

Poonam Electricals Vs. Ranjit Electronics

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Court : Trademark

Decided On : Jan-15-2003

Reported in : (2003)(26)PTC284Reg

Judge : R Lal, Artm

Appellant : Poonam Electricals

Respondent : Ranjit Electronics

Judgement :

1. On 49, December 1991, M/s. POONAM ELECTRICALS, 434-B, Rishi Nagar, Rani Bagh, Delhi 110034 (hereinafter referred to as the applicant) applied for registration of trade mark, "DUKE" (word per se) vide application No. 564078 in Class 9 and the same was advertised before acceptance in the trade marks journal No. 1180 dated 1, August 1998 at Page 1002 in respect of Electrical Accessories included in class 9 for sale in Delhi. The user claimed by the applicants in the said application was shown as since 1.4.1988.

2. On 23.10.1998, M/s. RANJIT ELECTRONICS, 30, Lajpat Rai Market, Delhi 110006 (hereinafter referred to as the opponents) filed the notice of opposition to oppose the registration of the trade mark advertised as aforesaid on the grounds of its violative of Sections 9, 11(a) and 11(e), 12(1), 12(2), 12(3) and 18(1) of the Trade and Merchandise Marks Act, 1958.

3. On 7,12.1999, the applicant filed their counter statement generally denying all the material allegations as contained in the notice of opposition.
4. The opponent vide their Affidavit dated 25.8.2000 filed their evidence in support of notice of opposition, in the name of Sh. Parvinder Singh, one of the partner of the opponents firm, the said affidavit was supported in Exhibits A-1 to A-37 consisting of labels of the parties and copy of opponents Registration and Renewal certificates of Regd, trade mark DUKE under No. 497344 in class 9 and Affidavit of one of the dealers of the opponents claiming the sale of goods of the opponent since the year 1984 and also copies of few invoices showing the sale of goods of the opponents firm.
5. The evidence of the opponents was taken on record by Trade Marks Registry and the attention of the applicant was invited to file evidence in support of application under Rule 54 of the Trade Marks Rules.
6. On 24.1.2001 the applicants filed one TM-16 seeking amendments of specification of goods, the said request was filed alongwith Affidavit dated 23.1.2001 annexing therewith some photo copies of supporting documents as exhibits and thereafter on 26 March 2001 filed one Interlocutory Petition for taking on record the evidence of the applicant and vide order dated 25 July, 2001 this Tribunal allowed the said TM-16 amending the goods to read as "Electrical Switches, Sockets, Tops and Holders", and the Affidavit and annexures filed with the said TM-16 were taken on record as evidence under Rule 54. The evidence of the applicants consists of copies of few documents of purchase of dies and machines and copies of few invoices showing the sale of goods.
7. After completion of the above proceedings, the matter was set down for hearing, which was adjourned from time to time and finally taken up on 2.12.2002 when Sh. G.D. Chugh, Advocate appeared on behalf of the opponent and Shri Sartaj Ali, Advocate appeared on behalf of the applicant. The matter was heard in detail and judgment was reserved subject to production of original documents by the applicant, and the applicant on 9.12.2002 produced the original copies of exhibits those were filed in the proceedings.

8. At the time of hearing, the Learned counsel for the opponent submitted that the opponent adopted and using the trade mark DUKE since the year 1982 and are also the Registered prop, of the same since 5.9.1988. The Ld. Counsel pointed out the figure of sales from the year 1981-82 to 1998-99 as indicated in para, 4 of the opponents affidavit and submitted that 50% of the sales pertain belonging to sale of goods bearing the trade mark DUKE. Sh. Chugh further stated that the use of trade mark DUKE by the applicant in respect of similar description of goods for which the applicant is seeking registration shall cause confusion and deception as to the source of origin of goods and in case, if the trade mark applied for is allowed to be registered the same is likely to deceive or cause confusion in the minds of the purchasers keeping in view of the long use, reputation of the opponents goods under the Registered trade mark DUKE in respect of similar description of goods.

