



IPAB Intellectual Property Appellate Board

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ORA/7/2019/TM/CHN

TUESDAY, THIS THE 22ND DAY OF DECEMBER, 2020

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

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

RPG ENTERPRISES LIMITED
463, DR.ANNIE BESANT ROAD
WORLI, MUMBAI - 400030

: APPLICANT

(Represented by Mr. Himanshu Deora)

Versus

R.PARAMAGURU
TRADING AS: M/S. RPG EXPRESS PARCEL
NO:14/47, STANES ROAD,
3RD STREET, NEAR VINAYAGAR KOVIL,
ODAKKADU, TIRUPPUR - 641602,
TAMIL NADU


THE REGISTRAR OF TRADE MARKS
TRADEMARKS REGISTRY
BOUDHIK SAMPADA BHAVAN
G.S.T. ROAD
GUINDY CHENNAI - 600032

: RESPONDENTS

(Represented by None)




ORDER






Hon'ble Ms. Lakshmid devi Somanath, Technical Member (Trade Marks)

1. The Rectification Application is filed under Section 57 of Trademark Act, 1999 for Removal of the Registration No. 3399076 for the mark "" in class 39 in the name of Respondent No.1. The application for the impugned registration has been filed on 27/10/2016 claiming use since 14/04/2014 and the sealing date for the registration certificate is 15/05/2017.
2. There is no representation on behalf of the Respondents at this and on the last few hearings.
3. The details of the Impugned registered Trade Mark are :

Trade Mark No : 3399076
 Class : 39
 Trade Mark : 
 Date of Application : 27/10/2016
 First Date of Use : 14/04/2014
 Date of Advertisement : 26/12/2016
 Date of Registration : 05/10/2017
 Valid Till : 27/10/2026
 Goods : Parcel delivery services; transportation of parcels overnight; courier services for the delivery of parcels

4. The Applicant's details of Trade Mark, applied / registered in the name of Applicant herein are:

S. No.	Trade Mark	App. / Reg. No.	Class	Date of Application	Page No.
1.		2083063	05	11/01/2011	183
2.	RPG Life	2409620	05	11/10/2012	185
3.	RPG Life Sciences	2409621	05	11/10/2012	187
4.	RPG Pharmaceuticals	2409622	05	11/10/2012	189
5.	RPG LIFE SCIENCES LIMITED	2409623	05	11/10/2012	191
6.		3549247	05	15/05/2017	193
7.		3549248	05	15/05/2017	195
8.	RPG LIFE SCIENCES DIRECT	3571200	05	15/06/2017	197
9.	RPG LIFE SCIENCES GENERIC	3571201	05	15/06/2017	198

10.	RPG LIFE SCIENCES GENERIC PLUS	3571202	05	15/06/2017	199
11.	RPG LIFE SCIENCES PLUS	3571203	05	15/06/2017	200
12.	RPG LIFE SCIENCES CARE	3571204	05	15/06/2017	201
13.		851098	09	13/04/1999	204
14.		2083064	09	11/01/2011	-
15.		850255	12	08/04/1999	202
16.		850256	16	08/04/1999	203
17.		2083065	30	11/01/2011	206

RPG Trade Mark Registered in Other Countries

S. No.	Trade Mark	App. / Reg. No.	Class	Country	Registration Date
1.		2008/039324	12	Nepal	13/08/2012
2.		4-1999-009171	12	Philippines	30/10/2004
3.		T9901537I	09	Singapore	18/12/2012
4.		35971	12	Vietnam	09/11/2009
5.		62470	12	Bangladesh	09/11/1996

5. Applicant submitted that it is also the registered owner of the copyright work-



vide copy right registration certificate No.A-49373/88CO dated June 30, 1988 issued by the Deputy Registrar of Copy Right. Applicant holds copyright for the artistic layout, get up and design of its said **RPG Logo**.

FACTS OF THE CASE

About the Applicant

6. As per the written submissions of the Applicant, it is a multi-group conglomerate which consists of various companies operating under the parent organization. These companies, identified as RPG Group Companies use “RPG logo” and trade mark “RPG”. The acronym “RPG” stands for the initials of the founder of the RPG Group Mr. R.P. Goenka. the trademark RPG was honestly adopted in the year 1979 and ever since then, it has been used continuously, extensively and uninterruptedly as a trademark as well as a part of corporate name.

