

**(2004) 10 IPAB CK 0007**

**In the Intellectual Property Appellate Board**

**Case No :** Transferred Appeal No. 130/2003/TM/DEL (CM(M) 10/97)

Sitaram Rawal And Madanlal Rawal

APPELLANT

Vs

Subhash Chander Gupta And Anr.

RESPONDENT

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**Date of Decision :** 25-10-2004

**Acts Referred:**

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

Trade Marks Act, 1999 — Section 100

**Citation :** (2005) 30 PTC 104 (IPAB)

**Hon'ble Judges :** S. Jagadeesan, J;Raghubir Singh, J

**Bench :** Division Bench

**Advocate :** M.R. Bhalerao, Mohan Vidhani

**Final Decision :** Allowed

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**Judgement**

S. Jagadeesan, J

1. The appeal is directed against the order of the Assistant Registrar of Trade Marks, Delhi dated 14.10.1996 rejecting the appellant's application for registration of the trade mark.

2. The appellants S/Shri Sitaram Rawal and Madanlal Rawal trading as M/s Lakshmi Electrical Industries (India) filed application No. 509937 dated

5.5.89 in class 11 of the Trade and Merchandise Marks Act, 1958 (hereinafter referred to as the said Act) for registration of trade mark 'EAGLE'

word per se in respect of heaters, fans, room heaters, immersion rods, geysers, toaster, hot plates for cooking, gas electric oven, fan regulators and

parts of the aforesaid goods included in class 11 claiming user of the mark since 1978. The said application was advertised before acceptance in the

Trade Mark Journal No. 1073 dated 16.2.1994 at page 1332. The first respondent

herein Shri Subash Chancier Gupta proprietor of M/s Classic Cable

Industries filed notice of opposition for the registration of the impugned mark on the ground that the same is violative of Sections 9, 11, 12 and 18 of

the said Act. The Appellant filed their counter statement on 2.3.95 refuting the statement of the first respondent in their notice of opposition. First

respondent on 19.6.95 filed evidence in support of his opposition by way of his affidavit alongwith few supporting documents. The first respondent also

filed affidavit of Shri Jagdish Prasad Gupta, sole proprietor of M/s Payal Electricals and Shri Bhajan Lal Singhal alongwith some photocopies of sale

bills separately with each affidavit. The appellants also filed evidence on 27.9.1995 by way of an affidavit in the name of Shri Sitaram Rawal, one o

the partners of the firm. He also filed six affidavits from various dealers. The first respondent also filed his reply evidence by way of an affidavit and

after completion of the evidence the Assistant Registrar heard the counsel for the respective parties. Ultimately under the impugned order the

Assistant Registrar of Trade Marks allowed the opposition No. DEL 8689 of the first respondent herein and refused registration of the application No.

509937 of the appellant herein. The Assistant Registrar has found that the registration of the impugned mark is prohibited under Section 12(1) of the

said Act only in respect of fan regulators on the ground that among the appellant's goods as well as the goods under the registered trade mark of the

first respondent, only fan regulators is of same description and rest of the goods under the impugned trade mark are not of the same description. The

Assistant Registrar found that the registration of the impugned mark is violative of Section 11(a) of the said Act since the first respondent has

acquired sufficient reputation by use of the mark 'EAGLE' from the year 1977. The Assistant Registrar further held that the first respondent's goods

are mainly switches, wires and cables etc., which have a definite connection with the appellant's goods, namely, heaters, fans, room heaters,

immersion rods, geysers, toaster, hot plates etc., which are included in class 11 and as such the registration of the impugned mark is prohibited under

the provisions of Section 11(1) of the Act. He further held that the appellant is not entitled for the benefit of registration under Section 12(3) of the

said Act also on the ground that the adoption of the trade mark by the appellant is not bona fide. On the same reasoning the Assistant Registrar found

that the registration of the impugned mark is violative of Section 18(1) of the said Act. Aggrieved by the same, the appellant preferred an appeal in

CM (M) No. 10/97 on the file of High Court of Delhi which stood transferred to this Board pursuant to Section 100 of the Trade Marks Act, 1999 and

numbered as TA/130/03.

3. We have heard learned counsel Shri M.R. Bhalerao on behalf of the appellant and learned counsel Shri Mohan Vidhani on behalf of the first

respondent during the sitting of the Board held at New Delhi on 14.9.2004.

4. Learned counsel for the appellant contended that the appellants are already the registered proprietors of the trade mark 'EAGLE' under trade mark

No. 412979 in respect of electric irons, video apparatus and instruments, radio, television, tape recorders all being goods included in class 9. The

application was filed on 11.11.83 and registration was granted on 13.6.1992 and as such the appellants are the registered proprietors of the said trade

mark 'EAGLE' since 11.11.1983. The present application was made under class 11 as the class of goods are different. The first respondent had also

obtained assignment of the registered trade mark 'EAGLE' from earlier proprietors under the trade mark No. 326163 in respect of electric switches.