9. The opponent counsel produced before me a copy of order dated 27th June, 2000 passed by the Hon'ble High Court of Delhi in the Suit No.1352 of 2000 wherein the Hon'ble Court while considering the proprietary rights of the opponent, passed the ex parte and interim order of injunction restraining M/s. Poonam Electricals, their servants, employees or agents, dealers, stockists, representatives and all other persons acting on their behalf from manufacturing, selling, offering for sale, advertising directly or indirectly dealing in Electrical Accessories or other allied or cognate goods under the trade mark DUKE or any other identical or deceptively similar trade mark. The said order of injunction is still in operation.

10. In the aforementioned Suit, the applicant alongwith the written statement dated 8.11.2000 and an application under Order 39 Rule 4, CPC for vacation of the interim order of injunction filed few documents in the judicial proceedings and in para 6 of the application under Order 39 Rule 4, the applicant stated and admitted that he has been engaged in the business since the year 1989 and in the document filed as Annexures of the label mark used by the applicant, wherein he represented letter 'R' in a circle above the trade mark DUKE. After going through the labels of the applicant, the opponent on 30.11.2000 filed one complaint under Section 81 of the Act seeking prosecution against the applicant and in reply thereto the applicant did not deny the said fact and confirmed not to do the same in future which was done under genuine mistake. The counsel for the opponent

produced before me the relevant documents at the hearing.

11. The Ld. Counsel for the applicant also drew my attention to the evidence of the applicant taken on record under Rule 54 and in para 2 of the said affidavit, the applicant admitted that he has been using the trade mark DUKE since the year 1989 and Sh. G.D. Chugh further stated that in view of admission on the part of the applicant that he is in business since the year 1989, the statement of user mentioned in the application as 1.4.1988 is false and wrong. Since the applicant had no business prior to the year 1989, hence the documentary evidence filed prior to the period of 1989 (those related to the purchase of dies and machines etc.) have been prepared after thought only to obtain registration of impugned trade mark wherein false statement of user was claimed. The documentary evidence filed even after the year 1989 is false, forged and manipulated and cannot be admitted in the proceedings since most of them are subsequent to crucial date of application i.e.

19.12.1991. The applicant has not filed any exact/particular of sale of goods bearing the imitated trade mark DUKE which has deliberately been shown by the applicant since 1.4.1988.

12. The learned counsel for the opponent further submitted that the opponent is the Registered proprietor of trade mark DUKE under No.497344 in class 9 dated 5.9.1988 in respect of Adopter, Leads, Transformer, Battery Eliminators, Radios, TV: Transistors, Two in One, Cassettes and parts thereof and the said registration is valid and subsisting on the records, copies of those filed in the evidence and further submitted that the applicant by filing the impugned application No. 564078 in class 9 in respect of similar description of goods has copied the prior used and Registered trade mark of the opponent. The Ld. Counsel further submitted that the opponent filed one Suit No. 1352 of 2000 in the Hon'ble High Court of Delhi and the Hon'ble Court on 27.6.2000 while considering the proprietary rights of the opponent in the trade mark DUKE passed an ex parte and interim order of injunction restraining the applicant, their servants, employees or agents, dealers, stockists, representatives and all other persons acting on their behalf from manufacturing, selling, offering for sale, advertising directly or indirectly dealing in

Electrical Accessories or other allied or cognate goods under the trade mark DUKE or any other identical or deceptively similar trade mark. The said order of injunction is still in operation. The Ld. Counsel submitted that since the adoption of the trade mark DUKE on the part of the applicant is dishonest and with mala fide intention, hence, the application of the applicant be dismissed under Section 12(1) of the Act and due to the dishonest conduct of the applicant, he is not even entitled for registration under Section 12(3) of the Act.

13. The learned counsel for the opponent submitted that the applicant himself has admitted that he is using the trade mark DUKE since the year 1989 and in the documentary evidence of the applicant, prior to the date of application i.e. 19.12.1991, the applicant filed only three invoices for sale of goods to few persons those cannot be verified in the absence of their address (which even are not admitted), hence the same is not distinctive and not even capable of being distinguishing with the goods of the applicant therefore, deserved to be dismissed, within the provision of Section 9 of the Act.

14. Sh. G.D. Chugh, the learned counsel submitted that for the reasons, facts and circumstances highlighted earlier, the applicant is not the proprietor of trade mark DUKE within the provision of Section 18(1) of the Act, hence prayed that the application of the applicant be dismissed accordingly.

