



IPAB Intellectual Property Appellate Board

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ORA/29/2020/TM/CHN

WEDNESDAY, THIS THE 30TH DAY OF DECEMBER, 2020

**HON'BLE SHRI JUSTICE MANMOHAN SINGH
HON'BLE MS.LAKSHMIDEVI SOMANATH
HON'BLE SHRI. MAKYAM VIJAY KUMAR**

**CHAIRMAN
TECHNICAL MEMBER (TRADEMARKS)
TECHNICAL MEMBER (TRADEMARKS)**

**HEWLETT-PACKARD DEVELOPMENT COMPANY,
L.P.**

10300 Energy Drive, Spring,
TX 77389,
United States of America

...Applicant

(Represented by: Mr. Ranjan Narula)

Versus

1. RONAK BHARAT SHAH
002, Adarsh Seelin Villa,
North Dark Road, High Grounds,
Bangalore - 560001

... Respondent No.1

2. THE REGISTRAR OF TRADE MARKS
TRADE MARKS REGISTRY,
INTELLECTUAL PROPERTY OFFICE BUILDING
G.S.T. ROAD, GUNIDY, CHENNAI-600032

...Respondent No.2

(Represented by: **None**)

ORDER

HON'BLE SHRI. MAKYAM VIJAY KUMAR, TECHNICAL MEMBER (TRADEMARKS) :

1. The Rectification Application is filed under Section 47 and 57 of Trademark Act, 1999 for Removal of the word mark "OBELISK" ("impugned mark") under Application No. **3227569** ("impugned Registration") in **class 9** registered in favour of the Respondent No. 1. Details of the impugned registration-

Date of Application: 04/04/2016

Use claim- Proposed to be used

Sealing date for the registration certificate: 07/02/2018


2. By this order, we propose to decide the said prayer.

THE CASE OF THE APPLICANT

3. That the Applicant's parent company i.e., HP Inc., is one of the world's leading multinational technology companies and an industry leader in the fields of computer hardware, computer software, IT solutions, printers and enterprise services. The Applicant caters to wide range of customers ranging from diverse sectors through

number of worldwide offices situated in more than 170 countries.(Hewlett-Packard Development Company, L.P., HP Inc. and HP Hewlett Packard Group LLC shall be collectively referred to herein as “Applicant” except where necessary to differentiate among them).

4. The Applicant submitted that the history of the Applicant goes back to 1939 when Bill Hewlett and Dave Packard founded Hewlett-Packard Company which was incorporated as a Company in California on August 18, 1947, and went public on November 6, 1957. The Applicant’s state of incorporation changed to Delaware in 1998. Since its inception, the Applicant has grown to a billion dollar company. The net revenue generated by HP Inc. in the financial year 2018 was US\$ 58.5 billion.

5. The Applicant submitted that it manufactures a wide range of products under HP mark, HP logo  and marks containing HP (hereinafter referred to as ‘HP trademarks’) that enhances and enriches consumers’ IT capabilities at home and at work all around the globe. HP Hewlett Packard Group LLC is the registered owner of the HP trademarks. Hewlett-Packard Development Company, L.P. is its licensee, and it has the authority to enforce the HP trademarks worldwide. HP Inc. and its subsidiaries and affiliates in India, are, in turn, sublicensed by Hewlett-Packard Development Company, L.P. to use the HP trademarks in India and elsewhere. The Applicant’s product range under HP trademarks includes, but is not limited to, large-format and industrial printers, digital printers, latex printers, industrial presses, scanners, inks, toners, laptop computers, desktop computers, all-in-one personal computers, communication devices, tablet computers, monitors, displays, computer peripherals and accessories, and computer printers. The details and/or information about the Applicant’s business activities in various jurisdictions, product range and technical specification of products are available on its website located at www.hp.com. The domain name www.hp.com was registered by the Applicant as early as on March 3, 1986.

6. The Applicant submitted that apart from its house name HP, during the course of business the Applicant has coined and conceived various trademarks and secured registration of the same in various countries across the world including India.

7. The Applicant submitted that on the eve of Gamescom, 2018 (a trade fair for video games held annually at the Koelnmesse in Cologne, North Rhine-Westphalia, Germany), the Applicant revealed its latest addition to the desktop gaming family under the name OBELISK. The OBELISK gaming computer system is the first system to carry the NVIDIA® GeForce® RTX 2080, giving the gamers access to the world’s ultimate gaming architecture. The Applicant has designed the OBELISK computer system to appeal to the do-it-yourself crowd who traditionally don’t consider the pre-built machines. With DIY friendly, industry standard upgrade path, along with options for the latest graphics and processor architectures, gamers can achieve the performance they expect from games.

