

**M/S Jain Electronics Vs. Cobra Cables P. Ltd. and ors.**

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**SooperKanoon Citation :** [sooperkanoon.com/906887](http://sooperkanoon.com/906887)

**Court :** Delhi

**Decided On :** Nov-30-2010

**Judge :** S. Muralidhar, J.

**Appeal No. :** W.P.(C) No. 12694 of 2005

**Appellant :** M/S Jain Electronics

**Respondent :** Cobra Cables P. Ltd. and ors.

**Advocate for Def. :** Mr. S.K. Bansal; Mr. Akshay Srivastava, Advs.

**Advocate for Pet/Ap. :** Mr. A.K. Goel; Mr. Praveen Kumar, Advs.

**Judgement :**

1. The Petitioner challenges an order dated 10th March 2005 passed by the Intellectual Property Appellate Board (IPAB) dismissing the Petitioners appeal against an order dated 17th May 1995 passed by the Deputy Registrar of Trade Marks rejecting the Petitioners application No. 481358 in Class 9 for registration of the trade mark Cobra.

2. The Petitioner filed the aforementioned application in respect of voltage stabilizer and parts and fittings thereof included in Class 9 of the Trade and Merchandise Marks Act, 1958 (TM Act, 1958). The Petitioners application dated 19th November 1987 was advertised in the trade marks journal dated 1st February 1992.

3. In response to the aforementioned application Cobra Cables Pvt. Ltd., Respondent No.1, herein filed a notice of opposition on 16th March 1992. The case of Respondent No. 1 was that they were engaged in the business of manufacturing electrical apparatus and instruments, electric cables and electric conductors under the trade mark Cobra which was part and parcel of their trading style. The mark Cobra had been registered in their favour under registration No. 369325 and was being renewed from time-to-time. The said trade mark Cobra was originally owned by M/s. M.P. Electric Company and was transferred on 5th December 1980 to M/s Cobra Cables (India) who in turn assigned the mark to Respondent No. 1 by an instrument of assignment dated 15th January 1991. The objection of Respondent No.1 which was accepted by the Deputy Registrar, was that mark Cobra applied for by the Petitioner, being identical to the registered trade mark of Respondent No.1 would cause confusion and deception and was, therefore, not registrable under Sections 9, 11(a), 12(1) and 18(1) of the TM Act, 1958.

4. The Petitioner claimed that it has been using the mark since 1978 but failed to produce any evidence to substantiate the said claim. Respondent No.1 filed a communication before the Deputy Registrar that they did not wish to file any evidence under Rule 53(1) of the Trade and Merchandise Marks Rules, 1959 (TMM Rules, 1959) and wished to only rely upon the facts and circumstances averred in the notice of the opposition. On its part, the Petitioner relied upon the W.P.(C) No. 12694/2005 Page 2 of 7 statement of annual sales from the year 1978-79 to 1992-93 and certain unattested photocopies of bills.

5. The Deputy Registrar allowed the opposition filed by Respondent No. 1 and refused to register trade mark Cobra in favour of the Petitioner. Apart from holding that the Petitioner had not produced any affidavit of user since 1978, the Deputy Registrar held that the mark Cobra was not distinctive of the goods. Further, because of non-use of the mark, it was not registrable under Section 12(3) of the TM Act, 1958. It was also held that the goods of the Petitioner and Respondent No.1 were of same description falling in Class 9. The Deputy Registrar held that with the mark of Respondent No. 1 being identical and being registered in the forum, acceptance of the application of the Petitioner for the same mark would

cause confusion and, therefore, could not be allowed. It was held that triple identity test, i.e., the mark being identical, the goods being of same description and the area of sale or the sales channel being the same stood satisfied.

6. Before the IPAB, the arguments already advanced before the Deputy Registrar were reiterated by the parties. As regards the finding on triple identity, the IPAB observed as under:

