

(2004) 08 IPAB CK 0010

In the Intellectual Property Appellate Board

Case No : Original Appeal No. 26/2004/TM/CH

P. Doraisamy Gounder Eswaramurthy And Ors.

APPELLANT

Vs

B. Mohamed Yousuff And Ors.

RESPONDENT

Date of Decision : 06-08-2004

Acts Referred:

Trade And Merchandise Marks Act, 1958 — Section 9, 11, 11(1), 12, 12(1), 18(1)
Trade Marks Act, 1999 — Section 18, 20, 22

Citation : (2004) 29 PTC 730 (IPAB)

Hon'ble Judges : S. Jagadeesan, J;Raghubir Singh, J

Bench : Division Bench

Advocate : Gladys Daniel, P. Saravana Sowmiyan

Final Decision : Dismissed

Judgement

S. Jagadeesan, J

1. The Appellants have preferred this Appeal against the order of the Assistant Registrar of Trade Marks, Chennai, dated 23.1.2004, directing the

registration of the Trade Mark ""Maharaja"" brand of the respondents in Application No. 578456 in Class 30 and dismissing the opposition No. MAS

56450 filed by the appellants.

2. The respondents filed an application under No. 578456 in class 30 on 4.8.1992, for the registration of the Trade Mark ""MAHARAJA"" and a device

of a man caricature. The said application was published in the Trade Marks Journal. The appellants filed their Opposition No. 56450 stating that the

Trade Mark of the respondents sought to be registered is similar to that of the appellants' Trade Mark in respect of the same goods. The respondents'

Trade Mark is neither adopted to distinguish nor capable of distinguishing the goods of the respondents, consequently, the impugned mark cannot be

registered under Section 9 of the Trade and Merchandise Marks Act, 1958. Yet another objection of the appellants is that, the appellants had established use of the Trade Mark and thereby built a reputation associated with the said Trade Mark ""MAHARAJA"" and as such any use of the same mark on the goods covered by the impugned Trade Mark would certainly result in deception and confusion in the minds of the consumers as well as the public at large. Hence, the registration of the impugned mark is prohibited under Section 11 of the said Act. The further objection of the appellants is that the word ""MAHARAJA"" together with the portrait of Maharaja in the impugned mark is identical to that of the appellants' mark. The goods mentioned in the impugned application are also the same. The appellants are using the said Maharaja Trade Mark since 1980 and as such the registration of the impugned mark is barred by the provisions of Sub-section 12(1) of the said Act. The applicants had also disputed the proprietorship of the respondents within the meaning of Section 18(1) of the Act.

3. The respondents filed their counter statement on 29.1.2001 denying the allegations made in the Opposition. Both the parties had filed their evidence.

After hearing both the counsel, the Assistant Registrar of Trade Marks held that the objection of the Appellants under Section 9 cannot be sustained.

Similarly, he also found the objections of the appellants under Section 11(1) cannot be sustained. Having found so, the Assistant Registrar imposed a

condition for registration of the respondents' Trade Mark in order to distinguish from the goods of others during the course of the trade. The condition

being that the respondents shall always use their Trade Mark ""MAHARAJA"" with full name and address of the respondents' firm in prominent

feature on the label, sticker, etc. under Section 12 of the Act. The Assistant Registrar further held that the objections of the appellants under Section

12(1) of the Act also cannot be sustained. With regard to the proprietorship of the respondents, the Assistant Registrar found that the respondents

have adopted the mark honestly and independently and in view of the evidence available on record, the respondents can very well claim the

proprietorship of the Mark. Consequently, under impugned order dated 23.1.2004, the Assistant Registrar allowed the registration of the impugned

Trade Mark of the respondents in application No. 578456 in class 30 and rejected the opposition No. 56450 of the appellants. Aggrieved by the same,

the appellants have filed the present appeal.

4. It may be pertinent to note that the appellants had also filed an application No. 581054 dated 15.9.1992, for registration of their mark

MAHARAJA"" with the word ""Maharaja"" and the respondents had filed their objections. The Assistant Registrar of Trade Marks, by order dated

30.1.2004, allowed the registration of the appellants with a restriction in respect of the area of operation. The appellants filed O.A. No. 25/2004

challenging the condition of restriction in the area of operation and the respondents filed O.A. No. 24/2004, challenging the order of the Assistant

Registrar permitting the registration of the appellants' Trade Mark. The discussion with regard to the earlier user in this appeal would dissolve the

question of entitlement of the parties. The finding would cover the main issue involved in the other appeal O.A. No. 24/2004 as to the right of

registration of the trade mark.

