

**INTELLECTUAL PROPERTY APPELLATE BOARD**

Guna Complex Annexe-I, 2nd Floor, 443 Anna Salai,  
Teynampet, Chennai-600018

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**(CIRCUIT BENCH SITTING AT AHMEDABAD)**

**OA/46/2012/TM/AMD**

**THURSDAY THIS THE 17<sup>th</sup> DAY OF DECEMBER, 2015**

**HON'BLE SHRI. JUSTICE K.N.BASHA ... CHAIRMAN**  
**HON'BLE SHRI SANJEEV KUMAR CHASWAL ... TECHNICAL MEMBER**  
**(TRADE MARKS)**

M/s Maruti Piston Private Limited,  
25/3, GIDC Estate,  
Kalol-382 725.  
North Gujarat.

... Appellant

(Represented by Mr. R.R. Shah)

Vs

1.M/s Maruti Udyog Limited.,  
11<sup>th</sup> floor, Jeevan Prakash,  
25, Kasturba Gandhi Marg,  
New Delhi 110 001.

2.The Registrar of Trade Marks,  
Having his Office at Trade Mark Registry Branch,  
15/27, National Chambers,  
Ashram Road,  
Ahmedabad 380 009.

... Respondents

(Represented by Ms. Anju Agarwal)

**ORDER No.221/2015**

**HON'BLE SHRI JUSTICE K.N.BASHA, CHAIRMAN:**

The order under challenge is dated 06/06/2012 passed by the Assistant Registrar of Trade Marks, Ahmedabad allowing the opposition filed by the respondent / opponent herein and dismissal of the application No.558520 in class 12 filed for registration by the appellant herein.

2. The case of the appellant is that they are carrying on business in manufacturing and marketing Pistons Auto Parts from the year 1991. It is stated that they have adopted and coined the mark "MARUTI" from their trade name Maruti Pistons (P) Limited and claimed that the rival marks are totally different and dissimilar. After following the procedure it was advertised in the Journal which resulted in filing the opposition by the respondent herein. In the above

said statement the appellant / applicant filed an application under registration No.558520 in Class 12 for registration of trade mark "MARUTI" along with a device.

3. The respondent in the opposition stated that they have already got the registration of trade mark "MARUTI" along with some device. After due publication in the journal and advertisement before acceptance the notice of opposition was filed by the respondent herein. In the notice of opposition, the respondent herein stated that they are the reputed manufacturers of vehicle particularly four wheeler and parts thereof under the mark MARUTI and Wing device for several years. The opponent stated that they got the registration of the trade mark MARUTI under No.319710, Maruti and Wing device under 405671 both in class 12 claiming use since 1972 and 1983 respectively and continues to use till today. It is stated that the impugned mark of the appellant/applicant is identical to their trade mark and the same is only proposed to be used by the appellant/applicant and they are intend to trade upon the goodwill and reputation acquired by the opponent/respondent herein. The objections raised under Sections 9, 11 & 18 of the Trade Marks Act, 1999 (hereinafter referred to as the Act). The appellant/respondent filed the counter statement raising their claim as stated above.

4. After considering the pleadings, evidence and the arguments advanced by both the counsel, the impugned order was passed on 6/6/2012 by the Assistant Registrar in this present appeal.

5 Mr. R. R. Shah, the learned counsel would vehemently contend that the impugned order is contrary to law and facts and put forward the following contentions:

(1) The appellant using the trade mark only for pistons which could be used for two wheeler or three wheeler and not for four wheeler.

(2) Trade Mark No.405671 under class 12 of the respondent is not in existence as on date as per the status report and the website report is produced.

(3) The Assistant Registrar failed to consider the special circumstances contemplated under Section 12 namely Piston not manufactured by the respondent/opponent. The piston to be used only for two wheeler and not for four wheeler of the respondent/opponent.

(4) The appellant has regularly participated world famous auto expo held at Pragathi Maidan, Delhi right from the year 2004-2012 and the same was ignored and all these special circumstances have been ignored.

(5) The respondent / opponent has not initiated any civil proceedings for infringement or passing of nor issued any desist notice against the appellant herein.

(6) The volume of evidence namely sales particulars have been ignored by the Registrar.

6. In support of his contention, the learned counsel would also placed reliance on the following decisions:

1. IPAB order No.115 dated 4/6/2010 – “M/s Ajay Auto Products, New Delhi Vs M/s Highway Cycle Industries, Ludhiana”
2. “AIR 1996 SC 2275” – “M/s Vishnudas Trading as Vishnudas Kishandas Vs Vazir Sultan Tobacco Co. Ltd., Hyderabad and Anr.”

