$~8

* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

Date of Decision: 13th December, 2023

\+ **C.A.(COMM.IPD-TM) 29/2022**

EMIL LUX GMBH AND CO. KG., EMIL-LUX-STRASSE 1 , 42929 WERMELSKIRCHEN, GERMANY ADDRESS FOR SERVICE IN INDIA , PERFEXIO LEGAL ATTORNEYS-AT-LAW 9655, SECTOR C, POCKET-9, VASANT KUNJ NEW DELHI-110070 ..... Appellant

Through: Mr. Darpan Wadhwa, Sr. Adv. with Dr. Sanjay Kumar, Ms. Arpita Sawhney, Mr. Arun Kumar Jana, Ms. Meenal Khurana, Mr. Harshit Dixit, Mr. Priyansh Sharma & Ms. Neelakshi Bhadauria, Advs. (M: 9810404749)

versus

THE SENIOR EXAMINER, TRADEMARKS ..... Respondent

Through: Mr. Harish V. Shankar, CGSC, Mr. Alexander Mathai Paikaday & Mr. Krishnan V, Advs. (M:9810788606)

CORAM:
JUSTICE PRATHIBA M. SINGH

Prathiba M. Singh, J. (Oral)

1. This hearing has been done through hybrid mode.

2. The present appeal has been filed challenging the impugned order dated 21st June, 2018 by which the Appellant's multi class application has been rejected on various grounds.

3. The Appellant-EMIL LUX GMBH CO. KG is a German company, which is stated to have been established sometime in 1918 by one Mr. Emil Lux. It is averred that the expression 'LUX' has been named after him. The trademark 'LUX' and its variants have been used by the Appellant since

Signature Not Verified
Digitally Signed
By:DHIRENDER KUMAR
Signing Date:18.12.2023
17:23:15

then internationally. According to the Appellant, the mark has come to be associated with the Appellant because of its continuous and exclusive use since 1920. The Appellant filed a multi class application seeking registration in various classes before the Trademark Registry on 21st February, 2013. The examination report cited various identical and similar marks and the application has been rejected by the impugned order.

4. Mr. Darpan Wadhwa, ld. Senior Counsel appearing for the Appellant submits that the Appellant has global registrations for the mark 'LUX' in several classes across the world including in Europe since 1931. The list of the said marks have been set out in paragraph 14 of the appeal. He further submits that in most of the classes, there are no cited conflicting marks. Even in those classes in which certain marks have been cited, the Appellant is willing to restrict the goods so as not to come in conflict with any earlier registered mark. He has taken the Court through a chart in order to deal with all the cited marks after which he submits that the restrictions may be enforced on the Appellant and the marks in the application be permitted to proceed for advertisement.

5. Mr. Harish Vaidyanathan, ld. CGSC on the other hand points out that in classes where there are cited marks, there are well known companies that use the trademark 'LUX' and there is a possibility of confusion and hence, objections under Sections 9 & 11 of the Trademarks Act, 1999.

6. The Court has considered the matter. The first and foremost fact that needs to be recorded are global registrations of the Appellant in various countries, which are set out in paragraph 14 of the appeal and are extracted below:

Signature Not Verified
Digitally Signed
By:DHIRENDER KUMAR
Signing Date:18.12.2023
17:23:15

Country Name	Class	Trade Mark	Application / Registration Number	Application/ Registration Date	Status
(IS) = WO	1, 10, 12, 16, 17, 18, 19, 20, 21, 22, 26, 3, 4, 6, 7, 8, 9	LUX	V0089699 = WO 1 163 422	2013-06-20	Registered
EM	1, 3, 4, 6, 7, 8, 9, 10, 12, 16, 17, 18, 19, 20, 21, 22, 26	LUX	011147361	2012-08-29	Registered

Signature Not Verified
Digitally Signed
By:DHIRENDER KUMAR
Signing Date:18.12.2023
17:23:15

