
(2004) 08 IPAB CK 0009

In the Intellectual Property Appellate Board

Case No : Original Appeal Nos. 24, 25/2004/TM/CH

B. Mohamed Yousuff

APPELLANT

Vs

P. Doraisamy Gounder And Ors.

RESPONDENT

Date of Decision : 06-08-2004

Acts Referred:

Trade And Merchandise Marks Act, 1958 — Section 9, 11, 12, 12(2), 12(3), 18(1)

Citation : (2004) 29 PTC 643 (IPAB)

Hon'ble Judges : S. Jagadeesan, J;Raghubir Singh, J

Bench : Division Bench

Advocate : P. Saravana Sowmiyan, Gladys Daniel

Judgement

S. Jagadeesan, J

1. Since both the Appeals are arising out of the order of the Assistant Registrar of Trade Marks, Chennai, dated 30.01.2004, in Application No.

581054 in Class 30 filed by M/s. P. Doraisamy Gounder of Shanmuga Rice Mill and Opposition No. MAS 57677 filed by M/s. Mujeeb Modern Rice

Mills, by consent of both the counsel, these appeals were taken up for joint disposal. For the purpose of convenience, we refer the rank of the parties

as in O.A. No. 25/2004.

2. The appellants filed application No. 581054 in Class 30 for registration of the Trade Mark ""MAHARAJA"" with the device of man caricature on

15.9.1992 claiming the user of the said mark since 12.9.1979. Acceptance of the application was advertised and published in the Trade Marks Journal

No. 1231 (S) dated 21.09.2000. The respondents herein filed their notice of opposition on 11.12.2000 on the following grounds:

(1) That the respondents are using the Trade Mark ""MAHARAJA"" and the device

of man caricature in respect of the goods raw and polished rice in

South India since 1980 onwards. (2) The respondents originally conceived and coined the Trade Mark ""MAHARAJA"" in respect of their goods rice.

(3) They also filed application No. 578456 in Class 30 and is already on record.

(4) The respondents' mark being well known in the market, the

registration of the appellants' mark is likely to cause confusion and deception during the course of the trade. (5) Hence, the registration would offend

Section 11 of the Trade and Merchandise Marks Act, 1958. (6) The appellants are not the proprietors of the said Trade Mark in accordance with

Section 18(1) of the said Act.

3. The appellants filed their counter on 24.4.2001 denying the allegations made by the respondents in their notice of opposition and contended that they

have adopted the mark honestly and independently. After hearing the arguments of the respective counsel, the Assistant Registrar of Trade Marks,

found that the objection of the respondents under Section 9 cannot be sustained since the Trade Mark ""MAHARAJA"" and the device of man

caricature do not have any direct reference to the character and quality of the goods and as such, the mark is distinctive under Section 9 of the said

Act. However, the Assistant Registrar of Trade Marks upheld the objection of the respondents under Section 11 of the said Act finding that the

respondents' mark is well known during the course of the trade. Similarly, the Assistant Registrar of Trade Marks upheld the objection of the

respondents under Section 12(2) of the Act finding that the respondents are the prior users of the disputed Trade Mark. So far as the objection with

regard to the proprietorship under Section 18(1) of the Act is concerned, the Assistant Registrar of Trade Marks overruled the same and found that

the appellants are the proprietors of the Trade Mark. Having found so, the Assistant Registrar of Trade Marks imposed a condition that the appellants

shall use the Trade Mark alongwith the name of the appellants' firm prominently also with the address for sale of goods, viz., rice in the State of Tamil

Nadu only. Consequently, dismissed the opposition filed by the respondents and allowed the application of the appellants for registration with the said

condition by order dated 30.1.2004.

4. Aggrieved by the same, the applicants filed the appeal O.A No. 25/2004/TM/CH, challenging the condition of restricting the area of operation, i.e.

the sale within the State of Tamil Nadu. The opponents filed the appeal O.A. No. 24/2004/TM/CH against the order of the Assistant Registrar

directing the registration of the applicants' Trade Mark.

5. The learned counsel for the appellants in O.A. No. 25/04, contended that the appellants are having interstate trade. In such circumstances, the

restriction imposed by the Assistant Registrar restricting the sale within the State of Tamil Nadu cannot be justified. The appellants also filed M/P. No.

24/2004, for accepting the additional evidence and on the basis of the additional evidence, the appellants have established their use earlier in point of

time than the respondents. Consequently, the restriction imposed by the Assistant Registrar of Trade Marks cannot be legally sustained.

6. The learned counsel for the respondents, on the contrary, contended that the Assistant Registrar of Trade Marks having upheld the opposition of the

respondents under Sections 11 and 12 of the said Act, has no other option, but, to reject the application of the appellant. The Assistant Registrar

without discussing the evidence available on record with regard to the claim of the appellants as the earlier user has granted relief under Section 12(3)

by restricting the area. Further, when the respondents' application No. 578456 in class 30 for registration of their Trade Mark was allowed by order

dated 23.1.2004, the Assistant Registrar ought to have rejected the application of the appellants herein on the ground that the use of the identical mark

would cause confusion and deception in the trade. There is absolutely no need for the Assistant Registrar to independently discuss the claim of the

appellants in their application and permit them to have the registration by imposing condition. When there is absolutely no evidence with regard to the

prior user by the appellants, the findings in application No. 578456 filed by the respondents would give a quietus to the issues involved in the application

filed by the appellants herein. Secondly, the Assistant Registrar of Trade Marks has committed a mistake in taking up the application of the appellants

without any relevance to the orders passed by him in the application of the respondents. Hence, the impugned order of the Assistant Registrar of

Trade Marks is liable to be set aside.

7. We have carefully considered the above contentions of the learned counsel on either side.

8. Since, we have elaborately discussed the claim of the parties as earlier user in

O.A. No. 26/2004, we do not think it necessary to once again repeat the same here. In view of our finding in O.A. No. 26/2004 the Appeal No. 24/2004, stands allowed.

9. We confine our discussion only in respect of restriction imposed by the Registrar with regard to the area to be operated by the appellant in O.A.

No. 25/2004.

10. Strictly speaking, there is absolutely no need for any discussion on this aspect also, since we have held that the application of the appellant in O.A.

No. 25/2004 cannot be entertained and the same is to be rejected. But, however, to give completeness, we are of the view that this aspect can also be discussed.

11. The only contention of the learned counsel for the appellant in O.A. No. 25/2004, is that the appellant had registered under the Central Sales Tax

and consequently, it can be inferred that the appellant is having trade outside the State of Tamil Nadu. We have also perused the bills produced by the

appellant, which are part of the typed set of documents in O.A. No. 24/2004. In fact, almost all the sales of the appellant in O.A. 25/2004 are confined

to Tamil Nadu. Virtually, most of the bills pertain to their sales in Tirupur. If really the appellants want to have a claim under Section 12(3) of the Act,

then, they could have claimed for their right outside the State of Tamil Nadu. If such plea had been put forth, then, there could have been some

justification for their claim outside the State of Tamil Nadu also. Now that we have held that the appellant in O.A. No. 25/2004 cannot have

registration and their application is liable to be dismissed, nothing survives in this O.A. Accordingly, O.A. No. 24/2004 is allowed. O. A.25/2004 is

closed. However, there will be no order as to costs.