The first respondent's predecessor also applied for registration of the same trade mark in respect of certain other goods. The first respondent himself

filed two more applications for registration in respect of electric fans, ceiling rose, air regulators, electric fixture and fittings, electric lamp holders,

domestic electric appliances, heater and kettle elements on 22.2.93. The appellant being the registered proprietor of the same trade mark in respect of

goods falling under class 9 and the use of the same was not disputed by the first respondent, the Assistant Registrar had strained himself on the

question of use and found that the registration of the impugned mark will be violative of Section 11(a) of the said Act. The first respondent's registered

mark is only in respect of electric switches and the appellant is not seeking registration of the impugned mark under class 11 in respect of electric

switches. The goods of the appellant being totally different, the registration of the impugned mark ought to have been allowed. Even in respect of the

question of Section 12(3) of the said Act the Assistant Registrar had misdirected himself in finding that the adoption of the trade mark by the appellant

is not bona fide which leads to the conclusion that the Assistant Registrar has

failed to keep in mind that the appellant is also a registered proprietor in respect of the same trade mark relating to the goods under class 9. Further when the first respondent claims that they have adopted the trade mark in respect of other goods, even then as per the findings of the Assistant Registrar only fan regulators could form the same class of goods. In that case the Assistant Registrar ought to have allowed the registration without forgetting the fact that one cannot claim monopoly of the mark in respect of different kinds of goods within a particular class and as these aspects have been totally missed the notice of Assistant Registrar, the impugned order is liable to be set aside.

5. On the other hand the learned counsel for the first respondent contended that the impugned mark had been notified as if it was associated with another mark No. 193367. The particulars of the said associated mark was not furnished. Hence, it cannot be said that the impugned trade mark is in any way associated with mark No. 193367. Further, it was contended that first respondent's application 591326 dated 22.2.93 in respect of all kinds of electric fans, ceiling rose, air regulators, electric fixture and fittings, electric lamp holders, domestic electric appliances, heater and kettle elements as well as application No. 591330 of the same date in respect of bakelite sheet, enamel shade, sleeving paper, PVC adhesive tape and insulating varnish have been registered on 31.5.2000 and 15.5.2000 respectively. So long as the first respondent is the registered proprietor of the said trade mark in respect of goods of same description and the registration having not been challenged by the appellant, it is not open to the appellant now to seek for registration of the impugned mark. Moreover, the Assistant Registrar has elaborately discussed the other issues in respect of Sections 11(a), 12(3) and 18(1) of the said Act and found, that the registration of the impugned mark cannot be permitted. As there is no illegality in the impugned order under appeal no interference is called for.

6. We gave our anxious consideration to the above referred contentions of both the counsel. The appellant is admittedly the registered proprietor of the mark 'EAGLE' under No. 412979 in respect of electric wires, irons, video apparatus and instrument, radio, television, tape records, all being goods included in class 9. In fact the appellant in their counter statement categorically stated as follows:-

That our trade mark 'EAGLE' is registered under No. 412979 in class 9 as of 11.11.83 in respect of electric wires, irons, video apparatus and instruments, radio, television, tape records"".

That we have also made publicity of our trade 'EAGLE' from time to time and public and trade identify and associate 'EAGLE' trade mark with our goods and our name

While dealing with the para-wise averments of the opposition the appellants have stated as follows:-

Contents of para 24 of notice of the opposition are wrong and denied. The applicant already holds registration of the same trade mark 'EAGLE' in class 9. The opponent has failed to show any reason for refusal of the application

The appellants further added by way of a separate paragraph as follows:-

That between the parties it is the applicant who has used the trade mark 'EAGLE' first. The applicant is the proprietor of the registered trade mark

No. 412979 in class 9 for electric and electronic goods stated above.

7. While dealing with the averments in the counter statement, except general denial the first respondent in his reply has not specifically stated anything

with regard to the use of the trade mark 'EAGLE' by the appellant. In the affidavit of the first respondent filed as the evidence in support of their reply

respondent has stated as follows:-

The denials are repudiated and corresponding contents of the notice of opposition are reiterated. I say that the applicants have wrongly got the

registration of the mark 'EAGLE' which has been wrongly and illegally adopted, as such any use or any registration by the applicant is illegal and is

liable to be rectified. The registration claimed by the applicant is denied. The applicants must file the documentary evidence that the applicants are the

registered proprietors of the mark 'EAGLE' as claimed and that the same is valid as of today. In any case, I say that the same is not the special

circumstance as the very adoption by the applicants is illegal

The denials are repudiated and the corresponding contents of notice of opposition are reiterated. I emphatically deny the alleged registration in favour

of the applicants. The applicants must prove the same by filing the necessary documents. In any case the applicants are not entitled to the impugned

registration as the very adoption of the mark is dishonest and tainted.

