hearing. The pleading and issues raised are the same or almost identical. The primary objections have been raised under Sections 9, 11 and 47/57 of the Act. The legal position is that the initial onus is on the applicant to establish a case. All the seven respondents impugned marks were registered as of 1995. The applicants started business in South Korea in 1998 and in 2000 in India. All dates are subsequent. The applicant have used two legal entities i.e. TT and Tegu Tech. There is no vertical integration of the two entities. There is no License Agreement on record. In that case on whose evidence, rights or claim the Board will rely on?. When the identity of the 'aggrieved person' for the rectification is not clear how will the Board decide the question of under Section 47/57?. The applicant are taking different stands in different forum. Arguments have to be made de novo in each case. There is no proof of their entry into India in 2000. The seven rectification petition is not in respect of Class 1 and 7 in which the applicant are purportedly trading but seek removal trade marks registered in Class 18, 27, 5, 19, 20 and 34. The purported reason for this cancellation petition are i) the respondents are not manufacturers ii) the applicants were served a Cease and Desist Notice by the respondent and iii) A suit has been filed against the applicant in Hon'ble Delhi High Court by respondent. There is palpable delay in filing rectification as the first opportunity was available in 2005 itself.

b.. The applicant have been unable to establish that the Registrar has committed any error or irregularity in granting registration or there is any palpable error resulting in the entry being made without sufficient cause. Infringement of Section 57 has not been pleaded properly. The applicant has based his case on non-user. The fact is the respondents have used the impugned mark after its registration. Our attention was invited to invoices in

pages 267, 268 and 281 (surgical bandage in Class 10); Page 287 and 288 (School bags in Class 18); Page 289, 290 and 292 (Class 19); Page 293

(Class 20); Page 296 & 297, 308 and 309 (Class 27). The applicant are not pressing on Section 47 (rectification was premature). The respondent are

not indulging in any trafficking of mark as alleged. Section 9(1)(a) and 9(2)(a) has not been argued and Section 11(2)(a) will not apply. No case for

the removal of the impugned trade marks has been made out and the subject rectification applications should be dismissed.

8. REJOINDER ARGUMENTS:

When registration is challenged the onus to prove user is on the respondent/ registered proprietor. There is not single document to prove use other than

for hosiery and readymade garments. 'T. T. Garments Park' is a mall selling everything is just an eyewash. One or two stray sales for each class

under challenge and that too God knows to whom it has been sold? These are suspect documents. Massive documents displaying advertisement is no

proof of user. The applicant stands by their plea that all seven impugned marks should be removed from the register.

9. Since we have to deal with as many as seven rectification petitions filed by the applicant which have been vigorously contested in all the cases by

the respondent with identical/similar arguments supported by documentary evidences running to more than 5000 pages, for easy understanding and to

get a grip on the issues involved, the factual position in respect of all these impugned marks is conveniently tabulated below:--

10.

Tegue Tech

Footnote - 1 APPLN. No. -666089

[CLASS : 18]

LEATHER AND IMITATIONS OF LEATHER AND ARTICLES MADE FROM THESE MATERIALS, SKINS, HIDES, TRUNKS,

TRAVELLING BAGS OF ALL KINDS AND BAGGOGES.UMBRELLAS, PARASOLS, WALKING STICKS, WHIPS, HARNESS,

SADDLERY, BEAUTYCASES.

Footnote - 2 APPLN. No. -666076

[CLASS : 5]

AYURVEDIC MEDICINAL, UNANI, PHARMACEUTICAL, VETERINARY PREPARATIONS, INSECTICIDES, DIETIC, PESTICIDE

PREPARATIONS, SANITARY, HORMONES, POLYPEPTIDE PREPARATIONS, DIABETIC AND INVALID FOODS, DENTAL WAX,

DISINFECTANTS, VERMICIDES, MATERIAL FOR BANDAGING PREPARATIONS.