15. Sh. G.D. Chugh, Ld. Counsel for the opponent relied upon few decision in support of his submissions namely:- Kumar Electric Works v. Anuj Electronics, 1989 Arb.L.R. (2) 133 : 1990 PTC 26, Para 9 which reads Admittedly the plaintiff was not using the trade mark OLUMPUS in respect of television the goods which the defendant was marketing under this name. However, the fact remains that, prima facie the plaintiffs electronic and electrical goods namely electric fans, heat convector, air coolers, juicer - blender- grinder, washing machine, cooler pump, cooler fans and sandwich toaster were marketed through the trade mark OLUMPUS. Plaintiffs right to restrain the defendant from using the trade mark, prima facie, extends to cognate classes of goods. Televisions, which are being sold by the defendant under exactly the same trade mark prima fade were in the same trading channel and were cognate goods.

Mitaso Appliances Ltd. v. Mehta Zinahhai Bhimji Bhai, 1995 PTC 294.

In this case, the plaintiff was the registered proprietor of trade mark MITASO in respect of installation for heating, steam generating, cooking, including LPG gas stoves, geyser and electrical household equipment's, fans, hot plates, toasters etc. and the defendant started using the track mark MITASO in respect of Electronic gas lighter. The High Court of Delhi held that the right of the plaintiff extend to the cognate classes of goods and accordingly, the defendant was restrained from using the trade mark MITASO in respect of Electronic gas lighter.

211. In this case, the plaintiff was the registered proprietor of trade mark TAJMAHAL in respect of Edible Oils etc. and the defendant started the same trade mark in respect of Oil cakes used for consumption by cattle. In Para 15 of the said case, the Hon'ble High Court stated that "It may be appreciated that the purchasers of the Oil cakes manufactured and sold by the defendant under the mark "Taj Mahal Khal", though not for human consumption but for the consumption of buffalows, cows etc. and the purchasers not themselves consuming the same, would be some human agency which has to purchase cattle feeds for the cattles. So it cannot be said in my view that the class of customers is different. In all such cases may it be for human consumption or for cattle consumption the customer would be persons or the human agency. In other words, the class of consumers may be different but not the class of In Para 20 "It makes no difference that the plaintiffs product is meant for human consumption whereas defendants product is for cattles feed meant for cows, buffalows etc, since the purchasers would be the human agency since even for cattles the purchasers are to be made by human being so it cannot be said that the class of customers is different and there will be no deception or confusion to the customers.

Daffodils Perfumes & Chemicals Indus, v. Daffodil Chemical P. Ltd., 1996 PTC 153 reads, "Where article or goods of trade are not identical and where the goods are cognate or allied, the chances of deception are more. The possibility of the unwary customers being deceived into purchasing the goods of the defendants as that of the plaintiffs on account of the confusion cannot be ruled out.

Shri Kuldip Singh trading as Saini Spares v. S.K. Auto Industries and Anr., 1993 PTC 228. In this case, the trade mark SAINI of the plaintiff was registered in respect of Hydraulic brake parts, oil seals, filters, helmets, switches, electric starters, head lights and parts and fitting thereof and on the other hand, the defendant commenced the business under the trade mark SAINI in respect of clutch system, clutch plates, cover assemblies, kit minor for use in the motor land vehicles. The Hon'ble High Court restrained the defendant while observing in para 9 "In the result, the plaintiff would be entitled to the injunction as even for an allied and cognate products as the purchaser may be led to believe the goods of the defendants to be that of the plaintiffs association/connection with the defendants goods." Binatone International Ltd. v. Sujan Kitchenware Appliances and Others, (Cases and material on trade mark at page 643). In this case, the Hon'ble High Court observed that "where a registered trade mark is adopted by another for goods of allied nature and there is likelihood of passing off, so as to bring bad name to the registered proprietor of the trade mark, the court may grant permanent injunction to restrain its use by the other persons." Borosil Glass Works Ltd. v. O.P. Batra, 1995 PTC 55 In the noted case, the Hon'ble Court while observing the fact that "A buyer not very much alert and intelligent would be guided by the word BOROSIL and what would attract him immediately is the word Borosil and eyes would be glued only to the word Borosil" restrained the defendant from using the trade mark BOROSIL in respect of Mixer cum Grinder, Juicer and Food Processors and Washing Machine upon filing the suit by the plaintiff who was the Registered proprietor of trade mark BOROSIL in respect of "Small domestic utensils and containers (not of precious metals or coated therewith) glass ware-porcelain and earthenware not included in other classes AND Paper and paper article AND Scientific, electrical apparatus and instruments, teaching apparatus And Surgical and Medical Instruments and apparatus AND Installation and parts thereof for lighting heating, steam generating and cooking." Com Products Refining Co. v. Shangrila Food Products Ltd., AIR 1960 SC 142 Para (11) : PTC (Suppl)(1) 13(SC) "The reputation with which we are concerned in the present case is the reputation of the trade mark and not that of the maker of the goods bearing that trade mark.

