

Rakesh Kumar Aggarwal Vs. Locks and Locking Devices (India)

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Court : Delhi

Decided On : Nov-08-1996

Reported in : 1997IAD(Delhi)573; 65(1997)DLT346; 1997(40)DRJ321

Judge : K. Ramamoorthy, J.

Acts : [Trade and Merchandise Marks Act, 1958](#); [Code of Civil Procedure \(CPC\), 1908](#) - Order 39, Rule 1

Appeal No. : Interim Application Nos. 4167 and 6010 of 1996 and Suit No. 1085 of 1996

Appellant : Rakesh Kumar Aggarwal

Respondent : Locks and Locking Devices (India)

Advocate for Def. : Mr. Parveen Anand

Advocate for Pet/Ap. : K.G. Bansal,; S.K. Bansal,; Parveen Anand and;

Judgement :

K. Ramamoorthy, J.

(1) The plaintiff has filed the suit claiming the propriety right in trade mark Vijayan for selling locks and handles. The defendant is also using the same trade mark Vijayan for selling the same product. thereforee, the plaintiff claiming to be the

proprietor of trade mark Vijayan in relation to the manufacturing and marketing of locks and handles has come forward with the suit for injunction on the ground of passing off. At this interlocutory stage having regard to the facts and circumstances of the case, I do not want to enter into the discussion at length because we can have the hang of the matter by recounting a few facts which will demonstrate the case of the plaintiff to be absolutely not true.

(2) In para 5 of the plaint the plaintiff states: That the trade mark Vijayan Label of the plaintiff is duly registered under No. 532484 in respect of All types of locks & handles in Class 6 of the Fourth Schedule of the [Trade and Merchandise Marks Act, 1958](#). He further stated that the said trade mark was advertised in trade marks Journal No. 1099 dated 16.03.,1995. The said trade mark is registered as from 2nd day of July 1990. By virtue of the said registration, the plaintiff has acquired exclusive rights to use the said trade mark in relation to the goods for which it is registered within the meaning of Section 28 of the Act and it is, therefore, not possible for any one else to make use of the same trade mark in respect of the same or same description of goods without the leave and license of the plaintiff.

(3) Mr. Parveen Anand, learned counsel for the defendant submitted that the suit is founded on fraud; two registrations are claimed by the plaintiff, one is cancelled and other is on the way of being cancelled and for the purpose of establishing a case of passing off, the plaintiff has not produced sufficient materials. In the Trade Marks Journal appearing the June 16, 1996 at page 522 the following advertisement is made: Re-advertisement under Section 20(2) previous advertisement as 536465 (1099) Vi and mark is cancelled. Advertised before acceptance under Section 20(1) proviso 536465 - September 6, 1990, Rakesh Kumar Aggarwal trading as R.M.V Hardware & Electricals, 13/303, Mamun Bhanja Street, Aligarh 202001. (U.P) Manufacturers and Merchants, User claimed since the year 1981. To be associated with No. 532484 (1099) Vi (BOMBAY). All types of locks and handles in class 6. Registration of this trade mark shall give to right to the exclusive use of the word Real appearing on the label. It may be noticed that the trade mark is associated with No. 532484. The learned counsel for the defendant produced a letter dated 03.10.1996 from the Assistant Registrar of Trade Marks, Government of India, Trade Marks Registry, Central Building, M.K.

Road, Mumbai - 400 020 in the following terms: Sub : Registered Trade Mark No. 532484 in Class 6. With reference to the above Registered Trade Mark, the Registrar of Trade Marks proposes to rectify the Register under Section 56(4) of the [Trade and Merchandise Marks Act, 1958](#) by removing the mark now on the Register in respect of the above trade mark on the following grounds:- 1. The Trade Mark under No. 532484 in Class 6 was not distinguishably advertised in Trade Marks Journal No. 1099 at page 1648 dated 16.03.1995. 2. In view of this, the aforesaid mark would not proceed to registration in terms of Section 23 of the Act and therefore the entry made in the Register in respect of the above mark is without sufficient cause and wrongly remaining in the Register by an error. Notice is accordingly hereby given to you under Section 56(4) of the Act as to why the impugned Trade Mark should not be removed from the Register forthwith. You should submit your reply to the aforesaid notice to the under signed in the form of a statement within one month from the date of this notice, setting out fully the facts upon which you rely to meet the grounds stated in the notice or alternatively file request for a hearing in respect of these proceedings, if no reply of this notice is received within time the application to be proceeded as per the provisions of the Act and Rules. This clearly shows the trade mark 532484 is on the way of being cancelled.

(4) Learned counsel for the plaintiff Mr. K.G. Bansal, stated that no doubt that such letter has been received and that cannot be taken into account for the purpose of considering the interlocutory application because the plaintiff will give Explanation to the show cause notice and it has to be considered on its merits by the Registrar therefore, the claim of the plaintiff on the ground of registration prima facie is not sustainable.

(5) Then comes to the question of passing off. Though in the advertisement which I have referred to, reference is made to the user of the plaintiff from 1981. No such claim is made in the plaint and reference is made to the user in the year 1946 which has not been substantiated by producing any material. In Para 4 of the plaint it is stated that the plaintiff adopted the trade mark Vijayan from 1946 but it is not explained as to why before the user the plaintiff represented the user to be from the year 1981.