7. Applicant submitted that RPG Group consists of several companies across core sectors of the economy. RPG Group, through its subsidiaries, operates in/manages diverse business interests in the areas of Power, Tyre, Transmission, IT, Retail, Entertainment, Carbon Black, Procurement and Construction (EPC), Railway signalling, Cable, Solar, civil and engineering, energy, properties, and plantation businesses in India and internationally.
 - a. Ceat Limited/Ceat Tyres
 - b. Ceat Speciality Tyres Limited
 - c. KEC International Limited- Infrastructure and Electric Power Transmission Tower, Power Transmission Engineering, Procurement and Construction (EPC), Railway Signalling, Cable, Solar, civil and engineering, and distribution
 - d. RPG Cables Limited (now Cable SUB of KEC International Ltd.)
 - e. ZENSAR Technologies Limited:a global information technology services and business process outsourcer
 - f. Harrisons Malayalam Limited: Petitioner operates in the field of agriculture under the name Harrisons Malyalam Limited, a one hundred and fifty year old company
 - g. Raychem RPG Private Limited -engineering products and services catering to the infrastructure segments of the economy such as power, telecommunications, hydrocarbon, oil & gas and water.
 - h. Seniority Limited:an online portal for old age-senior-care, Seniority/ senior care e-commerce.
 - i. RPG PROPERTIES LLP- Real estate and agriculture business.
 - j. Spencer International Hotels Limited- In business of hospitality.
 - k. RPG Academy of Art and Culture- it supports, encourages and promotes Indian art in various forms and has organised several art exhibitions for talented artists at prestigious venues such as the Jehangir

Art Gallery in Mumbai.

1. RPG LIFE SCIENCES LIMITED. [history dating back to 1983] RPG Life Sciences Limited (RPGLS) is an Indian pharmaceutical Co. specialising in manufacturing and marketing of bulk drugs, also known as API, (Active Pharmaceutical Ingredients), pharmaceutical formulation and fermentation & biotechnology, having presence in more than 30 countries including India


8. The Applicant submitted that it is now a well –known name across its core sectors by virtue of the strong association with the name of the group ‘RPG’. The Applicant has honestly adopted the distinctive and unique trade mark RPG. Further, the trade mark ‘RPG’ also serves as the trading name/house mark of the Applicant. The mark RPG has been used for a very long period of time and has, as of date, created an indelible association in the minds of the general public.

About the Applicant’s Trademarks


9. The Applicant submitted that it has numerous applications and registrations for the “RPG Marks” as submitted before us. The Applicant submitted that it has been using the trademarks RPG, **RPG**, RPG LIFE SCIENCES LIMITED and £ RPG LIFE SCIENCES.

10. The Applicant submitted that owing to the goodwill and reputation which the Applicant enjoys, the RPG Marks qualifies to be afforded the status of well known trade marks in India. The goodwill and reputation of the Applicant can be gauged from the fact that the Applicant incurred group revenue of Rs.22,000 crores in the year 2017. Applicant and its group companies have strong and indubitable presence in the territory of India. Applicant further submitted that owing to the extensive, exclusive, continuous and long-running use and extensive promotion of the prior and famous RPG Marks through India and worldwide, Applicant has acquired valuable common law rights. The consumers both know and associate the prior and famous RPG Marks with the Applicant and the Applicant only. Further, the details of the sales turnover and license fees earned by the Applicant’s one of the group companies namely RPG Life Sciences Limited, from 2011 to 2017 were submitted before us. Applicant’s group companies also exports its products to various countries including, but not limited to, Brazil, Argentina, Mexico, Canada, UK, Iran, Indonesia, Malaysia, Saudi Arabia, Egypt, France and Germany. The Applicant has been



granted an Import Export Code and the relevant certification thereof.

