
(2004) 01 IPAB CK 0021

In the Intellectual Property Appellate Board

Case No : TA/73/2003/TM/DEL (CM (M)/208/91)

Ram Tikai Engineering Works

APPELLANT

Vs

Bata India Limited

RESPONDENT

Date of Decision : 21-01-2004

Acts Referred:

Trade And Merchandise Marks Act, 1958 — Section 9, 11(a), 11(e), 12(1), 12(3), 18(1)
Trade Marks Act, 1999 — Section 100

Citation : (2004) 28 PTC 579 (IPAB)

Hon'ble Judges : S. Jagadeesan, J;T.R. Subramanian, Technical Member

Bench : Division Bench

Advocate : M.R. Bhalerao, Nitin Baradwaj

Final Decision : Dismissed

Judgement

T.R. Subramanian, Technical Member

1. This is an appeal filed by the appellants against the decision of the Deputy Registrar of Trade Marks in Opposition. No. DEL 4768 filed by the

respondents in respect of trade mark application No. 416782 filed for registration of trade mark in Class 11.

2. On 27th January 1984, the appellants hereinabove had filed an application No. 416782 in Class 11 for registering the trade mark 'NORTH STAR'

(word per se) in respect of exhaust fans claiming user from January 1981. The application was advertised in the Trade marks Journal dated

16.4.1987.

3. On 15th June 1987, the respondents hereinabove filed a notice of opposition opposing the registration of the appellants' trade mark on the grounds

that the respondents are the registered proprietors of the famous trade mark 'BATA' under No. 6574 in respect of variety of goods including foot

wear. They claimed that they are also the registered proprietors of the trade mark 'NORTH STAR' under No. 309788 dated 7.11.1995 in respect of foot wear included in class 25. They had also made application for registering the trade mark 'NORTH STAR' in different classes like Class 25, 18, 16, 24, 26 & 28 and that the respondents' business under the trade mark 'NORTH STAR' is so extensive and the reputation earned is so high that any goods sold or offered for sale identically with similar trade mark will inevitably create confusion and deception among the public. They submitted that the registration of the appellants' mark would be contrary to the provisions of Sections 9, 11(a), 11(e), 12(1) and 18(1) of the Trade and Merchandise Marks Act, 1958.

4. The appellants filed their counter-statement denying all the material averments contained in the notice of opposition and submitted that they are the lawful proprietors of the trade mark consisting of the word 'NORTH STAR' in respect of exhaust fans and water pumps. They submitted that they have adopted the mark from January 1981 and since then they have been continuously and extensively using the trade mark and the mark has become distinctive of the appellants goods. They further submitted that the trade mark 'BATA' has no relevancy to the present proceedings. They also submitted that the respondents goods are footwear whereas the appellants' goods are exhaust fans and water pumps. The respondents filed their evidence, which was followed by the evidence of the appellants. The respondents thereafter, filed their evidence in reply. The matter came up for hearing before the Deputy Registrar on 15th October 1990. The Deputy Registrar by his order dated 26th March 1991 allowed the opposition and refused the registration of the appellant's application.

5. The Deputy Registrar while dealing with Section 11(a) has held that the respondents have through their evidence proved that they have been using the mark since the year 1977. He has held that the opponents are the prior users of the registered trade mark. The opponents' objection under Section 11(a) had been upheld by him. While dealing with Section 11(a), he has observed that from the photocopies of the invoices filed by the appellants and also from the advertisement cuttings that the appellants had been using a trade mark which is identical with that of the respondents. The appellants had applied for registration of a trade mark 'NORTH STAR' (word per se) whereas

in the invoices, the appellants have been using the devise of a star alongwith the words 'NORTH STAR' in a different manner and not in ordinary capital letters as shown by them in their application. The adoption of the identical mark of the respondents by the appellants cannot be considered to be as honest. He, therefore, held that the mark is also not registrable under Section 12(3) of the Act. As regards Section 18(1) of the Act, he had held that the appellants have imitated the respondents trade mark dishonestly. They, therefore, cannot claim to be the proprietors of the mark.

6. The appellants filed an appeal before the Hon'ble High Court of Delhi under No. CM(M)/208/91. The above appeal was transferred to intellectual Property Appellate Board (IPAB) under Section 100 of the Trade Marks Act, 1999 which Section came into force on 6th October 2003. This was taken up for hearing by the Appellate Board.