8. One could see from the averments in the opposition that the appellant has claimed registered proprietorship of the trade mark 'EAGLE' in respect of goods in class 9. When that be so, it is not known as to how the first respondent not only deny the registration but also the adoption of the said trade mark by the appellant. The Assistant Registrar himself found that the appellant is using the trade mark since 1980 while dealing the issue under Section 11(a) of the said Act. Further he came to the conclusion that the respondent is the earlier user of the trade mark, that is, from 1977 in respect of switches, cables etc., on the basis of the evidence produced by the first respondent. We also perused the bills of the years 1977, 1978, 1979, 1982, 1983 and 1986 filed alongwith the affidavit of Shri Bhajan Lal Singhal in support of the first respondent who claims to have used the trademark of the first respondent for several years from the date of the registration till 1985. But the bills reflect only the switches and not the cables or any other articles. Few bills are related to the holders or the adopters. None of the bills deal with cable or any other electrical apparatus. Moreover the first respondent having stated in para 9 of his opposition about the filing of the application 591326 on 22.2.93 for registration of the same trade mark in respect of all kinds of electric fans, ceiling rose, air regulators, electric fixtures and fittings, electric lamp holders, domestic electric appliances, heater and kettle element added in para 10 that he has the intention to use the trade mark 'EAGLE' in respect of the aforesaid goods also in near future. The opposition is dated 5.5.94. The statement is explicitly clear that the first respondent is going to use the same trade mark 'EAGLE' only in future, i.e., after May, 1994 in respect of the goods for which application is pending for registration. So till May, 1994 his own statement is that the first respondent did not use the same trade mark in respect of fans, regulators, electric fittings, holders, domestic electric appliances, heaters and kettle elements. Hence we are unable to agree with the findings of the Assistant Registrar that the first respondent is the earlier user in respect of cable etc. Perhaps he may be the earlier user in respect of his registered goods viz., electric switches, about which there is no dispute.

9. Assistant Registrar while dealing with Section 11(a) has come to the conclusion that the first respondent's goods are mainly switches, wires and cables etc., which have a definite connection with the appellant's goods, namely, heaters, fans, room heaters, immersion rods, geysers, toaster, hot

plates for cooking, gas lighters, electric oven, fan regulators and parts of the aforesaid goods included in class 11. The Assistant Registrar has not elaborated as to what are the trade connections between the goods of the appellant and the goods of the first respondent. The conclusion is without any reasoning. As already stated the first respondent had registered the trade mark 'EAGLE' only in respect of their goods "electric switches". It is not clear from when the first respondent started manufacturing wires, cables and other articles. At any rate he did not use the mark in respect of the goods mentioned in application No. 591326. The appellant produced evidence and the Assistant Registrar himself found that the appellant is using the mark 'EAGLE' in respect of goods included in class 11. Even though the Assistant Registrar doubted the genuineness of Bill Nos. 343 and 344 of the year 1978, has given due credit to other bills produced by the appellant alongwith their evidence in support of their application from the years 1980 to 1988. These bills dealt with water heater, iron box, toaster, room heater, hot plates, geysers, oven etc. These bills clearly establish that the appellant is the earlier user of the mark 'EAGLE' in respect of the goods for which the registration is being sought for. When the first respondent had adopted the trade mark in respect of wires and cables subsequent to the appellant, then his adoption of the trade mark cannot be bona fide in respect of the goods other than for which he obtained registration. As the finding of the Assistant Registrar that the first respondent is the earlier user in respect of cables and wires cannot be sustained, as the same is not based on any evidence, we are inclined to hold that the rejection of the application of the appellant is illegal.

10. Here again what would be the effect of registration of the subsequent mark of the first respondent especially during the pendency of this appeal has to be considered. When once the subsequent registration of the trade mark in favour of the first respondent is only in the year 2000 that too during the pendency of this appeal on the file of the Hon'ble High Court of Delhi, such registration is subject to the result of this appeal. As the appellant succeed in this appeal, automatically the registration of the mark under application 591326 would stand cancelled on the principle that whatever is done during the pendency of litigation before any Court of law, the validity of such action would depend upon the result of the litigation.

11. Even in respect of the finding of the Assistant Registrar that the appellant is not entitled for registration under Section 12(3) of the said Act, we are unable to agree with the same because there is no question of honest concurrent user coming in. It is an admitted or established fact that the appellant is the registered proprietor of the trade mark 'EAGLE' in respect of goods falling in class 9. The use of the said trade mark as already pointed out was never disputed by the first respondent. It is a well laid principle that the undisputed or non-contraverted statement of facts need not be proved by separate evidence. The appellant claimed that they are the registered proprietors of the trade mark in respect of goods in class 9 and they are using the same. Though the first respondent disputed the ownership, they had merely stated that the appellant must prove the registration and never disputed the use of the mark by the appellant. On the other hand the specific plea of the first respondent in dealing with this question is that the use of the said trade mark by the appellant is illegal and the registration in favour of the appellant is also illegal and the same is liable to be rectified.

When the appellant is the registered proprietor of the trade mark, the question of adoption of the same by the appellant has to be construed as bona fide. For the same reason the findings of the Assistant Registrar in respect of Section 18(1) of the said Act also cannot be sustained.

12. For the reasons stated above, the impugned order of the Assistant Registrar of Trade Marks is set aside. The appeal is allowed. We direct the Assistant Registrar of Trade Marks to proceed with the registration of the application No. 509937 of the appellant. The opposition No. DEL 8689 of the first respondent is disallowed. No cost.