A trade mark may acquire a reputation in connection with the goods in respect of which it is used though a buyer may not know who the manufacture of the goods is.

Tube Investment of India Ltd. v. Trade Industries, 1997 PTC 655, In this case the Hon'ble Supreme Court of India restrained the respondents from using the trade mark "IT" in respect of bicycle saddle covers observing that these goods are similar to the goods Bicycle and parts of the petitioner.

269. In this case, the Hon'ble High Court of Bombay dismissed the appeal of the appellant and confirmed the order passed by the learned Deputy Registrar of Trade marks wherein the application was refused considering the fact that the applicant is misrepresenting the trade mark as Registered without securing registration in his favour and the learned Deputy Registrar of Trade Marks hold that the user of the mark was tainted with dishonest inspite the fact that the applicant admitted the same as honest mistake. The applicant was not considered for discretionary relief under Section 12(3) of the Act.

Raghubir Singh Jain v. Riazuddin Gyasuddin, 1996 Arb LR (2) 87 : 1994 PTC 143. In this case, the Hon'ble High Court of Delhi dismiss the ad interim order of injunction on account of mentioning of T.M. No. by the plaintiff to the trade mark which was merely an application for registration.

16. Sh. Sartaj Ali, Advocate representing the applicant stated that the application for registration of trade mark DUKE may be allowed in respect of goods amended as "Electrical Switches, Sockets, Tops and Holders", which are different from the goods of the opponent and also not being manufactured and sold by the opponent and also these goods are not covered in the registration certificate of the opponent issued by the Trade Marks Registry.

17. After hearing the counsel appearing on behalf of the parties, I have very carefully perused the material available on the records of these proceedings. First of all I take up the objection under Section 11(a) of the Act. The basic concept behind the provision of Section 11(a) of the Act is that the opponent trade mark is known in the minds of the purchasers that the subsequent use of the identical

and/or goods of same description, may put the purchasers in the state of wonder whether the later goods are coming from the trade source of the former.

The backbone of likelihood of confusion or deception, therefore, rests on the prior use and reputation of the opponents trade mark.

Thus, two main elements are required to be proved by the opponent for bringing the applicants registration within the scope of Section 11(a) are, firstly, the prior use of the opponents trade mark and secondly the use and reputation of the opponents trade mark in the market place.

18. The opponent is to prove these elements by way of clear and cogent evidence. In the instant case the opponent has filed the evidence by way of Affidavit dated 25.8.2000 in the name of Parminder Singh and at Para 4 of the affidavit, the opponent has stated that 50% sales belong to the trade mark DUKE. The opponent has also filed the Annexures being copies of bills for sale of goods prior in time to the alleged adoption by the applicant. In Para 9, the opponent has stated that the trade mark DUKE is exclusively associated with the opponent. In para 14, the opponent stated that the Hon'ble High Court of Delhi has granted injunction against the applicant from using the trade mark DUKE in respect of Electrical Accessories and the opponent has also filed one complaint under Section 81 of the Act against the applicant for misrepresenting the trade mark as Registered without having any registration in favour of the applicant. Apart from all these, the opponent filed one affidavit of his dealer stating the sale of goods of the opponent since the year 1984, Under these circumstances, it is in evidence that the opponent had been using the trade mark consisting of trade mark DUKE and has made substantial use as indicated by the figure of sales as stated in the affidavit.