(6) The defendant filed is No.6010/96 under Order 39 Rule 4 CPC. It is stated in the petition that the defendant is a prior user and prior applicant for registration and, therefore, a genuine proprietor of the trade mark VIJAYAN. The defendant had applied for registration in the year 1984 and the same was numbered as 424147 in class 6 as of 10th July 1984. The plaintiff's documents show that he filed an application for the identical mark which was numbered as 532484 in class 6 as from 2nd July 1990. It is no doubt true that the plaintiff's application was considered and the mark was registered subsequently. The defendant also pointed out that the defendant's application was advertised in the Trade Mark Journal 1002 dated 01.03.1991 whereas the application of the plaintiff was advertised in the Trade Marks Journal No 1099 dated 16th March 1995.

(7) In para D of the main para (2), the defendant had stated thus: The fraud played by the plaintiff on the public and members of the trade is apparent from the manner in which its impugned mark under No. 532484 in class 6 was advertised in Trade Marks Journal No. 1099 dated 16th March, 1995, an extract whereof is filed herein. The advertisement of the plaintiff's said application appeared without any sign or trace of the word Vijayan, simply as a black coloured rhombus. In the manner in which the mark was advertised, the defendant did not have an opportunity to oppose the trademark Vijayan since that was not the mark of the plaintiff nor the mark advertised in Trade Mark Journal No. 1099 in class 6 as application No. 532484. The mark as advertised was unknown, and bears no resemblance, except in outline, to trademark registration No. 532,484 in class 6. As a result, the defendant has come to know of the false claims staked by the plaintiff to the impugned mark through these proceedings wherein the plaintiff has disclosed its so-called trademark registration number. The attention of this Hon'ble Court is invited to the fact that the very purpose of advertisement of an application in the Trade Mark Journal, is to give an opportunity to parties who may be potentially aggrieved by the registration of the mark in the applicant's favor to file their objections thereto in the form of an opposition.

(8) In para E, the defendant has stated as to how the plaintiff had acted in trying to get the registration of the mark. In para E it is stated thus: In consequence of the above disclosed facts, the defendant submits that the plaintiff can claim to have

used either of two marks, namely: a) the one advertised in Trade Mark Journal No. 1099 dated 16th March, 1995 at page 1648: or b) the one shown in the photocopy of the certificate for use in legal proceedings under No. 532,484 at page 28 of its documents. In the first case, the plaintiff's application, as advertised, is a blank rhombus devoid of any word mark which would not confer any right at the registration stage in respect of the word VIJAYAN. Hence, assuming without admitting that the said mark was registered, it would not entitle the plaintiff to restrain use of the trademark Vijayan by the defendant. If the plaintiff's case is the second one, the registration - as obtained by the plaintiff pertains to a trademark which has not been advertised as per the requirements of Section 20 of the [Trade and Merchandise Marks Act, 1958](#), read with Rule 46 of the Trade and Merchandise Marks Rules, 1959. Hence, again, the mark is not validly registered. Even otherwise, the Trade Marks Registry was dutybound not to process the advertised mark. There has, therefore, been an inexplicable lapse on the part of the Registry due to which the certificate of registration granted in the plaintiff's favor cannot be deemed to be even prima facie proof of the validity of the impugned mark. The inescapable consequence of the manner in which the plaintiff's mark was advertised is that the registration granted to the plaintiff thereupon is void ab initio and a nullity, and the registration cannot withstand the test of validity for even a minute because there is an irreconcilable difference between the trademark of the plaintiff which was advertised in the Trade Mark Journal and that which is shown in its certificate for legal proceedings filed at page 28 of its documents. The defendant submits that this reason alone is sufficient to justify an immediate suspension and/or vacation of the injunction order dated 7th May 1996 granted against the defendant. The defendant had stated that it has been using the trade mark Vijayan in respect of locks and locking devices ever since the year 1960. The defendant has also given the sales figures. The defendant has also stated that the plaintiff has no figure relating to the advertisement made by the plaintiff. It is also stated by the defendant that it issued a notice dated 07.05.1996 to the plaintiff to suspend the business.

(9) The plaintiff has filed the reply to the application under Order 39 Rule 4 Civil Procedure Code by the defendant and has filed certain annexures. Annexure A relates to the Sales Tax Registration of the defendant, and according to the

plaintiff, as per this document the defendant has started the business only in 1993. Annexure B is the Carton wherein the trade mark is printed. Annexure C is application on Form TM-16 alleged to have been submitted by the plaintiff to the Registrar wherein the date of user should read as since 1946 and as per the assessment made in 1988. Annexure -D is again a communication from the Registrar of trade mark to the plaintiff about the advertisement to be made in the Journal. Annexure E is stated to be a deed of assignment of trade mark made on 02.11.1985 by one Babu Lal Agarwal, Proprietor M/s Agarwal Metal Foundry. It is not stated as to why this document was not filed Along with the plaint. The fact whether there was any assignment or not now claimed in reply can be taken in to account only at the time of trial of the case.

(10) The principle of law relating to passing off is well settled and there are in numberable decisions expounding the law on the point. Number of authorities were cited by the learned counsel for the parties and I do not want to deal with them because it will be only a unnecessary exercise when I had to consider the facts of this case in the light of the principles, as I said, which are very clear.

(11) The plaintiff has not at all on the facts of this case, established his prior user and there has been an attempt on the part of the plaintiff to suppress the facts and project the facts which are not true. For the purpose of the application for injunction, prima facie the documents filed by the plaintiff do not establish the case of the plaintiff for the grant of injunction. thereforee, I need not dwell at length on the balance of convience. The litigant who has come forward with a false case is not entitled to any consideration. Accordingly, the is No. 4167/96 under Order 39 Rules 1 and 2 filed by the plaintiff for injunction is dismissed. is No. 6010/96 under Order 39 Rule 4 filed by the defendant for vacation of stay is allowed. Post the matter for further proceedings on 17.12.1996.

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