

# INTELLECTUAL PROPERTY APPELLATE BOARD

Guna Complex, Annexe-I, 2<sup>nd</sup> Floor, 443, Anna Salai,  
Teynampet, Chennai – 600 018

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**ORA/82/2014/TM/CH**

TUESDAY THIS THE 1<sup>st</sup> DAY OF MARCH, 2016.

**Hon'ble Shri Justice K.N. Basha ...Chairman**  
**Hon'ble Shri Sanjeev Kumar Chaswal ...Technical Member(Trademarks)**

M/s AKAR Enterprises,  
at No.63, 2<sup>nd</sup> Main Road,  
Bangalore-560 002.

... Applicant

(Represented by – Mr. Harikrishna S. Holla)

**Vs.**

1. M/s Sri Nanjundeshwara Traders,  
No.32/1, 3<sup>rd</sup> Cross 3<sup>rd</sup> Main Road,  
New Tharagupet, Bangalore – 560 002. ...Respondent No.1
2. Mr. R.B. Vijayarajan,  
1-H/3, Dhamotharanagar Main Road,  
Thoothukudi – 628003,  
TAMIL NADU. ...Respondent No.2.
3. The Deputy Registrar of Trade Marks,  
I.P. Building, Industrial Area, G.S.T. Road,  
Chennai – 600032. ...Respondent No.3.

(Represented by – Mr.P.V.S. Giridhar)

## **ORDER (No.20 of 2016)**

**Hon'ble Shri Justice K.N. Basha, Chairman**

This application is filed by the applicant seeking for the relief of expunging and removing the trade mark “AKASH” bearing No.1147895 in class 30 in the name of M/s Sri Nanjundeshwara Traders, the first respondent herein. The second respondent stated to be a contract manufacturer of the first respondent herein.

### **CASE OF THE APPLICANT**

2. The case of the applicant is that they are carrying on business in manufacture and sale of salt since the year 1976 in the name and style as “AKAR Enterprises”. The trade mark “AKAR” with a particular artistic work,

design and get up and fonts for marketing of salt adopted by the applicant and has become distinctive on the ground of long and continuous use and acquired reputation and goodwill. The applicant had obtained the registration of the trade mark "AKAR" under No.556425 and 556426 in class 30.

3. The further case of the applicant is that they are the prior user and obtained prior registration of the trade mark "AKAR". It is their case that they came to know about the use of the impugned trade mark "AKASH" by the first respondent herein which is deceptively similar to the applicant's trade mark. It is stated that they have issued a legal notice dated 14/03/2009 calling upon the respondent 1 and 2 to cease and desist from using the trade mark "AKASH". The first respondent has sent a reply to the legal notice through their counsel on 01/04/2009 denying the entire allegations. Thereafter the applicant filed a suit against the respondents 1 and 2 in OS No.4431/2009 on the file of the Additional City Civil Court, Bengaluru and the same is pending as on date.

4. It is stated that in view of the deceptive similarity of the impugned trade mark "AKASH" with that of the applicant's trade mark "AKAR"

(i) It causes confusion among the consumers.

(ii) The applicant submitted that the first respondent have obtained the registration of the impugned trade mark "AKASH" in class 30 under No.1147895 on proposed to be used basis on 01/11/2002 and got the registration on 04/04/2005 and is valid upto 01/11/2022. Till the date of filing the application, the respondent has not been manufacturing and selling goods under class 30 of the Trade Marks Act.

(iii) The applicant stated that the impugned trade mark is registered without any bonafide intention on the part of the first respondent to use the trade mark in relation to the goods and the first respondent is not using continuously for the period of five years from the date of which the trade mark is actually entered in the register and as such the

impugned trade mark is liable to be removed from the register on the ground of violation of section 47 (1) (a) and (b). It is also stated that there is violation of section 50 (ii) of the Trade Marks Act.

### **COUNTERSTATEMENT OF THE FIRST RESPONDENT**

5. The first respondent emphatically denied the entire allegations contained in the application stating that all the grounds are frivolous, untenable and devoid of any factual or legal basis and there has been no violation of any provisions of the Trade Marks Act, 1999 (hereinafter referred to as the Act).

