

**(2021) 02 IPAB CK 0009**

**Intellectual Property Appellate Board, Chennai Circuit Bench At Kolkata**

**Case No:** Original Application No. 40 Of 2018/TM/KOL

Mutha Brothers

APPELLANT

Vs

Arjun Singh Rajguru, Trading As

RESPONDENT

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**Date of Decision:** Feb. 9, 2021

**Acts Referred:**

- Trade Marks Act, 1999 - Section 8, 11, 9(1)(a), 18, 32, 47, 47(1)(a), 47(1)(b), 57, 57(2)
- Code Of Civil Procedure, 1908 - Order 20 Rule 5

**Hon'ble Judges:** Lakshmidevi Somanath, Technical Member; Makyam Vijay Kumar, Technical Member; Manmohan Singh, J

**Bench:** Full Bench

**Advocate:** Shuvansish Sengupta

**Final Decision:** Allowed

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**Judgement**

Impugned mark, REAL NEW RADIUM (Label)

Registration No., 3542551 in class 16

Date of Application, 05/05/2017

Goods, "Pen, Ball pen, sketch pens marker

pens, refills included in class 16

Usage date, Since 01/04/2005

Advertisement details, Journal No. 1829-0 dtd. 25/12/2017

Jurisdiction, "Trade Mark Registry, Calcutta.

Respondent No. 1 to adopt the trademark "RADIUM" and "SPEED RADIUM" in the form of identical and deceptively similar label which is,

the impugned trademark herein. In around April, 2017, the Applicant came to know that the Respondent No.1 had introduced his products in the",  
market manufactured under the impugned label, which is inter-alia identical and deceptively similar to that of the Applicant. Copies of the Respondent",  
No.1 wrappers and packaging bearing the impugned trademark were placed before us.,

13. The Respondent No.1 has adopted the impugned trademark which is identical and deceptively similar to that of the Applicant in art work, words",  
layout, pattern, get up, special font, colour scheme, design placement and colour combination. There is a high chance of confusion among the",  
consumers when they are confronted with the products both the Applicant's and the Respondent No.1. The average consumers will definitely,  
presume that the goods of the Respondent No.1 are originated from the Applicant. This has caused immense monetary loss to the Applicant. Hence,  
the present Rectification was filed before us by the Applicant.,

#### ARGUMENTS ADVANCED BY THE APPLICANT,

14. Mr. Shuvansish Sengupta, learned counsel for the Applicant has argued that the Respondent No.1 herein had unlawfully adopted the",

Applicant's trademark and fraudulently obtained the registration on both the trademarks, that of the Applicant and the Respondent No.1 were",

compared and placed before us. Learned counsel for the Applicant has argued that,

a) In both the packets, the word "New Radium" is written on the face of the packet and/or wrapper vertically in silver and black colours with",

white background. The word "New" is written below the word "Radium" horizontally in both the packets.,

b) In the right hand side top, the Applicant has written "Speed Ball Pens" and the respondent/registered proprietor has written "Real Ball",

"Pens" in red, white and black colours.",

c) In both the packets, there are two transparent spares through which the contents of the boxes (pens packed inside) can be seen.",

d) In the middle portion of the packet, a circular logo is made with the words "All New Improved Radium". Inside the said logo, there is a picture",

of lion in black and white colours and written "Made In India" in the centre.,

e) In the right hand side bottom of the packets, "Two Years Shelf Life Link" with five coloured circles with an identical colour scheme and",  
arrangement are printed.,

15. The learned Counsel for the Applicant further argued that the Applicant is prior in use to that of Respondent No.1 and he is also prior Applicant,

before the Trade Mark Registry due to his multiple registrations for the mark "RADIUM" and "SPEED RADIUM" and the label. Learned,