5. The learned counsel for the appellants relied upon certain documents about which we would discuss later on, and claimed that the appellants are

also using the identical Trade Mark Maharaja with the word ""MAHARAJA"" since 1980, whereas, the respondents claim to be using it from 1983. The

appellants being the user in earlier point of time, they are entitled for registration of the mark. The respondents' application cannot be entertained as

both the Trade Marks of the appellants as well as the respondents both in device as well as word being the same, the respondents cannot have

registration of the same, especially when the goods of both the parties are same, the use of the identical Trade Mark would certainly cause confusion

and deception in the minds of the consumers and as such, the impugned Trade Mark cannot be registered.

6. The learned Counsel for the appellants also contended that as per Section 18(1) of the said Act, only a proprietor of the Trade Mark can seek for

registration. By virtue of the agreement entered into between the first respondent and his brothers in the year 1988, the respondents No. 2 and 3 have

no right whatsoever either in Trade Mark or in the business. In such circumstances, the joint application filed by the three respondents herein would

amount to false declaration claiming the proprietorship of the Trade mark when in fact, they are not the joint proprietors. In such a circumstance, the

application filed by the respondents cannot be considered to be one by the

proprietors of the Trade Mark and consequently, the same is liable to be rejected. She also relied upon the judgment of the Division Bench of Madras High Court reported in AIR 1957 Madras 76, B.S. Ramappa v. B.

Monappa and Anr.

7. The learned counsel for the respondents contended that Mujeeb Modern Rice Mill, originally belonged to one Bavadeen Sahib. After the death of

the said Bavadeen Sahib, his six sons B. Basheer Ahmed, B. Khalifulla, B. Mohammed Yousuff, B. Mohammed Sheriff, B. Mohammed Sulaiman and

B. Hyder Ali, constituted a Partnership firm M/s. B. Basheer Ahmed & Brothers and carried on the Paddy and Rice wholesale business since 1983.

Thereafter, in 1988, the first respondent's brothers executed an agreement giving up their rights both in the goodwill of the business as well as their

right in the Trade Mark and thereby the first respondent is the sole proprietor of the disputed Trade Mark. The inclusion of the respondents 2 and 3 in

the application for registration was on the advise of their Trade Marks Agent that their signature is necessary to show their consent in respect of the

proprietorship of the first respondent firm and before this Forum, the respondents No. 2 and 3 have filed affidavits stating that they have no right in the

Trade Mark as well as in the business. Hence, it has to be taken that the first respondent is the proprietor of the Trade Mark as contemplated under

Section 18(1) of the said Act. So far as the prior user claimed by the appellants is concerned, there is no evidence placed by the appellants to establish

the same. The materials relied upon by the appellants are only the letters from various traders which cannot be relied upon as the same are of the

tutored nature. In the absence of any evidence for the use of the Trade Mark by the appellants, their case of earlier user cannot be accepted. Further,

the appellants did not put forth any claim under Section 12(1) of the Act. The Assistant Registrar having found that the respondents are the earlier

users of the disputed Trade Mark and the opposition of the appellants under Sections 9 and 11(1) of the Act cannot be sustained is totally incorrect in

finding that the appellants are the concurrent users. In fact, Assistant Registrar has totally misled himself in coming to the conclusion that the

appellants are using the similar Trade Mark. In fact, the Assistant Registrar has failed to consider the question of prior user as claimed by the

appellants.

8. We have carefully considered the arguments advanced by both the Counsel.

9. The Registrar of Trade Marks had given a categorical finding that the Trade Mark of both the parties are identical and the registration of the

appellant's mark would offend Section 9 as well as Section 11(1) of the Act. This finding was not challenged before us. The learned counsel for the

appellant tried to convince us that the appellant was the earlier user of the Trade Mark and as such, they are entitled for the registration as a matter of

right and consequently the registrar ought to have allowed their application and rejected the application of the respondents.

10. The learned counsel for the appellant drew our attention to the evidence placed before the Registrar and also the additional evidence placed before

this Board in order to establish the claim of the appellant that they are using the trade mark ""MAHARAJA"" a device with the man caricature and the

word since 1980. The evidences pointed out by the learned counsel for the appellant are available in the typed set of documents filed in Appeal No.

