
(2008) 05 IPAB CK 0001

In the Intellectual Property Appellate Board

Case No : M.P. Nos. 124, 159/2007 In ORA/62/2007/TM/DEL, ORA/62/2007/TM/DEL

Safari Cycles Pvt. Ltd. And Subhash Gupta

APPELLANT

Vs

Safari Bikes Ltd. Through Its Director, Shri Ramdhari Sharma
And The Registrar Of Trade Marks, Trade Marks Registry

RESPONDENT

Date of Decision : 27-05-2008

Acts Referred:

Trade And Merchandise Marks Act, 1958 — Section 9, 11, 11(a), 12(1), 124, 18, 18(1), 20, 21, 56, 100

Trade Marks Act, 1999 — Section 9, 47, 57

Citation : (2008) 05 IPAB CK 0001

Hon'ble Judges : Z.S. Negi, J;S. Usha, Technical Member

Bench : Division Bench

Final Decision : Allowed

Judgement

Z.S. Negi, J

1. By this common order we propose to dispose of the aforementioned applications involving the similar and common issues for consideration in which

the applicants have sought removal/rectification of the entries relating to the registered trade marks under No. 898916 in class 12 in respect of cycle

and parts thereof under Sections 47 and 57 of the Trade Marks Act, 1999 (hereinafter referred to as the Act) and under No. 656900 in class 12 under

Section 56 of the Trade and Merchandise Marks Act, 1958, respectively, and the two miscellaneous petition Nos. 124/2007 and 159/2007, in the first

aforementioned application, whereby the respondent No. 1 has sought certain directions of the Appellate Board.

2. The brief facts leading to filing of the aforementioned applications is that the first applicant is a private limited company under the Companies Act,

1956 and the second applicant Shri Subhash Gupta is the managing director of the first applicant (for the sake of convenience hereinafter referred to as Shri Gupta). The applicants are engaged in the business of manufacture and sale of various types of cycles and their parts under the trade mark SAFARI, which was adopted by Shri Gupta way back in 1974 and which mark is being used by the first applicant continuously and extensively since 1985 up till now. It is stated that Shri Gupta, in the year 1974, started the business of manufacture and sale of various types of bicycles, baby cycles and tricycles under his proprietorship concern namely, M/s Shagun Udyog, by adopting and using the trade mark SAFARI. In the year 1977 Shri Gupta changed the assumed trade name from M/S. Shagun Udyog to M/s. Safari Cycles. On 18.4.1979 Shri Gupta applied for registration of the trade mark SAFARI and got the registration under No. 348290 as of 18.4.1979 in the name of Subhash Gupta trading as Safari Cycles. With a view to expand and organise his business activities, Shri Gupta incorporated the Safari Cycles Private Limited and from the year 1985 onwards, Shri Gupta continued the business activities of his proprietorship concern, M/s Safari Cycles, under the name of the first applicant from the same premises and by using the same infrastructure, telephones, dealers, employees and raw material suppliers as those of the proprietorship firm M/s. Safari Cycles. Shri Gupta is the majority shareholder in the company and the company continued to be the family concern of Shri Gupta who holds 70% of the shareholding and rest 30% is held by the wife of Shri Gupta. The applicants have claimed that being the proprietors of the trade mark SAFARI, they have acquired and retained exclusive rights to use that trade mark as well as an essential key and leading position of corporate name and to restrain others from using the identical and/or deceptively similar mark/name in relation to same goods or the same description of goods.

3. It is averred in the first aforementioned application that the same is filed against the illegal and unlawful grant of impugned label trade mark

registration to the respondent No. 1 under No. 898916 in class 12 by circumventing and negating the prescribed mandatory procedure under the law. It is alleged that the application for the registration of the impugned mark was advertised in the Trade Marks Journal Mega 3 dated 14.10.2003 at page

1277 which is extremely blurred, illegible and in undecipherable manner making it impossible for any person to read the contents thereof except the

word FRIEND appearing on the said label, whereas in the registration certificate, the words SAFARI INTERNATIONAL are also clearly visible.

