
(2008) 04 IPAB CK 0002

In the Intellectual Property Appellate Board

Case No : ORA/38/2007/TM/MUM

Mashreq International (L.L.C.) Represented By Its P.O.A.
Agent H. Syed Abdul Kader

APPELLANT

Vs

Tuff Stuff Watches Pvt. Ltd.

RESPONDENT

Date of Decision : 17-04-2008

Acts Referred:

Trade Marks Act, 1999 — Section 9, 11, 12, 47, 57, 125

Intellectual Property Appellate Board (Procedure) Rules, 2003 — Rule 10

Citation : (2008) 04 IPAB CK 0002

Hon'ble Judges : Z.S. Negi, J;S. Usha, Technical Member

Bench : Division Bench

Advocate : Rajesh Ramanathan

Final Decision : Dismissed

Judgement

Z.S. Negi, J

1. This is an application filed by the applicant through its Power of Attorney Agent for removing, cancelling and expunging of the trade mark,

'ZENART' under No. 830693 in class 14 registered in the name of the respondent, from the register under Section 47/ 57/ 125 of the Trade Marks

Act, 1999 (hereinafter referred to as the Act).

2. The brief facts as stated in the application is that M/s Habeeb Mujeebur Rahaman and Thaikai Asghar Ahmed Mohamed S. have been carrying on

an established business in manufacturing and selling clocks, watches and their accessories and spare parts for long time at Hong Kong in the name

and style of Commerce De Orient. During the course of the said business they had honestly conceived and adopted trade mark ZENART, written in

an artistic manner in respect of the goods mentioned here before. The trade

mark ZENART was got registered in Hong Kong under No. 05353 of 1997 as of 6.12.1995 in class 14 in the name of Habeeb Mujeebur Rahaman and Thaikai Asghar Ahmed Mohamed S. trading as Commerce De Orient, a partnership organized and existing under the laws of Hong Kong. By the deed of assignment dated 8.10.2002, M/s. Commerce De Orient assigned the trade mark to M/s. Thaika Sahib, Habeeb Mujeebur Rahaman, Habeeb Syed Mohamed Mukrim and Sabeeha trading as M/s GEM DE ORRIENT and that M/s GEM DE ORRIENT has been brought on record as the subsequent proprietors of the trade mark. The subsequent proprietor of the trade mark ZENART has appointed Mashreq International LLC of Dubai to act as its agent worldwide and authorised to further register the brand ZENART internationally in its name and act as its owners. It is further stated that the applicant has obtained registration of trade mark ZENART in Korea, State of Kuwait, U.A.E. (Government of Dubai) and Switzerland and the said registrations are in force. It is stated that the applicant has been selling its products through its Indian company M/s. Mashreq International Trading Co., Chennai in India continuously and extensively since 1.1.2003 and has applied for registration of trade mark ZENART written in an artistic manner under application No. 1240755 in class 14, which has been advertised, before acceptance, in the Trade Marks Journal No. 1339 Suppl. (1) dated 15.2.2006.

3. It is averred that the registered proprietor/respondent has copied the well established trade mark of the applicant with malafide intention to trade upon the reputation earned by the applicant's trade mark and obtained registration behind the back of the applicant. The applicant has sought the removal/cancellation of the respondent's registered trade mark on the grounds, inter alia, that the respondent's mark is not adapted to distinguish its products in terms of Section 9 of the Act; that the registered trade mark of the respondent is identical and is a virtual copy of applicant's well established and well-known trade mark offending the provisions of Section 11 of the Act; that the predecessor in title of the applicant and the applicant are the prior adopters and users of the trade mark ZENART and have registered the same in various countries which entitles protection to its mark as per the various International Conventions; that the respondent is not the proprietor of the trade mark; that the respondent is not entitled to claim

registration under Section 12 of the Act; that the respondent has obtained registration by fraudulently and making material misstatement about its proprietorship over the trade mark and that the respondent's mark has been registered without any sufficient cause and remaining on the register without sufficient cause. The applicant has further averred that the registered mark of the respondent is causing an embarrassment to the applicant in its business besides loss of goodwill and reputation. Since the applicant is engaged in the same business as that of the respondent and in the goods for which the impugned mark is wrongly registered. In view of the facts stated here before, the applicant claims to be the person aggrieved to institute the present application and prayed that in the interest of justice and purity of register, the impugned entry be removed from the register.

4. The notice dated 16.4.2007 in Form C under Rule 10 of the Intellectual Property Appellate Board (Procedure) Rules, 2003 issued to the respondent had been received back undelivered and therefore the applicant was directed to serve on the respondent a copy of application along with the enclosures but the copy of application sent to the respondent by the applicant has also been received back undelivered with an endorsement ""Left"". On an application M.P. No. 140/2007 being filed by the applicant for an order for substituted service on the respondent by way of publication in any of the daily newspapers at Mumbai, this Appellate Board had passed the following order: Accordingly, it is directed that service of notice in the main matter, be served upon respondent by substituted service by way of publication in one of the daily newspapers published at Mumbai and having large circulation. Returnable date to be specified in the notice for appearance of parties at our sitting at Mumbai on 31.03.2008.

