
(2009) 09 IPAB CK 0005

In the Intellectual Property Appellate Board

Godfrey Phillips India Limited

APPELLANT

Vs

Modi RJR Limited

RESPONDENT

Date of Decision : 04-09-2009

Acts Referred:

Trade Marks Act, 1999 — Section 11(3), 47, 57, 125

Citation : (2009) 09 IPAB CK 0005

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

Bench : Division Bench

Final Decision : Allowed

Judgement

Z.S. Negi, J

1. The applicant, M/s. Godfrey Phillips India Limited, has filed the above rectification application seeking removal of the trade mark registered in the name of the respondent from the Register of trade marks or rectification of the Register under Section 47/57/125 of the Trade Marks Act, 1999 (hereinafter referred to as the Act).

2. According to the applicant, it carries on the established business as manufacturers and merchants of, inter alia, cigarettes of all kinds. In or around the year 1999 the applicant adopted the trade mark FORCE -10 after satisfying itself that there was no same or similar trade mark on the Register or in the market and after completion of market survey and market tests with respect to acceptability of the market, it in or around February, 2004 decided to launch a cigarette under the said trade mark in India and abroad and it manufactured and exported cigarettes under the trade mark FORCE-10 to Sierra and Guinea. The applicant on 10.02.2004 filed application No. 1266032 for registration of the trade mark FORCE-10 in class 34

in India and in the examination report the Examiner cited the trade mark No. 922074 in class 34 as a bar to the registration of the applicant's

application for registration. The said application in the name of the respondent was stated to have been advertised in the Trade Marks Journal No.

9999-3. On enquiries made by the applicant, it was revealed that there was no such journal number published and circulated. Subsequently by the time

the applicant found that the journal number 9999-3 was a abbreviation for the Mega Journal 3 dated 14.10.2003 and was made available to the public

on 29.12.2003. As such the period for opposing the respondent's application for registration had already expired and therefore no opposition could be

filed against the aforesaid application of the respondent. Enquiries at the office of the Trade Marks Registry revealed that the mark FORCE-10 under

No. 922074 in class 34 had proceeded to registration and certificate No. 308656 had been issued in respect of the said registration. The applicant

claims to be the prior adopter and user of the trade mark FORCE-10 in India and by virtue of the impugned registration of the trade mark FORCE-10

in the name of respondent, it is a person aggrieved. The applicant claims that the applicant manufactured and exported cigarettes under the trade mark

FORCE- 10 to certain foreign countries in around February, 2004.

3. The applicant as a person aggrieved has sought for the expunction/removal of the impugned trade mark from he register on the grounds, inter alia,

that the registration of the mark is without sufficient cause and is wrongly remaining on the Register; that the trade mark has been registered without

any bonafide intention on the part of the registered proprietor that it should be used by it in relation to the goods and there has in fact been no bonafide

use of the trade mark three months prior to the date of the present application and that the trade mark has been registered in contravention of the

provisions of Section 11(3) of the Act.

4 . A copy of rectification application and notice for filing counter-statement was forwarded to the respondent on 21.02.2005 and the same was

returned undelivered with postal remarks ""company has been closed"". However, subsequent notice and application for rectification vide Form C dated

26.09.2007 was received by the respondent, but no counter-statement has so far been filed. Thereafter, hearing notice dated 5.06.2008 fixing the

matter for hearing on 30.06.2008 was received back undelivered and none

appeared for the respondent and the matter was adjourned. Thereupon, the applicant filed an application seeking permission for substituted service of notice of hearing by way of publication in the newspapers. The application was allowed on 1.5.2009 and the certified copies of the order dated 1.5.2009 was sent to all the parties and the respondent has also received the said copy of the order. The applicant published the notice of hearing in The Hindu Business Line, Chennai, dated 24.07.2009, Dina Thanthi, Tamil Daily, Chennai, dated 24.07.2009, The Hindu Business Line, Hyderabad Edition, dated 24.07.2009 and the Eenadu, Telugu newspaper dated 24.07.2009, stating the date fixed for hearing is 10.08.2009. Since there was no representation from the respondent, we had no option but to hear the matter ex parte, on 10.08.2009.

5 . We have heard learned Counsel for the applicant and perused the documents on record. Learned Counsel for the applicant urged that the rectification application be heard as the respondent has not chosen to make any representation and contest the matter. The respondent has even not chosen to file the counter-statement.

6. On perusal of the records we find that Shri Suresh Jagirdar, Vice-President of the applicant has filed affidavit evidence in support of the application annexing therewith documents (Annexure A to F) to show that the applicant has become an active player in the overseas market with significant export volumes, annual reports of the applicant for the period of 2003-2004 to show the volume and extent of business activities of the applicant, copies of overseas registrations of trade mark in various countries, copies of advertisements in respect of use of trade marks FORCE-10, copies of excise invoices, shipping bills, challans, purchase orders and copy of promotional materials, etc.. Shri Suresh has stated that the applicant is the second largest player in the Indian cigarette industry with annual turnover of over US \$ 300 million. In para 4 of the affidavit it is stated that the history of the applicant can be traced back to as early as the year 1844 from London. Today the operation of the applicant span the entire Northern and Western part of India with two manufacturing facilities located at Ghaziabad (near Delhi) and in Andheri (Mumbai). A state of the art R&D Center in Mumbai and the tobacco buying unit in Guntur (A.P.), the applicant which is headquartered in Delhi has its sales offices across the country at Ahmedabad,

Mumbai, Delhi, Chandigarh and Hyderabad. The proud products of the applicant are distributed through an extensive and wide network comprising approximately 500 exclusive distributors and over eight lakh retail outlets. From the documents on record we have noticed that the applicant is using the mark in respect of cigarettes. The Excise Invoices, which are counter-signed by Excise authorities show that the applicant is manufacturing the goods for which registration of trade mark is obtained. Excise Invoice No. 128 dated 11.4.2005 alone show a total duty of Rs. 4493977.

7 . It is evident from paragraph 4 above, that the respondent has not shown its interest to contest the matter despite ample opportunities afforded to the parties in the matter. There is no averment or evidence that the respondent has instituted suit for infringement or passing off or has issued any notice to cease or desist from using the trademark. In the circumstances a reasonable inference that could be drawn is that the registration has been obtained without any bonafide intention to use by it and the respondent is not using the mark in respect of goods for which the impugned registration is obtained and has no documents to prove user. If the mark is not used, the same is registered without any sufficient cause and the same is wrongly remaining on the Register. Such mark can be removed under Sections 47 and 57 of the Act.

8. In view of the above, we allow the present application and direct the Registrar of Trade Marks to remove the trade mark registered under No. 922074 in class 34 in the name of the respondent. Let a copy of this order be forwarded to the Registrar of Trade Marks for compliance.