
(2018) 02 IPAB CK 0001

In the Intellectual Property Appellate Board

Case No : ORA/251/2009/TM/DEL

Al Buheira Lacnor Dairies Co. Limited

APPELLANT

Vs

Ramesh Verma

RESPONDENT

Date of Decision : 16-02-2018

Acts Referred:

Trade Marks Act, 1999 — Section 9, 11, 11(a), 12, 12(3), 18, 33, 47, 57

Citation : (2018) 02 IPAB CK 0001

Hon'ble Judges : Manmohan Singh, J; Sanjeev Kumar Chaswal, Technical Member

Bench : Division Bench

Advocate : M.K. Miglani, Jaswant Singh

Final Decision : Allowed

Judgement

Manmohan Singh, J

1. The applicant submits that the applicant is a company based in United Arab Emirates (UAE) and is engaged in the business of manufacturing, marketing and export, inter alia of all kinds of juices, nectars, drinks, milk, milk products and tomato paste for the past several years with exports to over 30 foreign markets and claims to be proprietor of the said trademark "LACNOR" in respect of said goods. The applicant in the year 1981 started using trademark "LACNOR" in respect of the said goods, and has since then been openly, continuously and extensively been used by the applicant. The applicant also got created a unique and distinctive eye-catching label/artwork for the said trademark LACNOR, with a distinctive color combination and artistic features.

LACNOR

2. The applicant has business operations and/or presence in the following countries of the world, including India: Algeria, Bahrain, India Iran, Iraq, Jordan, Kuwait, Lebanon, Libya, Morocco, Oman, Pakistan, Palestine, Qatar, Saudi Arabia, Sudan, Egypt, Syria, Tunisia, Turkey and United Arab Emirates.

3. The applicant in order to secure their statutory right, the applicant has filed applications for registration in India under trademark "LACNOR", vide Application No. 1414787 in Class-29 in respect of milk and dairy products another application for Trademark "LACNOR" vide Application No. 1414788 in Class-32 in respect of natural drinks made from fruits, all kinds of naturals juices made from fruits and vegetables. During the course of this proceeding, the aforesaid applications were pending for consideration before the Registrar of Trade Marks and the same have now been registered in the name of the applicant.

4. The applicant came to know after receipt of an examination report from the Trade Marks Registry while processing its own application, where in the trademark of the applicant was Cited as being conflicting mark. On further inquiry the applicant was shocked to see that the respondent had obtained registration of an identical label mark LACNOR with identical artistic features as of the applicant's mark LACNOR in respect of identical/similar goods in Class 29. The respondent with intent to exploit and cheat the unwary and innocent purchasers represented the impugned trademark LACNOR in an identical manner, to create deception, confusion. As the goods of the applicant and respondent is also identical and/or same description. Hence the use of the impugned trademark by respondent is bound to result in confusion and deception amongst the public and trade and thereby causing injury to the applicant's goodwill and reputation in the market.

5. The respondent in the impugned application has claimed user as "PROPOSED TO BE USEP" thereby it shows that as on the date of application, the applicant has neither made any bona fide commercial use of the impugned trademark and nor had claimed any user of the impugned trademark. In fact the said trademark LACNOR belongs to the applicant and the same has been misappropriated by the respondent by representing falsely thereby obtaining the impugned registration fraudulently. As such the respondent is not the original, actual and true proprietor of the impugned trademark "LACNOR" under the provisions of the Trade Marks Act, 1999. The registration of the impugned trademark has been obtained by the respondent by making false and misleading statements and concealing material facts and misrepresentation. The said registration is ex facie illegal and invalid and deserves to be cancelled from the Register.

6. The Respondent in this petition has failed to submit its counter statement with any supportive documents but the counsel of the respondent has made an oral submission that the Applicant Company had approached the Respondent with the intent to access the Indian market and the Respondent was in talks with the Applicant Company in relation business opportunities and market available in India. Consequent to these discussions, the Respondent registered the impugned trade mark so that the business of the Applicant Company could be set up in India. The Applicant Company was well aware of the fact that the Respondent had registered the impugned trade mark in the year 2000.

7. The applicant has stated that the respondent has created a contention simply

to wriggle out of allegation of obtaining the impugned registration fraudulently. The registration of the impugned trademark "LACNOR" has been obtained by the respondent through fraud by making false misrepresentation and misleading statements as well as concealing material facts. The Respondent has failed to lead cogent evidence in support of the contentions. The contention of the Respondent is incomprehensible and unfathomable, how the applicant who is having already established goodwill in Middle East will allow the Respondent to register the similar mark in India.