11. The Applicant submitted that it has also invested immense capital in advertising and popularizing the course offered under the RPG Marks. The Applicant further submitted that has an extensive presence on internet and owns various domain names/ websites including but not limited- www.rpggroup.com, www.rpglifesciences.com, www.raychemrpg.com, www.rpgables.com, www.kecrpg.com, etc. The said websites clearly displays the RPG Marks and the goods and/ or services which are marketed and offered by the Applicant and are accessible in the whole of India and worldwide, thus, increasing awareness of the Applicant's **RPG Marks**. Applicant is active on social media and has substantial following on popular social media websites like Facebook, Twitter and LinkedIn. The RPG Marks of the Applicant have thus acquired a high degree of distinctiveness and have earned a meaning as connotative of the goods of the Applicant. The consumers both know and associate the brand RPG and the associated trademarks with the Applicant and the Applicant only.
12. The Applicant submitted that it filed a civil suit numbered CS(COMM) 21/2018 before the Hon'ble High Court of Delhi and vide its interim order dated January 10, 2018, the Hon'ble Court was pleased to restrain RPG Developers Private Limited, its directors, employees, agents, representative and assigns from giving any service in any matter whatsoever and using the registered trade mark RPG and or RPG Developers.
13. The Applicant submitted that it has acquired reputation and goodwill in the prior and famous RPG Marks in various business segments and its reputation and goodwill is not restricted to any specific segment. Therefore, the prior and famous **RPG** Marks, particularly the trademark RPG and RPG Logo [] of Applicant, are today entitled to be protected as well-known trade marks in India, as per the provisions of Section 2(1)(zg) of the Trademarks Act, 1999.

Applicant's Case against Respondent No.1

14. The Applicant submitted that in or around August, 2018, while conducting a routine check of the TM Registry database, Applicant came across Reg. No. 3399076 for the impugned mark  in Class 39 in the name of R.Paramaguru Trading As : M/S. RPG Express Parcel- Respondent No. 1.


15. The Applicant submitted that the impugned mark covered under the impugned registration entirely incorporates the **RPG** Marks of the Applicant and also, the prominent and distinctive portion of the impugned mark is RPG. Therefore, the impugned mark is identical and/ or deceptively similar to Applicant's well-known **RPG** Marks. Further, the Applicant owns registration for the prior and famous **RPG** Marks in Class 16 (covering the goods namely *Paper & Paper articles, Cardboard & articles made there from, printed matter, Newspaper & Periodicals, Books, Photographs, all types of Stationery, Office Requisites (other than Furniture, Instructional & Teaching Materials, Printers types & cliches.)*, which are similar and/ or cognate to the services covered under the impugned registration (namely- *Parcel delivery services; transportation of parcels overnight; courier services for the delivery of parcels*). Therefore, there exists a strong likelihood of confusion on the part of the public which includes likelihood of association or a commercial relationship with Applicant's marks. The impugned registration therefore is in contravention of the provisions of Section 11(1) of the Trade Marks Act, 1999. Even otherwise, it was further submitted by the Applicant that its marks today qualify as well-known trademarks and therefore, any use of the impugned mark, in respect of any goods and/ or services, would without due cause take unfair advantage of and be detrimental to the distinctive character and repute of the Applicant's earlier and well-known **RPG** Marks. The Applicant submitted that the impugned registration therefore is in convention of the provisions of Section 11(2) of the Trade Marks Act, 1999. A side by side comparison of the competing marks was placed before us by the Applicant-

Applicant's famous RPG Marks	Resp. No. 1's impugned mark
	
<p>The points of similarity highlighted by the Applicant were-</p> <ul style="list-style-type: none"> • Identical word mark- RPG 	

- The colour combination is identical and/ or deceptively similar to the Applicant's RPG Marks
- The impugned mark also includes a device of bird which is similar to the device used by the Applicant in its trademark-