8. The Applicant submitted that the top features of the OBELISK gaming system include a sleek and refined black chassis that adheres to microATX standards with a tool-less access to the interior and a tool-less removal of up to two 3.5”drives, full-length graphics card support and room for an industry standard ATX power supply. Further, extensive venting on the top, bottom and sides takes advantage of thoughtfully placed components to generate optimal airflow.

9. The Applicant submitted that the details of the Applicant’s products under the name OBELISK can be accessed on the Applicant’s website <https://www8.hp.com/us/en/gaming/omen/obelisk.html>. This website is accessible by people across the world. The widespread publicity of the OBELISK products has resulted in enormous sales of the OBELISK products worldwide including India. The Applicant’s OBELISK products are available worldwide and in India through their website www.store.hp.com and through e-commerce websites such as Ubuy & Tanotis, India. The continued use and immense popularity of the OBELISK products have

resulted in the Applicant's mark to have acquired distinctiveness in the world market including India.

10. The Applicant submitted that it is a well-known company in India and the consumers/ purchasing public are well aware of the products sold under the HP house brand including the OBELISK products. This can further be evidenced by the reviews provided by the gaming enthusiasts throughout the world including India. These reviews are available on the internet and a person from any corner of the world can access such reviews in order to make an informed choice to purchase the Applicant's products.

11. The Applicant submitted that it has sought to protect its OBELISK trademark in India and in furtherance to the same has filed an application on June 06, 2019, under no. 4198508 in class 09 for "Computers; personal computers; laptop computers; notebook computers; desktop computers; computer hardware; computer peripherals; computer monitors; computer display screens; computer keyboards; computer mice". Through the official examination report issued by the Trade Mark Registry, the Applicant learned about the trademark no. 3227569 for the mark OBELISK in class 09 belonging to Respondent No.1 (hereinafter referred to as "impugned mark"). The said mark was cited as a conflicting mark in the official examination report. On a perusal of the Trade Marks Registry website for the impugned mark it was ascertained that the trademark application has been filed by one Mr. Ronak Bharat Shah on April 04, 2016, on a 'proposed to be used' basis in relation to "cabinets for loud speaker, microphones, USB flash drives, transmitters (telecommunications) and charger for electrical batteries".

12. The Applicant submitted that the present action concerns the Applicant's intellectual property rights in the OBELISK trademark in class 9 and violation thereof by the Respondent No. 1 on account of their registration of the identical impugned mark OBELISK.

13. The Applicant submitted that it is relevant to note that the application for the impugned mark was filed on April 04, 2016, on a 'proposed to be used' basis. In this regard the Applicant has engaged an investigator to ascertain whether the impugned mark is in use and also whether the OBELISK branded products are available. The inquiries conducted by the investigator has revealed that Respondent No. 1 till date has not used the mark OBELISK for any goods in relation to which the trademark is registered. Therefore it can be clearly inferred that Respondent No.1 has blocked the Register for now more than 4 years with no bonafide intention to use the mark. Respondent No.1 is simply trafficking in trademarks and has no intention to use or actual use of the mark. The Respondent No. 1 has made no preparation to use the mark and has not appeared inspite of service indicating that he has given up his rights in the mark. The Applicant has filed Affidavit of Rakesh Chhabra with regard to the market inquiries conducted to ascertain use of the mark OBELISK by Respondent No. 1.

14. The Applicant submitted that it is a "person aggrieved" within the meaning of Sections 47 and 57 of the Act as the continued subsistence of the impugned mark without any use or bonafide intention to use the same unduly blocks the Register thereby hampering the smooth registration of the Applicant's genuine and bonafidely adopted mark OBELISK. Thus, the Applicant filed the instant rectification petition for removing/cancelling the mark OBELISK under number 3227569 in Class 9 from the Register.

15. The Applicant submitted that the Respondent No.1 was served by IPAB on Respondent No. 1 official email dated August 07, 2020. The Respondent No. 1 was directed to file counter statement within two months. Thus, the Respondent no. 1 was required to file counter statement by October 07, 2020. However, till date Respondent No. 1 has not filed the counter statement. This clearly shows that Respondent No. 1 has no interest or intention to use the trademark OBELISK nor does it intend to contest the rectification proceedings.

16. The Applicant submitted that the Respondent No. 1 had filed the application for registration of the impugned mark OBELISK on April 04, 2016, for broad specification of goods viz., "cabinets for loud speaker, microphones, usb flash drives, transmitters (telecommunications) and charger for electrical batteries" included in

class 09. The Applicant submitted that Respondent No.1 till date has not used the impugned mark in respect of the goods for which the mark is registered. The fact that the impugned mark has not been in use is substantiated by the inquiries conducted by the Applicant and an affidavit has also been filed in this regard. Thus, the Respondent No. 1 had registered the mark without any bonafide intention to use it in relation to the aforesaid broad specification of goods and there has, in fact, been no bonafide use of the impugned mark by the Respondent No. 1 upto a date three months before the date of this application. Therefore, the impugned registration is liable to be rectified under Section 47 (1)(a) of the Act.

