
(2014) 08 IPAB CK 0002

In the Intellectual Property Appellate Board

Case No : ORA/27/2007/TM/DEL

Cole Haan

APPELLANT

Vs

Surbhi Wears Pvt. Ltd

RESPONDENT

Date of Decision : 05-08-2014

Acts Referred:

Trade Marks Act, 1999 — Section 11(1), 11(3)

Citation : (2014) 08 IPAB CK 0002

Hon'ble Judges : K.N. Basha, J; Sanjeev Kumar Chaswal, Technical Member

Bench : Division Bench

Advocate : Shubneet Panjete

Final Decision : Allowed

Judgement

K.N. Basha, J

1 . This application is filed by the applicant seeking for the relief of removal of the trade mark from the register of trade marks in respect of 'KOLE-HAAN' bearing Registration No. 944567 B in Class 17 registered in the name of M/s. Surbhi Wears Pvt. Ltd., New Delhi the respondent herein

2 . Ms. Shubneet Panjete, the learned counsel for the applicant is present today, though the notice was served to the respondent, neither appeared in person nor through any advocate. It is seen that even in the last date of hearing, the respondent was not appearing or any counsel representing for them. The fact remains that the notice was already served on the respondent, therefore we are decided to proceed with the matter on merits.

3 . The case of the applicant is that they are the leading manufacturer of footwear, clothing, handbags and accessories having their organization at United States of America. They have adopted their trade mark "COLE HAAN" derived from the names of Trafton Cole and Eddie Haan, the founders of the company in the year 1920. They were using the said trade mark in respect of goods covered under Class 17 in a number of countries around the world including in India and

they obtained fame and name in the world of footwear. The said trade mark KOLE-HAAN was registered are also using the registration in number of countries around the world including in India. The applicant was manufacturing footwear in India since the year 1995 and also export their goods under the trade mark COLE HAAN since 1995 and their trade mark is well know trade mark in the footwear trade in India.

4 . During the month of March 2004, the applicant came to know about the advertisement of an application for registration of the impugned trade mark 'KOLE-HAAN' under No. 944567 B in class 17 in respect of 'fancy leather, rubber sheet, pvc sole and all kinds of shoe materials.' It was advertised in the Trade Mark Journal No. Mega 3 dated 14th October, 2003. It is the case of the applicant that impugned trade mark is virtually identical, visually, phonetically and structurally similar to the trade mark of the applicant namely COLE HAAN. The applicant also carried out an investigation in respect of the extent of use of the impugned trade mark by the respondent and the investigation revealed that the company was no longer at the address shown in the Trade Marks Journal. It is found that the impugned trade mark was not used by the respondent up to a date three months before the date of application. The impugned trade mark was registered without any bona fide intention. Apart from no bona fide use of the trade mark, the registration of the impugned trade mark is in contravention of Section 11(1) & (3) of the Trade Marks Act, 1999 and such an entry wrongly remaining on the register as such the same is liable to be expunge or remove.

5. The respondent having chosen not to appear in this matter, inspite of serving notice and as a result no counter filed by the respondent disputing and denying the claim of non use by the applicant.

6. The learned counsel for the applicant would contend that the applicant has proved their case of non use of the impugned trade mark by the respondent as the respondent are not denied the same by filing any counter. It is further contended that even the applicant has engaged private investigators to find out the use of the impugned trade mark by the respondent and such investigation revealed that the respondent company is not at all using the impugned trade mark KOLE-HAAN more particularly for the last three months proceeding the filing of the application.

7 . The learned counsel would also submit that in respect of the same, similar and identical trade mark i.e. KOLE-HAAN registered by the very same respondent as per application No. 944565 under Class 25, the Hon'ble Board in its order dated 27 July 2012 in Order No. 196/2012 in ORA/89/2005/TM/DEL allowed the application and removed the trade mark KOLE-HAAN registered under No. 944565 in Class 25.

8. The learned counsel would also produced the order of the Registrar of Trade Marks dated 19.12.2012 wherein the very same respondent withdrawn the application No. 944566 in Class 18 in respect of the very same, similar and

identical trade mark. In view of the above, we are able to see much force in the contention put forward by the learned counsel for the applicant, it is seen that the applicant has establish their claim and allegation that the respondent is not using the impugned trade mark right from the date of its registration and particularly three months before filing this application.

9. In view of the foregoing reasons, the ORA/27/2007/TM/DEL is allowed. No order as to costs.

10. The Registrar of Trade Marks, New Delhi is hereby directed to remove the trade mark 'KOLE-HAAN' registered under No. 944567 B in class 17.