7. At the hearing before the Appellate Board Shri M.R. Bhalerao, Advocate appeared for the appellants and Shri Nitin Baradwaj, Advocate appeared for the respondents. The teamed counsel for the appellants at the hearing submitted that the appellants' mark is 'NORTH STAR' and is in respect of exhaust fans whereas the respondents' mark is 'NORTH STAR' in respect of footwear. He submitted that the goods of the appellants and that of the respondents are quite different and so there cannot be any confusion and deception in the minds of the public. He further submitted that the sales figures and the promotional expenses which have been submitted by the respondents relate to the trade mark 'BATA' and hence the same cannot be considered. He further submitted that the trade mark 'NORTH STAR' cannot be considered as a well known trade mark as the respondents have not adduced any evidence in support of their contention that it is a well known trade mark. He further submitted that the Deputy Registrar has decided the case on the basis of the reputation of the trade mark 'BATA' and not on the basis of the reputation of the trade mark 'NORTH STAR'. He also submitted that the appellants have filed for registration of the trade mark 'NORTH STAR' (wordier se). However, as they have every right to illustrate the word 'NORTH STAR' by incorporating the device of a star alongwith a word 'NORTH STAR' they have used it with the device of a star. In reply, the learned counsel for the respondents submitted that the sales turnover and publicity expenses given by them include the sales and

publicity expenses for the word 'NORTH STAR' also. Because of their extensive sale and publicity, the word 'NORTH STAR' had acquired

reputation and goodwill and the appellants have tried to use the goodwill and reputation of the respondent's trade mark in their favour thereby causing

confusion and deception in the minds of the public.

8. Section 11(a) reads as follows:-

A mark the use of which would be likely to deceive or cause confusion shall not be registered as a trade mark.

9. The respondents through the use and reputation of their mark can prove that the registration of the appellant's mark is likely deceive or cause

confusion among the public. The respondents have through advertisement and other documents have proved that they have been using the trade mark

'NORTH STAR' from 1977 in India. They have also enclosed a photocopy of the advertisement in the Newspaper 'Statesman' dated 26th November

1977 which clearly illustrates the respondents trade mark, i.e. the device of a Star with the word 'NORTH STAR' written in a stylised manner and the

same has been registered by them under No. 309788 dated 7.11.1975 in Class 25. The respondents have also filed about 84 trade affidavits in their

support. Also the sales figures submitted from 1977 to 1987 are huge and we are inclined to believe the explanation of their counsel that it covers all

the products of the respondents. On the other hand, the appellants have produced evidences by way of invoices etc., that they have been using the

mark from 4th February 1981. The earliest of the invoices filed by the appellants is Invoice No. 5 dated 4th February 1981. This is followed by many

invoices, which goes upto Invoice No. 249. It is seen from most of the invoices that the trade mark which is shown at the top left side corner of the

invoices is identical with the trade mark of the respondents. The trade mark which is illustrated in the invoices of the appellants is a device of a star

with the word 'NORTH STAR' in a stylised manner which is identical with that of the respondents. The appellants have in fact applied for registration

of the trade mark in their application which comprises of the word 'NORTH STAR' (word per se). From the above it may be seen that the intention of

the appellants is to copy the identical trade mark of the respondents and to cash on the reputation and goodwill of the mark of the respondents. The

appellants have not given any explanation as how they came to adopt the

identical trade mark of the respondents. It can only be surmised that there has been dishonest adaptation of the mark by the appellants. Furthermore, it can also be seen from many of the invoices submitted by the appellants that there has been interpolation in the invoices by addition of the words 'NORTH STAR', which addition appears to be an afterthought. The appellants might have amended their mark later. But that does not absolve them of their dishonest adoption done earlier from which date they have also claimed users of the mark from January 1981. From the above, it is concluded that there has been dishonest adoption of the mark by the appellants even if the goods of the appellants and that of the respondents happen to be different. The appellants, therefore, cannot claim proprietorship to the mark on the basis of dishonest adoption. We, therefore, concur with the findings of the Deputy Registrar that because of dishonest adoption they cannot claim to be the proprietors of the mark under Section 18(1) also.

10. Accordingly, the appeal is dismissed. There is no order for costs.