

**(2010) 01 IPAB CK 0019**

**In the Intellectual Property Appellate Board**

**Case No :** M.P. No. 226/2008 In ORA 37/2005/TM/AMD, ORA/37/2005/TM/AMD,  
M.P. No. 227/2008 In ORA/8/2006/TM/AMD, ORA/8/2006/TM/AMD

Tucker Fastners Ltd.

APPELLANT

Vs

Solsons Export Pvt. Ltd.

RESPONDENT

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**Date of Decision :** 15-01-2010

**Acts Referred:**

Trade Marks Act, 1999 — Section 9, 9(20), 11, 18, 57

**Citation :** (2010) 01 IPAB CK 0019

**Hon'ble Judges :** S. Usha, J; Syed Obaidur Rahaman, Technical Member

**Bench :** Division Bench

**Final Decision :** Allowed

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**Judgement**

S. Usha, J

1. The above two rectification applications are for removal/rectification of the trade marks ""POP JAWS"" and ""POP"" registered under Nos. 449510 in

class 7 and 722090 in class 8 respectively from the Register of Trade Marks under Section 57 of the Trade Marks Act, 1999 (hereinafter referred to

as the Act).

2. The applicants are a company of international repute and are known worldwide for their high quality products. The goods are available in the major

countries of the world. They had adopted the trade mark ""POP"" and had been using the same for their products and have also obtained world over

registration for the ""POP"" mark. The trade mark ""POP"" has been in continuous use in India since the year 1960. The applicants have obtained

registration of the trade mark ""POP"" in class under No. 157493. The trade mark has been widely published and used continuously and extensively. By

its long use the mark has acquired immense goodwill. The mark has acquired

distinctiveness exclusively with the goods of the applicants' manufacture.

3. The impugned registrations ""POP JAWS"" and ""POP"" are similar to the applicants trade mark ""POP"". The Respondent has copied the trade mark

and added a prefix ""JAWS"" to it. Such addition does not afford any distinctiveness, as any purchaser may view it as another variation of trade mark.

The impugned marks being identical to that of the applicant's marks in respect of similar goods is likely to cause deception and confusion among the

public. The impugned trade marks ""POP JAWS"" in class 7 in respect of lathe chucks, saws and machine tools and ""POP"" in class 8 in respect of hand

tools are of similar description which are normally used by the same class of consumers which will lead to confusion among the public. The applicants

are therefore aggrieved persons.

4. The applicants have also filed notice of opposition for the other applications for registration i.e. for the trade marks ""POP KEYS"" and ""POP PRO

filed by the present applicant. The application for registration of the trade mark ""POP PROW"" in the United States of America was also opposed by

the applicant and the application was refused registration.

5. The applicants are registered proprietors of the trade mark ""POP"" as early as 1953 and the mark was on the register as on the date when the mark

was applied for.

6. The grounds of the application for rectification are -

(a) that the impugned registration does not qualify for registration as it does not designate the source of the goods for which it is used;

(b) that the impugned registration has been wrongly registered in the name of a person who is not the proprietor of the trade mark;

(c) that the impugned registration ought not to have been granted as the applicants similar trade mark was already on the register;

(d) that the impugned registration has been granted in contravention of the provisions of the Act which is likely to cause confusion and deception;

(e) that the impugned registration has resulted in infringement of our rights in the trade mark;

(f) in view of visual resemblance between the marks the unwary purchasers may be deceived;

(g) that the impugned trade mark is not entitled to protection under law;

(h) that the trade mark is registered and remaining on the Register wrongly and without sufficient cause; and

(i) that the impugned registration is contrary to Sections 9, 11 and 18 of the Act.

7. The Respondents filed their counter-statement denying the various allegations made in the application for rectification. The defense raised in the

counter-statement was that they had been using the impugned trade mark since the year 1986. The trade marks were not opposed and hence the

marks were registered. The Respondent had also stated about the impugned trade marks and also the pending trade marks which are under opposition

by the applicant herein. The trade marks are used continuously without any interruption. Due to honest adoption and long use the trade marks have

become distinctive and the purchasers associate the trade marks with the Respondent's goods and with none else. The sales turnover runs to several

lakhs of rupees. The Respondent has spent huge amounts towards advertisement in order to popularize their trade marks.

8. There is no bar under Sections 9 and 11 of the Act as no similar/identical marks was available in the Register as on the date of application of the

impugned trade marks. Due to innovation of Chuck's Jaws which means modern or new the Respondent coined the words. Therefore, the impugned

trade marks became a well known mark. The counsel further submitted that the counsel i.e. M/s De penning & De Penning have no authority to file

this rectification application as they were not given any authorization to do the same. The Respondent had further denied the various other allegations

made there in.