This illegality in the advertisement has denied the applicants- being the registered proprietors of the trade mark SAFARI-an opportunity to oppose the

impugned registration and as such the illegally and unlawfully granted registration which subsists in the name of the respondent No. 1 is liable to be

cancelled. It is further averred that by virtue of the impugned trade mark the respondent No. 1 is trying to take benefit of the said registration in legal

proceedings pertaining to the trade mark SAFARI pending against it at the behest of the applicants. It is further averred that even otherwise the

impugned registration has been obtained by fraud committed on the respondent No. 2 in as much as apparently on false claim of the user since

1.4.1959 despite the fact that the company itself has been incorporated in the year 1998. The respondent No. 1 knowing fully well that the user

claimed by it is false has defrauded the respondent No. 2 in accepting the application for registration for publication on the basis of such false user

claimed and thus the registration obtained by fraud is liable to be cancelled/rectified. The other grounds, on which removal/rectification sought, inter

alia, are that the entry relating impugned trade mark has been made without any sufficient cause and the same is wrongly remaining on the register;

that the respondent No. 1 had no bonafide intention to use the label mark at the time of making application for registration in relation to the goods of its

manufacture and sale and the said mark has been registered without any bonafide use of the respondent No. 1 in relation to cycle and its parts; that

the registration is contrary to the provisions of Sections 9, 11 and 18 of the Act and that the registration granted is also in contravention of the

provisions of Sections 20 and 21 of the Act. The applicants claimed to be the persons aggrieved to file the application as being the proprietors of the

well-known trade mark SAFARI which is inter alia contained in the impugned label registered under No. 898916 in respect of the same goods and

business as those of the applicants'.

4. The respondent No. 1 in its two miscellaneous petitions has sought certain directions from this Appellate Board. In the Miscellaneous Petition No.

124/2007 it is averred that the petition is not maintainable as the petitioners have themselves stated in the petition that they have come to know about

the registered trade mark when the respondent filed an application in the pending suit. In such circumstances, the petition could not have been filed without complying with the provisions of Section 124 of the Act. Since the present petition is filed without complying with the provisions of Section 124 of the Act, this Appellate Board may, in the interest of justice, dismiss the case at the threshold. In the other Miscellaneous Petition No. 159/2007 it is averred that the petition is not maintainable firstly, that two persons cannot file one petition and the present petition has been filed by two petitioners, namely, the Safari Cycles Pvt. Ltd. and Shri Subhash Gupta and secondly, as per The Trade Marks (Application to the Intellectual Property Appellate Board) Rules, 2003, which prescribes a fee for filing of rectification application, two petitioners cannot file one petition with one filing fee and such the Appellate Board may dismiss the petition with exemplary costs.

5. Averment has been made in the second aforementioned petition/application (which was filed before the High Court of Delhi and which has, upon transfer by the High Court of Delhi to this Appellate Board in pursuance of Section 100 of the Act, been renumbered by this Appellate Board as TRA/21/2005/TM/DEL) that the petitioner/applicant had on 11.11.1988 filed an application for registration of trade mark SAFARI in class 6 in the name of the first applicant and the said application numbered as application No. 500653 and was advertised. The said application was opposed by the respondent No. 1. During the pendency of the proceedings, the applicant came to know that the respondent No. 1 had filed two applications for registration of the trade mark SAFARI (word per se) under No. 644843 in class 12 and SAFARI (label) under No. 656900 in class 12 claiming user since the year 1994. In order to protect its interest in the trade mark SAFARI, the petitioner/applicant filed two separate requests on Form TM-58 requesting the Registrar of Trade Marks, Mumbai to inform about the particulars of the Journal in which the said applications were to be advertised. The Registrar of Trade Marks replied to the petitioner/applicant in respect of the application No. 644843 and accordingly, the petitioner/applicant filed opposition to that application but no response to request on Form TM-58 dated 24.11.1999 about the particulars of application No. 656900 was received from the Registrar. The applicant as a matter of abundant caution filed yet another request on Form TM-58 dated 30.10.2000 for the

particulars of application No. 656900 but the Registrar again failed to perform its statutory obligation and did not inform the required particular of the

said application to the petitioner/applicant. Only on the filing of evidence by the respondent No. 5 in the opposition proceedings to application No.

644843, it was revealed that the application No. 656900 had already been advertised in the Trade Marks Journal No. 1233 dated 16.10.2000 at page

2818. On perusal of the said page 2818 of the Journal, it transpired that a label mark, which is not legible and extremely cloudy and blurred in

appearance, had been advertised under the application No. 656900 in class 12. Thus the petitioner/applicant, even being cautious enough to file the

second Form TM-58 could not locate the impugned application advertised in the Trade Marks Journal at that particular time and hence could not

oppose the said application for registration and the way in which the impugned registration has been granted has not only violated the principles of

natural justice but beats the whole purpose and intent of legislature in enacting the Trade and Merchandise Marks Act, 1958. It is apparent from the

facts and circumstances of the case that the petitioner/applicant was bonafidely and genuinely intended to oppose the impugned application. Apart

from this, the other grounds, on which removal/rectification of impugned registration under No. 656900 in class 12 sought, inter alia, are that the

registration has been granted in contravention of Sections 9, 11(a) and (e), 12(1) and 18(1) of the Trade and Merchandise Marks Act, 1958. The

petitioners/applicants have claimed that they are the persons aggrieved by the entry pertaining to trade mark registered under No. 656900 in class 12

in view of the circumstances specified in the petition/application.