7. Per contra, Ms. Anju Aggarwal, the learned counsel for the respondent would strenuously contend that there is no infirmity or illegality in the impugned order and put forward the following contentions.

1. The so called special circumstances relied by the appellant were not placed before the Registrar before passing the impugned order and as such the same could not be relied for the application of Section 12.

2. Even in the application, the appellant has specifically stated that they proposed to use the trade mark under question and as such they cannot take shelter under Section 12.

3. The appellant/application has not established their distinctiveness of their product and as such they are not entitled for seeking registration of the trade mark MARUTI.

4. The appellant failed to clear the obstacles contemplated under Section 9(1), 11(1), 11(1)(b), 11(2) and 11(3).

8. The Registrar has clearly held that the mark sought to be registered by the appellant/applicant is identical and similar to that of the mark of the first respondent.

9. The respondent/opponent has filed second application in view of the lapse of their registration under No.405671 in Class 12 and obtained registration under

No.1721579 for the same class 12 for the same mark MARUTI. The appellant has also obtained registration for their mark under 558519 but the same was lapsed subsequently.

10. The respondent also produced volume of evidence to prove their sales record namely annual report, invoices, etc. to establish that their mark is a well known mark and obtained goodwill and reputation from the public through out the world.

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

12. The undisputed fact remains that at the time of filing the application, the appellant has categorically stated that they proposed to use the trade mark MARUTI. The learned counsel for the appellant took enormous pain to contend that the Assistant Registrar has overlooked the voluminous evidence filed by them and also ignored the special circumstances. We are unable to countenance such contention as the perusal of the impugned order reflects the application of mind of the Assistant Registrar coupled with the appreciation of the evidence produced before him.

13. It is pertinent to note that in the impugned order the claim made by both sides have been clearly stated and thereafter considered the contentions by rendering findings on the basis of the pleadings and the evidence produced before him. Though, it is contended by the learned senior counsel for the appellant that they were using the trade mark MARUTI for a long period, the fact remains that they have not substantiated their reputation and goodwill in order to establish the distinctiveness of their products for registration. It is relevant to note that the Assistant Registrar has clearly and categorically held that the claim of the appellant/applicant to the effect that the impugned mark is totally different and dissimilar does not hold good. It is relevant to note that the respondent/opponent has established their company as early as in the year 1972

and their product of four wheelers released for the public as early as in the year 1984 and thereby they have obtained world wide reputation and goodwill. In view of the same, we have no difficulty in holding that the mark of the first respondent/opponent is a well known mark. As far as the applicant mark MARUTI is concerned as it is already pointed out the same is similar, identical and the logo device also same namely Wing device are also same. The name of the mark itself makes it crystal clear that the impugned trade mark is phonetically and visually similar that of the impugned trade mark and certainly it would cause confusion in the mind of the public who are the consumers and who are the users of MARUTI cars. The learned counsel for the first respondent rightly contended that the appellant is snatching the reputation and goodwill of the first respondent in order to promote their trade.

14. In respect of the application of Section 12, the contention of the learned counsel for the appellant to the effect that Section 12 would be applicable even on the basis of the special circumstances and the Registrar failed to consider the same, we are unable to countenance the said contention for the simple reason even the learned senior counsel for the respondent fairly submitted those special circumstances came into existence subsequently. It is pertinent to note that the provision of Section 12 is not at all attracted to the facts of the instant case as it is already pointed out that the appellant/applicant has specifically stated that the impugned mark is only proposed to be used.

15. The appellant made a feeble attempt to establish their use by placing reliance on their registration under TM No.558519 but even the same was allowed to be lapsed as the action was taken by the Registrar under Section 56(4) which resulted in the appellant themselves to surrender the said registration. The yet another contention of the learned counsel for the appellant to the effect that the first respondent has not initiated any civil proceedings of infringement or passing off against the appellant herein is of no use or helpful to advance the case of the appellant. It is open to the first respondent to initiate any

action as they desire and they have filed opposition in the application preferred by the appellant herein.

16. The decision relied by the learned counsel for the appellant are not applicable to the facts of the instant case in the first case of this Bench Order dated 4/6/2010 under Order No. 115/2010 – “M/s Ajay Auto Products, New Delhi Vs M/s Highway Cycle Industries, Ludhiana” wherein it is clearly stated that the goods are different category and as far as the case in hand is concerned both the goods are related to automobile parts and more particularly the name and fame obtained by the first respondent cannot be disputed in the automobile market and the same would cause confusion in the mind of the consumer.