ARGUMENTS ADVANCED BY THE APPLICANT

16. Learned Counsel for the Applicant argued that the impugned registration has been obtained by the Respondent No. 1 with *mala-fide* intention and concealment of material facts and information. It was argued that the Respondent No. 1 has wrongfully obtained a registration for the impugned mark  which entirely incorporates the **RPG Marks** of the Applicant and is therefore nearly identical to the trademarks in which the Applicant has obtained prior rights. It was argued that the impugned registration was therefore in contravention of the provisions of Section 11(3) of the Trade Marks Act, 1999.
17. It was argued that the Applicant is being prevented by reason of subsistence of the said impugned registration on the Register and from the mala-fide conduct of its business activities (if any) as a legitimate prior user and adopter of the same in relation to the goods. The impugned mark is liable to be cancelled as the same was registered with *mala-fide* intention to cash upon the goodwill and reputation of the Applicant and is an entry wrongly remaining on the Trade Marks Register, and without sufficient cause.
18. The Applicant argued that the factum of lack of any *bona fide* intention on part of the Respondent No.1 is evident from the fact that the application for registration of the impugned mark was filed on 27th October, 2016 with false use claim of 14th April, 2014 and the Respondent No. 1 is therefore not entitled to maintain the impugned registration under Section 11(10) of the Trade Marks Act, 1999.. There are no cogent documents filed by the Respondent No. 1 to prove its claim of use. The Applicant also argued that even if the Respondent No. 1 has any use, the same will not give any special rights to the Respondent No. 1 to infringe and/or ride upon the goodwill and reputation of the Applicant's earlier and well-known **RPG Marks**.
19. The Applicant submitted that in its capacity as the owner of the RPG Marks, it has never consented to the registration of the impugned mark and the Respondent No. 1 is therefore not entitled to rely upon Section 11(4) of the

Trade Marks Act, 1999. It was argued that the registration granted in the name of the Respondent No. 1 is contrary to the various provisions of the Trade Marks Act, 1999. The Respondent No. 1 cannot therefore claim to be the proprietor of the impugned mark under Section 18(1) of the Trade Marks Act, 1999. The Respondent No. 1 is not entitled to maintain the impugned registration under Section 12 either. Thus, the impugned registration violates the provisions of Section 11(10) (ii) of the Act. And was therefore wrongly granted in contravention of the provisions of Section 11 of the Act.

Judgements relied upon by the Applicant:

20. The following judgments were relied on by the Counsel for the Applicant:

i. In KSB Aktiengesellschaft and Ors. Vs. KSB Global Limited, 2011(45)PTC 103(Del), Applicant relied on the Hon'ble Court's observations as under-

“12.1 The defence taken by the Defendant that 'KSB' is a derivative of a family name, assuming that to be true, the same is untenable. This for the reason that the plaintiffs' trade mark 'KSB' has gained both in India, and in several countries across the world, a reputation. The annual sales turnover of the 'KSB' even in 1995 was several Rs 100 crores. Therefore, the Defendant's use of the mark 'KSB' cannot be permitted as it is bound to create a confusion in the minds of the trading community as well as its customers. The products of the plaintiffs are used; amongst others, by agriculturists. At least a significant section of its customers are bound to associate the goods supplied by the Defendant as those originating from the plaintiffs. The argument of the learned Counsel for the Defendant that it is the partnership firm which is in the business of selling pipes and fittings, and, therefore, no case can be made out against the Defendant, is a contention which will have to be rejected, in the facts and circumstances of this case; for the reason that: the Defendant's own pleadings and the evidence placed on record clearly demonstrate that the line of demarcation of business between the two is completely blurred. The submission of the learned Counsel for the Defendant that Section 35 of the Trade Marks Act permits the Defendant to use its family name, which includes any abbreviation of a name, as part of its business, will have to be rejected in this particular case, as the evidence on record demonstrates that the conditions stipulated therein that the use of the name has to be bona fide is not established in the instant case. I am, however, not in agreement with the submission of the learned Counsel for the plaintiff that the defence under Section 35 of the Trade Mark is restricted only to individuals and that a juristic entity cannot take resort to the provisions of Section 35 of the Trade Marks Act. There are no such limitation in Section 35 of the Trade Marks Act.”

- ii. In the case of Larsen and Toubro Limited Vs. LachmiNarain Trades and Ors., 2008(36)PTC 223(Del), Applicant relied on the Hon'ble Court's observations as under--

“12.As rightly held by the learned Single Judge the test of 'field of activity' is no more valid. The question really is one of real likelihood of confusion or deception among the consumers and the resultant damage to the plaintiff. The legal position on the subject is fairly well settled by a long line of decisions rendered by this Court as also the Apex Court.” (underline added)

- iii. In DPS World Foundation and Ors. Vs. Delhi Public School Society, FAO (OS) (Comm.) 21/2016- MANU/DE/0924/2017, the Hon'ble Division Bench of Delhi High Court, confirmed the injunction order passed by the Ld. Single Judge restraining the Defendants from using the mark 'DPS World Foundation' for educational services/ schools, as the Defendant's mark 'DPS World Foundation' incorporated the Appellant/ Plaintiff's trademark 'DPS'.

