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**(2009) 01 IPAB CK 0001**

**In the Intellectual Property Appellate Board**

SLA Impex Pvt. Ltd.

APPELLANT

Vs

V.P. Agarwal And Ors

RESPONDENT

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**Date of Decision :** 13-01-2009

**Acts Referred:**

Trade Marks Act, 1999 — Section 47, 57, 125

**Citation :** (2009) 01 IPAB CK 0001

**Hon'ble Judges :** Z.S. Negi, J;S. Usha, Technical Member

**Bench :** Division Bench

**Final Decision :** Disposed Of

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**Judgement**

S. Usha, Technical Member

1. This is an application for rectification/cancellation of the trade mark 'TIGER' under No. 1297091 in class 8 under Section 47/57/125 of the Trade

Marks Act, 1999 (in short the Act). M.P. No. 59/2008 therein has been filed seeking stay of the operation of registration of registered trade mark No.

1297091.

2 . The applicant is a company carrying on the business of selling cutting tools and power tools. The applicant company imports the goods from China

and sells those goods in India using its trade mark label 'TIGER'. The applicant's goods bearing the trade mark 'TIGER' has gained extensive

reputation by its superior quality. By virtue of prior adoption and continuous use the applicant is the proprietor of the trade mark 'TIGER'.

3 . The applicant was a sole proprietorship concern since January, 1996 which was changed to a partnership concern in the year 2002. In the year

2005 the partnership firm floated into a private limited company with all rights transferred to the company. The applicant and their predecessors have

been carrying on extensive business since 1996 without any interruption from any corner. By virtue of such long and extensive use, the applicant's

goods bearing the trade mark TIGER' along with the device have acquired immense goodwill and wide reputation among the public. The applicant has

filed few invoices to prove their user.

4. The applicant has also filed an application for registration of the trade mark TIGER' along with the device of TIGER in class 7 under No. 1611284

which is pending.

5. On 3.10.2007, M/s Vega Plus Exim Private Limited through its advocate has issued a caution notice stating that the impugned trade mark had been

registered under No. 1297091 in class 8 in respect of power tools and cutting tools. The applicant, on verification understood that the respondent has

had the trade mark registered and had filed this application for rectification. The applicant is a person aggrieved as they were threatened on the basis

of registration, as it adversely affects the rights and interest of the applicant. The impugned registration is wrongly remaining on the Register of Trade

Marks and therefore the applicant is an aggrieved person. The respondent No. 1 has obtained registration by playing fraud and by giving false facts.

The applicant, therefore, prayed that the impugned trade mark under No. 1297091 may be removed/rectified from the Register of Trade Marks on the

following grounds:

(a) The user claimed since 1995 by the respondent No. 1 is false and it has not used the trade mark continuously and has thus gained undue benefit of registration.

(b) The registration has been granted in a different class as the goods dealt with are of a different class and has got to be rectified.

(c) The applicant is the prior user and adopter of the trade mark.

(d) The applicant is the exclusive proprietor of the trade mark as they are the prior user and adopter of the trade mark.

(e) The respondent No. 1's adoption is totally dishonest.

(f) The respondent No. 1 has played fraud and obtained registration.

(g) The registration will definitely cause confusion and deception as the marks are identical.

(h) The impugned registration will adversely affect the purity of the Register.

(i) The impugned trade mark was never used by the respondent No. 1 and ought to be removed from the Register.

(j) The impugned registration has been wrongly obtained and is wrongly remaining on the Register.

6 . On receipt of the application for rectification by the respondent No. 1, the respondent No. 3 herein had filed a miscellaneous petition No. 136/08 for

leave to intervene in the rectification proceedings as they were the interested persons. The said miscellaneous petition was allowed as the applicant

herein had no objection in allowing the petition. The respondent No. 3 had filed their counter statement in the main application for rectification.

7. The respondent No. 3 herein had filed their counter statement narrating the entire facts as to how they acquired the right to the trade mark and had

countered the averments made in the application for rectification. The said impugned registration was made in the name of three partners of a

partnership firm J.M. Ramachandra & Sons. The said three partners had assigned the registered trade mark in favour of the respondent No. 3 on

28.07.2007. The respondent No. 3 along with the three partners had filed a request on Form TM-23 to bring on record the subsequent proprietor, i.e.

the respondent No. 3, before the Trade Marks Registry, which is pending.

8. The predecessor of respondent No. 3 had adopted the trade mark 'TIGER' with the device of tiger in respect of cutting tools and power tools as on

01.04.1995 and have been using the same continuously and extensively without any interruption. The predecessor had in fact made a market survey

and a search in the Trade Marks Registry to verify if there was any conflicting mark available and then adopted the impugned trade mark and applied

for registration. The year wise sales figures of the predecessor were given which starts from 1997-1998 up to the date of assignment which runs to

few crores of rupees. The sales turn over of respondent No. 3 runs to several lakhs of rupees for the period from the date of assignment upto the date

of filing of counter statement.

9 . The application for rectification is liable to be dismissed as there is no proof to show that the applicant firm was earlier a sole proprietary firm and

subsequently converted to a partnership, also there is no proof to show that the goods were either exported or sold in India and that the documents

filed by the applicants proves that they are infringers of various trade marks. The

grounds in the application were all denied by respondent No. 3 in their counter statement.

10. The applicant herein filed the rejoinder to the counter statement and denied the various allegations made therein.

11 . The matter was taken up for hearing in the Circuit Bench at New Delhi on 18.12.2008. Learned Counsel Shri N. Mahabir along with Shri C.S.

Patney appeared for the applicant and learned Counsel Shri Vipin Jain appeared for the respondent No. 3.