8. The impugned registration was sought and obtained dishonestly as such the respondent was fully aware of the proprietary rights of the applicant's prior adoption and prior used trademark "LACNOR" in relation to its goods. As such the respondent has no justification and reason for the adoption of an identical impugned trademark "LACNOR" in respect of identical goods.

9. The respondent has deliberately adopted and/or uses the impugned trademark as a trademark with intent to take advantage of the goodwill and reputation of its trademark "LACNOR" and to earn wrongful gain from it and cause wrongful loss to the applicant. The respondent has failed to show any plausible reasons for adoption of the impugned trademark "LACNOR". As such the registration of the impugned mark is illegal and its use is likely to result in the dilution and blurring of the goodwill and reputation of applicant's hard earned and carefully nurtured trademark "LACNOR".

10. The applicant is "person aggrieved" and can maintain & institute this action as it is engaged in the trade of juices, nectars, drinks, milk and tomato paste and is prior adopter, prior user of the said trademark. The goods for which the respondent has registered the impugned trademark are of the same description and are used for the same purposes by the same class of customers and are sold in the same shops. The goods have close nexus and connection in course of trade and in course of use.

11. As per registry record the Respondent did not file any counter statement nor did documents thus the Respondent has failed to set up his case, by bringing any materials/documents to justify the adoption of a label mark LACNOR that is identical to the applicant trademark and similar artistic representation as of the Applicant. The Registered proprietor has not been able to justify as to how it hit upon an identical mark as an imitation of the trademark of the Applicant.

12. After going through the documents extensively submitted by the applicant, in our considerable opinion, the respondent has admitted in his written submissions that "the Respondent was in talks with the Applicant Company in relation business opportunities and market available in India" as such the respondent knew the existence of the applicant company and of their business activities and further the respondent counsel has failed to show any tangible document, which supports the counter of the respondent where it says that "the trade mark is 'proposed to be used' because the idea was to secure the trade mark for the

Applicant Company. This clearly establishes that the trade mark was to be used for the products of the Applicant Company, whenever it decided to enter the Indian markets and the Respondent would assign the mark to the Applicant subsequently". Hence at this stage the respondent cannot take refuge of registering it with the premise that in future the applicant will be assigning the impugned trademark only to the respondent.

13. The respondent counsel has failed to show the consent of the applicant for allowing the respondent to register the impugned trademark; hence in our considerable opinion the said trademark was registered by the Respondent in bad faith with the intention to prevent the applicant from registering it and at the same time it had no intention of using it and by falsely claiming itself to be the proprietor without the knowledge and consent and on the back of the applicant. The said registration is thus an outcome due to fraud played by the Respondent on the Registrar of Trade Marks. During the course of hearing arguments of both parties, the Respondent has not been able to prove the use of the impugned registered trademark in India; as such the impugned trademark deserves to be rectified on the ground of non-use also. Our predecessor bench has allowed the Misc. Petition No. 262/2009 of the Applicant vide its order dated 27/12/2010 and the said order is still operating against the Respondent.

14. The applicant counsel has referred the two citations in support of his arguments to buttress his arguments M/s. M.P. Jewellers v. New M.P. Jewellers (IPAB) 2005 (30) PTC 517 (IPAB) wherein the appellate Board has said "There was sufficient evidence that the applicant had been using the trade name of M.P. Jewellers for considerable period attaining goodwill and reputation. When considering customers and goods dealt with by both parties, the mark of the respondent would cause confusion and deception. Cancellation of respondents registered mark ordered-In another case M/s. Kanshiram Surinder Kumar v. M/s. Thakurdas Deeomal Rohire and Others - AIR 1982 Bombay 505 CJ V.S. Deshpande and Justice D.M. Rege. "Two important points decided. Purity of register is in public interest and is a prime consideration as against acquiescence or delay unless injury caused to party is so substantive as to outweigh public interest - Held also, protection under Section 12(3) or 33 cannot be extended to identical marks failing under Section 11(a) (old Act)" Keeping in view of the extensive submissions made herein above by the respective counsels, we are of the considered opinion that the registration of the impugned trademark "LACNOR" having registered trademark No. 927139 in Class 29 is granted contrary to the provisions of Sections 9, 11, 12, 18, 47 & 57 under the Trade Marks Act, 1999 and Rules thereto, as such the present original rectification application deserves to be allowed thereby directing the Registrar of Trademarks to rectify the registered trademark No. 927139 in Class 29 from the Trademark Register in order to maintain the purity of the Trademark Register.

The copy of the order is sent to the Registrar of Trademarks in order initiate necessary steps for removal of the trademark "LACNOR" having registered

trademark no, 927139 in Class 29 within 15 days of the receipt of this order.

Order as no cost