- iv. In the case of Honda Motors Co. Ltd. Vs. Mr. Charanjit Singh and Ors., 2003(26)PTC1(Del), the Hon'ble Delhi High Court restrained the Defendants from using the mark HONDA in respect of the different goods namely pressure cookers, and Applicant relied on the Hon'ble Court's observations as under--

“43. As observed above, the concept of passing off is a tort and with the passage of time, with the developing case law it has changed and now the two traders need not necessarily operate in the same field so as to suffer injury on account of the goods of one trader being passed off as those of the other.

44. With the changed concept of passing off action, it is now not material for a passing off action that the plaintiff and the defendant should trade in the same field. I find that some business are truly international in character and the reputation and goodwill attached to them cannot in fact be held being international also. The plaintiff's business is of international character and obviously the reputation and goodwill attached to its trade mark HONDA is also of international repute. The plaintiff's trade mark HONDA, which is of global repute, is used by the defendants for a product like pressure cooker, to acquire the benefit of its goodwill and reputation so as to create deception for the public who are likely to buy defendant's product believing the same as coming from the house of HONDA or associated with the plaintiff in some manner. By doing so, it would dilute the goodwill and reputation of the plaintiff and the wrong committed by the defendants would certainly be an actionable wrong and the plaintiff is within its rights to ask for restraint against the defendants from using its

mark HONDA for their products.”

- v. In the case of *Sony Kabushiki Kaisha Vs. Mahaluxmi Textile Mills, 2009(41)PTC 184(Cal)*, the Hon’ble Full Bench of Calcutta High Court held that the similarity of the goods of the rival traders is not an essential requisite for maintaining an action for passing off and Applicant relied on the Hon’ble Court’s observations as under--

“15. From these authorities, it is apparent that similarity of the goods of the rival traders is not an essential requisite for maintaining an action for passing off. In the case of Mahendra & Mahendra Paper Mills Ltd., the defence of dissimilarity in the field of operation was taken. This argument was not accepted, and it was held by the Hon'ble Supreme Court:

23. Judging the case in hand on touchstone of the principles laid down in the aforementioned decided cases, it is clear that the plaintiff has been using the word "Mahindra" and "Mahindra & Mahindra" in its companies/business concerns for a long span of time extending over five decades. The name has acquired a distinctiveness and a secondary meaning in the business or trade circles. People have come to associate the name 'Mahindra' with a certain standard of goods and services. Any attempt by another person to use the name in business and trade circles is likely to and in probability will create an impression of a connection with the plaintiffs' group of companies. Such user may also effect the plaintiff prejudicially in its business and trading activities. Undoubtedly, the question whether the plaintiffs' claim of 'passing off' action against the defendant will be accepted or not has to be decided by the Court after evidence is led in the suit. Even so for the limited purpose of considering the prayer for interlocutory injunction which is intended for maintenance of status quo, the trial Court rightly held that the plaintiff has established a prima facie case and irreparable prejudice in its favour which calls for passing an order of interim injunction restraining the defendant company which is yet to commence its business from utilising the name of 'Mahendra' or 'Mahendra & Mahendra' for the purpose of its trade and business. Therefore, the Division Bench of the High Court cannot be faulted for confirming the order of injunction passed by the learned Single Judge.”


- vi. In the case of *FDC LIMITED Vs. DOCSUGGEST HEALTHCARE SERVICES PVT. LTD. & ANR., 2017(69) PTC 218*, the Plaintiff was using the registered mark 'Zifi' for goods falling under Class 05 of the Schedule of the Act i.e. pertaining to pharmaceutical preparations. On the other hand, the Defendants were using the mark 'Ziffi' for booking of appointments for doctors, diagnostics, spas and salons, and applied for registration under Class 35 and 42 of the Schedule of the Act. It was the submission of the defendant that goods and services falling under different classes cannot be allied and cognate. The Delhi High Court rejected the submissions of the Defendants and held that the classification

of goods and services under Section 7 of the Act is not the criterion for deciding the question of similarity in goods/services (Para 48). The Court found that the Plaintiff's goods are similar to and associated with the defendants' services and restrained the Defendants from using the mark 'Ziffi'.

