
(2011) 01 IPAB CK 0001

In the Intellectual Property Appellate Board

Case No : ORA/108/08/TM/AMD

Anant Oil Industries

APPELLANT

Vs

New Nandi Seeds Corporation

RESPONDENT

Date of Decision : 13-01-2011

Acts Referred:

Trade Marks Act, 1999 — Section 47, 57, 124, 125

Citation : (2011) 01 IPAB CK 0001

Hon'ble Judges : S. Usha, J; Syed Obaidur Rahaman, Technical Member

Bench : Division Bench

Final Decision : Dismissed

Judgement

S. Usha, J

1 . Application for removal of the trade mark registered under No. 509344 under Section 47/57/125 of the Trade Marks Act, 1999 (hereinafter

referred to as the Act). The applicant herein is engaged in the business of manufacturing and marketing of all types of cattle feed / cattle food which

are being marketed under the trade mark 'NANDINI BRAND'. The applicants have also obtained necessary sales tax registration for their business.

The applicants have been carrying on business since the year 1990 throughout India. The applicants have been using the trade mark 'NANDINI

BRAND openly, extensively, continuously since 19.09.1990 in connection with all types of cattle feed / cattle food. By reason of the said trade mark

having come to be understood as goods being manufactured and marketed by the applicant's firm and none else, the people / public associate the said

brand only with the applicants and with none else. The sales made by the applicants' runs to several crores of rupees. The applicants have also spent

huge amount towards advertisement and publicity expenses.

2. The Respondent herein is also carrying on business since the year 1990 adopting the trade mark 'NANDHINI BRAND' which has hardly a

distance of 50 Kms. The Respondent has obtained registration in respect of goods seeds alone whereas the applicants have been dealing with cattle

feed and cattle food.

3 . In the year 2005 the applicant had issued a caution notice by which the Respondent is aware of the applicant's use, apart from the fact that both

the applicant and the Respondent are carrying on business within the close limits. The Respondent is not carrying on business under the registered

trade mark. As per the provisions of the Act the mark is not used by the Respondent in the course of trade and needs to be removed on the ground of

non-user. The applicant therefore prays that this Hon'ble Board be pleased to allow the rectification application and direct the Registrar to remove the

mark from the Register of Trade Marks.

4 . The Respondent filed their counter-statement stating that the application for rectification is not maintainable and deserves to be dismissed.

5. The applicants are neither bonafide nor honest in invoking the jurisdiction of this Board. The admitted fact is that the Respondent herein filed a suit

bearing Reg. Civil Suit No. 977 of 2008 on 30.04.2008 in the City Civil Court at Ahmedabad for perpetual injunction and for damages with cost. The

City Civil Court was pleased to issue notice to the applicant herein. On receipt of the suit summons, the applicant herein had preferred this rectification

application on 12.05.2008 only with a view to cause prejudice in the mind of the Court trying the suit as to the validity of the registered trade mark.

6 . On 21.05.2008, the applicant herein filed their written statement contending that the applicants have filed rectification application which is pending

and as such the Respondent's right in the matter can be decided only by the competent authority and had also filed an application to stay the

proceedings till the disposal of the rectification application. The applicants are neither bonafide nor honest in approaching this Board for rectification.

7 . It is also relevant to point that the Respondents have produced sufficient documents to prove their extensive and uninterrupted use of their trade

mark 'NANDIBINI. Hence the logo containing the name 'NANDI' and the device of Bull in respect of the goods seeds since the year 1976. These

facts are still within the knowledge of the applicant.

8 . The applicants have deliberately filed this application for rectification on the simple ground of non-user. It is relevant to state that while the

applicants filed their written statement before the City Civil Court they have categorically admitted that the Respondent is using ""NANDI BRAND,

NANDIBINI or NANDI-12 along with the device of NANDI in the course of trade for the goods' seeds only. They have also stated that right from

the inception the Respondent is using the trade mark in relation to seeds and have obtained registrations for seeds only. The Respondent confirmed in

the said suit that they are using the device of Bull as 'NANDI' in relation to seeds only. The goods of the Respondent is seeds whereas applicant's is

cattle feed / cattle food. Both the applicant and the Respondents are using a distinctive mark since 1990 to till date, there has been no instant of

confusion or deception. Both the applicant and the Respondent have knowledge of each other's trade mark since year 1990"" in view of the aforesaid

admission, the application for removal under Section 47 of the Act for non-user is absolutely misconceived and not maintainable and the same

deserves to be dismissed in limine.

9 . Furthermore, the applicant though have based their application for rectification have not urged any ground for rectification under Section 57 of the

Act, nor have they made any averment to the effect that the mark has got to be removed under Section 57 of the Act, but have only stated that the

mark deserves to be removed under Section 47 of the Act for nonuse.

