
(2020) 07 IPAB CK 0008

In the Intellectual Property Appellate Board

Case No : ORA/115/2014/TM/MUM

Parfums Parour

APPELLANT

Vs

Riyas Choudhury And Ors.

RESPONDENT

Date of Decision : 15-07-2020

Acts Referred:

Trade And Merchandise Marks Act, 1958 — Section 9, 11, 18, 47, 57, 57(2)
Trade Marks Act, 1999 — Section 2(z)(g)

Citation : (2020) 07 IPAB CK 0008

Hon'ble Judges : Manmohan Singh, J;Dr. Onkar Nath Singh, Technical Membe

Bench : Division Bench

Advocate : Ankita Mohanty, Sheeja John

Final Decision : Allowed

Judgement

Manmohan Singh, J

1. The applicant has filed the present petition in the month of October 2006, for removal of the impugned registration No. 1046446 dated September

20, 2001 in Class 03 (hereinafter 'Impugned Registration') for the mark 'LOMANI'(hereinafter 'Impugned Mark') granted in favour of respondent No.

1. Before filing the present petition, a cease and desist notice dated October 04, 2006 was immediately issued on behalf of the Applicant and was duly

delivered to the Respondent No. 1. However, no response thereto was received. Thereafter, the instant application for rectification of the Impugned

Registration was filed by the Applicant on 03/11/2007.

2. Despite of service the Respondent No. 1's continuous failure to appear before IPAB. The IPAB on June 09, 2015, proceeded Respondent No. 1 as

ex-parte and ordered the matter to be heard on merits.

3. On January 06, 2016, after hearing both parties and perusing the extensive documents filed on behalf of the Applicant, this Tribunal passed a

detailed order (hereinafter 'IPAB Order') on January 06, 2016 allowing the prayer of Rectification Petition and directing the Respondent No. 2 to

remove the Impugned Registration from the Trade Marks Register within a period of four weeks from the date of receipt of the said IPAB Order.

4. The Respondent No. 1 filed a writ petition bearing No. WP/1196/2016 before the Hon'ble High Court of Bombay (hereinafter 'Writ Petition')

requesting writ of certiorari to be passed quashing the IPAB Order. The Hon'ble High Court, in its final order dated December 07, 2018 (hereinafter

'BHC Order'), made the following observations:

2. The case of the Petitioner (the Respondent No. 1 herein) is that the copy of the Application for rectification dated 3 November 2007 (Rectification

Petition) was not served on him.

2. ...On the other hand the case of the Respondent No. 1 (the Applicant herein) is that it had taken steps to serve the Petitioner (the Respondent No.

1 herein) including service by publication in the News papers viz. Times of India and Maharashtra Times (Marathi) and no evidence has been relied

upon by the Petitioner (the Respondent No. 1 herein) to show that he had shifted his base to Dubai as averred in the Petition.

5. The Hon'ble High Court finally set aside the IPAB Order in the interest of justice and granted the Respondent No. 1 an opportunity to contest the

Rectification Petition, subject to costs of INR 1,00,000/- to be paid to the Applicant within four weeks. The Court further permitted the Respondent

No. 1 to file its Reply, if any, to the Rectification Petition within eight weeks; and finally issued a direction to this IPAB to decide the Rectification

Petition expeditiously and in any event one year from the date of its order, i.e. by December 07, 2019.

6. As per Order, the deadline for the Respondent No. 1 to file its Reply counter statement to the Applicant's Rectification Petition was expired on

February 01, 2019, but. despite lapse of substantial time, no Reply to counter statement has been filed by the Respondent No. 1 till date. This has been

confirmed via an inspection of physical file pertaining to the present case undertaken on behalf of the Applicant on April 01, 2019 on payment of the

prescribed official fees.