vii. In the case of Allied Auto Accessories Ltd. Vs. Allied Motors Pvt. Ltd. and Ors., 2003(27)PTC 115(Bom), the Hon'ble High Court of Bombay observed that guidelines or classification lists which are published by the Trade Marks Registry are only administrative guidelines.

viii. Reliance was placed on the judgement of Hon'ble Delhi High Court in Suresh Kumar Jain Vs. Union of India and Ors., 2012(49)PTC 287(Del) – Para-3 & 4, and Vivek Kochher and Ors. Vs. KYK Corporation Ltd. and Ors., 2018(74)PTC 120(Del)- Para-18, 19 and 20.

COMPARISON OF THE MARKS

21. We have examined the Impugned Trade Mark  and find that the impugned mark is deceptively similar to the Applicant's RPG trademark and various other trademarks of the Applicant containing RPG. The impugned mark, therefore, cannot qualify for protection as a trademark under any circumstances as members of the trade and public would invariably associate the same with the Applicant. Thus the impugned mark is incapable of distinguishing the Respondent No.1's goods from those of the Applicant.

INTENTION OF THE RESPONDENT

22. It is seen that the goods offered by Respondent No-1 under said deceptively similar impugned trade mark are also allied goods to that of the Applicant. The behavior of the Respondent No-1 is having copied various elements of the Applicant's marks, including the phonetic element RPG and the visual element of the bird in flight, and combining them, evinces that they had deliberately and fraudulently adopted the impugned mark in respect of similar and allied goods and has applied for registration thereof, in order to establish a connection between the impugned marks and the Applicant's goodwill and reputation, and having full prior knowledge about Applicant's exclusive proprietorship over the RPG series of trademarks and the reputation and goodwill attached to the Applicant's marks. The impugned mark has been used on similar and allied goods in a manner so as to evince malafide on the part of the Respondent No.1.

FINDINGS

23. We understand that the Applicant is an Indian business conglomerate, operating in diverse business sectors. Applicant has generated extensive sales for its products and services under the trademark/ trade name RPG, which is evident from the fact that for the year 2017 itself, the Applicant's sales were Rs. 22,000 crores. It has also been exporting its products to other countries. Today, the Applicant's trademark/ trade name RPG has acquired extensive goodwill and reputation in India and also, in other countries. By virtue of the same, the trademark/ trade name RPG is associated with the Applicant and the business or products under the trade mark/ trade name RPG has acquired such goodwill and reputation that it has become distinctive of its products/ services.
24. We find that the impugned mark is deceptively similar to the Applicant's prior used and registered RPG trademark and various other trademarks containing RPG. 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 including *Roche & Co. v. Manners & Co. (P) Ltd.*, AIR 1970 SC 2062, *Parle Products v. J P & Co.* AIR 1972 SC 1359, and *Cadila Health Care Ltd. v. Cadila Pharmaceuticals Ltd.* [2001 CLC 564 the Apex Court has observed that 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. Mere use of the terms 'Express Parcel' will not make the impugned mark dissimilar from that of the Applicant since 'RPG' is the prominent and distinctive portion of the impugned mark, and the term 'Express Parcel' merely describes the services covered under the impugned mark and has no trade mark value. In this regard, the reliance is placed on *Ruston and Hornsby Ltd. Vs. Zamindara Engineering Co.*, 1970 AIR(SC) 1649, wherein the Defendant was using the mark 'RUSTAM INDIA' and the Hon'ble Supreme Court of India observed that- "8..... If the respondent's trade mark is deceptively similar to that of the appellant the fact that the word 'INDIA' is added to the respondent's trade mark is of no consequence and the appellant is entitled to succeed in its action for infringement of its trade mark." This was also relied on in *Greaves Cotton Limited V. Mohammad Rafi &ors*, 2011 (46) PTC 466 (Del.)
25. Further the Hon'ble Supreme Court in *Mahendra & Mahendra Paper Mills Ltd. v. Mahindra & Mahindra*, [2002 2 SCC 147] laid out certain guidelines on deceptive similarity resulting in infringement by capitalizing on the goodwill and

reputation of the original trader. This was relied on in a plethora of decisions including *Standard Electricals Limited vs Rocket Electricals And Anr. 2004 (28) PTC 26 Del.* In the present case, the Respondent No.1's mark is deceptively similar to the trademarks of the Applicant.


