

Palta Engineering Works Vs Dewan Rubber Industries And Ors

Court: Intellectual Property Appellate Board, Chennai Circuit Bench At New Delhi

Date of Decision: Feb. 9, 2005

Acts Referred: Trade And Merchandise Marks Act, 1958 " Section 9, 11(a), 11(e), 12(1), 18(1), 18(4), 46, 56
Trade Marks Act, 1999 " Section 100

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

Bench: Division Bench

Advocate: V.P. Ghiraiya

Final Decision: Dismissed

Judgement

S. Jagadeesan, J

1 . The petitioner filed this petition under section 56 and 46 of the Trade and Merchandise Marks Act, 1958 for cancellation of the registered

trademark No. 326169 in Class 12 in the name of the respondents 1 and 2. Originally the petition was filed in the High Court of Delhi in C.O. No. 15

of 1993 and the same stood transferred to this Appellate Board by virtue of section 100 of the Trade Marks Act, 1999. The petition was heard on

25.1.2005 during our sitting at New Delhi.

2. It is the case of the petitioner that they were carrying on business of manufacture and sale of cycle tubes and tyres and quality rubber goods since

1973 adopting the trademark 'USHA' in respect of cycle tubes. By virtue of the user, the petitioner became the proprietor of the said mark and the

same is used in the course of the trade and the mark has become distinctive to identify and recognise with goods exclusively belonging to the

petitioner. The second respondent herein filed a suit No. 1409 of 1993 against the petitioner for infringement of trademark 'USHA' and passing off

etc. on the basis of the registration of the mark No. 326169 in class 12 in respect of tyres and tubes for cycles, in their favour. The second respondent

also obtained an interim injunction restraining the petitioner from using the same mark and the order of injunction is still in force. The word 'USHA' is a

well-known female personal name among the Hindus and as such, the respondents 1 and 2 cannot claim any exclusive right over the trade mark

'USHA'. The first and second respondents were not the proprietors of the trademark 'USHA' on the date when the first respondent filed the

application for registration as the petitioner was already using the said trademark in respect of cycle tubes. The respondents 1 and 2 had obtained the

registration by making a false statement. Though they claim the user since 1974, they have totally failed to produce any evidence to substantiate their

claim. The first respondent did not even file the affidavit of user of the said trademark 'USHA'. The first respondent assigned the impugned trademark

in favour of the second respondent. The Assistant Registrar has allowed the request on Form TM-24 without any documentary evidence and as such,

the assignment pleaded by the second respondent is illegal. The registration in favour of the first and second respondents is in contravention of the

provisions of section 9, 11(a), 11(e), 12(1), 18(1) and 18(4) of the Trade and Merchandise Marks Act, 1958 and as such, the registered mark of the

second respondent has to be removed from the register of the trademark.

3 . The respondents 1 and 2 filed a reply stating that they filed a suit No. 1409 of 1993 in the Delhi High Court and obtained an order of injunction

restraining the petitioner from using the trademark 'USHA' as early as 7.7.1993. Immediately thereafter, the petitioner filed this petition on 3.8.1993 as

a counter blast to the suit filed by the respondents 1 and 2. It is also stated that the petitioners are neither owners nor proprietors of the impugned

mark and the petitioners pirated the same during the first week of July 1993 with malafide intention. The injunction granted in favour of the

respondents 1 and 2 is still in force and the respondents are restrained from using the said mark. The respondents are using the mark since 1974 and

the first respondent assigned the mark in favour of the second respondent as early as 2.1.1989. Since the registration in favour of the respondents is in

conformity with the provisions of Trade and Merchandise Marks Act, 1958, the petitioner cannot seek a rectification to have the benefit of the use of

the said mark. Hence the petition is liable to be dismissed. The petitioner filed a rejoinder mainly controverting the statements in the reply and also

further stated that the documents produced by the petitioner establish that the petitioner is the prior user of the mark since 1973. Admittedly, when the

first respondent has claimed the user since 1974, they become the later user adopting the petitioner's mark with malafide intention and got the

registration of the same by filing an application in 1977. As admittedly the respondents being subsequent user, they are not entitled for registration of

the same and consequently the registration in their favour is liable to be removed.

