
(2004) 08 IPAB CK 0019

In the Intellectual Property Appellate Board

Case No : Transferred Appeal Nos. 96/2003/TM/DEL (CM) (M) No. 433/1994,
111/2003/TM/DEL (CM) (M) No. 184/1995

Usha Rani

APPELLANT

Vs

Registrar Of Trade Marks And Anr.

RESPONDENT

Date of Decision : 27-08-2004

Acts Referred:

Trade And Merchandise Marks Act, 1958 — Section 9, 11(a), 11(b), 11(e), 12(1),
12(3), 18(1)
Trade Marks Act, 1999 — Section 100

Citation : (2004) 29 PTC 647 (IPAB)

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

Bench : Division Bench

Advocate : Mohan Vidhani, K.R. Gupta, N.K. Anand

Final Decision : Dismissed

Judgement

S. Jagadeesan, J

1. The appellant has filed these appeals against the order of the Deputy Registrar of Trade Marks dated 07.03.1994 and 11.11.1994 respectively allowing the opposition filed

by the second respondents in No. DEL 7267 and No. DEL 7219 of the respective appeals and refusing the registration of application No. 434294 filed by the appellant in

class 9 under the Trade and Merchandise Marks Act, 1958 (hereinafter referred to as the Act). The appellant filed application No. 434294 for the registration of the trade

mark 'USHA' in respect of switch gears, electric switch, electric main switch, metal clad switch fuse. The said application was advertised in the trade mark journal No. 1004

dated 01.04.1991 at page 28, on 21st June, 1991 M/s. Chinar Trust, the second respondent in TA No. 96/2003 who also claimed that they are the sister concern of the

second respondent Jay Engineering Works Ltd., in TA No. 111/2003 filed a notice of opposition opposing the application of the appellant for registration of the trade mark on

the ground that they are registered proprietors of the trade mark 'USHA' under various registration numbers in respect of goods falling under classes 7, 9 and 11 and that

they attained goodwill and reputation in the mark for their standard quality of goods. The appellants copied their mark for the purpose of enjoying upon the goodwill and

reputation attained by the respondents. The goods in respect of which the appellant seeks registration are goods of similar description in respect where of the respondents

use their trade mark. The registration of the appellant's mark will be contrary to the provisions of Sections 9, 11(a), 11(e), 12(1) and 18(1) of the Act. On 20.08.1992 the

appellants filed the counter statement denying the material averments stated by the second respondent in their opposition and further added that the appellants are engaged in

the business of manufacturing and selling switch gears, electric switches, electric main switches and metal clad switch fuse units since the year 1969 and the word 'USHA'

has been taken from the personal name of the appellant. The parties led in evidence.

2. Similarly second respondent in TA No. 111/2003 M/s. Jay Engineering Works Ltd., filed their opposition on 29th May 1991 stating that they are the manufacturers and

merchants in sewing machines, electrical fans, regulators and parts thereof with the trade mark 'USHA' and that they are the registered proprietors of the said trade mark.

They are the registered owners of the mark under Copyright Act also and the word trade mark applied for by the appellant is identical with and/or deceptively similar to the

second respondent's mark and as such the registration of the impugned mark is prohibited under Sections 9, 11(a), 11(b), 11(e), 12(1) and 18(1) of the Act. The Deputy

Registrar of Trade Marks separately considered the opposition filed by the second respondent in the respective appeals and ultimately by order dated 7th March, 1994

allowed the opposition DEL-7267 filed by the second respondent in TA No. 96/2003 and by order dated 11th November, 1994 allowed the opposition DEL-7219 filed by the

second respondent in TA No. 111/2003 and consequently rejected the application No. 434294 of the appellant for registration of the impugned trade mark.

3. Against the order of the Deputy Registrar of Trade Marks the appellant filed CM(M) No. 433/94 and 184/95 on the file of High Court of Delhi. These appeals have been

transferred to this Board pursuant to Section 100 of the Trade Marks Act, 1999 and numbered as TA No. 96/2003 and TA No. 111/2003 respectively. As the issues

involved in both the appeals are common and in respect of one application filed by the appellant for registration of the impugned trade mark, by consent of both the counsel

the appeals were taken up for joint disposal.

4. We heard Mr. Mohan Vidhani the learned counsel for the appellant and Shri Kulwant Rai Gupta learned counsel for the second respondent in TA No. 96/03 and Shri.

N.K. Anand learned for second respondent in TA No. 111/03.

5. Learned counsel for the appellant contended that the appellant sought registration of the trade mark 'USHA' being the name of the appellant, Usha Rani. Further the

goods of the appellant are under class 9 where as the goods of the second respondent in both the appeals do not fall under class 9. Hence, the goods of the appellant and the

respondents cannot be said to be similar in nature. So far as the similarity of the trade mark is concerned he contended that though there is slight difference in visual, as the

goods are totally different, Section 12(1) of the Act is not attracted. Similarly Section 11(a) is also not attracted as there cannot be any confusion or deception when the

goods of the appellant and the respondents are totally different. He further contended that the appellant had commenced use of the impugned trade mark since 1969 or 1970

and as such the Registrar ought to have considered the claim of the appellant under Section 12(3) of the Act. The failure of the Registrar to consider the claim of the

appellant under Section 12(3) would vitiate the entire order and the same is liable to be set aside. On the contrary the learned counsel Mr. Gupta for the second respondent

in TA No. 96/2003 contended that the second respondent being the sister concern of second respondent in TA No. 111/2003 and they are using the trade name 'USHA'

being the registered proprietors of the said trade mark. The respondent is having the registered trade marks in respect of various goods and those goods are being sold in the

same shop where the appellants goods will be sold. In such circumstances, there will be definitely a confusion in the minds of the consumers as well as the public as to the

manufacturer of the goods. The appellants having built up very good reputation in the trade, there is every possibility that the consumer may be of the impression that the

goods of the appellant are also coming out of the respondents. These questions were fully and elaborately considered by the Deputy Registrar of Trade Marks and he also

found that, there will be confusion in the minds of the consumer and Section 11(a) is attracted and consequently upheld the opposition of the respondents. The well

considered order of the Registrar needs no interference. Shri N.K. Anand also advanced the same arguments.