Counsel for the Applicant further submits that they had filed a suit CS No.265 of 2017 before the Hon<sup>ble</sup> High Court of Calcutta praying for a,

decree of permanent injunction along with other consequential reliefs. However, in the first week of August, 2018 while moving the Application for",

vacation of interim order, the Respondent No.1 stated before the Hon<sup>ble</sup> High Court that the impugned mark had been registered. The Applicant",

obtained knowledge of the same and took steps to file the present Rectification Petition before us.,

COMPARISON OF THE MARKS JUDGEMENTS RELIED UPON BY THE APPLICANT,

16. Computer & Sciences Corporation v. R.Thangaraj, ORA/86/2006/TM/CHN, decided on 28.08.2007",

Registration of a trade mark has to be refused under Section 18 of Trade mark Act, if a party",

establishes that it is the prior adopter and user of a similar trademark.""  
"Registration of a trade mark has to be refused under",

Section 9(1)(a) of Trade mark Act if the trade mark in question has not acquired a distinctive character of its own. """,

Registration of a trademark can be cancelled if said trade mark is deceptively similar to another trade mark and there is likelihood of",

confusion among the public about the same."",

17. Creative Travel Private Limited Vs. Creative Tours and Travels (I) Pvt. Ltd. and Ors., Miscellaneous Petition Nos. 232/2012 & 233/2012 in",

ORA/56/2007/TM/MUM and ORA/56/2007/TM/MUM Decided On: 26.11.2012,

When a mark is likely to cause confusion, then the mark is an entry made without sufficient cause and is wrongly remaining on the Register",

and therefore the mark deserves to be expunged."",

18. Delhi Public School Society Vs. Amir Education Society ORA/199/2008/TM/DEL  
Decided On: 16.07.2018 From the above gambit of the,

matter, it appears to us that:- a) The respondent no. 1 has failed to file evidence of continuous use bearing the mark in question. b) Two",

marks are the parties almost same. c) The adoption and use of the mark/name was tainted and dishonest. d) The registration was obtained,

contrary to section 8, 11 and 18 of the Act. e) The respondent no. 1 has appropriated the entire mark and name from the applicant. Even",

adoption of the word MODERN which is prefix of the mark is also amount to 07-01-2021 (Page 16 of 17) www.manupatra.com Ranjan,

Bachawat fraud as in India Modern School is known for the same services. 42. We are of considered opinion that if a party deliberately,

and intentionally adopts and uses the same mark of another party knowingly that it belongs to other party, the filing of applications for",

same/similar mark amount to fraud, the said party cannot claim the ownership under any circumstances as stolen mark will remain stolen",

property of original/genuine party.,

19. Haldiram (India) Pvt. Ltd. and Ors. Vs. The Registrar of Trade Marks and Ors., M.P. No. 147 of 2012 and R.P. No. 1 of 2013 in",

ORA/14/2004/TM/KOL and ORA/14/2004/TM/KOL Decided On: 26.04.2013,

FINDINGS,

Intention of the Respondent,

20. Counsel for the Applicant has appraised us of the fact that the Respondent No. 1 is doing business in the same area as that of the Applicant and is,

very well aware of the Applicant's business and its trade marks. The impugned mark is nearly identical to that of the Applicant, it is evident that",

the same has been adopted deliberately and with a clear malafide intention to ride on and usurp the goodwill earned by the Applicant in the industry.,

The mark is being used by the Respondent No.1 on similar and allied goods in a manner so as to reveal fraudulent intent on the part of the Respondent,

No.1.,

21. In Midas Hygiene vs. Sudhir Bhatia & Others (2004 )3 SCC 90, the Honable Supreme Court observed that:",

6. In this case it is an admitted position that the Respondents used to work with the Appellants. The advertisements which had been issued by the, Appellants in the year 1991 show that at least from that year they were using the Mark LAXMAN REKHA on their products. Not only that but the, Appellants have had a Copyright in the Marks KRAZY LINES and LAXMAN REKHA with effect from 19th of November, 1991. The copyright", had been renewed on 23rd of April, 1999. A glance at the cartons used by both the parties shows that in 1992 when the Respondent first started he", used the mark LAXMAN REKHA in cartons containing colours red, white and blue. No explanation could be given as to why that carton had to be", changed to look almost identical to that of the Appellant at a subsequent stage. This prima facie indicates the dishonest intention to pass off his goods, as those of the Appellants (emphasis supplied),.