12 . Learned Counsel for the applicant mainly contended that the registration was wrongly granted in a different class and the mark was wrongly

remaining on the Register and that on this ground alone the mark was to be rectified. The respondent No. 1 had applied for registration in a different

class and if the respondent would have made a search would have found that the impugned trade mark 'TIGER' application in class 7 which were filed

by various parties which were pending and would have produced some Trade Marks Journal advertisement in support of his contentions.

13 . The learned Counsel further submitted that the applicants were persons aggrieved as the marks were identical and goods were similar and also

that a caution notice was issued. The counsel also submitted that they had imported goods from China and had sold the same under the trade mark

'TIGER' and has brought to our notice the list filed as document along with the application.

14. The counsel further submitted that though the respondent had pleaded in the counter statement that a market survey was made and a search made

in the Trade Marks Registry, but no proof had been filed in support of the same. If really a search was made, the search report would have been filed

before this Tribunal. He also submitted that the invoices filed were only from the year 2001 and even in those no trade mark was mentioned.

15. The counsel for the applicant, therefore, prayed that the mark be removed of the Register mainly on the ground that the mark is registered in a different class of goods.

16 . Learned Counsel for the respondent submitted that they had applied for registration on 15.10.2007 claiming user since 01.04.1975 whereas the

applicants are using the mark only since 1996. The respondents being prior in adoption and use are the proprietors of the trade mark and their rights

are to be protected. The counsel further submitted that as prior users of the trade mark, their rights were to be protected and the application for rectification be dismissed.

17. We have heard the arguments of both the counsel and have gone through the pleadings and documents filed therein.

18. We shall deal with the issue as to whether the applicant is an aggrieved person. Any person may file an opposition to an application for registration, but an aggrieved person alone can file an application for rectification.

19. The expression "person aggrieved" has been liberally construed by various courts. Persons who are aggrieved are persons who are in some way or other substantially interested in having the mark removed from the register or persons who would be substantially damaged if the mark remained -

Powell's TM. Wherever it can be shown that the applicant is in the same trade as the person who has registered the trade mark, 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 mark upon the register, he could lawfully do, he has a locus standi to be heard as a person aggrieved.

20. In this instant case, the marks are identical and the goods being the same, the applicant is considered to be a person aggrieved. The respondent has also issued a caution notice which has caused grievance to the applicant. The grievance must be legal and not sentimental. It is also to be seen that where the registration is clearly illegal or improper, it is immaterial who the applicant is. Here, we find that the applicant has the locus standi to file and maintain this application for rectification in the interest of the public as the purity of the Register is to be maintained.

21. The other issue for consideration is that the mark has been registered in a different class of goods. For better appreciation of the facts of the case it would be proper to mention class 7 and 8 of the Fourth Schedule - Classification of goods and services - Name of the classes

7. Machines and machine tools; motors and engines (except for land vehicles); machine coupling and transmission components (except for land vehicles); agricultural implements other than hand-operated; incubators for eggs.

8. Hand tools and implements (hand operated); cutlery; side arms; razors.

22 . Here the goods mentioned in the application fall under class 7 of the Fourth Schedule but the application has been made in respect of goods in

class 8 of the Fourth Schedule which itself is improper

23. Any error or defect, which may either be clerical or substantive in any entry in the Register is also a ground for rectification of the Register. Any

error of a simple nature in any entry in the Register could be rectified which would be like correction of name or address. But major error or defect in

the original entry cannot be corrected, since the date of registration dates back to the date of application and the registration would be improper and

would required to be expunged.

24 . In the trade marks administration, the purity of the register trade marks has always been recognised as important. The courts and the Registrar

have always taken necessary steps in protecting the public interest and maintaining the purity of the Register, while considering the registration of a

trade mark and also in the aspect of removal of the trade mark from the Register.

25. The law laid down in *Paine v. Daniell* (1893)10 RPC 217 (CA) in this regard is noteworthy. "The purity of the Register of Trade Marks is of much

importance to trade in general, quite apart from the merits or demerits of particular litigants. If on a motion like the present, the attention of the court is

called to an entry in the Register of trade marks which cannot in law be justified as a trade mark, it seems to me that the Court's duty may well be -

whatever be the merits of the applicant - to purify the register and expunge the illegal entry in the interests of the trade, as was done in the *Stone Ales*

case. As a rule, the Court on being seized of the matter would doubtlessly put an end to the existence of a trade mark which could not possibly be

justified by law. But the matter is wholly different when the trade mark complained of is one which is not itself illegal or improper, although on the date

of registration its registration might have been perhaps successfully opposed by some third party who did not in fact oppose it. In such a case, the

defect in the register is not a defect of which the Court is bound to take cognizance at the instance of every complaint.

In an application for rectification, it has got to be remembered that the primary duty of the court is towards the public and the maintenance of the

purity of the register. When a case is sought to be made out that a particular trade mark is likely to deceive or cause confusion, the contest is not so

much between the parties to the litigation as it is a contest between the party defending his right to a particular trade mark and the public and the duty

of the court must always be to protect the public, irrespective of what hardship or inconvenience it may cause to a particular party whose trade mark

is likely to deceive or cause confusion.

26. We also find some force in the contention of the applicant that the respondent has applied for registration under a different class as they were

aware that various other traders had registered in the respective class. We, therefore, are of the view that the respondent's intentions are not bonafide

27. In the light of the above observations, it is clear that the entry has got to be removed as the same is improper.

28. We, therefore, hold that the application for rectification is to be allowed and the registration be rectified / removed from the Register. We direct

the Registrar of Trade Marks to remove the trade mark TIGER' registered under No. 1297091 in class 8 from the Register. As the main rectification

application has been disposed of, MP No. 59/2008 does not survive.