Footnote - 3 APPLN. No. -666090

[CLASS : 19]

BUILDING MATERIALS, NATURAL AND ARTIFICIAL STONES, CEMENT, LIME, MORTAR, PLASTER AND GRAVEL, PIPES OF

EARTHENWARE OR CEMENT, ROAD MAKING MATERIALS, ASPHALT, PITCH AND BITUMEN, PORTABLE BUILDING, STONE

MONUMENTS, CHIMNEY POTS, WATER PROOF AND DAMP PROOF ARTICLES INCLUDED IN CLASS 19.

Footnote - 4 APPLN. No. -666103

[CLASS : 34]

BIRIS, CIGARETTES HUKKA AND CHEWING TOBACCO, MATCHES, SMOKERS ARTICLES, RAW & MANUFACTURED TPBACCO,

SNUFF.

Footnote -5 APPLN. No. -666096

[CLASS : 27]

CARPETS, RUGS, MATS AND MATTING, LINOLEMS AND OTHER MATERIALS FOR COVERING FLOORS, WALL HANGING.

Footnote -6 APPLN. No. -666081

[CLASS : 10]

SURGICAL, MEDICAL, DENTAL, VETERINARY INSTRUMENTS AND APPARATUS (INCLUDING ARTIFICIAL LIMBS, EYES,

TEETH), BIOMEDICAL TESTING EQUIPMENTS, COMPUTER MODULES, MONITORING, ALARM AND TELEMESURING SYSTEM

FOR MEDICAL PURPOSES AND BANDAGES, CONTRACEPTIVES.

Footnote -7 APPLN. No. -666091

[CLASS : 20]

FURNITURE, MIRRORS, PICTURE FRAMES, ARTICLES (NOT INCLUDED IN OTHER CLASSES) OF WOOD, CORK, REEDS, CANE,

WICKER, HORN, BONE, IVORY, WHALEBONE, SHELL, AMBER, MOTHER OF PEARL, MEERSCHAUM, CELLULOID AND

SUBSTITUTES FOR THESE MATERIALS, STATUES, STATUTES, CABINETS, CASES, WARDROBES, CHAIRS, TABLES, BEDS,

MATTRESSES, PILLOWS, CUSHIONS, INFANTS, CRADLES, SLEEPING BAGS.

11. But to be fair to the applicants, they have sought removal of the impugned marks under Section 57(2) and not under Section 47(1)(a) or (b).

12. On the preliminary issue of 'Person Aggrieved' the applicant are facing opposition in respect of all their applications filed before the Registrar.

Express provisions are made in the Trade Marks Act for cancellation of registered trade mark wrongly remaining on the register. This is of great

importance to an aggrieved litigant. All trade marks registration is effected with a commercial purpose and if the continued existence of a mark on the

register proves to be a nuisance in the course of commerce or business of the applicant, the law provides an avenue to agitate their grievance before

the competent authority for its removal from the register. This is a salutary remedy to right a wrong. In our view the applicant herein have 'sufficient

interest' to seek removal of the impugned marks. The respondent have filed a suit against the applicant and that also provides Substantial Cause to

seek removal of the impugned trade mark. Accordingly, we hold the applicant to be 'person aggrieved'.

13. It is an admitted position that the respondent have registered the impugned trade mark in all 42 Classes unmindful of their assets getting depleted

or evaporated in legal fees. It is also not in dispute that they are in the business of manufacturing and selling hosiery products since 1968 and from

1964 through their predecessor in business. The only question that remains to be answered is the respondent entitled to stop the applicant from doing

business in India under the trade mark TT and Taegu Tech? The entire focus of the respondent response revolves around their claim that "" "" is a

well known trade mark and so no one can use the same in Indian market in respect of any goods bearing same or similar mark. This, in short is the

gist of their contention. It would be in order to restate the law on the point mentioned in the Act. A trade mark to be well-known need not be used in

India [Section 11(9)(i)]. Further, to be well known a mark need not be registered in India [Section 11(9)(ii)] or that an application for registration is

pending in India [Section 11(9)(iii)]. Conversely, Section 11(9)(iv)(a) to (c) provides factors such as that a trade mark is not well-known or registered

or application has been filed in a foreign jurisdiction outside India is not a relevant consideration for a determination that the mark is well-known in

India. Section 11(10)(ii) then provides Registrar shall in an opposition proceeding take into consideration the bad faith involved of the applicant or

opponent affecting the right relating to the trade mark.