22. We had examined the impugned Trademark New RADIUM and find the impugned mark is merely identical to that of the Applicant's mark, "RADIUM" and "SPEED RADIUM" and the label. The identical nature of both the trademarks be it the colour scheme, lay out, words", used, pattern, colour combination etc. can only lead to the conclusion that the mark was used malafidely.",

23. In Madhuban Holiday INN vs. Holiday Inn 2002 SCC Online Del 864, it was held that:",

50. The respondent company Holiday Inn Inc is a registered company in the United States of America. The company has acquired immense global, reputation. It has a large number of hotels in various parts of the world. The adoption of the words ""Holiday Inn"" by the appellants from the very", inception was based on the doctrine of bad faith. The appellants were fully aware of the considerable transborder reputation of the respondent and, they wanted to derive pecuniary benefits from their reputation, the question that arises is that out of the millions of words of English language, why did", the appellants adopt only the words ""Holiday Inn"", The answer has to be that the appellants deliberately adopted these words to ride on the immense", global reputation of the respondent. The intention of the appellants becomes absolutely clear after seeing the computer print out of the appellants and,

respondents pages taken from the internet under the heading ""Holiday Inn, Delhi"". These documents were placed before us by the respondent. Under",  
the heading ""Holiday Inn"" in the internet information about the respondent's hotel world wide is given. Similarly the appellants, Kapoor Holiday Inn,",  
also has a web site in the Internet under the heading ""Kapoor Holiday Inn"" giving its tariff, location etc and advertising itself as the ""most distinguished",  
address in New Delhi"". By giving all this description the appellants in fact wanted to ride on the reputation of the respondent and derive pecuniary",  
benefit from it. As observed in Simatul Chemicals Industries Pvt. Ltd. (supra) the test to be applied is the test of an average person with imperfect,  
recollection. It would not be right to apply the test of a man of extraordinary memory who remembers the spelling of the name of each company or a,  
person who jots down meticulously and methodically the names of companies in his diary and brings out his diary and contemplates whether he is,  
dealing with one company or the other. The average person is likely to be deceived by or confused with the use of the words ""Holiday Inn"" by the",  
appellants.,

51. In our considered opinion, the adoption of the words ""Holiday Inn"" by the appellants is ex facie fraudulent and mala fide from the very inception.",

The words ""Holiday Inn"" have been adopted by the appellant to ride on the global reputation of the respondent. The appellant was actuated by bad",  
faith and dishonest motive. (emphasis supplied) In the facts and circumstances, the learned Single Judge was fully justified in granting the injunction",  
and decreeing the suits in order to protect the commercial goodwill and to ensure that the global business reputation of the respondent is not exploited,  
by the appellants In a clandestine manner.,

24. Counsel for the Applicant has appraised us of the fact that the Respondent No. 1 is doing business in the same area as that of the Applicant and is,  
very well aware of the Applicant's business and its trade marks. The impugned mark is nearly identical to that of the Applicant, it is evident that",

the same has been adopted deliberately and with a clear malafide intention to ride on and usurp the goodwill earned by the Applicant in the industry.,

The mark is being used by the Respondent No.1 on similar and allied goods in a manner so as to reveal fraudulent intent on the part of the Respondent,

No.1.,

25. In Aakash Educational Services Private Limited v. Akash Educational & Charitable Trust & Ors, CS(OS)--2043/2015, decided on September 14,"