7. Thereafter a letter dated April 04, 2019 was filed with this Tribunal on behalf of the Applicant requesting appointment of the case for a hearing on merits in-line with the BHC Order. Butas per a notice dated October 01, 2019, as issued by the Registrar, all hearings scheduled until December 31, 2019 before any offices of the IPAB were cancelled indefinitely due to administrative reasons. Once the working of IPAB was resumed in January 2020, a second letter dated January 14, 2020 requesting this Tribunal to appoint the present matter for a hearing at the earliest was filed on behalf of the Applicant.

8. It is stated on behalf of applicant that in compliance with the Order, a cheque dated January 04, 2019 for INR 1,00,000/- in the name of the Applicant was issued by the Respondent No. 1. However, due to technical difficulties, the cheque could not be encashed by the bank. This was intimated to the Respondent No. 1 via a letter dated March 27, 2019 wherein it was requested to instead do a wire transfer in the Applicant's bank account directly. However, no amount was deposited in the Applicant's bank account by the Respondent No. 1. Finally, a letter dated January 21, 2020 was received by the Applicant from the Respondent No. 1 intimating that the concerned amount of INR 1,00,000/- could not be deposited in the Applicant's account due to technical issues raised by the bank. Thereafter, details of an Indian Bank account were provided to the Respondent No. 1 for making the payment, to which the Applicant was informed that the Respondent No. 1 is in Dubai and will make the payment on his return to India. However, no payment has been made till date. The matter was taken up for hearing in view of order passed by the Hon'ble Court. No one appears on behalf of respondent.

9. The Order passed by the Hon'ble High Court mentions that ""The Reply, if any, to the Application for rectification to be filed by the Petitioner within eight weeks from today. ""Considering that the Hon'ble High Court laid down a very clear time-line for the Respondent No. 1 to file its Reply to the Rectification Petition, which lapsed on February 01, 2019, the Respondent No. 1 can no longer file or be permitted to file the said Reply to this Rectification Petition.

10. The Order further directed IPAB to decide the matter within one year, which lapsed on December 07, 2019, and hence it is imperative that this

Hon'ble Tribunal consider and decide the dispute expeditiously and at the earliest, on the facts and merits of the case already put forth by the parties.

11. The net result is that the respondent No. 1 has not complied the order passed by the High Court in toto. The respondent No. 1 has neither filed the counter statement nor paid the cost or argued the matter.

12. Once the counsel for respondent No. 1 has appeared before us, it was his duty to appear and argue the matter.

13. It is stated on behalf of the applicant that since no reply has been filed by the Respondent No. 1 in support of its registration in the Impugned Mark

till date, the IPAB ought to reinstate the IPAB Order in the absence of any new facts available. The grounds of decision earlier possessed by IPAB

Order still hold good.

14. On merit it is the case of appellant that the Applicant was incorporated in the year 1986 in Paris, the world capital of fashion and elegance and

since then its international reputation alongwith its brands and products available thereunder have been known across 70 countries on all continents.

14.1. The Applicant, over the years, has stood out in the magical world of perfumery by way of its world-renowned brands, including LOMANI,

VIZZARI, GIORGIO VALENTI, KRISTEL SAINT MARTIN and REMY LATOUR.

14.2. The Applicant adopted the trademark LOMANI for its business in or about the year 1986. The mark LOMANI is a coined word having no

dictionary meaning and adopted arbitrarily with respect to the Applicant's specific products. LOMANI is the star brand of the group Parfums Parour

and has reigned on all international markets for over 30 years now. Consequently, LOMANI has become radically distinctive to the goods of the

Applicant.

14.3. The Applicant has adopted and used a number of LOMANI variant trademarks in respect of its goods and business. A few of such brands and

trademarks include AB SPIRIT BY LOMANI, BEST BYLOMANI, BIG B BY LOMANI, DO IT BY LOMANI, DO IT FOR LOMANI, DUE DI

LOMANI, EL PASO BY LOMANI, HIGH TECH BY LOMANI, LE COUPE BY LOMANI, LOMANI POUR HOMME, LOMAX BY

LOMANI, MISS LOMANI, NETWORK BY LOMANI, SOLARA LOMANI, etc.