14. Shorn of complexities of issue involved in the case on hand, there are some straight forward inferences that can be drawn. If the respondent's

mark is truly well-known, there is no compulsion to secure registration in all 42 Classes. Rather registration in all 42 classes cannot improve their case

one bit more than securing no registration at all so long as conditionality specified in Section 11(6) is met which is reproduced below:

11(6) The Registrar shall, while determining whether a trade mark is a well-known trade mark, take into account any fact which he considers relevant

for determining a trade mark as a well-known trade mark including ____

(i) the knowledge or recognition of that trade mark in the relevant section of the public including knowledge in India obtained as a result of promotion

of the trade mark;

(ii) the duration, extent and geographical area of any use of that trade mark;

(iii) the duration extent and geographical area of any promotion of the trade mark, including advertising or publicity and presentation, at fairs or

exhibition of the goods or services to which the trade mark applies;

(iv) the duration and geographical area of any registration of or any application for registration of that trade mark under this Act to the extent they

reflect the use or recognition of the trade mark;

(v) the record of successful enforcement of the rights in that trade mark, in particular, the extent to which the trade mark has been recognized as a

well-known trade mark by any Court or Registrar under that record.

15. There is no doubt that the respondents have used the impugned mark in respect of goods sold by them (but 99.9% of invoices relate to or pertain

to sale of hosiery products) which is supported by sales figures mentioned in Para 15 of the affidavit of Ms. Jyoti Jain, the Principal Officer of T.T.

Industries dated 23rd February, 2009. The annual sales figures for the

proceeding five years prior to date of rectification are stated as follows:

16. These are very impressive sales turn over and has not been disputed by the applicant. Reference has also been made to numerous ruling both by

Court and the trade marks registry to support the respondents claim that it is well known the gist of which is reproduced for convenience:

Held, plaintiff (respondent) have long established user of trademark T.T. for hosiery products. Adoption of a similar trade mark T.T. by defendant for

silk sari amounts to infringement. Suit decreed.

4) Various Trade Marks Registry Rulings

a) Appln. No. 510242 - Opposition No. 9685 (by respondent) Outcome - Application was abandoned.

b) Application was for trade mark- Team Tex for textile articles under No. 422429 made on 28th May, 1984. Opposed by respondent herein.

Application was refused. Case was decided under the repealed Trade and Merchandise Marks Act, 1958.

c) Application No. 374274 - Opposition 6459 (by respondent). Outcome - Application was abandoned.

d) By a Common Order issued by Asst. Registrar of Trade Marks dated 20th April, 1998, 11 applications of respondent opposed by various parties

was directed to proceed for registration and all the oppositions were dismissed. Matter decided under repealed TMM Act, 1958.

e) 5 applications filed by respondent for registration in 16, 18, 23 and 25 (two application) opposed by D.M.R. Textiles, Tiruppur was ordered to

proceed to registration vide Asst. Registrar's order dated 4th February, 2004. In it he has made a one line observation towards the end: ""It is also to be

noted by virtue of such widespread use of T.T. monogram in India and abroad, it has become a very well known mark"". Exactly, identical observation

was made in other opposition by order dated 19th March, 2004 by the same Assistant Registrar.

f) In other cases opposed by respondent herein in Opposition No. DEL-T-4577 to Appln. No. 832339 decided on 30th May, 2005, the same Asst.

Registrar had observed in the operative part as follows:--

I have heard both the Ld. Counsels and I have also carefully gone through the entire documents filed by both the parties and I am of the considered

view that the applicants have no case.

On the other hand the opponents have substantiated their claim by way of filing documentary proof.

In view of above, Opposition No. DEL-T-4577 is allowed application No. 832339 in Class 7 is refused.

g) In the last decision relied on by respondent an application by the applicant herein for registration of TT and TEGUTEC under No. 832338 in Class 1

was refused in Opposition No. 180033 vide order of the Deputy Registrar dated 17th September, 2000 - on ground of Section 9, 11 and 18 of the Act.