DE	6, 1, 3, 4, 7, 8, 9, 11, 12, 16, 17, 18, 20, 21, 22, 24, 25, 26		DE30557533	2005-09-27	Registered
DE	7, 1, 3, 4, 6, 8, 9, 16, 17, 20, 21, 22		DE39944760	1999-07-28	Registered
DE	7, 1, 3, 4, 6, 8, 9, 16, 17, 20, 21, 22		DE39814674	1999-03-16	Registered
DE	7, 4, 6, 8, 9, 11, 17, 20, 22		DE1092468	1985-08-31	Registered
DE	7, 4, 6, 8, 9, 11, 17, 20, 22	LUX	DE1092467	1985-08-31	Registered
DE	7		DE995259	1979-05-25	Registered
DE	7	LUX	DE985747	1978-10-25	Registered

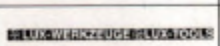
Signature Not Verified
Digitally Signed
By:DHIRENDER KUMAR
Signing Date:18.12.2023
17:23:15

DE	8, 6, 7, 26, 28	440528 	DE440528	1931-08-26	Registered
DE	8, 6, 7, 9, 17, 26, 28	437209 LUX	DE437209	1930-06-21	Registered
(IS) = WO	1, 11, 12, 16, 17, 18, 20, 21, 22, 24, 25, 26, 3, 4, 6, 7, 8, 9	LUX	V0064173 = WO 906994	2006-12-27	Registered
EM	1, 3, 4, 6, 7, 8, 9, 11, 12, 16, 17, 18, 20, 21, 22, 24, 25, 26		004355558	2005-03-22	Registered
WO	1, 3, 4, 6, 7, 8, 9, 10, 12, 16, 17, 18, 19, 20, 21, 22, 26	LUX	1163422		Registered
WO	1, 3, 4, 6, 7, 8, 9, 16, 17, 20, 21, 22		706107		Registered

Signature Not Verified
Digitally Signed
By:DHIRENDER KUMAR
Signing Date:18.12.2023
17:23:15

WO	1, 3, 4, 6, 7, 8, 9, 11, 12, 16, 17, 18, 20, 21, 22, 24, 25, 26		906994		Registered
WO	1, 3, 4, 6, 7, 8, 9, 16, 17, 20, 21, 22		751026		Registered
WO	7		450595		Registered
WO	6, 7, 8, 20		505095		Registered
WO	6, 7, 8, 20		671574		Registered
WO	7, 8, 16	LUX-TOOLS	716502		Registered

Signature Not Verified
Digitally Signed
By:DHIRENDER KUMAR
Signing Date:18.12.2023
17:23:15

EM	1, 3, 4, 6, 7, 8, 9, 10, 11, 12, 16, 17, 18, 19, 20, 21, 22, 24, 25, 26		011147345	2012-08-29	Registered
DE	7, 8, 16		DE39814861	1998-03-17	Registered
WO	1, 3, 4, 6, 7, 8, 9, 10, 11, 12, 16, 17, 18, 19, 20, 21, 22, 24, 25, 26		1183565		Registered
WO	1, 3, 4, 6, 7, 8, 9, 11, 12, 16, 17, 18, 20, 21, 22, 24, 25, 26	LUX - TOOLS	906993		Registered
(IS) = WO	1, 10, 11, 12, 16, 17, 18, 19, 20, 21, 22, 24, 25, 26, 3, 4, 6, 7, 8, 9	LUX – TOOLS	V0091298 = WO 1 183 565	2013-11-29	Registered

Signature Not Verified
Digitally Signed
By:DHIRENDER KUMAR
Signing Date:18.12.2023
17:23:15