14.4. With respect to India, the Applicant first made available its LOMANI brand of products in the year 1986 through a distributor-Damma Trading

Co., which would import such products into India for sale.

15. The Applicant has been the registered proprietor of the mark LOMANI and variants across various jurisdictions of the world since the year 1986.

A few of the major jurisdictions where the Applicant holds statutory rights in the said marks include Australia, China, European Union, France,

Germany, India, Italy, Japan, Russia, Singapore, South Africa, South Korea, Spain, Switzerland, UAE, USA, etc. In France itself, the Applicant holds

150 registrations over LOMANI and LOMANI-formative trademarks.

16. With respect to India, the Applicant enjoys statutory protection over several LOMANI-specific averment is made that formative trademarks for

goods falling in Class 03, including BEST BY LOMANI, EL PASO BY LOMANI, LOMANI (Label), BEST BY LOMANI (Label), MISS

LOMANI PARIS (Label), NETWORK BY LOMANI PARIS (Label), LOMAN POUR HOMME(Label) and DOIT FOR LOMANI PARIS

(Label). The earliest of such registrations, i.e. the mark BEST BY LOMANI was filed claiming use since early 1989, thereby evidencing presence of

different LOMANI brands in India since the late 1980s.

17. The Applicant owns and maintains the domain name which completely comprises the trademark LOMANI and hence

further augments the Applicant's proprietary rights therein.

18. In view of the above, it has come on record that the Applicant has been continuously, extensively and uninterruptedly using the trademark

LOMANI and its variants for almost three decades now. By virtue of such continuous and pervasive use of the said trademark in relation to its goods

and business, the mark has come to acquire immense goodwill and is recognized and associated with the Applicant alone and the Applicant has

marketed, promoted and advertised its products under the trademark LOMANI and variations vide various media including print and electronic. As a

result of its worldwide promotion, the Applicant's products under the brand and trademark LOMANI have met with exponentially rising sales

translating into even greater reputation and goodwill.

19. The Applicant has an invincible presence in the virtual world also via its website www.parfumsparour.com, which provides exhaustive information

on the Applicant, its business, services and products under various brands, including LOMANI. The Applicant also has a dedicated website,

www.lomani-parfums.com that showcases detailed information on the brand LOMANI, the variety of products available thereunder conveniently

categorized into for men, women and kids and the locations of their availability. In fact, the Applicant vide its exclusive e-shopping website,

www.shop-parour.com, offers an unparalleled choice of bold and varied collections under its various brands, including LOMANI, for sale online

thereby making it convenient for its present and potential consumers to explore the said collections and make purchases. The easy availability and

accessibility of the aforementioned websites has consequently helped the brand LOMANI to transcend all geographical boundaries to reach

consumers from across the world.

20. The Applicant and its various brands, including LOMANI, apart from being extensively advertised and promoted through its own websites, have

also been listed on a number of popular international and Indian online shopping websites that offer for sale products under inter alia the brand

LOMANI, such as www.fragrantica.com, www.flipkart.com, www.amazon.in, www.perfumesdirect.co.in, www.fragrancex.com,

www.maniacstore.com, www.deobazaar.com, etc. In fact, the brand LOMANI, since its adoption and launch, has been the subject of much media

attention. A few of the earliest articles on the LOMANI brand of products appeared in the French business magazine, L'Usine Nouvelle, in its

October 1996 and again in January 1997 issue. The Applicant's presence in the virtual world further extends to the major social networking website,

Facebook.com and Twitter.com.

21. Internationally renowned, the Applicant also creates perfumes for well-known personalities. Indian film superstar Amitabh Bachchan and popular

Iranian film star Hedieh Tehrani have both chosen LOMANI to create their signature fragrances. The Applicant incurred massive expenditures in

launching, advertising and promoting the Amitabh Bachchan perfume by LOMANI, which received wide coverage by media since its launch in the

year 2002.