O.A. 24/2004. Since all the appeals have been taken up for common disposal, without going into any technicalities, the evidences available on record in

all the three appeals are taken into consideration by us. The typed set of paper book referred to above consists of the bills related to Sri Thilagaraj

Offset Printers for the period 1980 to 1998. The next set of evidence is the bills related to Sakthi Ganesh Textiles, which is also in respect of the same

period. The other set of evidence is the bills related to Sukumar Printers for the period 1981 to 1997 and the last set of evidence is the bills related to

the appellant for the period 1990 to 2001. By way of additional evidence, the appellant filed some more documents in O.A. No. 26/2004 and reliance

was placed mainly on pages 158 to 180, which contains the letters from various dealers and also the one from the Taluk Supply Officer, certifying that

the appellants had supplied or dealt with rice under the brand of ""MAHARAJA"". Apart from this, certain advertisement pamphlets have also been

relied up on.

11. We take up the evidences relied up on by the appellant one by one. So far as the first set of documents, the bills related to Sri Thilagaraj Offset

Printers and also the third set of documents, the bills related to Sukumar Printers, which are of the period 1980 to 1998, are of no use for the

appellants to establish their claim to the use of the disputed Trade Mark. These documents relate to the printing charges of the bill books. There is absolutely no reference to the Trade Mark of the appellant and hence, these documents do not in any way advance the case of the appellant with regard to the use of the disputed Trade Mark. Insofar as the bills of Sakthi Ganesh Textiles is concerned, with whom the appellant had placed orders for the gunny bags and other bags. Out of the 100 bills relied upon by the appellant for the period 1980 to 1994, most of the bills do not contain the Trade Mark, even though there is a reference for the brand name without identifying the brand name. However, at page 51 of the typed set of documents in O.A. No. 24/2004, which is of the year 1982 and pages 57, 59 and 60, which are for the period 1983 and pages 63 and 64 which are of the year 1984, the brand name was mentioned as ""MAHARAJA"", the other documents do not refer to the brand name of ""MAHARAJA"". The bills at pages 117 to 125 are of the period October, 1998 to December, 1998. If we consider the bills related to Sri Sakthi Ganesh Textiles, there are stray bills mentioning the disputed trade mark of the appellant. Though the appellants claim the user from the year 1980, there is absolutely no evidence on the part of the appellant to establish their claim. Only one bill at page 51 is of the year 1982. But, the isolated bill cannot be a conclusive proof for the established use of the appellant. Of course, we are fully conscious that to establish the use, there need not be continuous use of the Trade Mark, but, substantial use must be established. When the substantial use is to be established, then the position is whether the available documents produced by the appellant would establish his substantial use. Out of the 100 documents, only five documents are referring to the disputed Trade Mark. Nine documents are of later period 1998. Hence, we are of the view that the bills related to Sakthi Ganesh Textiles relied upon by the appellants to establish their use from 1980 may not help them.

12. Insofar as the bills of the appellant are concerned, they relate to the year 1990 to 2001. Of course, these bills of the appellants bear the Trade Mark ""MAHARAJA"" up to 1993. From 1993, the appellants added one more device of ""LORD MURUGA"" in their bills. Consequently, both the disputed Trade Mark ""MAHARAJA"" and the device of 'LOR Muruga' are found on either side of the bill and it is written with the device of Maharaja

the words ""MAHARAJA BRAND"" and these evidences are of a decade beyond the date of claim put forth by the appellant for their use.

13. Coming to the additional evidences relied up on by the learned counsel for the appellants, as already stated, pages 158 to 180 of the paper book of

additional evidences produced in O.A. No. 26/2004, they are the letters from various dealers. When the appellant had produced the bills from 1990 to

2001, then why they procured the affidavits from their purchasers to establish their use of the Trade Mark since 1980? We have perused the letters

from the purchasers. The appellant failed to point out a single bill co-relating to any of the purchaser who gave the letters. We have no hesitation to

come to the conclusion that the letters are tutored one and almost stereo-typed with do not weigh much in our mind to rely on the same. The last set of

evidence relied upon by the appellant is the advertisements available at pages 140 to 145(a) and 147(a) of the paper book filed in O.A. No. 26/2004.