6. After completion of the procedural requirements, the applications alongwith the miscellaneous petitions came up for hearing on 27.5. 2008 when

Shri Neeraj Grover, Advocate appeared on behalf of the applicants and Shri D.K. Dhingra and Shri Shailen Bhatia, Advocates appeared on behalf of

the respondent No. 1.

7. Shri Neeraj Grover, learned Counsel for the applicants, submitted that the applicants being the prior adopter and user of the mark in point of time

and being the registered proprietors of the well known trade mark SAFARI, they have acquired and retained the exclusive right to use the said trade

mark and to restrain others from using the identical or deceptively similar mark

or name in relation to the cycles and parts thereof included in class 12.

Shri Grover submitted that the applicants have in the month of February, 1999 filed Suit No. 394 of 1999 for permanent injunction restraining

infringement of its registered trade mark and passing off by the respondent No. 1 and also its sister concern, M/s. Safari International, before the High

Court of Delhi and the respondent No. 1 in its written statement filed in the said-Suit disclosed that its said sister concern had filed in 1995 a

rectification petition before the Registrar of Trade Marks, New Delhi for removal/cancellation of registered trade mark No. 348290 in the name of

Shri Gupta on a technical ground of non-use as the trade mark SAFARI was being used since 1985 by the first applicant and not by the proprietorship

firm of Shri Gupta. The said application was finally allowed by the learned Assistant Registrar of Trade Marks, New Delhi by passing order dated

1.9.2000 for removal of the registered trade mark from the register. On an appeal preferred by the applicants before the High Court of Delhi against

the said order, the said appeal was, due to the statutory changes made in the Act, transferred to this Appellate Board.

8. The Appellate Board had set aside the impugned order passed by the Assistant Registrar and restored the trade mark under No. 348290 and an

appeal under the writ jurisdiction filed by the sister concern of the respondent No. 1 was dismissed by the Single Judge of Delhi High Court and on an

appeal to the Division Bench of High Court of Delhi, the Division Bench of that Court on 6.2.2008 dismissed the appeal observing that the learned

Single Judge has rightly upheld the order of the Appellate Board. In view of these facts and other circumstances setout in the application, the

applicants are the persons aggrieved to file the present application. The learned Counsel for the applicants argued at length on the illegible

advertisement of the application in the Journal and cited various judgments in support of his argument and also argued on various other grounds on

which the removal/rectification of the registered trade mark is sought in the application, which we think is unnecessary to record in this order as we

are not required to record our findings thereon because of the fact that the learned Counsel for the respondent No. 1 while replying to the arguments

of the counsel for the applicants has fairly submitted that the matter may be remanded to the Registrar of Trade Marks for making fresh

advertisement of the application No. 898916B dated 20.1.2000 in the Trade Marks Journal in accordance with the law. On pointing out by the learned

Counsel for the applicants that there is another application for rectification listed for hearing just next to the application on hand, the learned Counsel

for the respondent No. 1 fairly conceded that the same may also be remanded back for taking similar action by the Registrar of Trade Marks.

9. Now coming to the Miscellaneous Petitions, since we are not deciding the applications on merits, we do not think it necessary for us to go into the

issues raised therein. Moreover, the issue of filing of one petition by two persons with one filing fee has been raised for the first time and there is no

such objection raised in the counter-statement filed by the respondent No. 1. The other issue regarding non-compliance of provisions of Section 124 of

the Act, the same will be decided at an appropriate time after fully hearing both the parties.

10. In view of the above, we allow the applications and remand the matters to the Registrar of Trade Marks with the direction to remove the

registration Nos. 898916 in class 12 and 656900 in class 12 from the Register and to proceed in the application Nos. 898916B dated 20.1.2000 and

656900 dated 24.2.1995 afresh by re-advertising the same in accordance with law. Since the applications are allowed the miscellaneous petitions

become infructuous. There shall be no order as to costs.