(i) It is the case of the first respondent that they are the prior adopter and user of their trade mark "AKASH" and obtained a high reputation and goodwill due to its long, continuous and extensive use. In order to substantiate their claim they produced the sales invoices right from the year 1999-2000. They have also filed sales tax return along with their counter.

(ii) The first respondent applied for registration of their trade mark "AKASH" on 01/11/2002 since their trade mark attained the distinctive character and after following the procedure the registration certificate was issued to them and got the registration of the trade mark on 04/4/2005. It is the claim of the first respondent that they are using the trade mark from the year 1999 and produced the documents namely sales invoices from the year 2002.

(iii) The first respondent stated that though the applicant claimed usage of their trade mark from 1976 that they have stated even in the application in respect of sales turn over only from the year 1998-99. It is stated that the impugned trade mark "AKASH" is visually, phonetically and semantically different from the applicant's trade mark "AKAR". It is further

stated that even fonts are different in style, manner, artistic work and device from the applicant's label.

(iv) The first respondent also stated that the impugned trade mark "AKASH" does not violate the provisions under section 9, 11, 18, 47 and 57 of the Act. It is categorically stated by the respondent that they are using the impugned trade mark right from the year 1999 honestly without any malafide intention. It is stated that the application filed by the applicant only in the year 2014 ie. fifteen years after the mark was registered in spite of knowing fully well all along the impugned mark was in wide use. The applicant has filed the present application with malafide motive. Therefore it is stated that the application is liable to be dismissed.

#### **ARGUMENTS OF THE COUNSEL FOR APPLICANT**

6. Mr. Harikrishan S. Holla, the learned counsel for the applicant would vehemently contend that the impugned trade mark "AKASH" has been wrongly registered and wrongly remaining in the register and as such the same is liable to be removed from the register and put forward the following contentions:-

(i) The applicant is the prior user of their trade mark "AKAR" right from the year 1976 in respect of salt and they have also obtained prior registration of their mark "AKAR" on 15/09/2000 and as such the first respondent suppressing registration of their mark and wrongly obtained the registration of the impugned mark "AKASH" only on 04/04/2005.

(ii) The applicant in order to substantiate their prior use they have stated about their sales turn over from the year 1998-99 to 2012-13 and thereby acquire distinctiveness by their long and continuous use of their trade mark "AKAR".

(iii) The impugned trade mark "AKASH" is visually, phonetically and structurally similar to the applicant's trade mark "AKAR" which would cause confusion among the consumers.

(iv) In order to establish that they are selling their product salt under the trade mark "AKASH" they have produced the factual materials.

(v) The applicant with a view to proving the unauthorized use of impugned trade mark which is deceptively similar to that of the applicant's trade mark, the applicant apart from issuing the legal notice in the year 2009 ultimately filed a Civil Suit under OS No.4431/2009 on the file of Additional City Civil Court at Bangaluru and the same is pending. The respondent having got the registration of the impugned trade mark without bonafide intention to use the same has caused irreparable damage to the business of the applicant and in view of their non use of the impugned trade mark provision under section 47 is also attracted.

(vi) Therefore, it is contended that the applicant has established the violation of the provisions under section 9, 11, 18, 47 and 57 by the first respondent and the impugned trade mark "AKASH" is liable to be expunged and removed from the register.

#### **ARGUMENTS OF THE LEARNED COUNSEL FOR THE FIRST RESPONDENT**

7. Mr. P.V.S. Giridhar, the learned counsel for the first respondent would strenuously contend that the present application is liable to be dismissed on the basis of the false, frivolous and baseless allegations contained in the application and would submit the following contentions :-

(i) The first respondent is the prior user of the impugned trade mark "AKASH" right from the year 1999 and the documents have been

produced from the year 1999 and got the registration on 04/04/2005 on the basis of the application submitted on 01/11/2002.

(ii) Though the applicant claimed the usage right from the year 1976, the applicant has miserably failed to prove by producing any single document to substantiate their claim except making bald and vague sales figures in the application without submitting any single document of invoices or any other documents.

(iii) The impugned trade mark "AKASH" cannot be stated to be visually, phonetically and semantically similar to that of the applicant's trade mark "AKAR".

