

MANU/IC/0027/2011

**BEFORE THE INTELLECTUAL PROPERTY APPELLATE BOARD, CHENNAI
CIRCUIT BENCH AT KOLKATA**

OA/26/2007/TM/KOL

Decided On: 11.10.2011

Khushi Ram Laxmi Narain **Vs.** Gopal and Company and Ors.

Hon'ble Judges/Coram:

Prabha Sridevan, J. (Chairman) and S. Usha, Vice Chairman

ORDER

S. Usha, Vice Chairman

1. The 1st Respondent herein filed an application for registration on 30.04.2001 of the trade mark "gopal" under No. 1006523 in class 30 in respect of Tea, coffee, cocoa, sugar, rice, tapioca sago, artificial coffee, colour and preparations made from cereals, bread, pastry & confectionery, ices, honey, yeast, baking power, salt, mustard, vinegar, sauces, spices etc. under the provisions of the Trade marks Act, 1999 (in short the Act). The user was claimed since 02.04.1998. The said application was advertised before acceptance on 15. 07.2005 in Trade Mark Journal No. 1333 at pages 5191 & 5192.

2. The Appellant herein opposed the registration on the ground that they are engaged in the business of processing & marketing various non-alcoholic drinks like syrups, thandai & other preparations for making beverages etc. under the trade mark "Gopaljee" since the year 1991. They are registered proprietors of the trade mark "Gopaljee" under No. 626608 in class 30 as of 28.04.1994 for the goods "thandai" powder, jaljeera powder etc. under No. 1215843 in class 30 as of 21.07.2003 for the goods "spices, tea, badam shake powder etc. and under No. 1330583 in class 35 as of 07.01.2005.

3. The Registrar heard both the counsel and passed the impugned order on the ground that the applicants i.e. the 1st Respondent had every right to adopt the trade mark after their name "Gopal Shaw", the mark was accepted for advertisement in the Trade Marks Journal for goods for sale in the state of Bihar only after considering their use at the acceptance stage, the rival marks though are deceptively similar but considering the restriction of use in a restricted area for specific goods for more than eight years and where no evidence of confusion was brought to the notice of this Tribunal, the opponents are dealing with thandai & syrups mainly and though they have obtained registration for masala have not sold their goods in Bihar where the Respondents are carrying an business and so therefore ordered that the registration be proceeded to.

4. The Appellants preferred the appeal on the ground that the impugned trade mark is not adapted to distinguish the impugned goods, the mark is devoid of any distinctive character; the learned Registrar ought to have considered the fact that the trade mark had not acquired distinctiveness by use, the Registrar failed to consider the objection under Section 9 of the Act; the Registrar ought to have appreciated the fact that the rival marks are identical; the Registrar erred in not appreciating the fact that the Appellants are prior in use of the trade mark; and that they are the registered proprietors of the trade mark Gopaljee which is deceptively similar to the impugned trade mark "Gopal".

5. In the counter statement, the Respondents stated that they are manufacturing and marketing spices & other related products over a decade. They adopted the trade mark "Gopal" in or about April 1998. Before adopting the Respondents conducted a search in the adjoining areas. The Respondents masala acquired goodwill & reputation by its good quality among the public. The public used to call the masalas as "Gopal masala" as the Respondents name is Gopal. In view of this, the Respondents adopted the trade mark "Gopal".

6. The Respondents thereafter in order to obtain statutory right over the trade mark "Gopal" applied for registration. At the acceptance stage, the Trade Marks Registry passed an order for advertisement with a condition restricting the goods to spices & Ghee for the sale in the State of Bihar only. Though such an order was recorded the same was not reflected in the Trade mark Journal Advertisement. There was no scope for any confusion as the rival goods are different and also that the area of operation of the rival products are evidently different. The Appellants failed to prove their case of distinctiveness and as well the goodwill and reputation in relation to spices in Bihar was not proved. The Respondent denied the rest of the averments.

7. We have heard Mr. S.K. Bansal Learned Counsel for the Appellant and Dr. Alok M. Saha, Learned Counsel for the Respondent No. 1 along with Ms. Priyanka Dubey.

8. The Learned Counsel for the Appellant submitted that the impugned trade mark "Gopal" application was filed on 30.04.2001 claiming user since 02.04.1998 in class 30, whereas the Appellants had adopted and used the trade mark "Gopaljee" since 1991. They had applied for and obtained registration in various classes. The Appellant then relied on various advertisements the 1st being of the year 1997 and also to some vouchers and bills. The Respondents user is of the year 1998 only which is subsequent to the Appellants use. Though the Respondent claims user since 1998 but the first invoice is only of the year 2006 which bears the trade mark "Gopal".

9. The Registrar has not dealt with the provisions of Section 9 and decided the issue of distinctiveness. The burden of proving the same is on the Respondent which had not been satisfied. The issue of confusion and deception has not been proved by the Respondent on whom lies the onus. The Respondent is not the proprietor of the trade mark and therefore not qualified for registration under Sec 18(1) of the Act.

10. In reply the Respondent submitted that the trade mark Gopal was adopted by them after their name Gopal Show. The Appellants goods namely thandai & Syrup were only in Delhi and other nearby places as is seen from the advertisement was the Respondents contention. He further submitted that initially their business was in a small scale where no proper bill was given, subsequently in the year 2006 the business grew and they were able to give proper bills for their sale of goods. The provisions of Section 9(2) does not apply.

11. Both the counsel relied on few judgements.

12. We have considered the arguments of the counsel and have gone through the pleadings and documents. The Appellants case is that they are registered proprietors of the trade mark "Gopaljee" under various classes and therefore the registration of the mark "Gopal" would cause confusion and deception. On perusal of the records, it is seen that though the Appellants are registered under various classes for the whole of India, the sale is only in a particular area and the goods are only thandai & syrup, whereas the Respondents are dealing only with ghee & masala in the State of Bihar and nearby places. The burden is on the applicant i.e. the Respondent to prove that the

mark applied for will not cause confusion among the public, was the contention of the Appellant. In the instant case, as the goods are sold in different areas, we do not think there is any possibility of confusion or deception being caused.

13. The application shall, therefore, be registered in respect of spices and ghee for sale in the State of Bihar. Accordingly, the appeal is dismissed without costs.

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