17. In the second case namely “Charminar” case, It is seen that the facts are entirely different and the registration was restricted after the rectification by limiting or confining the impugned mark of the respondent in the said case to particular goods and as such the said case is not at all applicable to the present case.

18. On the other hand the learned counsel for the first respondent has produced the latest website extract of the status of their subsequent registration, in view of the earlier lapse of the second registration mark namely 405671 in class 12 and subsequently registered under Trade Mark No.1721579 in class 12 as the application filed on 14/8/2008 itself in respect of MARUTI vehicles. It is seen that the learned counsel also produced the decision of this bench reported in 2006(32) PTC 397 – “Enfield India Ltd. Vs Deepak Engineering Syndicate” in respect of deceptive similarity is squarely applicable to the facts of the instant case. The said decision of this Bench is hereunder:

*“If there is a possibility for the consumer to think that the product which he is purchasing is from that of the appellant’s factory by virtue of similarity of the trade mark, that itself will amount to confusion or deception eve though the product of the first respondent is different. In short, if the disputed trade mark gives rise to a doubt with regard to the source of production, that is more than enough to come to the conclusion that there is confusion. The appellant’s mark ‘ENFIELD BULLET’ has its own distinctiveness in respect of their product*

*motorcycles. “ENFIELD BULLET” has its own distinctiveness in respect of their product motorcycles. ‘ENFIELD’ being the company name, ‘BULLET’ being the trade mark to identify the product, the BULLET motorcycles of the appellant company were supplied in large numbers to Army and Police personnel. Apart from that, even in the rural areas, it was considered to be a status symbol among the agriculturists to own a ‘BULLET’ motorcycle. When that much of reputation had been built up by the appellant in respect of their motorcycles having the trade mark ‘BULLET’ the use of the same mark by any other individual for any other category of goods would create confusion that the goods with the disputed mark are being produced by the appellant company.*

19. The second decision relied by the learned counsel for the respondent reported in **2011(46)PTC 244(Del) – “M/s Tata Sons Ltd. Vs Manoj Dodia & Ors.”** of the Hon’ble Delhi High Court is also applicable to the facts of the instant case. The said decision is in respect of well-known mark. The Hon’ble Delhi High Court has held hereunder:

*“Para -10 “Well known marks and trans-border reputation of brands was recognized by Courts in India, even before Trade [Marks Act](#), 1999 came into force. In Daimler Benz. Aktiengesellschaft v. Hybo Hindustan, AIR 1994 Del 239, the manufacturers of Mercedes Benz sought an injunction against the defendants who were using the famous „three pointed star in the circle” and the word “Benz”. The Court granted injunction against the defendants who were using these marks for selling apparel. Similarly, in [Whirlpool Co.& Another v. N.R. Dongre](#), (1996) PTC 415 (Del.), the plaintiff Whirlpool had not subsequently registered their trademark after the registration of the same in 1977. At the relevant time, the plaintiff had a worldwide reputation and used to sell their machines in the US embassy in India and also advertised in a number of international magazines having circulation in India. However, the defendant started using the mark on its washing machines. After an action was brought against them, the Court held that the plaintiff had an established “trans border reputation” in India and hence the defendants were enjoined from using the same for their products. In the Kamal trading Co. vs. Gillette UK Limited,(1998 IPLR 135), injunction was sought against the defendants who were using the mark 7’O Clock on their toothbrushes. This was further reaffirmed by*

*the CS(OS)Nos.264/2008 & 232/2009 Bombay High Court, which held that the plaintiff had acquired an extensive reputation in all over the world including India by using the mark 7'O Clock on razors, shaving creams. The use of an identical mark by the defendant would lead to the customer being deceived.”*

20. In view of the principles laid down by the decisions cited supra we have no hesitation to hold that no one is entitled to snatch the goodwill & reputation obtained by a company and as far as the instant case is concerned, it is needless to state that the brand name MARUTI has obtained world-wide reputation in respect of four wheeler and there is any attempt to use the same name for two wheelers or three wheelers it will certainly affect the reputation of the first respondent which would ultimately result in substantial reduction in the trade of first respondent and dilution of reputation. In view of the aforesaid reasons, we are of the considered view that there is absolutely no infirmity or illegality in the impugned order warranting our interference. Accordingly, the appeal is hereby dismissed.

**(SANJEEV KUMAR CHASWAL)**  
**TECHNICALEMEMBER**

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

Reportable: Yes / No

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