US	1, 3, 6, 7, 8, 9, 16, 20, 21		85933295 4,779,813	2013-05-15	Registered
(IS) = WO	1, 11, 12, 16, 17, 18, 19, 20, 21, 22, 24, 25, 26, 3, 4, 6, 7, 8, 9	LUX – TOOLS	V0064172 = WO 906993	2006-12-27	Registered
DE	6, 1, 3, 4, 7, 8, 9, 11, 12, 16, 17, 18, 20, 21, 22, 24, 25, 26	LUX – TOOLS	DE30557534	2005-09-27	Registered
EM	1, 3, 4, 6, 7, 8, 9, 11, 12, 16, 17, 18, 20, 21, 22, 24, 25, 26	LUX – TOOLS	004355574	2005-03-22	Registered
DE	7, 8, 16	LUX-TOOLS	DE39856680	1998-10-02	Registered
DE	8	Emil Lux	DE251192	1920-05-18	Registered

Signature Not Verified
Digitally Signed
By:DHIRENDER KUMAR
Signing Date:18.12.2023
17:23:15

7. Insofar as the use of the mark in India, is concerned, ld. Senior counsel fairly concedes that the applications were filed on *proposed to be used* basis.

8. The Appellant has filed various documents before the IPAB which are part of the record and which show that the Appellant does have a presence on the internet as the website of the Appellant is also accessible in India. Considering that the marks are filed on a *proposed to be used basis* and after perusing the conflicting marks and the cited marks, ld. Counsel for the Appellant has also agreed to restrict the goods in some of the classes. On the strength of the said submissions made, the following order is passed in respect of each of the classes in which the Appellant has filed for registration of the mark LUX:

Class	**Goods Applied for**	**Particulars**	**Directions**
Class 1	Tempering and soldering preparations; Adhesives used in industry.	There is no cited or conflicting mark.	The mark can proceed for advertisement in Class 1.
Class 3	Cleaning, polishing and abrasive preparations; Abrasive paper.	There are several cited marks as this class relates to soaps, perfumes, toiletries, *etc*. They belong to another leading FMCG company in India as also to other companies who are engaged in the manufacturing of agarbati (incense sticks), *etc*. Considering the same, the Appellant has agreed to restrict the	Mark to proceed for advertisement only in respect of abrasive paper.

Signature Not Verified
Digitally Signed
By:DHIRENDER KUMAR
Signing Date:18.12.2023
17:23:15

		goods only to abrasive paper.	
Class 4	Industrial oils and greases; Lubricants; Dust absorbing, wetting and binding compositions; Fuels (including motor spirit) and illuminants.	No cited marks	Mark can proceed for advertisement.
Class 6	Common metals and their alloys; Materials of metal for railway tracks; Ores; Metal building materials; Transportable buildings of metal; Non-electric cables and wires of common metal; Ironmongery, small items of metal hardware; Pipes and tubes of metal; Goods of metal, included in class 6; Garage doors of metal; Tool chests of metal (empty); Safes; Locks (other than electric) of metal; Padlocks; Hoppers (non-mechanical) of metal; Ladders of metal, stepladders of metal; Pegs of metal; Wall plugs of metal; Fittings of metal for building; Fittings of metal for furniture; Pensioning and lashing straps; Rods of metal for brazing and welding; Soldering wire	No cited marks	Mark can proceed for advertisement.

Signature Not Verified
Digitally Signed
By:DHIRENDER KUMAR
Signing Date:18.12.2023
17:23:15

	of metal; Posts of metal; Wire rope; Workshop equipment. As far as included in international class 06, Including tool holders (aforesaid goods of metal); Tool boxes of metal (empty); Handles of metal for tools and garden implements; Carry straps of metal; Oil cans, special-purpose containers, included in class 06 (the aforesaid goods being of metal); Posts of metal for attaching marking aids, in particular barrier tapes and warning tapes; Gates of metal; Locksets; Pegs of metal; Wall plugs of metal; Trellis and Espaliers; Clips; Clips and nails for hand tackers; Metal garage door rollers; Rollers of metal for sliding doors.		
Class 7	Machines and machine tools. Machine coupling and transmission components (except for land vehicles); Agricultural implements other than hand-operated; Machines and machine tools. Namely colour mixing machines.	There is a cited and a conflicting mark.	Considering the cited marks, the Appellant's mark is restricted to agricultural implements, hand operated machine, machine tools, mechanical, horticultural and agricultural