19. Under these circumstances, the opponent is prior in adoption and use and has gained a substantial reputation by way of extensive use of the trade mark DUKE. That being so, the mark applied for which consists of trade mark DUKE is likely to deceive or cause confusion in the minds of the purchasers when used by the applicant in the normal manner during the course of their trade and in case, if the impugned mark is allowed to proceed to registration it will certainly cause

confusion and deception during the course of trade. It is well established that in an opposition proceedings, the onus is ultimately upon the applicants to establish that he is entitled to registration of the trade mark applied for. This also follows from the fact that there is no absolute right in any one to obtain the registration of a trade mark, where the objection to the application is based upon the alleged use and reputation of the opponents trade mark or on any other facts, the onus of establishing those facts lies upon the opponents. But once this initial onus is on the applicants to show that the use of his mark is not likely to deceive or cause confusion. In this instant matter before me this onus has been discharged by the opponents and this Tribunal is satisfied. Therefore, the objection of the opponents under Section 11(a) and under Section 11(e) of the Act is maintainable.

20. Now I take up the objection of the opponent under Section 12(1) of the Act. The opponent is the Registered proprietor of trade mark DUKE under No. 497344 in class 9 dated 5.9.1988 in respect of Adopter, Leads, Transformer, Battery Eliminators, Radio, T.V. Transistors, Two In One, Cassettes and parts thereof and the said registration is valid on the records, which I have verified from the copy of the Registration certificate and Renewal Certificates filed in the evidence. In view of the filing of Suit No. 1352 of 2002 in the Hon'ble High Court of Delhi in which the Hon'ble Court passed the ex parte ad interim order of injunction restraining the applicant, their servants, employees or agents, dealers, stockists, representatives and all other persons acting on their behalf from manufacturing, selling, offering for sale, advertising directly or indirectly dealing in Electrical Accessories or other allied or cognate goods under the trade mark DUKE or any other identical or deceptively similar trade mark. I fully agree with the order of the Hon'ble Court and in my opinion, the very adoption of the trade mark DUKE on the part of the applicant is dishonest, hence, the application of the applicant is liable to be rejected under Section 12(1) of the Act and I hold that the objection of the opponent is maintainable under the law.

21. Coming to the objection of the opponent under Section 9 of the Act.

The opponents objection is that the mark applied for is not distinctive, hence, violates the provisions of Section 9 of the Act. As per the provisions of Section 9 of

the Act, in general terms, distinctiveness of a trade mark must be that the trade mark distinguish the goods of its proprietor from the similar goods sold by other persons. In the instant case, it has already been held that the use of the mark applied for is likely to deceive or cause confusion, hence, obviously it cannot distinguish the applicants goods from that of the goods of the other proprietor to become a distinctive trade mark in terms of the provisions of Section 9 of the Act. In the instant case, the application was filed on 19.12.1991 claiming user of the mark as 1.4.1988 but in the Affidavit filed under Rule 54 as well as in the application under Order 39 Rule 4, CPC filed before the Hon'ble High Court of Delhi, the applicant admitted that he in business since the year 1989 and more in the evidence, the applicant has filed just three bills before the date of application for registration, hence I am unable to consider the registrability of the trade mark DUKE under Section 9 of the Act. The opponents objection on this count is therefore maintainable.

22. Coming to the opponents objection under Section 18(1) of the Act, the objection is that the applicant has no claim to the proprietorship of the mark applied for. It is well established that a person cannot be allowed to have the claim of proprietorship on a trade mark on which there is already an established right of property by some other person.

In the instant case, the opponent has already established the right of property on the trade mark DUKE and more particularly the applicant has been restrained from using the trade mark DUKE in respect of Electrical Accessories etc. by the Hon'ble High Court of Delhi. Thus, the applicant cannot be held to have any claim on mark DUKE in relation to the goods similar to the opponents. That being so, the opponents objections under Section 18(1) is maintainable.

23. Keeping in view of considering all the facts of the present opposition proceedings, the applicant has completely failed to prove his case and also the user of the mark is not honest and is tainted in view of the judgments referred by the opponents counsel and under no circumstances, the applicant is entitled for any benefit under any of the provisions of the law, hence, I do not feel any hesitation in allowing the notice of opposition, therefore, the above opposition

No.DEL-T-929/52949 is allowed and application No. 564078 in class 9 is refused registration. It is further ordered that the applicant shall pay a sum of Rs. 285/- as costs of these proceedings to the opponents.

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