
(2005) 03 IPAB CK 0005

In the Intellectual Property Appellate Board

Case No : Transferred Appeal No. 140 /2003/TM/DEL (CM(M) 414/98)

Sunil Gupta Trading As Jai Durga Electronics

APPELLANT

Vs

Assistant Registrar Of Trade Marks And Standard Electric
Appliances

RESPONDENT

Date of Decision : 09-03-2005

Acts Referred:

Trade Marks Act, 1999 — Section 11(a), 100

Citation : (2005) 31 PTC 231 (IPAB)

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

Bench : Division Bench

Advocate : Mohan Vidhani

Final Decision : Dismissed

Judgement

S. Jagadeesan, J

1. This appeal is directed against the order of the Assistant Registrar of Trade Marks dated 2.2.1998 rejecting the application of the appellant herein

for registration of their trade mark.

2 . The appellant applied for registration of their trade mark word 'VENUS' and monogram under application No. 489540 on 20.4.1988 in respect of

chokes for fluorescent tubes, patties and starters included in class 9, claiming user from 1.4.1988. The said application was advertised in the Trade

Marks Journal No. 1034 dated 1.7.1992 at page 382. The second respondent M/s Standard Electric Appliances on 13.7.1992 filed their notice of

opposition on the grounds of its violative of the provisions of the Trade and Merchandise Marks Act, 1958 (hereinafter referred to as the Act). On

27.10.1993 the appellant filed their counter statement. Thereafter the second respondent filed evidence in support of their opposition and the appellant

also filed their evidence in support of their application. After completing the formality the matter was heard by the Assistant Registrar of Trade

Marks. Under the impugned order the Assistant Registrar rejected the application of the appellant and allowed the opposition DEL-7788 of the second

respondent on the ground that the second respondent is the registered proprietor of the trade mark 'VENUS' in respect of water heaters, oven,

immersion heaters and water coolers included in class 11 and they are using the same since 1961. The impugned mark being the same, the registration

would offend section 11(a) of the Act in view of the mark of the second respondent having become a well known mark. The Assistant Registrar

further held that the appellant cannot be considered to be the proprietor of the impugned mark since the same mark was already registered in the

name of the second respondent. Aggrieved by the same the appellant filed the appeal in the High Court of Delhi at New Delhi in CM (M) 414/98. By

virtue of Section 100 of the Trade Marks Act, 1999 the said appeal has been transferred to this Board and numbered as TA140/03.

3 . During our sitting held at New Delhi on 16.2.2005 we listed the appeal for disposal. Learned counsel Shri Mohan Vidhani appeared on behalf of

the appellant and there was no representation on behalf of the second respondent.

4 . Learned counsel for the appellant contended that the Assistant Registrar has committed a grave error in overlooking the advertisements under the

impugned mark which is word 'VENUS' with a monogram and the goods for which the registration is sought for also falls under class 9. The second

respondent's mark is word per se 'VENUS' and their goods falls under class 11. When the goods are different and there is a significant difference

between the two marks, there cannot be any question of confusion as concluded by the Assistant Registrar. The Assistant Registrar has also erred in

proceeding on the basis of the theory that the second respondent's mark is a well known one and also had attained reputation.

5 . We carefully considered the above contention of the learned counsel for the appellant. Apart from the above two issues no other ground was put

before us. There is no dispute that the second respondent is the registered proprietor of the trade mark 'VENUS' in respect of water heaters and

water coolers falling under class 11 of the Fourth Schedule. The main contention of the learned counsel for the appellant is that the appellant's

impugned mark consists of word 'VENUS' with the monogram and as such the distinction between the two marks can easily be made out. Further the goods of the appellant falls under class 9 and as such the goods of the appellant is not the same or of same description, as that of the second respondent.

