(2012) 04 IPAB CK 0011

In the Intellectual Property Appellate Board

Case No : ORA/201/2007/TM/CH

M/s K.B. Products Pvt. Ltd., Dodaba Compound, Anjurphata, Talukia, Bhiwandi, Val-Village, District Thane, Maharashtra — APPELLANT

Vs

M/s Nakoda Distributors Pvt. Ltd., No. 68, P.V.R. Road, Near Jolli Mohala, Bangalore-560053 — RESPONDENT

Date of Decision : 04-04-2012

Acts Referred:
Trade Marks Act, 1999 — Section 12

Citation : (2012) 04 IPAB CK 0011

Hon'ble Judges : Prabha Sridevan, J;V. Ravi, Technical Member

Bench : Division Bench

Final Decision : Allowed

Judgement

S. No.,Appln. No.,Class,Brand Name,PRODUCTS

1.,1499570,29,NAKODA COCO SPECIAL (LABEL),"Edible Oil, Coconut Oil,

2.,1499571,29,NAKODA DAIRY TAAZA (LABEL,"Milk & Milk products, Pure Ghee

3.,1499572,29,Premium Nakoda Sweetened (Label),"Milk & Milk products, Milk Powder

4.,199573,29,Nakoda Dairy Special Pure Ghee (Label),"Milk and Milk Products, Pure Ghee

5.,1499574,29,Nakoda,"Milk and Milk products, Edible Oil

6. Before dealing with the submissions made by the learned counsel it is necessary to refer to the judgment in O.S.A.. No. 97 to 100 of 2009 filed by,,,,

the respondent M/S Nakoda Dairy (P) Limited against the applicant M/s Kewal Chand Vinod Kumar, M/s Hirachand Bakhtawarmal and M/s K.B.",,,,

Products. The appellant filed the suit for injunction which was dismissed on the ground that the defendants/applicants herein are the proprietor and,,,, long term user. The learned single Judge had held that Shree NAKODA Stores is not a brand name. It is a business store and was never engaged in,,,,

manufacture or production of milk products and that the user is only from,,,,

19. 03.2004. Against this O.S.A. No. 97 to 100/2009 an appeal was filed. The Hon'ble Division Bench held that the appellants had not made a prima-,,,,

facie case for grant of injunction and that the defendants, respondents would suffer irreparable injury if injunction is granted.",,,,

7. The learned counsel appearing for the applicant submitted that Annexure 'A' which is the trade mark application would show that there was user,,,,

from 01.04.1992 and Annexure 'B' would show how 'NAKODA' has formed part of their permanent feature of the trade mark. He referred to the,,,,

various exhibits and Annexure 'A - Z' to prove user. The use of the word NAKODA is seen from Newspaper 'HALKAR' of November, 1998. He",,,,

also referred to Annexure 'AB' which is the application filed by the respondent herein, who has claimed user from 19.03.2004. The learned counsel",,,,

submitted that the respondent document Annexure ' R-45' would only show that the ""Blending-Repacking marketing of all dairy products"" with effect",,,,

from 08.03.2004 and this does not show use of the trade mark. The learned counsel submitted that the respondent's was Nakoda Stores and it is not,,,,

correct to state that they had been using it as their trade name. Learned counsel submitted that even in their documents R 54', which is the Accounts",,,,

for the year 2005 - 2006, in the Directors report to Share holders, it is stated that "" the company continues to deal in the products of M/s Kothari",,,,

Products and M/s Milk Foods India Limited."" The learned counsel submitted when this is their own submission then the case projected by them of long",,,,

user cannot be accepted. All that they were doing was marketing the goods belonging to others and the adoption of the trade mark NAKODA is,,,,

dishonest. The learned counsel submitted that the respondents Document No. R '29' would also show that ""Shree Nakoda Stores"" opened at",,,,

Bangalore was distributor of pharmaceutical i.e. stockist of Procter & Gamble India Limited and the learned counsel submitted that the respondent,,,,

had started the business in March 2003 and two months thereafter had made the application. The mark could not have obtained distinctiveness in this,,,,

short time.,,,,

8. Learned counsel appearing for the respondent submitted that the decision in

OSA is not relevant for deciding the rectification application. He also,,,,

submitted that the applicant is not a ""person aggrieved"". The word NAKODA is the respondent's store name. He referred to Document No. 77 which",,,,

is the Brand Index and it would show only the respondents' name and not the applicants' so this proves the respondents case. Learned counsel,,,,

submitted that there are enough documents to show that the respondent had all along been using the word NAKODA first as his Store's name and,,,,