At page 140, the appellant made an advertisement of Maharaja Brand rice with the disputed Trade Mark. But, above the same, the figure of a

Goddess is also published as part of the advertisement. In pages 141 to 145(a) and 147(a), the advertisements are there. But, there is absolutely no

evidence with regard to the date of advertisement. In such circumstances, the advertisements cannot be taken as proof for the prior use of the

disputed Trade Mark by the appellant from 1980 onwards. Hence, we are of the opinion that the appellant has not established their claim that they are

using the disputed Trade Mark since 1980.

14. As the respondents have also filed their application for registration, it is but necessary to consider the evidence led in by them. In the typed set of

documents filed by them in O.A. No. 24/2004, the respondents have produced the sale bills issued by them which are in three volumes. The first

volume is for the period 1983 to 1987 and the first bill being of the date 7.4.1983. The second volume is in respect of the bills of the year 1988 to 1995

and the third volume is for the period 1996 to 1999. These bills contain the Trade Mark device with a man caricature, the words ""MAHARAJA

BRAND"" rice. If these bills are taken into consideration, then there is absolutely no difficulty for us to conclude that the respondents had established

their continuous use from 1983 onwards as partnership concern alongwith other brothers after the death of their father. A series of bills further

establish the continuous use of the said Trade Mark by the respondents. In fact, the Registrar of Trade Marks, has allowed the application of the respondents for registration of the Trade Mark in their favour, by order dated 23.01.2004. In the said order, the Registrar rejected the objection raised by the appellant in respect of Sections 9 and 11. He also found that the respondents are the earlier users. The Registrar having found the objection raised by the appellant for the registration of the respondents' Trade Mark, cannot be sustained and having allowed the registration by an earlier order dated 23.1.2004, he ought to have simply rejected the application of the appellants for registration. There is absolutely no justification for the Registrar to consider both the applications independently on merits and pass two separate orders, in fact, conflicting with each other.

15. The learned counsel for the appellant, knowing the weakness of the appellant's case on merits, strongly relied up on the technical issue to challenge the order of the Registrar of Trade Marks. The respondents filed the application before the Registrar for registering the Trade Mark.

Section 18(1) of the Act, envisages that the application for registration can be filed only by a person who claims to be the proprietor of the Trade

Mark. Section 18(1) is extracted below:

18 Application for Registration :- (1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him, who is desirous of

registering it, shall apply in writing to the Registrar in the prescribed manner for the registration of its trade mark either in Part A or in Part B of the

register." The contention of the learned counsel for the appellant is that Sub-Section (1) of Section 18 contemplates a person claiming to be the owner

of the trade mark to file the application for registration. The respondents claiming to be the owners are not the real proprietors of the trade mark in

view of the agreement relied up on by the first respondent dated 30.3.1988, wherein his brothers have totally given up their right in the Mujeeb Modern

Rice Mills alongwith the Trade Mark ""MAHARAJA"" in favour of the first respondent. Hence, the respondents 2 and 3 have no right whatsoever in

the trade mark and consequently their joining as the co-proprietors in the application for registration makes the application liable to be rejected.

16. The learned counsel for the respondents contended that the first respondent is the absolute owner of the trade mark by virtue of the agreement

entered into between himself and his brothers as early as 30.3.1988. But, however, the respondents No. 2 and 3 have joined the first respondent and signed the application on the advice of the Trade Mark Agent. They have filed separate affidavits before this Board stating that they have no right in the trade mark and they have no objection for the registration of the trade mark in the name of the first respondent. In such circumstance, the Registrar can be directed to register the trade mark in the name of the first respondent alone. There is absolutely no bad faith or any fraud on the part of the respondents in making the application as joint proprietors. This being a technical issue, by the consent of the respondents, the mistake can always be rectified and no prejudice would cause to anyone.

17. We have carefully considered this issue. Of course, for a bare outlook, the arguments of the learned counsel for the appellant appear to be very attractive. But, when we go into a little more detail, we are of the view that the arguments have been advanced as a last resort to sustain the claim of the appellant for their registration. What are the basic requirements under Section 18(1) for the registration of the trade mark is that the application must be filed by the proprietors. There is no dispute that Mujeeb Modern Rice Mills was initially started by the respondents' father and after his death, the business was carried on by his sons, the respondents and three others under partnership. The brothers arrived at a settlement on 30.3.1988 and they executed a written agreement signed by all the six. Under the said agreement, the first respondent alone is to run the rice mill with the MAHARAJA"" trade mark. The other brothers have also agreed in the agreement that if any assistance is required from them to register the said trade mark in the name of the first respondent, they are willing to help the first respondent. From the said agreement, it is clear that the first respondent is the absolute owner.