2017 it was held that:,

16. From the evidence on record, it is apparent that without any explicit permission or authorisation to use the plaintiff's trademark and trade",

name, the defendants had malafidely copied the trademark AAKASH of the plaintiff and if the defendants are allowed to continue their illegal",

activities by infringing the registered trademarks of the plaintiff in respect of identical/similar services as well as passing off its services as those of the,

plaintiff, the exclusive proprietary rights acquired by the plaintiff under the statute as well as under the common law shall become redundant and",

aforesaid registrations shall become a nullity.,

17. Further, as the plaintiff's evidence has gone un rebutted, said evidence is accepted as true and correct. The Supreme Court in Ramesh Chand",

Ardawatiya Vs. Anil Panjwani, AIR 2003 SC 2508 has held as under:-",

33 In the absence of denial of plaint averments the burden of proof on the plaintiff is not very heavy. A prima facie proof of the relevant facts",

constituting the cause of action would suffice and the court would grant the plaintiff such relief as to which he may in law be found entitled. In a case,

which has proceeded ex parte the court is not bound to frame issues under Order 14 and deliver the judgment on every issue as required by Order 20,

Rule 5. Yet the trial court should scrutinize the available pleadings and documents, consider the evidence adduced, and would do well to frame the",

points for determination"" and proceed to construct the ex parte judgment dealing with the points at issue one by one. Merely because the defendant is",

absent the court shall not admit evidence the admissibility whereof is excluded by law nor permit its decision being influenced by irrelevant or,

inadmissible evidence.""",

26. The Respondents have failed to file any counter statement in the present proceedings, therefore the malafide of the Respondent No.1 is evident.",

Respondent No.1 has never used nor has had any bona fide intention to use the impugned mark. The Applicant owns common law rights in connection,

with the trade mark label RADIUM, SPEED RADIUM and is the bona fide prior adopter of the same in the year 2004.",

Comparison of the Marks,

27. We find that the impugned mark label of the Respondent No.1 is nearly identical to that of the Applicant's prior used and registered trade,

mark label, be it the art work, words, layout, pattern, get up, special font, colour scheme, design placement and colour combination and the same is",

devoid of any distinctive character and is not capable of distinguishing the goods of the Respondent No.1. The Applicant is the prior adopter and prior,

user of the trademark labels RADIUM and SPEED RADIUM.,

28. In *Perfetti Van Melle S.P.A. & Another v/s Om Prakash Khushwant & Another*, 2013 (54) PTC 288, it was held",

that:,

9. This Court is also of the view that subsequent adoption of the mark Super Fresh by the defendants amounts to infringement of the plaintiffs' trade,

mark inasmuch as the plaintiffs are the registered proprietor of the trade mark CENTER FRESH vide Registration Certificates dated 27th November,"

1981 and 30th October, 1995 and the defendants have, without permission of the plaintiffs, subsequently adopted the mark Super Fresh.",

10. This Court has compared the broad and essential features of the plaintiffs' trade mark and the defendants' mark and is of the opinion that,

defendants have not only copied the essential features of the plaintiffs' registered trade mark but have also used a mark Super Fresh which is,

deceptively similar to that of the plaintiffs' mark CENTER FRESH. This Court is of the view that by deceptively copying a similar mark and by,

imitating the get up, lay out and artistic features of the plaintiffs' label, defendants have tried to trade on plaintiffs' reputation and goodwill.",

Consequently, the defendants have not only infringed the plaintiffs' trade mark but have also indulged in passing off.",