26. The concept of well known mark, first elaborated on in cases such as *Daimler Benz Aktiengesellschaft & Anr v. Hybo Hindustan, AIR 1994 Del 2369* and was further expanded in *Kamal Trading Co., Bombay and Others v. Gillette U.K. Limited, Middle Sex, England, 1998 PTC 288 DB, Kirloskar Diesel Recon Pvt. Ltd. v. Kirloskar Proprietary Ltd., AIR 1996 Bom. 146* and a plethora of subsequent decisions. We have also declared vide our judgement in TA/1/2007/TM/DEL/(C.M(M)) No. 148 of 2002 dt. 11/12/2009 that KIT KAT is a well-known mark having trans-border reputation. Further we also recognised the trans-border reputation enjoyed by the mark WOOLWORTH 2004 (29) PTC 477. Other marks we have declared well known are AMUL (OA/56/2011/TM/KOL), RAYMOND (OA/16-17/2010/TM/CH), SONY (OA/49/2007/TM/KOL), ENFIELD BULLET (2006(32) PTC 397), LETTER*T IN A CIRCLE (2006 (32) PTC 296), NIRMA for washing & cleaning preparations (2004(29) PTC 634), USHA For sewing machines, electric fans etc. (2004(29) PTC 647), Canon (Order in OA/43/2005). The RPG trade mark of the Applicant is well known to the public at large in India. It is an Indian industrial and services conglomerate with a long duration, extent and geographical area of usage of the aid trademark. The Applicant's mark is in use for four decades. The name has acquired a distinctive secondary meaning in the business or trade circles. The Applicant's trade mark RPG therefore qualifies as well known under Sec. 11(10) of TM Act 1999. In *Kirloskar Diesel Recon Pvt. Ltd. vs Kirloskar Proprietary Ltd., AIR 1996 Bom 149*, the Court while extending protection to the mark 'Kirloskar' stated that –“*in case of trading name which has become almost a household word and under which trading name a variety of activities are undertaken, a passing off can successfully lie if the defendant has adopted identical or similar trading name and even when the defendant does not carry on similar activity. Even if the defendant's activities in such circumstances, are remote, the same are likely to be presumed a possible extension of plaintiff's business or activities. In the instant case, the Respondents have established that word 'Kirloskar' has become a household word and their businesses cover variety of activities and that there is even a common connection with some activities of the Respondents and activities of the Appellants.*” We note that the services covered under the impugned marks (namely *Parcel delivery services; transportation of parcels overnight; courier services for the delivery of parcels*) are similar and/ or cognate to the Applicant's goods covered under Registration No. 850256 for the mark



in class 16. Even otherwise, the Petitioner's RPG Marks are

liable to be entitled to be protected across classes being a well-known trademark. Hence, any use of the impugned mark 'RPG Express Parcel' in respect of "*Parcel delivery services; transportation of parcels overnight; courier services for the delivery of parcels*" tends to mislead the public to believe that the Respondent No. 1's business and services 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 RPG Marks.

27. Also, the Respondent No. 1 has not contested the present matter by filing its counter-statement and the evidence to support its use date of 14/04/2014 made in the impugned registration. 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 RPG trademarks. 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.
28. The conduct of the Respondent No.1 shows that they have not come with clean hands in seeking the registration of the impugned Trade Mark and therefore, the application of the impugned trade mark should be regarded as having been made in "bad faith". 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.
29. The RPG trademarks is being used by the Applicant in India since the year 2001 and worldwide since 1979 and due to such long, continuous and extensive use, the mark is associated solely with the Applicant and none else. No other trader can therefore register the mark in their name. The registration of the mark in the name of Respondent No. 1 should therefore have been refused by the Respondent No. 2 as the same is against the law of passing-off.

30. 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.
31. Respondent No.1 has not appeared in this matter. 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. User, if any, was tainted and dishonest. Thus the mark is wrongly remaining on the Register and is liable to be removed.
32. In the light of above the Petition is allowed and Respondent No.2 is directed to delete the entry of registered Trade mark No. 3399076 for the mark  in class 39 in the name of R.PARAMAGURU TRADING AS: M/S. RPG EXPRESS PARCEL 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
33. No 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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