18. It may be pertinent to note that the application can be filed by one who claims to be the proprietor as per Section 18(1). At that stage, all that is required is a bona fide claim. If no opposition on that ground is raised and the claim is not obviously mistaken on the face of the application, then, thus an implication on the part of the applicant that he is the user or he intends to use the mark in the manner applied for. In this case, the Registrar has found that the respondents have become the proprietors of the trade mark by

virtue of inheritance. There is no rival claim against the respondents so far as proprietorship is concerned. The objection of the appellant is also quite vague, as the appellant has stated that the respondents are not the proprietors as contemplated under Section 18(1) of the said Act. In the case on hand, it is not that none of the respondents is the proprietor of the trade mark ""MAHARAJA"". It may be that all may not be the joint proprietors. But, the fact remains that by virtue of the arrangement entered into between the brothers, the first respondent is the proprietor of the trade mark. To confirm this, the respondents No. 2 and 3, who joined the first respondent in filing the application have explained as to why they joined as a co-proprietor and filed the application for registration of the trade mark and now they made it clear before this Board in the same affidavit that they do not claim any right in respect of the disputed trade mark and further, they have no objection to register in the name of the first respondent alone.

19. The Division Bench judgment relied up on by the learned counsel for the appellant in the case of B.S. Ramappa v. B. Monappa and Anr., AIR

1957 Madras 76, lends support to our view. Of course, in the said case, the learned Judges held that the application filed by the non-proprietor cannot

be registered. In that case, the son of the registered trade mark owner filed an application for change of proprietorship and the same was ordered by

the Registrar. This was challenged by another son of the registered proprietor. The person who got the transfer of the proprietorship before the

Registrar put forth the plea that he had obtained express consent from the father, the registered proprietor, for the change of proprietorship, but in the

proceedings before the Court, the father who was also a party, denied such express consent. On that basis, the learned Judges found that the transfer

of proprietorship was on mis-representation and consequently, set aside the order of the Registrar. In the instant case, the respondents sought the

registration of the trade mark ""MAHARAJA"". Though the respondents No. 2 and 3 are not the proprietors as per the agreement entered into between

the brothers, it cannot be said that with any malicious intention, the respondents No. 2 and 3 have signed the application for registration alongwith the

first respondent. As put forth before this Board by way of an affidavit, their claim is that they signed the application only to assist the first respondent

to get the registration of the Trade Mark and the same was done at the instance

of the trade mark agent. In the absence of any mala fide intention, we feel, in the interest of justice, that the statement of respondents No. 2 and 3 can be accepted and the registration in the name of the first respondent alone can be ordered. In our view, the mere mis-declaration without any mala fide intention and bad faith may not deprive an individual from enforcement of his right. In the case on hand, the appellant did not plead either any lack of bona fides or bad faith on the part of the first respondent or in respect of other respondents also. When that be the case, we are at a loss to know as to what the respondents are to gain by such mis-declaration when it is not a deliberate one.

20. Section 22 of the Trade Mark Act, 1999, empowers the Registrar, whether before or after the acceptance of an application for registration under Section 18, to permit amendment of the application. There is no prescribed form in the schedule for such amendment. In that case, it is open to the Registrar at the time of registration, to permit such amendment by receiving TM 16. Section 20 of the said Act refers to the advertisement of the application. Sub-section (2) of Section 20 deals with the amendment which is as under:

20. Advertisement of application :-

(1).....

(2) Where :-

(a) An application has been advertised before acceptance under Sub-section (1); or

(b) after advertisement of an application -

(i) an error in the application has been corrected; or

(ii) the application has been permitted to be amended under Section 22; the Registrar may in his discretion cause the application to be advertised again

or in any case falling under Clause (b) may, instead of causing the application to be advertised again, notify in the prescribed manner the correction or

amendment made in the application.

As per the above said provision, if any error is corrected in the application, the Registrar may in his discretion cause the application to be advertised

again or in the case falling under Clause (b) may, instead of causing the application to be advertised again, notify in the prescribed manner the

correction or amendment made in the application. Hence, we direct the Registrar to amend the application for registration filed by the respondents by

deleting the names of respondents No. 2 and 3 claiming to be the proprietors and confine the application for registration in respect of the first

respondent alone and register the same. We do not think it is necessary to make any advertisement of the amendment as no public interest is involved.

21. Accordingly, we dismiss the appeal. However, with no order as to costs.