"8. So far as this finding is concerned, there is absolute no dispute. The main objection on the part of the learned counsel for the appellant is that the first respondent is not using the mark, whereas, the appellant had let in evidence in respect of the use of the impugned mark and hence, there cannot be any objection under Section 11(a) of the Act. Such a plea was W.P.(C) No. 12694/2005 Page 3 of 7 raised on the assumption that the appellant is regularly using the impugned mark COBRA for Voltage Stabilizers and the documentary evidence produced by the appellant is more than sufficient to establish such a plea. In such circumstances, we have to consider whether the evidence produced by the appellant establishes their use of mark COBRA. We have perused the sales statistics, Annexure-A to the affidavit of Shri N.K. Jain filed as evidence in support of application. It is a statement of the appellant without any reference to any of the returns submitted to the statutory authorities and not even authenticated by the Auditor. Hence, the self serving documents cannot be taken as valid evidence. The copies invoices and the bills produced by the appellant at Annexure- D3 to D75 do not reveal that the appellant had sold the Voltage Stabilizers under the brand name COBRA. Some of the printed Bills/Invoices bear the name of the appellant Jain Electronics. In those Cash/Credit memos, the monogram of Cobra along with the word COBRA is printed. What is significance attached to the monogram of the cobra along with the words is not clear. In the description of goods sold by the appellant, it is simple mentioned Automatic Voltage Stabilizer without any reference to the trade mark. In such circumstances, it is very difficult for us to accept the plea of the appellant that they used the impugned trade mark in relation to the Voltage Stabilizers. Unless the trade mark with the description of goods or the goods identified by the trade mark is mentioned in the bills or invoices, the relation between the two cannot be inferred or cannot be said to have

been established."

On the above reasoning, the IPAB rejected the Petitioners appeal.

7. Appearing for the Petitioner Mr. A.K. Goel, learned counsel reiterated the submissions advanced both before the Deputy Registrar W.P.(C) No. 12694/2005 Page 4 of 7 and the IPAB. Mr. S.K. Bansal, learned counsel appearing for Respondent No. 1 also reiterated the submissions advanced before the two authorities.

8. The submissions of learned counsel for the Petitioner was that Respondent No.1 not having led any evidence to establish its case that it had the proprietorship of the marks even before 1978, the case of prior user since that date ought to have been accepted. This submission overlooks the basic rule that the Petitioner had to make good its case of prior user since 1978. The Deputy Registrar as well as the IPAB concurrently held that the Petitioner failed to do so. Before this Court, the learned counsel referred to the duplicate copies of certain invoices which did not bear the mark Cobra but on which a handwritten date of 1978 figured. This certainly cannot be considered satisfactory evidence of user since 1978. Further, even the invoices produced by the Petitioner are since 1984 onwards. Many of them do not show the sale of voltage stabilizers with the name of Cobra, although the mark figures in the top position of the invoices. Learned counsel for Respondent No.1 is right in pointing out that the user had to be in relation to the goods and not merely the invoices.

9. On the evidence produced by the Petitioner the concurrent finding of the Deputy Registrar as well as the IPAB is that the user since 1978 of the mark in relation to goods produced and sold by the Petitioner has not been established. This Court is not persuaded to come to a different conclusion.

10. Extensive case laws were relied upon by the learned counsel for the Petitioner to urge that the Petitioner could avail of defence of concurrent user of the mark even if not a prior user. It was also submitted that Respondent No.1 not having sought any infringement action against the Petitioner must be held to have acquiesced in the use of the mark Cobra by the Petitioner.

11. With there being a registered trade mark Cobra in the name of Respondent No. 1, which has not been opposed by the Petitioner till date, there can be no doubt that grant of registration in respect of an identical mark in favour of the Petitioner would cause deception and confusion. The mark has been registered in favour of Respondent No. 1 in respect of goods which included electrical apparatus. The Petitioner is seeking registration of an identical mark in respect of voltage stabilizers. It was sought to be urged that Respondent No. 1s goods were electric cables whereas the Petitioners were voltage stabilizers and therefore the goods were different. There can be no doubt that the electric cables are used in voltage stabilizers as well. The trade channel is essentially the same. The goods are available usually in the same place as well. Use of an identical mark in respect of the two goods is bound to cause deception and confusion in the market. The Deputy Registrar and the IPAB concurrently concluded that the triple identity test stood satisfied in the present case, particularly since the description of the goods is the same, the area of the sale and the trade channel are the same. This Court concurs with the said view. The registration in favour of Respondent No. 1 dates back to 1980, whereas the W.P.(C) No. 12694/2005 Page 6 of 7 Petitioners invoices, all of which do not show use of the mark in relation to goods, is only since 1984. In the circumstances, the plea of concurrent user is not available to be taken by the Petitioner.

12. This Court finds that no ground is made out to interfere with the impugned order dated 10th March 2005 of the IPAB. The petition is dismissed.

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