Signature Not Verified
Digitally Signed
By:DHIRENDER KUMAR
Signing Date:18.12.2023
17:23:15

	Building machines. In class 7; Mechanical tools for construction, horticultural and craft purposes, mechanical horticultural and agricultural equipment; Compressors [machines]; Spray guns for paint. Compressed air guns for the extrusion of mastics. Electric glue guns. Electric Power Staplers; Pistols and pumps for applying paints, mastics and other viscous preparations; Gas-powered soldering irons; Drill chucks (parts of machines). Drilling machines. Electric hand drills. Nuttapping machines. Drill stands for electric hand drills; Planing machines; Trueing machines. Grinding discs (being a machine part). Cutting discs (parts of machines). Grinding wheels (parts of machines); Saws (machines). Chain saws; Current generators; Welding apparatus, gasoperated; Welding machines, electric; Lawnmowers (machines). Scarifiers		equipment, soldering irons. The mark shall not be registered for household appliances and parts thereof.

Signature Not Verified
Digitally Signed
By:DHIRENDER KUMAR
Signing Date:18.12.2023
17:23:15

	(other than hand-operated); Tillers (other than hand-operated); Soil ventilators (other than hand-operated); Snow blowers (other than hand-operated); Snow shovels (other than hand-operated); Snow sweepers (other than hand-operated); Parts for motors and engines, namely spark plugs for internal combustion engines, mufflers for motors and engines (exhausts), petrol and oil filters, filters for cleaning cooling air for motors and engines, cylinders for motors and engines, cylinder heads for motors and engines, pistons for motors and engines, piston rings; Electric roller blind drives. Electric drives for garage doors; Elevators, In particular hoists; Electric arc welding apparatus; Lathes (machine tools); Electric turning machines; Electric straw cutting machines, motorised straw cutting machines; Grindstones (machine parts); Machines for tile laying, gas concrete and		

Signature Not Verified
Digitally Signed
By:DHIRENDER KUMAR
Signing Date:18.12.2023
17:23:15

	dry construction, stone, screed and concrete works, electrical and sanitary installation, masonry, parquet floor, laminate and carpet laying, plastering, painting, wallpapering and welding; Electric tools for construction and DIY, including tool bits therefor; Cordless screwdrivers, chainsaws, grinders, polishers; Drilling hammers. Electric planers. Tile cutting machines, small electric tools. Electric staplers. Electric milling machines; Mechanical garden implements, including lawnmowers and grass-trimming machines; Border shears and chainsaws, and accessories for mechanical garden equipment, namely collecting devices and apparatus covers; Spare parts for mecharucal garden tools, included in class 7; Driving machines for tools; Mobile generators; Soldering and welding machines (gas operated);Compressed air tools; Lathes (machine operated);		

Signature Not Verified
Digitally Signed
By:DHIRENDER KUMAR
Signing Date:18.12.2023
17:23:15

	Wood-turning lathes (machine-operated); Pressure spraying devices (machine-operated); Couplings other than for land vehicles; Grinding inserts, grindstones and replacement parts for the aforesaid goods; Rollers and wheels for machines; Soldering irons, electric; Welding apparatus.		
Class 8	Manually operated tools; Hand-operated implements for agricultural, horticultural and forestry purposes, and for structural engineering; Hand-operated vaporisers; Hand operated guns for applying paints, mastics and other thick fluid products. Guns, hand-operated, for the extrusion of mastics; Spatulas [hand tools]; Snow shovels (hand tools); Ice scrapers; Sharpening stones; Tackers (hand-operated); Hand-operated riveting tools; Trowels; Saws (hand tools); Files [hand tools]; Clamps for carpenters or coopers; Tongs [hand tools];	The cited mark appears to have not been renewed and the last renewal was only upto 12th May, 1966.	The Appellant's application shall proceed for advertisement.