9. We have heard the matter on 01.12.2009 at the Circuit Bench sitting at Ahmedabad. Shri Amit Jamsandekar, learned Counsel appeared on behalf

of the applicant and none appeared on behalf of the Respondent in spite of service of notice for the hearing.

10. The learned Counsel for the applicant submitted that they had adopted the trade mark ""POP"" as early as 1956 and had been using the same

continuously without any interruption. They have obtained registration in various countries of the world. The trade mark thus has become a well

known trade mark. The trade mark was used since the year 1933 outside India.

11. The applicant submitted that the Respondent had not made a search and if done would have come to know of the applicant's mark already on the

Register. The adoption of the trade mark by the Respondent is dishonest. The Respondent in their counter statement has not denied the applicants

user. The applicant brought to our notice the various documents filed to prove his user and to say that the mark was registered in various countries.

The counsel brought to our notice the order passed by the US court refusing the Respondent's application for registration of the trade mark ""POP

Prow"".

12. The applicant further submitted the Respondent had made a vague statement that search was made before application for registration was made

but no proof filed to substantiate the same. The goods are similar and as the applicants are prior users of the trade mark their rights are to be

protected. The counsel also referred to and relied on various Judgments in support of his case.

13. We have heard the arguments of the counsel for applicant and have gone through their pleadings. The Respondent though did not appear for the

hearing had filed their counter-statement to the application for rectification and we have perused the same.

14. In an application for rectification, the Hon'ble High Court of Bombay held in the case of Ciba Limited v. Ramilangam AIR 1958 Bom 56 - ""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 set 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 courts 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"".

15. In the case on hand, it is clear that the marks are identical except for the suffix added to the word ""POP"". It is not denied by the Respondent as to

date of user averred by the applicant. The public in such case, will assume or associate the goods of the Respondent as that of the applicants as the

trade channels are the same. Therefore, there is likelihood of confusion and deception which would cause loss to the applicants. The applicant is,

therefore, a person aggrieved and has the locus standi to maintain and file the application for rectification.

16. In our considered opinion, when the Respondent has adopted a similar suffix with the applicant, the trade marks are deceptively similar which is

likely to cause confusion which in turn would cause irreparable loss to the applicant and has got to be rectified.

17. As per the provisions of Section 18 of the Act, a person who has just copied another person's trade mark cannot be said to be the proprietor of the

said trade mark, even if it is an invented word. The Respondent has in fact stated that it is an invented word, but there is no doubt that the applicants

are prior users of the mark since 1954 in India and earlier outside India. If the owner of a similar mark who has made an earlier assertion of

proprietorship and who had not abandoned that claim, then the claim of the applicant is not correct and should not be allowed to continue.

18. The case of the Respondent is that they adopted the trade mark in the year 1986 and the impugned application were made in the year 1996 which

is undoubtedly after the adoption and use of the mark by the applicants. In such circumstances the rights of the earlier user are to be protected. The

Respondents though have stated to have made a search but nothing was placed before us for proving the same. As seen from the records, it is clear

that the applicant's mark has been registered as of the year 1954 and to say no such mark was on the register, which statement cannot be accepted.

19. The other only defense by the Respondent was that the registration was not a bar under Sections 9 & 11 of the Act. Section 9 of the Act deals

with the absolute grounds for refusal of registration and Section 11 of the Act deals with the relative grounds for refusal of registration. Sub-section

(20 Clause (a) of Section 9 provides that if a mark is of such a nature as to deceive the public or cause confusion. In this case, there is possibility of

confusion as observed in the earlier para and hence the registration granted is in contravention of the provisions of Section 9 of the Act.

20. Section 11 deals with identical goods and marks and similar goods and marks. Under this provision also it has been stated that the marks shall not

be registered if there is similarity or identity of the earlier marks for similar goods or identical goods which will cause confusion among the public.

21. The applicants have also produced various bills and invoices to prove their user. The registration of the impugned trade marks are, therefore, in

contravention of the provisions of the Act and are to be removed from the register of trade marks.

22. In view of the above, we allow the rectification application directing the Registrar of Trade Marks to remove/cancel the trade marks ""POP JAWS"" UNDER No. 449510 in class 7 and ""POP"" under No. 722090 in class 8 from the Register. Since the original rectification applications have been disposed of, M.P. No. 226/2008 and M.P. No. 227/2008 filed in ORA 37/2005/TM/AMD and ORA/8/2006/TM/AMD respectively do not survive. There shall be no order as to costs.