

(2012) 12 IPAB CK 0004

In the Intellectual Property Appellate Board

Case No : OA/84/2009/TM/CH And OA/86/2009/TM/CH

Karnataka Cooperative Milk Producers Federation Limited APPELLANT
Vs

Venkada Swamy Seenivasan And The Deputy Registrar Of RESPONDENT
Trade Marks

Date of Decision : 28-12-2012

Acts Referred:

Trade Marks Act, 1999 — Section 12, 18(1)

Citation : (2012) 12 IPAB CK 0004

Hon'ble Judges : S. Usha, J;V. Ravi, Technical Member

Bench : Division Bench

Final Decision : Allowed

Judgement

S. Usha, J

OA/84 & 86/2009/TM/CH

1 . Both the appeals arise out of the orders dated 03/06/2009 and 23/06/2009 respectively passed by the Deputy Registrar of Trade Marks dismissing the oppositions and allowing the application to proceed for registration. The brief facts of the case are:-

OA/84/2009/TM/CH

2 . The respondents filed an application for registration of the trade mark "nandhini a/c" along with the expression "ANDHRA STYLE MULTICUISINE FAMIL RESTAURANT" in respect of "Meat, fish, poultry and game, Meat extracts, preserved dried and cooked fruits and vegetables, jellies, jams, eggs, milk and diary products, edible oils and fats, preserves, pickles and other allied products included in class 29 on 23/12/1999 under No. 893661. The user was claimed since 01/09/1999. The said application was advertised in the Trade Marks Journal No. 1341 dated 01/04/2006 at page No. 1039.

3. The appellants herein opposed the above said registration on the ground that

they are highly reputed and well known dealers of milk and milk products, cattle feed and other allied product. The trade mark NANDHINI with the device of the cow is being used by them extensively not only in the State of Karnataka but also in other parts of the country. The appellants had been using the trade mark since 1983 and are the registered proprietors of the trade mark.

4. The respondents adoption of a deceptively similar mark is only to trade upon the goodwill and reputation earned by the appellants. The impugned trade mark registration is confusingly similar to the appellants trade mark. The respondents cannot therefore claim to be the proprietor of the trade mark as per section 18(1) of the Act.

5 . The respondents filed their counter statement stating that they are carrying on business in catering since 1999. By virtue of long, continuous and extensive use, the respondents are the owners of the trade mark since 1999. The trade mark NANDHINI is a mythological name and is commonly used.

6. On completion of the pleading, the learned Registrar heard the matter and held as under:-

(a) the applicants, i.e. the respondents are using the trade mark continuously since 1999 and have filed evidence in support thereof and therefore the objection raised by the appellants was rejected;

(b) the marks are different and the goods are different. The appellants mark is NANDHINI word per se whereas the respondents mark is "nandhini a/c". The appellants are using for diary products such as milk and milk products whereas the respondents are using for various goods falling in class 29 like meat, fish, poultry etc. Even though the goods fall in the same class, the description of the goods are totally different. The appellants therefore cannot claim any monopoly over the trade mark NANDHINI.

(c) There is no deception or confusion among the public as they are dealing in different goods even though the appellants are prior user of the trade mark NANDHINI.

(d) The respondents are the proprietors of the trade mark NANDHINI as they have been using the trade mark extensively and continuously since 1999.

(e) The appellants are using the trade mark only for milk and milk products whereas the respondents are not using for milk products. In the interest of justice and to maintain the purity of the register the applicants i.e. the respondents are to delete milk and milk products from the specification of goods;

(f) The appellants have not produced any evidence to prove that the mark if allowed to be registered would cause confusion or deception;

(g) The respondents are the proprietors of the trade mark NANDHINI by long, continuous and extensive use and are therefore to be protected by grant of registration.

7 . The respondents herein filed an application for registration of the trade mark "nandhini a/c" along with the expression "ANDHRA STYLE MULTICUISINE FAMIL RESTAURANT" in respect of restaurants, catering, hotels, boarding houses, snack bars and providing of food and drinks under application No. 1351115 in class 42. The mark was applied for registration on 15/04/2005 claiming user since September 1999. The said mark was advertised in the Trade Marks Journal No. 1342 dated 16/04/2006 at page No. 2229.

8 . The appellants herein opposed the registration on the ground that they are the manufacturers and dealers of milk and milk products, cattle feeds and other allied products. They are the source of NANDINI products. The word NANDINI with or without the device is very famous. The trade mark NANDINI with the device of the cow is being used not only in the State of Karnataka but also in other parts of India. They are the registered proprietors of the trade mark NANDINI. The respondents trade mark for which the impugned application has been made is confusingly and deceptively similar to the appellants trade mark.

9. The very adoption of the trade mark NANDHINI by the respondent is only to trade upon the goodwill and reputation earned by the appellants. The registration if granted would be in contravention of the provisions of the Act.

10 . The respondents herein filed their counter statement stating that they are carrying on business in catering since September 1999 and by virtue of such long and continuous use, they are the absolute owners of the trade mark "nandhini a/c". The impugned trade mark is a mythological name and is very commonly used in respect of catering business.

11. The learned Registrar held as under:-

(a) The goods and services are of different description, the class of customers and the trade channels are different and therefore there will be no confusion or deception;

(b) The issue of prior user does not arise as the trade channels are different;

(c) The respondents are using the trade mark "nandhini a/c" since 1999 without any interruption and they are honest and concurrent user within the meaning of section 12 of the Act;

(d) The appellants are using the mark only for milk and milk products;

(e) The application shall proceed to registration subject to conferring the services in Hosur only in the State of Tamil Nadu.

12. Being aggrieved by these orders, the appellants are before us in appeal.

13. The notice sent to the respondent has been served but the respondents failed to appear and therefore were set ex parte. We heard the learned counsel for the appellant Ms. S. Indhumathi Ravi.

14. The learned counsel submitted that the appellants had been using the trade mark since the year 1983. The respondents had adopted and used the trade mark only since 1999. The appellants have built a valid goodwill and reputation among the trade and public. The registration of the impugned trade mark would be in contravention of the provisions of the Act. The learned counsel relied on the order of this Board in an identical matter between the appellant and the third party. The Board held that "the words are identical and the adoption of the letter 'H' does not make a difference." The marks are phonetically identical. The general public associate the trade mark NANDINI only with the appellants and therefore the respondents cannot be permitted to use the trade mark NANDHINI.

15. We have heard and considered the arguments of the appellants counsel and have gone through the pleadings and documents.

16. In an opposition proceeding, it is for the applicant i.e. the respondent herein to prove that there will be no confusion or deception if the mark is allowed to be registered. The respondents have filed certain documents before the Registrar. There are advertisements of the year 2003 and 2004-05, TNGST Registration Certificates and few assessment orders and invoices of the year 1999. There are four invoices of the same date 21/03/1999. It is pertinent to mention here that the date of use claimed in the application in class 29 is since September 1999 and in class 42 is 01/09/1999. It is not clear as to how the respondents have produced bills dated March 1999, which is prior to the date of the user claimed in the application for registration.

17. As observed in the earlier order when the marks are identical, the confusion is certain and therefore the mark cannot be allowed to be registered. The appellants are prior users and their rights are to be protected. For the above stated reasons, the impugned orders are set aside and the appeals are allowed rejecting applications for registration. No order as to costs.