Signature Not Verified
Digitally Signed
By:DHIRENDER KUMAR
Signing Date:18.12.2023
17:23:15

	Screwdrivers; Wrenches (hand tools); Hammers (hand tools); Axes; Lawn clippers (hand instruments); Border shears; Planes; Stationery scissors; Riveting pincers; Scraping tools (hand tools); Hand tools for tile laying, gas concrete and dry mortarless construction. stone, screed and concrete works, electrical and sanitary installation, masonry, parquet'floor, laminate and carpet laying, plastering; Painting and welding; Hand tools, including cutting, separating, embossing and striking tools, in particular Japanese chisels, borers, rasps, thread cutters, planes, trowels, chisels, screwdrivers, socket wrenches and socket wrench sets, vices, pliers, toolholders, hand operated grippers and carrying equipment, including stone-carrying equipment, sanding blocks, ferrules of metal, hand riveters, eyelet pliers; Hand-operated tile cutting		

Signature Not Verified
Digitally Signed
By:DHIRENDER KUMAR
Signing Date:18.12.2023
17:23:15

	apparatus, knives, in particular pocket knives, cutter lames, glass cutters, carpet knives, blades, cutters; Scissors, including household scissors, secateurs, branch, tree and hedge clippers, hand-operated garden implements, including forks, hoes, spades, shovels, rakes, sickles, scythes, trimmers and hand-operated lawnmowers; Hand operated vaporisers; Hand-operated pneumatic apparatus; Spare parts for the aforesaid goods; electric flat irons.		
Class 9	Signalling, life-saving and teaching apparatus and instruments; Apparatus and instruments for conducting, switclring, transforming, accumulating, regulating or controlling electricity; Fire-extinguishing apparatus; Electric installation material (included in class 9), namely electric cables and electrical wire; Material for electricity mains (wires, cables); Lustre terminals; Plugs,	One of the cited mark has already been abandoned.	Measuring meters and related goods, be deleted

Signature Not Verified
Digitally Signed
By:DHIRENDER KUMAR
Signing Date:18.12.2023
17:23:15

	sockets and other contacts [electric connections]; Covers for electric outlets; Cable ducts; Volt meters; Electric welding apparatus; Welding electrode; Solderers' helmets; Electronic control systems for shutters. Time switches, automatic; Electronic security systems, namely motion detectors, gas, smoke and carbon monoxide detectors, electric theft prevention installations, bells (warning devices), optical data media, video cassettes; Solar energy collectors for electricity generation; Electric batteries, battery charging equipment; Thermostats; Thermometers (not for medical purposes); Scales; Work protection clothing (included in class 9); Protective helmets, protective sports helmets. Arm, knee and wrist guards (work safety); Gloves for protection against accidents;		

Signature Not Verified
Digitally Signed
By:DHIRENDER KUMAR
Signing Date:18.12.2023
17:23:15

	Locks, electric; Gloves for protection; Protective goggles and masks; Safety belts and fastening belts, except for vehicle seats, included in class 9; Voltage detectors; Intercommunication systems; Marking aids, in particular barrier tapes and warning tapes		
Classes 10, 12,16,17, 18,19, 20	Hearing protectors Load and transport rollers; Rollers and Wheels for vehicles; Hose carts; Rollers and Wheels for barrows and Sackbarrows. Printed matter; Bookbinding material; Photographs; Adhesives for stationery or household purposes; Artists materials; Paintbrushes; Typewriters and office requisites (except furniture); Instructional and teaching material (except apparatus); Plastic materials for packaging, included in class 16. Packing, stopping and insulating materials; Flexible pipes, not of	No cited marks.	The mark to proceed for advertisement.