29. As was observed by Parker, J., in *Re Pianotist Co.'s Application*, (1906) 23 RPC 774, and further expanded on in a plethora of",

subsequent cases it must be seen whether there was an overall similarity between the two names in respect of the same description of goods, both",

visually as well as phonetically.,



30. In Staples Inc. Vs. Staples Paper Converters Pvt. Ltd. 2015 (61) PTC 207 (Del), it was held that:",

25. The written statement of the defendant, surprisingly, is bereft of any explanation as to the adoption of the mark "STAPLES" by the defendant. I",

have in fact wondered as to what could be the reason for the defendant to adopt the said mark. The word "Staple" with plural "staples" is a noun",

meaning a piece of thin wire with two short right-angled end pieces which are driven by a stapler through sheets of paper to fasten them together. I,

have wondered as to why anyone would want a noun as a trademark and which may not enjoy such protection as may be available to coined words,

and which, really speaking neither describes the proprietors of the business nor the business in the Indian context. In fact an ordinary person is likely to",

consider the defendant as dealing only in staples, instead of in paper products as claimed. The only plausible explanation is that the said name and",

trademark having international recognition, was adopted for the same trade / business with a view to take advantage thereof in the event of the",

plaintiff no.1 foraying into India. (emphasis supplied),

31. The impugned mark was filed by the Respondent No.1 plainly with full awareness of the existence of the trade mark labels RADIUM, SPEED",

RADIUM in the name of the Applicant. It is evident that the Respondent No.1 acquired the impugned registration by misusing its filing before the,

Respondent No.2, as to the real ownership of the trade mark label RADIUM. The impugned mark, in view of the Applicant's rights as aforesaid",

is of such nature as to be capable of deceiving/causing confusion among the public and members of the trade/ public, and is therefore in contravention",

of Section 9 (2) of the Act. The impugned mark is also violative of Section 11 of the Act,

32. The goods covered under both the Respondent No.1's and the Applicant's registrations are identical and nearly similar goods. Therefore",

any use of the impugned mark in respect of these goods tends to deceive the public to believe that the Respondent No. 1's business and goods are,

that of the Applicant. Such user by the Respondent No. 1 will also dilute and debase the goodwill and reputation of the Applicant in its RADIUM",

SPEED RADIUM trademark labels.,

33. Applying the triple identity test, in Jain Electronics v. Cobra Cables P. Ltd., 2011 (45) PTC 52 (Del), the Honâ€™ble Delhi High Court has held as",

under:-,

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. 1's goods were electric cables whereas the Petitioner's,

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 DeputyÂ Registrar andÂ the IPABÂ concurrentlyÂ concludedÂ thatÂ 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. (emphasis supplied) This Court concurs with the said view. The registration in favour of Respondent No. 1 dates back to 1980",

whereas the Petitioner's 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.,

The same is satisfied in the present case.,

34. Counsel for the Applicant further apprised us of the fact that the Respondent No.1 has represented before the Honâ€™ble High Court of Calcutta,

in the abovementioned suit pending between the parties that it is not using the impugned mark. Considering that the use of the impugned mark, if any",

was illegitimate, there is no acquired distinctiveness which has accrued in favour of the respondent No.1 and hence, no protection is available to the",

said registration under the provision of Section 32 of the Act. The impugned registered trade mark is therefore, liable to be cancelled under the",

provisions of Section 11 & 18 of the Act. It also offends under Section 57 of the Act. The existence of the identical/nearly,

identical impugned registration which was wrongly granted is prejudicial to the Applicant's interests.,

35. In view of facts and material placed on record, it is evident that the registration of the impugned trade mark has been wrongly granted by the",

Respondent No. 2 and should be removed from the register as it is in breach of provisions of 9(1)(a), 9(2)(a), 11(1), 11(2), 11(3), 11(10), 12, 18(1) and",

32 of the Trade Marks Act and therefore is liable to be removed and cancelled from the Register under Section 47 and 57 (2) of the Trade Marks,

Act, 1999.",

36. In the light of above the Petition is allowed and Respondent No.2 is directed to delete the entry of registered Trade mark No. 3542551 in class 16,

in the name of Arjun Singh Rajguru, trading as Ramdev Pen Marketing, Respondent No.1 herein from the Register under the provisions of Section",

47(1)(a) and (b) and Section 57 of the Trade Marks Act, 1999. Copy of order be sent to the parties as well as Respondent No.2 who is directed to",

remove the said mark from the Register forthwith,

37. No costs.,