thereafter when the firm had become incorporated, the word NAKODA has always part of the business entity through the applicant and the",,,,

predecessors in the interest of the applicant. Learned counsel submitted that the applicant has discharged the burden that there is no dishonesty in,,,,

adoption.,,,,

9 . We have seen the evidence and documents and gone through the pleadings and have taken note of the submission. There cannot be any dispute,,,,

regarding the fact that the business of the respondent started originally in Kumbakonam as Shree NAKODA Stores. All the documents filed relating,,,,

to the tax authorities or other documents do not show that they had used the mark NAKODA in relation to their goods i.e. milk products as stated,,,,

earlier. Even in their Directors report they have only spoken of their dealings in the products of Kothari Products & Milk Foods India. Even as late as,,,,

2000, NAKODA Distributors Pvt. Ltd. the assessee under the Central Sales Tax Act is stated to be dealing with Pan Parag, Dairy products., Fortune",,,,

Oil, Coconut Powder, Yummies, illegal purchase of milk products and first sale of skimmed milk powder. According to the learned counsel for the",,,,

respondent, the first sale can only refer to sale of skimmed milk powder under the brand name NAKODA. This evidence has very little weight. The",,,,

other evidence which is relied on by respondent is the milk & milk products brand index which shows brand name NAKODA and the company name,,,,

NAKODA Dairy. We do not know if we can accept this entry to show proof of existence for the purpose of showing user or priority of user. The,,,,

Customer Satisfaction Survey can only relate to the year in which it is recorded-which is 2007 and it cannot be related to any period earlier. One mark,,,,

which is used by the respondent shows 'splash of milk' but there are two other marks which show the' face of a cow ' or 'cow bending down'. The,,,,

impugned registration is of course only for a label mark without any logo or device. The applicants mark also shows the head of a cow.,,,,

10 . The applicant claim user from 1990 and even if we exclude the hand-written bills, in Annexure 'E', definitely, the bill dated 16.08.1990, Bill No.",,,,

1872 refers to NAKODA's skimmed milk powder, similarly bill dated 08.08.1990, Bill No. 1801 also shows the NAKODA skimmed milk powder.",,,,

There is an advertisement in the issue ""Halkar"" in 1998 itself which says that Customer always look at the NAKODA trade mark while buying Pure",,,,

Ghee. Therefore, we can not accept the contention of the respondent that it was the applicant who is illegally and dishonestly adopted the mark.",,,,

Clearly, the applicant had adopted the trade mark NAKODA in respect of Dairy Products long before the respondent adopted the trade mark.",,,,

Therefore, the applicant is clearly the prior user, prior adopter and the prior proprietor of the mark NAKODA.",,,,

11. Now we have to see whether there are any special circumstance which we should consider with regard to the impugned mark bearing in mind, the",,,,

fact that the respondent was carrying on business as Shree NAKODA Stores.,,,,

12 . As we have already stated, the applicant has used his mark 'NAKODA' much before the respondent and there is acceptable evidence to show",,,,

user from 1990 in the Magazine Halkar which has already been referred to. On the other hand, the suggesting any modification.",,,,

13. But in this case, one factor which weighs with us is that the respondent had begun his shop in the name of ""Shree NAKODA Stores"" in 1978.",,,,

Thereafter they spread their business outside Kumbakonam after 1993. On the other hand, by this time, the applicant had already started marketing his",,,,

products even from 1990. There is no evidence to show that the respondent had imitated the applicants mark 'NAKODA', on the other hand their",,,,

original business was ""Shree Nakoda Stores"". But on that count, we cannot permit the respondent to continue using mark 'NAKODA' for the same",,,,

Class of goods, when the applicant is clearly the prior user of the mark. It will definitely cause confusion, and the consumer is likely to mistake the",,,,

product of respondent to be the product of the applicant. For the above reasons, we find that the use of the word 'NAKODA' by respondent as a",,,,

trade mark is not dishonest since even from 1978, their business had been carried on from ""Shree Nakoda Stores"". But the adoption of the mark",,,,

'NAKODA' per se will definitely cause confusion because of the existence of the applicants' mark who is clearly the prior user of the work,,,,

'NAKODA' as a mark. The class of goods is also the same. Therefore, we invoke section 12 of the Trade Marks Act and impose the following",,,,

conditions amending the mark to read as ""Shree Nakoda Stores"" with a disclaimer to the device of Cow. The certificate of registration of the",,,,

impugned trade mark shall be surrendered within 15 days from the date of receipt of this order. On a request made by the respondent along with a,,,,

copy of this Order, the Registrar may re-advertise the mark as amended and deal with the matter in accordance with law.",,,,