Signature Not Verified
Digitally Signed
By:DHIRENDER KUMAR
Signing Date:18.12.2023
17:23:15

	metal; Insulating gloves; Self-adhesive tapes, other than stationery and not for medical or household purposes; Plastic film, namely pond liners and Building membranes. Tool bags (empty); Tool chests of leather (empty); Tool bags (empty), not of metal, not of leather. Building materials (non-metallic); Non-metallic rigid pipes for building; Asphalt, pitch and bitumen. Dowels, not of metal; Wall plugs, not of metal; Locks (other than electric), not of metal; Pasting tables; Racks [furniture]; Tool stands, not of metal; Door stoppers, not of metal; Workshop equipment, included in class 20, including tool cabinets, small parts storage boxes, open storage boxes, sorting boxes, tool holders, machine tables, tool stands, workbenches (the aforesaid goods not of metal); Workshop equipment (furniture), including tool cabinets,		

Signature Not Verified
Digitally Signed
By:DHIRENDER KUMAR
Signing Date:18.12.2023
17:23:15

	storage boxes for small parts, open storage boxes, sorting boxes, machine tables, tool stands, workbenches (the aforesaid goods being of metal); Paste tables, clamping tables; Tool boxes and tool chests (empty), not of metal, not of leather; Handles for tools and garden implements, not of metal; Plastic chains, rope and chain clamps, bolts, plugs, screws, nuts, washers, hooks, rivets (the aforesaid goods all not of metal); Transport pallets; Special-purpose containers, not of masonry, not of metal, included in class 20; Ladders of wood or plastic, stepladders, not of metal; Furniture glides of felt and plastic; Coat hangers; Casters of metal for beds; Casters, not of metal, for beds.		
Class 21	Sponges; Articles for cleaning purposes; Steelwool; Brooms; Funnels.	Out of the three cited marks one mark has been abandoned, one has been opposed. The goods for which another mark has been applied is registered but the Appellant is willing to restrict the	The Appellant has agreed to restrict the goods to articles for cleaning purposes, steelwool, Brooms Funnels. Ordered

Signature Not Verified
Digitally Signed
By:DHIRENDER KUMAR
Signing Date:18.12.2023
17:23:15

		specification of goods, so that there is no overlap of goods with the cited marks.	accordingly. Mark to proceed for advertisement with the change in description of goods
Class 22	Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (so far as included in class 22); Raw fibrous textile materials; Tensioning and lashing straps, not of metal.	There is a conflicting registered trade mark	The mark shall not proceed for advertisement in this Class.
Class 26	Hooks and eyes, pins and needles; Velcro.	Out of the two cited marks one marks has not been renewed after 1986 and the second mark has been abandoned as per the status handed over today.	Accordingly, the Appellant is also willing to restrict the marks to hooks and eyes, pins and needles; Velcro. The mark shall proceed for advertisement.

9. The appeal is allowed in the above terms.

10. Ld. counsel for the Appellant submits that the form TM 16 was already filed with the Registrar of Trademarks for Classes 3,21 & 22. If there are any other formalities to be undertaken, in terms of the present order, the same shall be undertaken within four weeks.

11. Let a hearing for this purpose be fixed by the Registrar of Trademarks within four weeks. After the formalities are undertaken, the marks shall proceed for advertisement in the trademark journal in the respective Classes as directed above. Needless to add, if there are any opposition proceedings, the present order would have no bearing on the merits of such opposition

Signature Not Verified
Digitally Signed
By:DHIRENDER KUMAR
Signing Date:18.12.2023
17:23:15

proceedings.

12. The appeal is disposed of in the above terms. All pending applications are disposed of.

PRATHIBA M. SINGH
JUDGE

DECEMBER 13, 2023
dk/dj/ks
(corrected & released on 18th December, 2023)

Signature Not Verified
Digitally Signed
By:DHIRENDER KUMAR
Signing Date:18.12.2023
17:23:15