6 . Even though the appellant's impugned mark consists of the word 'VENUS' with monogram, when a purchaser wants to purchase the goods he can make a requisition with the word per se being the name by which the goods can be identified. The monogram has no relevance to identify the goods. For example, if one wants to purchase a choke or starter of the appellant, they have to identify the same with the trade mark 'VENUS'. Without the word 'VENUS' they cannot make any requisition to identify the appellant's goods. Hence the word 'VENUS' plays a main role in identifying the goods of the appellant.

7 . The appellant filed application on 20.4.1988 claiming user from 1.4.88 whereas the second respondent was in the field with their trade mark 'VENUS' from January, 1961. There is no doubt that the appellant has adopted the word 'VENUS' knowing fully about the reputation attained by the second respondent in respect of their goods. Apart from that the goods of the appellant is also closely associated with the goods of the second respondent and the trade channel is also the same.

8 . Without multiplying the authorities we would like to refer a few judgments wherein the principles have been laid down as follows:-

In a case reported in AIR 1983 Punjab and Haryana 418 Banga Watch Company, Chandigarh v. N.V. Philips Eindhoven, Holland and Anr .the

learned Judge of the Punjab & Harayana High Court held that the trade mark 'PHILIPS' was used extensively with respect to radios. Use of the identical mark 'Philips' with respect to timepieces, wall clocks which are available across the same counter will lead to passing-off. It is immaterial that the goods belong to different classes as they are available across the same counter.

In AIR 1985 Allahabad 242- Bata India Limited v. Pyare Lal & Co., Meerut City and Or. sthe Allahabad High Court held that as the trade mark

'Bata' was used extensively with respect to footwear, the use of the mark 'Batafoam' with respect to mattresses would amount to passing off.

In 1988 PTC 1 Kamal Trading Co., v. Gillette U.K. Ltd., England the Bombay High Court held that use of the trade mark 7 clock with respect to tooth

brushes will lead to passing off, as the use of 7 clock with respect to blades is already well known in the mark.

In AIR 1994 Delhi 239 Daimler Benz Aktiegesellschaft v. Hybo Hindustan the High Court of Delhi held that the trade mark 'BENZ' was extensively

used with respect to automobiles. The use of an identical mark 'Benz' with respect to undergarments will lead to confusion in the market, although the

manufacturers of Mercedes Benz cars were neither manufacturing nor selling garments or underwear apparels. The said judgement of the learned

single Judge was confirmed by the Division Bench of the same High Court and also confirmed by the Supreme Court.

In 1998 IPLR 326 Caterpillar Inc., US v. Jorange and Anr. the Division Bench of the Madras High Court held that the use of 'Caterpillar' name for

ready made garments in India would amount to passing-off since the name 'Caterpillar' is registered in respect of heavy vehicles which name had

earned the reputation and goodwill world-wide.

The Delhi High Court in the case of Honda Motors Company Limited v. Charanjit Singh and Ors. reported in 2003 (26) PTC 1 (De lh)ad held that the

plaintiff's mark Honda has acquired a global goodwill and reputation and the said name is associated with the plaintiff established in the field of

automobiles and power equipments and as such the same trade mark has acquired goodwill and reputation, the use of the said trade mark by the

defendant was for their product pressure cooker, does mislead the public to believe that the defendant's business and goods are that of the plaintiff and

such user by the defendants is also diluted and deface the goodwill and reputation of the plaintiff.

9. From the principles laid down by various courts in the judgments referred to above it is clear that even if the goods are totally different, without

having any trade connection, but still if the impugned mark is identical and similar to that of the well known or reputed mark of the opponent, then the

impugned mark cannot be registered. Here the said principles squarely apply.

10. Apart from that the appellant did not offer any explanation for his adoption of the word 'VENUS' when the second respondent is in the trade for

more than 27 years with the same name and trade mark. In the absence of any

explanation by the appellant to adopt the impugned name, we have to conclude that the adoption is not a bonafide one.

11. For the reasons stated above, we do not find any infirmity in the order of the Assistant Registrar of Trade Marks and accordingly the appeal is dismissed. However, there will be no order as to costs.