

(2006) 03 IPAB CK 0004

In the Intellectual Property Appellate Board

Case No : Original Appeal No. 13/2005/TM/(CH)

Prabha Singh Jaswant Singh

APPELLANT

Vs

B. Mohammed Yousuff And Anr.

RESPONDENT

Date of Decision : 15-03-2006

Acts Referred:

Trade Marks Act, 1999 — Section 107, 107(1), 107(1)(a), 115

Citation : (2006) 33 PTC 216 (IPAB)

Hon'ble Judges : S. Jagadeesan, J; Syed Obaidur Rahaman, Technical Member

Bench : Division Bench

Advocate : S.J. Jagadev, P. Saravana Sowmiyan

Final Decision : Dismissed

Judgement

S. Jagadeesan, J

1. The Appellant filed this Appeal against the order of the Assistant Registrar of Trade Marks, Chennai, finding that the appellant has committed an offence under Section 107 of the Trade Marks Act, 1999 (hereinafter referred to as the Act).

2. The Appellant filed the Suit C.S. No. 726/2004 on the file of the High Court of Madras, against the 1st respondent herein and others for the relief of permanent injunction restraining the first respondent or their representatives from claiming or offering for sale with the use of the trade mark

MAHARAJA in relation to rice and other consequential reliefs. In the plaint filed by the appellant, they have claimed that they are the registered

owners of the trade mark MAHARAJA SPECIAL the word mark MAHARAJA with a device of Air India Maharaja which is being used by the

appellant. Their further plea is that the respondent and others who are the defendants in the suit adopted the mark MAHARAJA and the device of

Maharaja knowing fully well that the Plaintiffs are the registered owners of the trade mark and its reputation. Since the appellants are the registered proprietors of the trade mark MAHARAJA SPECIAL word per-se without the device, their claim that they are the proprietors of the registered trade mark of the word MAHARAJA and also with the device of Maharaja is a false representation since the appellants claim the unregistered trade mark as a registered one, their commission falls under the mischief of Section 107 of the said Act and accordingly the respondent gave a complaint to the Trade Marks Registry. After full fledged enquiry, the Assistant Registrar of Trade Marks, under the impugned order, found that the appellant committed an offence under Section 107(1) of the said Act. Against the said order, the present appeal is filed by the appellant.

3. The learned Counsel for the appellant contended that the appellant did not make any false representation in claiming that their mark is a registered one. Admittedly, the mark MAHARAJA word per-se was registered and about the same there is no dispute. In the advertisement or in the label, the appellant made a reference to the registration number and printed the registered mark MAHARAJA SPECIAL. The device Maharaja is printed within a circle with the words ""PULAO RICE, KING OF RICE"". Hence, the separate circle within which the device has been printed cannot be taken as a part of the registered mark. Further, the contention of the learned Counsel for the appellant is that even assuming for the purpose of argument that the claim of the appellant before the High Court of Madras is to the effect that both the trade mark word per-se Maharaja and the device as registered one and any offence has been committed as contemplated under Section 107 of the Act, even then, the Registrar of Trade Marks has no jurisdiction to go into the question. This contention is based on the basis that the IPC and the Cr.P.C. prescribed the procedure to be followed when the parties to the proceeding made false statement and thereby commit perjury. The claim that the mark and the device are registered is made in the plaint before the High Court and as such, only the High Court can initiate proceedings for perjury either suo-motu or at the request of the respondent therein. Even otherwise, it is for the respondent to raise such a plea before the High Court and seek a finding and only thereafter, he can give any complaint as contemplated under the provision of the Trade Marks Act. Hence, the complaint before the Assistant Registrar of Trade Marks

is pre-mature.

4. The learned Counsel for the first respondent, on the contrary, contended that the claim made by the appellant in the plaint filed in the Civil Suit on the file of the High Court of Madras, clearly makes out a case that the appellant claimed the mark MAHARAJA word per-se as well as the device of Maharaja as their registered trade mark, whereas the registration is only in respect of mark word per-se. Hence, the respondent, bonafidely gave a complaint under Section 107 to the Assistant Registrar of Trade Marks, Chennai, for suitable action. The claim of the appellant that the label used by him in which a reference is made to the registration number would only be in relation to the word mark MAHARAJA and it has nothing to do with the device inscribed in the circle. When both the word mark as well as the device are in the same label, a common man will think that both represent the registered trade mark and as such the claim of the appellant that he is the proprietor of the registered word mark as well as the device of Maharaja is incorrect and as such, the claim is in contravention of Section 107(1) of the Act. The learned Assistant Registrar of Trade Marks also clearly found that the appellant has made a false claim in respect of the unregistered trade mark as that of the registered one. There is absolutely no merit in the appeal.

5. We have carefully considered the above contentions of both the counsel. Section 107 of the Trade Marks Act, 1999, deals with the basis of false representation of a trade mark as registered. Such representation is made an offence punishable with imprisonment, fine or both. The following different kinds of false representations are objectionable;

(a) to represent a mark which is not registered to the effect that it is a registered trade mark;

(b) to represent a part of a registered trade mark which is not separately registered to the effect that it is separately registered as a trade mark;

(c) to represent a registered trade mark as registered in respect of any goods when in fact the registration does not cover those goods;

(d) to represent that the registration of a trade mark makes an exclusive right to the use thereof in any circumstances, when in fact, having regard to

the limitation entered on the register, the registration does not give that right.

6. In the case on hand, the complaint of the respondent is that the appellant

made a claim that he is the registered proprietor of the mark

MAHARAJA word perse along with the device. It is the admitted case of the appellant that the device Maharaja was not registered and his

registered mark is only the mark MAHARAJA word per-se. In that case, the claim of the appellant definitely contravenes the law of Trade Marks

and his action squarely falls as false representation as contemplated under Sub-section (1)(a) of Section 107 of the Trade Marks Act, 1999.

7. We have also perused the plaint filed by the appellant. Since the Assistant Registrar of trade Marks has referred to the portions of the plaint, we

are of the view that it is unnecessary for us to repeat the same once again. The extracted averments referred to in the impugned order, in our view,

establishes the false representation made by the appellant and as such, his claim or action attracts the provisions of Section 107(1)(a) of the said Act.

Hence, so far as this finding is concerned, we do not find any infirmity in the impugned order.

8. The impugned order only empowers the Assistant Registrar of Trade Marks to file a complaint as prescribed under Section 115 of the Trade Marks

Act, 1999, before the Judicial Magistrate. When once the complaint is filed before the Judicial Magistrate, it is open to the appellant to take

appropriate defence. The finding in the impugned order is only a preliminary one in order to lay a complaint under Section 115 of the said Act and as

such, the rights of the appellant have not been affected. There is absolutely no need to interfere with the findings of the Assistant Registrar of Trade

Marks. So far as the question of jurisdiction is concerned, there is nothing on record to show that any such issue was raised before the Assistant

Registrar on behalf of the appellant. For the first time, it is being raised before this Appellate Board. Here again, we are unable to agree with the

contention of the learned Counsel for the appellant. Under the Trade Marks Act, a false representation with regard to the unregistered trade mark as

that of a registered one is an offence. With respect to false evidence in a Court of Law, the I.P.C. and the Cr.P.C. prescribe certain procedures to be

followed to initiate proceedings against the person who gave false evidence. That is a separate proceeding and when two different enactments make

the commissions as distinct crime, each has to be considered separately and both cannot be combined together. Hence, we do not find any merit in the

contention of the learned Counsel for the appellant. We are of the view that the O.A. is liable to be dismissed and accordingly, the same is dismissed.