6. We have carefully considered the above contentions of the respective counsel. Though the learned counsel for the appellant contended that the second respondent's

artistic work comprising of the word 'USHA' within a single continuous block is totally different from the artistic work comprising of the word 'USHA' adopted by the

appellant, we are unable to agree with the same. In a trade mark case when considering the similarity of the trade mark, it has been repeatedly held that the microscopic

comparison of the two marks cannot be made. Always it is necessary that both the marks to be placed side by side and compare the same. If, for a mere look, both are

identical or similar then it has to be held that both the marks are similar and the infringer's mark is deceptively similar to that of the other one. In this case we have no

hesitation to conclude that both the trade marks are identical and similar and as such the appellant's mark, without any doubt, is deceptively similar to that of the respondent's

mark.

7. It is the contention of the learned counsel for the appellant that the goods of the appellant falls under Class 9 whereas the second respondent's goods are of different class

and do not fall under Class 9. In view of the same, Section 11(a) and 11(e) is not attracted because when the goods of the appellant and the respondent are different in

nature, there cannot be any confusion or deception in the minds of the consumer or the general public. In considering this question it is worthwhile to refer to some of the

judgments where the passing-off action had been considered in cases where the disputed trade mark is deceptively similar to that of the registered one even though both are

engaged in production of different goods. There is no dispute that the second respondent in TA No. 96/2003 has registered trade mark as detailed below:-

8. As the second respondent in the respective appeals is engaged in the manufacturing of electrical appliances, their apprehension is that if the appellant also produces switch

gears, electrical switch, electrical main switch, metal clad switch fuse which are also electrical appliances that falls under a different class, there is every possibility that the

general public are likely to presume that the articles produced by the appellant are that of the respondent, especially when the goods of the respondent as well as the

appellant are to be dealt with by a common dealer in the same window or the counter. Definitely the possibility of confusion cannot be ruled out. When the respondent had

built up a long reputation and good will, whether the same can be permitted to be benefited by the appellant. To start with;

In AIR 1960 SC 142, Corn Products Refining Co. v. Shangrila Food Products Ltd., the learned Judges of the Supreme Court held that the mark applied for registration

'Gluvita' for biscuits cannot be permitted to be registered on the objection raised by the registered trade mark proprietor of 'Glucovita' for Glucose. It was held that the

commodities are so connected as to make a confusion or deception likely in view of the similarity of the two trade marks.

In AIR 1969 Bombay 24, Sunder Paramanand Lalwani and Ors. v. Caltex (India) Ltd., the Bombay High Court held that the name 'Caltex' cannot be permitted to be

registered in connection with the applicant's watches on the ground that a large number of persons if they saw or heard about the mark 'Caltex' in connection with the

applicant's watches, would be left to think that watches were in some way connected with the opponents who were dealing in petrol and various oil products with the mark

'Caltex'.

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

& Haryana 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 Ors. the 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 AIR 1988 Bombay 1967, Bajaj Electricals Limited v. Metals & Allied Products the Bombay High Court held that the trade mark 'Bajaj' was used extensively with respect

to electrical goods. Despite the fact that 'Bajaj' is a personal name, the use of identical mark with respect to utensils will lead to passing-off, as these goods are sold across

the same counter.

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 'O' clock with respect to tooth brushes will lead

to passing off, as the use of 7'O' 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 judgment 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.

9. On the above principles if we look at the facts of the case, 'USHA' the registered trade mark of the second respondent, has got wide reputation and good will in India as

well as abroad. Whether such name can be permitted to be used by others either in respect of different goods or by different architecture or design. The above principles

laid down by various courts makes it clear that where a registered trade mark has got the reputation and good will, such trade marks cannot be permitted to be used by

another person, as the same would cause confusion in the mind of the general public that the goods being manufactured with the identical trade mark has some connection

with the registered proprietor of that trade mark. This confusion cannot be totally ruled out. In that case this appellant cannot be permitted to have the same name 'USHA' of

which the respondents are the registered proprietors.

10. The learned counsel for the appellant contended that the Registrar has failed to consider their claim under Section 12(3) of the Act. Section 12(3) of the Act will be

attracted only if the appellant had used the said trade mark with bona fide intentions. The respondents are the registered proprietors of the trade mark, and long after such

registration of the trade mark in the name of the respondents the appellant had started the using the same name 'USHA'. When that be the case the adoption of the same

trade mark by the appellant lacks bona fide. When the adoption of the trade mark lacks bonafide, Section 12(3) of the Act is not attracted and consequently the Registrar

has not committed any error in non-considering of the claim of the appellant under Section 12(3) of the Act. For the reasons stated above, we are of the view that the

appeals are devoid of any merit and the same are dismissed with cost of Rs. 10,000.