17. The Applicant submitted that the Respondent No.1 has obtained registration for the impugned mark OBELISK under no. 3227569 in class 9 without sufficient cause and is wrongly remaining on the Register. The Respondent No. 1 has obtained registration of the impugned mark covering the specification of goods under class 09 with a view to simply block the Register to thwart competition, while they have had no actual intention to carry out business under the goods for which registration is sought. Therefore, existence of impugned registration is without sufficient cause and is an entry wrongly remaining on the Register which is liable to be rectified under the provisions of Section 57(2) of the Act.

18. The Applicant relied on the case of Hardie Trading Ltd. and Anr vs Addisons Paint And Chemicals Ltd(decided by Supreme Court on 12 September, 2003), wherein the court held that the expression 'person aggrieved' has to be liberally construed'. Further, the court observed that "Wherever it can be shown, as here, that the Applicant is in the same trade as the person who has registered the trade mark, and wherever the trade mark, if remaining on the Register, would, or might, limit the legal rights of the Applicant, so that by reason of the existence of the entry on the Register he could not lawfully do that which, but for the existence of the mark upon the Register, he could lawfully do, it appears to me he has a locus standi to be heard as a person aggrieved."

19. The Applicant submitted that the Applicant is a 'person aggrieved' considering that the Respondent No. 1 has obtained registration of the impugned mark covering the specification of goods under class 09 with a view to simply block the Register to thwart competition and the existence of the impugned registration is likely to cause damage and irreparable injury to Applicant's business and its rights in the OBELISK mark.

20. The Applicant stated that it enjoys exclusive rights to the use of the trademark OBELISK, which is established beyond doubt by extensive evidence and supporting documents adduced by the Applicant.

21. The Applicant submitted that it had discharged their burden of proof by showing that the registered mark has been wrongly registered and the registered proprietor has not filed the counter statement nor taken any steps to contest the instant rectification petition. This in turn shows that Respondent No.1 has no interest in the trademark OBELISK nor any intention to use the mark in relation to which it is registered.

22. The Applicant submitted that the contentions of the Applicant and the documents filed along with rectification petition remain unrebutted as no counter statement has been filed by Respondent No. 1. The Applicant has also filed an affidavit confirming that the impugned mark till date has not been used by the Respondent No.1 which substantiates the fact that it is an entry wrongly remaining on the Register. Thus, the Applicant is aggrieved by the registration of the impugned mark, it deserves to be removed from the Register.

FINDINGS OF THIS BOARD

23. We have gone through the submissions of the counsel for the Applicant and material placed on the record. It is admitted position that the Applicant is prior adopted and using the mark OBELISK. Respondent No.1 despite service has not appeared before this Board. The Respondent No.1 had fraudulently adopted the mark OBELISK and obtained Registration under Application No. 3227569 in class 9.

24. Given the long and extensive use and promotional initiatives undertaken by the Applicant worldwide, it is incomprehensible that the Respondent No.1 was unaware of the prior use, registrations, goodwill and reputation of the Applicant's OBELISK trademark. Thus the adoption of the impugned mark by the Respondent No.1 for conflicting goods is dishonest, fraudulent and solely motivated to encash upon the goodwill attached to the above trademarks of the Applicant. It is likely to create an unmistakable impression in the minds of consumers that the services offered by the Respondent No.1 are somehow associated with the Applicant. 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.

25. 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 57 (2) of the Trade Marks Act, 1999 and Under Section 47 for non-usage of the mark by the Respondent No.1 despite Registered to it.

26. Respondent No.1 has not appeared for the past hearings. It appears that Respondent No.1 is not interested to contest the matter. The Respondent No.1 is not the proprietor of the trade mark. Thus the mark is wrongly remaining on the Register and is liable to be removed.

27. In order to maintain purity of the register, trademark OBELISK bearing registered No. 3227569 in class 9 is ordered to be removed from the Register forthwith on the grounds that it is wrongly registered by Respondent No.2 and is covered under the provisions of Section 47 and Section 57 of the Trade Marks Act, 1999. The Respondent no 2 shall remove the entry immediately from the record of the Register of Trademarks.

28. Copy of order is to be served to Respondent no 2 for compliance.

29. There shall be no orders as to the Costs.

-SD/-

**(Ms. Lakshmidevi Somanath)
Technical Member (Trademarks)**

-SD/-

**(Shri. Makyam Vijay Kumar)
Technical Member (Trademarks)**

-SD/-

**(Shri Justice Manmohan Singh)
Chairman**

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