4 . Shri V.P. Ghiraiya, learned counsel appeared on behalf of the petitioner. Though the notice was served on the respondents, there was no

representation on their behalf.

5. The learned counsel for the petitioner contented that the documents produced by the petitioners established their earlier use of the mark 'USHA'

since 1973. The respondents admittedly claimed user from 1974 and as such, they are the subsequent users and adopters of the petitioner's mark.

When the documents prove that the claim of the respondents that the petitioners have infringed their registered mark in 1993 is patently a lie, their

entire case built up on such plea has to be rejected. He further contented that the respondents 1 and 2 are not in the market and they filed a letter to

that effect before the share market authorities and consequently the impugned mark is liable to be removed from the register of trademarks by way of

rectification.

6 . We carefully considered the above contentions of the learned counsel for the petitioner. At the outset, we are not inclined to take the statement of

the learned counsel for the petitioner that the respondents are not in the market especially in the absence of any evidence or record to establish the

same. So it is necessary for us to consider the matter on merits.

7. The petitioner has filed this petition for rectification mainly on the ground that the registration of the impugned mark in favour of the respondents is

in contravention of section 9, 11(a), 11(e), 12(1) and 18(1) of the said Act claiming to be the prior user. We perused the records. Of course the

evidence produced by the petitioner reveals that in the year 1973, the petitioner was using the mark 'USHA' for cycle tubes. One or two invoices refer

to the mark 'USHA' and some of the invoices do not refer the mark 'USHA'. In the year 1974, the invoices of the petitioner refer to the mark

'SUPER & USHA' as well as 'VESPA & USHA' (page 525 of the Exhibit File). Thereafter, til 1979, the petitioner seems to have used the mark

'USHA'. Again in 1980, the petitioner has used the mark as 'PALTA USHA' (page 532) as well as 'SUPER & USHA' The same was continued till

1984. In the Invoice No. 262 dated 31.8.1984 (page 543), there is no reference to the mark. The Invoice No. 712 dated 18.3.1986 (page 544) refers

the mark 'PALTA' alone. The entire documents reveals that the petitioner was using the mark 'USHA' for some time and thereafter, the same has

been combined with the word 'PALTA' or 'SUPER'. Some of the invoices also reveal that the petitioner was using the mark 'SUPER' exclusively and

'PALTA' and 'USHA' as combined mark. So it is clear from the documentary evidences that the petitioner though initially started the use of the mark

'USHA' for some time, thereafter, the same was not independently used by the petitioner.

8 . On the other hand, the respondents have claimed user since 1976 as per the advertisements notified in the Trade Marks Journal and applied for

registration in 1977. The certificate was issued in 1984. The fact remains that the petitioner did not choose to oppose the same and also did not opt for

the registration of the same. By virtue of the registration in the year 1984, with effect from 1977, the date of application, the respondents have become

the proprietors of the mark. As already stated, the documentary evidence produced by the petitioner did not reveal that since 1977 the petitioner was

using the mark 'USHA' in respect of cycle tubes independently. It has always been used with the combined word 'SUPER' or 'PALTA'.

9 . The respondents 1 and 2 obtained the registration in the year 1984, with effect from 1977. The petitioner has come forward with the application for

rectification only in 1993 immediately after the receipt of the injunction order in the suit filed by the respondents 1 and 2. Hence there is no doubt that

the present proceedings had been initiated by the petitioner only as a counter blast to the civil suit filed by the respondents. In the petition, the petitioner

did not state anywhere that they have no knowledge about the use of the mark 'USHA' by the respondents either since 1974 or after the registration

of the same in the year 1984.

10. From July 1993, the petitioner had been enjoined by way of order of the civil court from using the mark 'USHA'. It is more than eleven years

elapsed after the preventive order. It is not the case of the petitioner that they have taken any effective step for vacation of the injunction order. The

fact remains that the petitioner had been effectively prevented from using the mark 'USHA' for more than eleven years and the petitioner is using the

impugned trademark since 1974, for almost more than three decades.

11. As the petitioner is not in any way prejudiced since he has all along been using the word 'USHA' as a mark in combination with the words

'SUPER' or 'PALTA' as a combined mark, we are of the view that there is absolutely no need to grant relief sought for by the petitioner. Accordingly,

the petition is dismissed as devoid of any merits. There is no order for costs.