

(2011) 10 IPAB CK 0005
In the Intellectual Property Appellate Board
Case No : OA/8/2005/TM/DEL

M/s. Hamdard Industries, Dhaunra Tanda, Bareilly - 243 204 **APPELLANT**
U.P.

Vs

M/S. Hamdard National Foundation (India) 2A/3, Asaf Ali **RESPONDENT**
Road, New Delhi - 110 002 And The Assistant Registrar Of
Trade Marks, Trade Mark Registry, Okhla Industrial Area, New
Delhi - 110 020

Date of Decision : 04-10-2011

Acts Referred:

Trade Marks Act, 1999 — Section 12(3), 17

Citation : (2011) 10 IPAB CK 0005

Hon'ble Judges : Prabha Sridevan, J;S. Usha, J

Bench : Division Bench

Final Decision : Dismissed

Judgement

1. Appeal arises out of the order dated 23/07/2004 passed by the Assistant Registrar of Trade Marks allowing the opposition No. DEL-T-2499/57950

refusing registration of the trade mark under No. 517277 in class 30 under the provisions of the Trade Marks Act 1999 (hereinafter referred to as the Act).

The brief facts of the case are:

2. The appellant herein on 22/02/1989 filed an application for registration of a label mark Hamdard Brand under No. 517277 in class 30 in respect of

rice for sale in India and also for export. The mark was proposed to be used on the date of application. The said application was advertised before

acceptance on 1st October, 2009 at page 2640 in Trade Marks Journal No. 1232.

3. The respondent herein filed their notice of opposition opposing the registration on various grounds. The appellant herein filed their counter

statement. The Registrar on completion of the pleadings heard both the counsel and passed the impugned order. The Registrar held that the trade mark Hamdard is not an invented word but had acquired a secondary meaning by virtue of long and extensive use and extensive advertisement. The public associate the trade mark "Hamdard" only with the opponents/the respondent herein. The appellants are not entitled to the benefit of the provisions of Section 12(3) of the Act as their adoption is dishonest however long user may be. Therefore the opposition was allowed and the application was refused registration.

4 . The appellants being aggrieved by the said order of refusal of registration had filed this appeal on the ground that the Registrar had erred in holding that the appellants adoption is dishonest without considering the fact that they had adopted the trade mark from their firm name, erroneously held that the trade mark is not an invented word, wrongly held that the proprietor of law regarding honest and concurrent user; through held that the user does not create confusion in spite of holding that the respondents are not directly dealing in the sale of rice; the Registrar ought to have held that the goods are different, the Registrar ought to have put conditions or limitation and ought not to have refused registration; the impugned order suffers from non application of mind; and the impugned order is bad in law.

5 . The respondents filed their counter statement. The respondent stated that the appeal has been filed as a counter blast to a suit filed by this respondent against the appellant herein. The appellant was restrained by an order of injunction restraining from using the trade mark Hamdard and Hamdard Eye Design by the Hon'ble High Court of Delhi in C.S. No. 1240 of 2004. They are the proprietors of the trade mark Hamdard and a series of mark incorporating its primary mark Hamdard.

6 . The trade mark "Hamdard" was adopted by the respondent in the year 1905 in relation to a wide range of products like Unani and Ayurvedic Medicines, Syrups and Sherbets. Consuming public associate the mark Hamdard only with the respondents and with none else by virtue of long and continuous use. The respondents have exported their products to the United Kingdom and the Middle East. They have obtained registration in various class of memo of grounds of appeal were denied by the respondent.

7 . We have heard Shri S.K. Bansal, counsel for the appellant and Shri N.K.

Anand counsel for the respondent in Circuit Bench Sitting held at Delhi on 1st August, 2011.

8. The learned counsel for the appellant submitted that on the date of application ie. On 22nd September 1989 the application for registration for the label mark was proposed to be used in class 30. But later the mark was put to use. The respondent though had used the mark were only in classes other than class 30. The counsel then stated that they had adopted the trade mark as of 1989 and had being using the same since then. The counsel also relied on few judgments.

1. 2001 PT 889 (Del) (DB) - Veerumal Praveen Kumar Vs. Needle Industries (India) Ltd. & Anr. ""If the mark is registered it should be put to use. A trade mark cannot exist in vacuum.

2. AIR 1960 SC 142 -Corn Products Refining Co. Vs. Shangrila Food Products Ltd. - ""Reference to the trade mark and not to the manufacturer of goods - reputation among the public. Registration under special circumstances as per section 12(3) of the Act.

3 . AIR 1964 (2) SCR 211 - London Rubber Co. Ltd. Vs. Durex Products Incorporated & Anr.

4. 2006 (3) SCC 208 - S.N. Chandrashekar and Anr. Vs. State of Karnataka and Ors. - The decision if passed without proper application of mind to the requirement of law it vitiates the decision. The Registrar had not considered the special circumstances for allowing the registration under Section 12(3) of the Act.

9. In reply the learned counsel for the respondent submitted that when the adoption of the trade mark is dishonest there is no need for any evidence.

The trade mark was proposed to be used on the date of application i.e. in the year 1989 whereas the respondents had been using since the year 1905.

The counsel then placed reliance on the order of the Delhi High Court in C.S.(OS) 1240/2004 reported in 2008 (38) PTC 109 (Del) between the same parties.

10. The counsel for the appellant in rejoinder referred to the Section17 of the Act.

11. We have heard and considered the submissions of both.

The onus is on the applicant for registration to prove that the registration will not cause any deception among the public. The appellants contention was

that the respondents are not dealing in rice and the other contention was that they were entitled to the benefit of honest and concurrent user. The

appellants have not given any reason for the adoption of the trade mark, that apart not only the mark Hamdard has been copied but the entire get up

that is enclosure of eye design with the word Hamdard in the centre has been slavishly copied. The appellants therefore cannot have any reason for

such adoption which will only amount to dishonest adoption. When the adoption is not honest, it is clear that the appellants have adopted an identical

trade mark with an intention not bonafide only to trade upon the goodwill and reputation earned by the respondents.

12 . The appellants have not denied the fact that the respondents are prior in adoption and user but have only submitted that they are not dealing in

rice. On perusal of the records, it is seen that the respondent are dealing with goods falling in class 30.

13. As we have observed that the appellant's adoption is dishonest the application for registration has to be refused. Accordingly, the impugned order is

upheld and the appeal is dismissed without costs.