

(2011) 10 IPAB CK 0004
In the Intellectual Property Appellate Board
Case No : OA/27/2004/TM/DEL

Satish Kumar Lamba, Trading As M/S. Satish Soap Mills, B-8-
Focal Point, Khanna - 141 401 (Punjab) APPELLANT

Vs

Assistant Registrar Of Trade Marks, Okhla Industrial Estate,
New Delhi - 110 020 And Mrs. Radhika, Trading As M/S.
Radhika Chemical Works, 2/260, Subhash Nagar, New Delhi -
110 027 RESPONDENT

Date of Decision : 04-10-2011

Acts Referred:

Trade Marks Act, 1999 — Section 9, 11(a), 11(b), 12(1), 12(3), 18(1)

Citation : (2011) 10 IPAB CK 0004

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

Bench : Division Bench

Final Decision : Allowed

Judgement

S. Usha, J

1. Appeal has been filed against the order dated 31st December, 2002 and the review order dated 5th February 2004 passed by the Assistant

Registrar of Trade Marks dismissing the opposition No.DEL-T-1779/55533 and allowing application No. 616225 in class 3 to proceed to registration

under the provisions of the Trade Marks Act, 1999 (hereinafter referred to as the Act).

2. The respondent No. 2 herein filed an application for registration of the trade mark ""Karan"" in Class 3 in respect of detergent soap, washing soap

and electric cleaning powder on 10.01.1994. They had claimed user since 01.01.1994. The application was advertised as accepted in the Trade Marks

Journal No. 1215 (Supplement) dated 21. 1.2000 at [page 17.

3. The appellant herein opposed the registration on the ground that the

registration would be violative of Sections 11 (a), (b), 12 (1), 12 (3) and 18 (1) of the Act. The respondent No. 2 filed their counter statement denying the averments made in the notice of opposition.

4 . On completion of the pleadings, the Assistant Registrar dismissed the opposition No.DEL-T-1779/55533 and allowed the application No. 616225 in class 3 for registration after hearing the respondent in the absence of the appellant on the finding that the appellants have not proved commercial use of the mark though had obtained registration, whereas the respondent No. 2 had filed documents to prove their concurrent use of the trade mark. In the absence of any documentary evidence, the objections under Sections 9, 11 (a), (b), 12 (1) & 18 (1) were not considered.

5. Being aggrieved by the said order the appellants are before us on appeal.

6 . The appellants had stated that they adopted the trade mark ""Karan"" in the year 1989 and had been using the same continuously since then. They had further stated that the registration of the mark Karan would lead to confusion and deception.

7 . The respondents stated that they had been using the trade mark ""Karan"" since 01.01.1994. They had made a search of any competitor in the market with the mark ""Karan"" and then adopted the trade mark and thereafter applied for registration. The mark was adopted on being inspired from the well known character of the epic ""Mahabharata"" due to the positive qualities in the said character.

8 . We have heard Shri Mohan Vidhani, counsel for the appellant and Shri Vinay Kumar Vibhu, counsel for the respondent in Circuit Bench Sitting held at Delhi on 3rd August 2011.

9 . Learned counsel for the appellant submitted that the application for registration was filed by the respondent on 10.01.1994 claiming user since 01.01.1994 whereas the appellants had been using the mark ""Karan"" since 1989 and registered proprietors as of 1990 only from the state of Punjab.

The opposition was heard and disposed in the absence of the appellant on the 1st hearing date. The Registrar had given the benefit of provisions

Section 12(3) of the Act in favour of the respondents. The respondent had filed a rectification application against the appellants registered trade mark.

The said application was dismissed by this Board in the year 2008 and a copy of the same was produced before us.

10. The counsel then submitted that they claim user since 1989 and the same was also stated in their notice of opposition. Whereas the respondent in the counter statement to the notice of opposition had though stated that they had caused a search to find out any competitors using the trade mark had not produced any proof thereof. The respondents have filed the application on 10.01.1994 claiming user since 1. 01.1994 which is subsequent to the appellants use since 1989 and registration is of the year 1990. The appellants have raised the issue of the provisions of Section 12(1) which has not been dealt with by the Registrar. Sales figures were given which were not considered by the Registrar. Only one bill dated 01.01.1994 is filed and no other bill or invoice filed to prove user. The other bills are after the date of application for registration. The appellant then pointed out to the search report and submitted that the trade mark ""Karan"" was seen in the appellants' name which was ignored by the respondent and now to say that a search was made among the competitors and no such mark was available is a false statement.

11. The appellant then relied on the following judgments:

TRA/16/2005 - Smt. Radhika Trading Vs. Shri Sathish Kumar Lamba Trading - The matter is between the same parties herein. The application for rectification was dismissed with the finding that the respondent ie. the appellant herein has filed adequate proof of user and are the prior adopter and user of the trade mark.

1995 IPLR 15 - GTC Industries Limited Vs. ITC Limited

2005 (31) PTC 201 (IPAB) - Raj WAdhwa Vs. Glaxo India Limited and Another

1993 IPLR 39 -Charak Pharmaceuticals Vs. M.J. Exports Private Limited and Another -The benefit of honest concurrent user can be had only if the user is for a period prior to the date of application.

1995 (15) PTC 165 (SC) - Power Control Appliances and Others Vs. Summet Machines Private Limited and Others. - The settled principle of law

relating to trade mark there can be only mark, one source and one proprietor.

12. In reply, the counsel for the respondent submitted that the sales figures given by the appellant was not supported by any invoices and therefore is a false statement. The wrappers filed did not have any date mentioned. The respondents have filed an invoice dated 01.01.1994 to prove their claim of

user.

13. The counsel then relied on the corn products cases AIR 1960 SC 142 - Corn Products Refining Co. Vs. Shangrila Food Products Ltd. and 1998

PTC (18) High Court of Delhi - Gupta Enterprises Vs. Gupta Enterprises - to say that the appellants trade mark registration will not prove their user.

We have considered the submissions of both.

14 . The rival marks are identical for the same goods. The main opposition proceedings had been decided in the absence of the counsel for the

appellant. On perusal of the records it is seen that the appellants are registered proprietors of the trade mark ""Karan"" as of the year 1990 for the State

of Punjab only and subsequently for the whole of India. The Board in another matter TRA/16/2005 between the parties has held that the appellants

are prior adopters and users of the trade mark ""Karan"". The rights of the appellant are therefore to be protected.

15 . As regards the benefit of honest concurrent user the respondents have not proved their user as on the date of application. They have filed only

one bill dated 01.01.1994 prior to the date of application and the other bills are subsequent and we cannot be relied on in support of their application.

16. It is also seen that the respondents have received an examination report along with the search report where the appellants mark is reflected. The

respondent's adoption therefore cannot be said to be honest and the respondent cannot take advantage of the benefit of Section 12 (3).

17. Without going into the other issues as regards similarity or registrability, as it has been decided by this Board regarding the adoption and user of the

mark, we are of the opinion that the appellants are earlier in adoption and user and the opposition shall be allowed. The onus is always on the

respondent to prove their case in the opposition proceedings. The respondents have failed to prove the same.

18. For the reasons stated above, we are of the view that the impugned order is set aside and the appeal is accordingly allowed without costs.