17. In the light of the above, we find there is no explicit court order recognising the impugned mark in India as well known even though in T.T. Silk

sari case widespread use of respondents mark for hosiery was acknowledged. As regards the registry rulings on this aspect samples of which is

indicated in Para 16 (e) and (f) (Supra) the less said the better. In any event, we in these proceeding are not adjudicating the question of well-

knownness of the respondent's mark. Rather the issue is can the impugned mark escape eviction from the register in the seven classes for which

cancellation has been sought? For this we need to look at the evidence before us.

18. What is troubling us is that a manufacturer of hosiery sets up a "T.T Garment Park" in the guise of a mall and starts selling "everything under the

Sun" in the capacity of a retail sale. What this implies is merely to protect their House Mark "" "" also used as a trade mark, the respondent are

buying products from the open market and stamping their brand"" "" on it and sells it to interested customers. Does it indicate a connection

between the mark used in relation to those unconnected and unrelated goods and the proprietor? We think not. If protection were to be permitted for

retail services in the manner sought by the respondent, in theory, every trade mark owner would be entitled to registration to cover all 42 classes for all

type of customers whatever the trade and whatever the goods or services. The purpose of trade marks protection is to guarantee that it functions as

an indication of origin. The respondent arguments ultimately will lead to uncertainty in the scope of statutory protection leading to difficulties in

classification of goods and in comparison of marks for the purpose of registration and infringement. In view of this position, the few stray bills

furnished by the respondent as evidence of use the impugned mark in each of class in respect of which it is registered do not convince the Board as

genuine use but effected merely to save the registration in the relevant class. Ultimately a mark can be kept alive on the register only by constant,

continuous and sustained use to establish a trade connection between the goods and the proprietor.

19. The respondent have not registered their mark for retail and wholesale services. The stated practice of respondent will only lead to disputes and

confusion about the content and scope of services being provided by them given that they have not specified the goods or type of goods their retail

services relates to. We are not aware of the current trade marks registry practice to extend protection for retail or wholesale services and if permitted

to what particular sector of the market it is allowed?. ""T.T. Garment Park"" has not been registered as a retail store as per record in class 35. The

avowed aim of trade marks law is to give goods and services uniform and equal chances to participate in the market. The respondent who are

essentially in hosiery business are basically selling their own goods in ""T.T. Garment Park"". However, the requirement of law is only retail sale of

goods originating from other companies are capable of being protected under the trade marks statute. From the Registrar's perspective, proper legal

framework and guidelines need to be formulated to expand the scope of trade marks protection to include virtual retailers such as TV Shopping,

Online shopping, catalogue shopping and other electronic media to keep abreast of changing consumer behavior and update the officials of the registry

on the reach and import of trade marks statutory protection for retail sales.

20. On the question of bona fide intention to use under Section 47(1)(a) all the seven impugned trade marks and possibly many more were filed on the

same day i.e. 18th May, 1995. Even the best global brand cannot conceive of a business plan to use its trade mark for all the goods or products on the

earth. That is not the intent or purpose of trade marks law. This single act of the respondents knocks out the entire claim of bona fide adoption and it is

only an exercise to block the register. Further, the impugned mark is merely a two letter loose monogram and the respondent cannot expropriate one

of the 26 alphabets all to himself for all times to come against genuine business competitors seeking protection for unrelated goods.

The admission by the respondent that they have entered into Licence Agreements for all variety of goods all over the world for"" "" only exposes

the intent to traffic on the trade mark and excites obvious suspicion. No particulars of infrastructure, skill speciality, quality control etc. for the infinite variety of goods for which it has been registered are on record. This is against the mores and conventions of Indian business practice merely to sustain the illusion of it being a well known mark and is completely against the spirit and *raison d'être* of the Act 'One product, one mark, one source'. The entire defense of the respondents are merely based on semantic posturing. In the result, all seven ORA/123/2008, ORA/129/2008, ORA/130-133/2008 and ORA/136/2008 are allowed and registered trade mark Appln. No. 666089 in Class 18; Appln. No. 666076 in Class 05; Appln. No. 666090 in Class 19; Appln. No. 666103 in Class 27; Appln. No. 666096 in Class 34; Appln. No. 666081 in Class 10; Appln. No. 666091 in Class 20 are removed from the register. There is no order as to costs.