(iv) Even the labels of the first respondent's trade mark "AKASH" is entirely different from the label of the applicant's trade mark "AKAR" in colour, design and style and both the fonts are entirely different.

(v) Even the meaning of the two trade marks viz. the first respondent trade mark "AKASH" means "SKY" and the applicant's trade mark "AKAR" means "SHAPE" and as such there is no question of any deceptive similarity between the two marks in any manner which was likely to cause confusion and deception among the consumers. The applicant stated that they came to know about the impugned trade mark on 14/03/2009 and they have not taken any action of filing this present application immediately but they have waited for a period of 10 years by filing application before this Bench and as such the first respondent is entitled to invoke the provision under section 33 of the act as the applicant had acquiescence for a continuous period of five years of use of the trade mark of the first respondent and as such the applicant is not entitled to

seek relief of declaration that the registration of the impugned trade mark is invalid.

### **DISCUSSIONS AND FINDINGS**

8. We have given our careful, thoughtful and anxious consideration to the rival contentions put forward by either side and also thoroughly scanned through the entire materials available on record.

9. At the outset we are constrained to state that the impugned trade mark "AKASH" is visually, structurally and phonetically different from that of the applicants trade mark "AKAR" and as such there is no question of any deceptive similarity of the impugned trade mark as that of the applicant's trade mark. We have also seen the labels of the trade marks of the applicants and the first respondent and it is pertinent to note that the label mark also consisting fonts in different style, colours, art works and device. If it is taken both the label together it looks entirely different from one another for a blanket eye. Therefore, by no stretch of imagination it can be contended by the applicant that the impugned trade mark "AKASH" is deceptively similar to that of the applicant's trade mark "AKAR". Therefore, there is no violation of provision under section 11 committed by the first respondent herein.

10. The applicant has claimed that they are the prior user of the trade mark "AKAR" right from the year 1976. It is pertinent to note that the applicant has not filed even a scrap of paper to establish that their trade mark is in use from the year 1976. It is seen that the applicant has come forward with the statement of sales turn over from the year 1998-99 to 2012-13. Here again we have to state that the said statement is nothing but the self declaration and cannot substantiate or authenticate by producing a single document of sales invoices or any other documents.

11. It is their further contention that they got the registration of their trade mark "AKAR" in the month of September, 2000 and as such they are the prior registered owner of their trade mark "AKAR" and the first respondent has got the registration only in the year 2005. It is well settled by a catena of decisions that mere registration itself is not sufficient to establish the prior use and it is incumbent on the part of the applicant to substantiate their claim of prior use by producing authenticated documents of sales of their goods. As far as the first respondent is concerned they have claimed prior use from the year 1999 and they have also produced registration of sales tax even in the year 1999 and there after produced the sales invoices from the year 2002 and they got the registration of their trade mark "AKASH" on 04/04/2005 on the basis of their application dated 01/11/2002. Therefore by no stretch of imagination it can be claimed by the applicant that they are the prior user.

12. The last but not the least contention put forward by the learned counsel for the first respondent is that there is enormous delay of 10 years in filing their present application in spite of knowing very well that the first respondent is continuously using the impugned trade mark "AKASH" right from the year 1999 and even as per their admission to the effect that they came to know about it from 14/03/2009 but they have not raised their little finger to file the present application and to take any action. It is seen that even the Civil Suit was filed only in the year 2009 in OS No.4431/2009 on the file of Additional City Civil Court, Bengaluru and the present application is filed only after nine years. It is pertinent to note that both the applicant and first respondent are having their business place in Bengaluru and also in the same area at New Tharagupet and such being the position it is unimaginable to state that the applicant came to know the use of impugned trade mark only in the year 2009. Considering all these aspects we are of the firm view that the first respondent is entitled to invoke the provision under section 33 in respect of the effect of acquiescence though the learned counsel for the applicant took pain to contend the present



facts would not make out the case of acquiescence. In view of the above said reasons we are unable to countenance such contention.

13. In view of the aforesaid reasons the ORA/82/2014/TM/CH is hereby dismissed. No order as to cost.

**(SANJEEV KUMAR CHASWAL)**  
**TECHNICAL MEMBER**

**(JUSTICE K.N. BASHA)**  
**CHAIRMAN**

Reportable : YES / NO

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