The notice was, accordingly, published in the Business Standard, Mumbai Edition dated 27.02.2008 but despite that the respondent has neither filed any counter-statement nor appeared on the date of hearing on 31.03.2008 at Mumbai. Therefore, the rectification application was heard in the absence of the respondent.

5. We have heard Shri Rajesh Ramanathan, learned Counsel for the applicant, who submitted that the predecessor in title of the applicant has adopted and used the trade mark ZENART as far back as since 6.12.1995 and got registration thereof in 1997 in Hong Kong and by virtue of assignment of

the said mark to the applicant, the applicant is the subsequent registered proprietor of the mark, whereas the respondent has applied for registration on 30.9.2003 claiming user since 1.1.2003. The counsel also submitted that these facts clearly show that the applicant is first to adopt and use the mark.

The learned Counsel submitted that the impugned mark of the respondent is identical to the applicant's mark and in fact the registered

proprietor/respondent's trade mark ZENART is a slavish imitation and copy of applicant's well established and well-known trade ZENART. The

goods covered by the impugned mark and the mark of the applicant are of same description and fall in the same classification of goods. Therefore, the

respondent's mark is likely to cause confusion and deception amongst the unwary consumers and in the trade. It was also the submission of the

learned Counsel that the respondent has no right whatsoever to adopt the mark ZENART in respect of watches having full awareness about the

existence of the applicant's mark at the time of making application for the registration of the impugned mark. Learned Counsel concluded his

arguments by submitting that the impugned entry relating to trade mark under No. 830693 may be removed, cancelled and expunged from the Register

of Trade Marks and costs of the proceedings may be awarded in favour of the applicant.

6. For making an application seeking relief under Sections 47 and 57 of the Act the condition precedent is that the applicant should be a person

aggrieved. The Apex Court in National Bell Co. (P) Ltd. and Anr. v. Metal Goods Mfg. Co. Ltd. and Anr. PTC (Suppl) (1) 586 (SC) at p. 593 has

observed that the expression ""aggrieved person"" has received liberal construction from the courts and includes a person who has, before registration,

used the trade mark in question as also a person against whom an infringement action is taken or threatened by the registered proprietor of such a

trade mark. Person aggrieved includes rivals in the same trade who are aggrieved by the entry of rival's mark in the register of trade marks or persons

who are in some way or the other substantially interested in having the mark removed from the register or persons who would be substantially

damaged if the mark remained on the register.

7. In the present case it is averred that both the parties are in the same trade and the registration obtained by the respondent is causing embarrassment

to the applicant in its business and is causing loss of its goodwill and reputation. Prima facie, the applicant is the person aggrieved and hence has locus

standi to file the present application under Section 57 of the Act.

8. The next issue is whether the applicant is the prior adopter and user of the mark ZENART. There is no dispute that the predecessor in title of the

applicant had obtained registration of trade mark in Hong Kong as of 6.12.1995. The applicant made application for registration of trade mark in India

on 3.9.2003 claiming user since 1.1.2003 and the respondent made application for registration on 4.12.1998 for proposed to be used and obtained

registration of the mark. There is no specific averment as to whether the applicant has any use of the trade mark ZENART in India before making

application for registration. The averment of the applicant at para 4 of Form I is ambiguous as it reads as ""We submit that we, ourselves and our

predecessors in title have been using the aforesaid trade mark ZENART continuously and extensively all over the world for the past several years and

our trade mark has become well known in the trade and among the consuming public."" The applicant has not adduced any evidence to show what the

trade mark ZENART fulfills requirements/conditions to be a well-known mark as contained in Section 11 of the Act. The applicant has not filed an

iota of piece of evidence to show that its mark is in use in India before or after the filing of application for registration. To claim protection under the

International Conventions the mark should be well-known and having transborder reputation. In the absence of any evidence it will not be prudent to

easily dislodge the respondent who is a registered proprietor having statutory rights. The question of similarity of marks and the likelihood of causing

confusion or deception will arise only when the two competing marks are in use. Here the applicant has not made any endeavor to show use of its

mark nor has setout a case of non-use against the respondent. In the absence of evidence of use of marks, it would not be possible for us to decide

the question of deceptive similarity. It would also not be possible for us to decide issue raised in para 14 of the application that the registered proprietor

is not entitled to claim registration under Section 12 of the Act since the initial adoption of the trade mark in question by the registered proprietor is

dishonest. Prima facie, the facts shows that the respondent is first in India to make application for registration in 1998. If that be so, the question of

respondent to seek protection of Section 12 of the Act does not arise.

9. Further, we have failed to find any whisper in the application about any suit for infringement of the registered trade mark has been filed in a Court

of law in which case application has to be made only before this Appellate Board under Section 125 of the Act. When there is no suit filed in any

Court of law and alternative forum is provided under the statute, what prompted the applicant to file the present rectification application before this

Appellate Board is beyond our comprehension.

10. In view of above, we find no merit in the application and the application must fail. We, accordingly, dismiss the application without any order for

costs.