22. A general search for the word 'LOMANI' per se on the search engine Google.com throws results that leads to either the Applicant's website(s) or

to third party websites offering information on or sale of the Applicant's LOMANI products, consequently reflecting association of the said

word/trademark exclusively with the Applicant.

23. By virtue of worldwide trademark registrations including in India, publicity and advertisement of the trademark LOMANI by the Applicant and

sale of products thereunder, as elaborated in the preceding paragraphs, the trans-border reputation and goodwill enjoyed by the brand and mark

LOMANI has only enhanced. The said mark, therefore, is identified as the source indicator of the goods of the Applicant by general public and more

so by the relevant section of the trade and hence the Applicant is entitled to the sole, exclusive and undisturbed use of the said trademark for its goods,

products and business. Consequently, the mark LOMANI has established itself as a well-known mark within the meaning of Section 2(z)(g) of the

Trade Marks Act.

24. As per facts available, it has come on record that the Applicant has vigilantly opposed each and every trademark application of the Respondent

No. 1 that comprises of its proprietary mark LOMANI and has received favourable orders in most of them - as evident from the list below:

25. The Applicant has also instituted a law suit against the Respondent No. 1 before the Hon'ble High Court of Bombay for permanent injunction from

infringement and passing off as well as filed a criminal complaint with the Mumbai Police for sale of counterfeit LOMANI products in India. Both the

said civil and criminal cases are presently sub-judice.

26. Thus in the absence of any rebuttal and material placed on record, it is evident that the Respondent No. 1 has sought registration in the Impugned

Mark with an intention to not only harass the Applicant but also to sell counterfeit products thereunder and deprive the Applicant of the economic

benefit it would have otherwise reaped by selling original products under its LOMANI brand. The Applicant's application No. 2723577 for trademark

LOMANI in Class 03 was objected by the Learned Registrar during its examination on basis of presence of the Respondent No. 1's Impugned Mark

on the Trade Marks Register. While the Applicant was able to overcome this objection and prove its prior and bona fide proprietorship over the mark

LOMANI before the Learned Examiner of Trade Marks, its said application No. 2723577 has been mala fide opposed by the Respondent No. 1 on

basis of the Impugned Registration.

27. The Impugned Mark is identical to the Applicant's prior LOMANI mark and is

registered for identical goods. Therefore, allowing the Impugned Mark to remain on the Register of Trade Marks will not only cause confusion among the minds of consumers but will also result in infringement and passing off the Applicant's intellectual property rights. The existence of the Impugned Registration on the Trade Marks Register is hence wrongful and in violation of provisions under Sections 9, 11, 18, 47 and 57 of the Act.

28. In view of the above, it appears that the Respondent No. 1 was not the proprietor of the Impugned Mark at the time its application was made, or at the time of its registration or even at the time of filing of the present Rectification Petition. The registration in the Impugned Mark was acquired by the Respondent No. 1 by submitting false and fraudulent information to the Respondent No. 2 as the same was never adopted and/or put to use in a bona fide manner", as required by law. Since the adoption of the Impugned Mark is dishonest at the inception, no amount of use, if any, can inure to the Respondent No. 1's benefit. The Respondent No. 1 is, therefore, not the proprietor of the Impugned Mark as required under Section 18(1) of the Act. The Respondent No. 1 obtained registration in the Impugned Mark mala fide and the registration therein on the Trade Marks Register is wrong, without sufficient cause and in violation of provisions laid down by the Act. The said entry is thus liable to be rectified as per Section 57(2) of the Act.

29. In the light of above the earlier order passed by IPAB Order is restored..

30. In light of the above, the registration No. 1046446 in class-3 is removed from the Register as the same is wrongly remaining on the Register. The respondent No. 1 is burdened with costs of one lac as costs for playing the tricks and making misrepresentation before court as well as IPAB. The prayer is allowed. The respondent No. 2 shall delete the entry accordingly. Copy of order be sent to the respondent No. 2 for taking steps without any delay.