10. The applicants have not complied with the provisions of Section 124 and 125 of the Act. The Respondent further states that as per the

observations made by the Hon'ble Gujarat High Court Division Bench in the case of Patel Field Marshal case reported in 1999 PTC 718, the impugned

rectification application filed by the applicants is misconceived and contrary to the provisions of law and the same deserves to be dismissed in limine.

11. We have heard Shri Prashant R. Trivedi learned Counsel for the applicant and Shri Y.J. Jasani learned Counsel for the Respondent in the Circuit

Bench Sitting at Ahmedabad on 24.11.2010.

1 2 . Learned Counsel for the applicant submitted that the impugned trade mark registered under No. 5093343 in class 31 as of 27.04.1989. The mark

is not used as a whole. The applicants are prior in use of the trade mark, using

the similar mark since the year 1990. The counsel relied on the judgment reported in 2007 (34) PTC 282 (IPAB) Venkata Rama Rao Avvas and Ors. v. American Cyanamid Company and Ors. to support his case that the trade mark registered, if not used ought to be removed.

13. In reply, the learned Counsel for the Respondent submitted that the applicant has himself admitted that they are not dealing with the goods seeds whereas are only carrying on business in cattle feed/ cattle food. The applicants have not produced any evidence to say that the impugned mark was not put to use.

14 . On 30.04.2008, the Respondent filed a civil suit for infringement against the applicant. On 12.05.2008 the applicant filed the rectification application for cancellation of the trade mark based on which the civil suit was filed. On 21.05.2008 the applicant filed the written statement where the applicants have admitted use of the trade mark by the Respondent and have also raised the validity of registration. The Respondent has been using the trade mark without any interruption, continuously and extensively. The counsel further submitted that the applicants have not sought permission from the civil court for filing this rectification application and therefore the application is not maintainable as per the provisions of Section 124 of the Act. In this regard, the counsel relied on the judgment of the Division Bench of the Gujarat High Court reported in 1999 PTC (19) 718 Patel Field Marshal Agencies v. P.M. Diesels Ltd.

15. In rejoinder, the counsel for the applicant submitted that the Respondent had not used the trade mark as registered and ought to be cancelled.

16 . We have heard and considered the arguments of both the counsel and have perused the documents and pleadings.

17 . First we shall deal with the issue of locus stand to file an application for rectification. As per Section 21, any person may oppose the registration of the trade mark whereas an application for rectification shall be filed only by a person aggrieved. A person is said to be aggrieved by the entry of the mark in the name of another person if he is not able to lawfully carry on his business by the presence of that mark on the Register. A person against whom a suit is filed is said to be a person aggrieved. In the instant case, the Respondent has filed a civil suit against the applicant and hence could be said to be a person aggrieved. But a person who had not suffered or was not

likely to suffer any damage by reason of the registration is not considered to be a person aggrieved. The applicants as well as the Respondent have been carrying on the business in the same place. It is also an admitted fact by the applicant that their business is within a distance of 50 Kms. Mover over, the Respondents have applied and obtained registration as of the year 1989. The applicant has not suffered any loss or damage, in our opinion. This application has been filed only after the civil suit. Therefore the applicant is not a person aggrieved.

18. The general principle is that when the application for rectification is based on the grounds of non-user, it is only a private interest between the two parties whereas an application on the ground under Section 57 of the Act, the public interest is taken into consideration for deciding whether the applicant is a person aggrieved or not. In the case on hand, the application for rectification is based on the ground of non-user and the rights are only between the two parties. The rights of the applicants are not affected as because of the trade mark remaining on the Register and therefore, in our opinion, the applicant is not a person aggrieved. The applicant being considered to be not a person aggrieved has no locus stand to file and maintain an application for rectification.

19 We shall now deal with the only ground of non-user for rectification. The applicant's allegation is that though the Respondent has obtained registration, has not used the trade mark. The Respondent in reply to this application have brought to our notice the averments made in the written statement to the civil suit filed by the applicant admitting the use of the trade mark by the Respondents in respect of seeds only, for which the registration has been granted. The only submission is that it is used for seeds and not for cattle feed or cattle food. This fact has not been disputed by the applicant either by filing a rejoinder to the counter-statement or during the course of arguments. The application is, therefore, only a counter-blast to the civil suit filed by the Respondent against the applicant. The ground of non-user therefore falls to ground.

20. The other defence was that the applicants have not complied with the provisions of Section 124 of the Act. Necessary permission from the civil court has not been obtained prior to filing of the rectification application. We are not going into this issue as we had decided that the ground of non-

user on which the application for rectification application is filed itself is baseless and not maintainable.

21. For the foregoing reasons there is no case made out for allowing this application for rectification. We, therefore, are not inclined to order the removal as the trade mark has been on the register for more than ten years. Accordingly, the original rectification application is dismissed with no order as to costs.