

(2014) 06 IPAB CK 0008

In the Intellectual Property Appellate Board

Case No : ORA/116/2011/TM/KOL And M.P. Nos. 90/2011 & 395/2012 In
ORA/116/2011/TM/KOL And ORA/336/2012/TM/KOL And M.P. No.
397/2012 In ORA/336/2012/TM/KOL

Sangita Saha

APPELLANT

Vs

Debashish Saha

RESPONDENT

Date of Decision : 23-06-2014

Acts Referred:

Trade Marks Act, 1999 — Section 9(1), 18

Citation : (2014) 06 IPAB CK 0008

Hon'ble Judges : K.N. Basha, J; Sanjeev Kumar Chaswal, Technical Member

Bench : Division Bench

Advocate : S. Majumdar

Final Decision : Dismissed

Judgement

K.N. Basha, J

1. In these matters, the respondent No. 1 was continuously called absent in number of hearings and they have filed Form-5 applications giving stereo type of reasons. It is pertinent to note that no one represented during the earlier hearings to make their submissions in respect of request made by them by filing Form-5. Earlier the matter was listed on 12.06.2013, as there was no representation by the respondent No. 1 except sending a Form-5, the matter was against listed on 18.12.2013 and again the respondent No. 1 filed Form-5 without appearing either in person or through their advocate. In view of such a conduct of the respondent No. 1, this bench granted the relief of interim stay till the next date of hearing i.e. till today. Even today, the respondent No. 1 neither appeared in person nor through any advocate, or filed any Form-5 till 12.45 AN today during the time of second call. In view of the above said conduct of the respondent No. 1, we have left with no other alternative except to set the respondent No. 1 ex-parte and proceed with the matter for hearing on merits.

2. These two applications are filed by the applicants for the removal of the trade mark of the respondent in respect of 'SIKHA BIRI' bearing Registration Nos. 1758978 & 1758979 in Class 34 respectively from the register of trade marks.

3. In both these applications, the applicants and the respondent No. 1 are one and the same and the issue involved is also same as the dispute is in respect of the same impugned trade mark except a difference in respect of size and therefore both the matters are taken together for hearing and we are passing common order hereunder:-

4 . As we have already pointed out earlier, the respondent No. 1 was set ex-parte by assigning reasons. Now we are pointing out the sum and substance giving rise to the claim made by the applicants and the counter claim made by the respondent No. 1 through their counter statement.

5. The undisputed fact remains that originally the father of the applicants namely Shri Haralal Saha and his brother Shri Mihirlal Saha, the respondent No. 1 being his legal heir , are the partners of the firm namely "M/S. HARALAL MIHIRLAL SAHA" and they were doing business in Bidis under the trade mark "SIKHA BIRI" and in the label photographs of both the brothers have been exhibited. The said partnership was executed on 11.12.1974. Thereafter, the said partnership was dissolved by a dissolution deed dated 01.04.1990 as the father of the respondent No. 1 namely Mihirlal Saha voluntarily retired from the firm. The deed of dissolution dated 01.04.1990 reveals that Shri Haralal Saha the father of the present applicants was entitled to carry on the business Bidis either alone or under partnership with any other person. It is seen that thereafter Shri Haralal Saha was doing the business by taking his legal heirs as partner and by using the same trade mark "SIKHA BIRI". The said position was specifically made clear in class 5 of the deed of dissolution dated 01.04.1990. The applicants relied on second document an affidavit sworn by Shri Mihirlal Saha before the Judicial Magistrate, 1st Class, Agartala, West Tripura stating about the dissolution of partnership between himself and his brother Shri. Haralal Shah and also stating that he has started a separate business in his own name under the brand name as AGNI SIKHA BIRI. It is specifically stated in the affidavit that he had no connection with the firm SIKHA BIRI FACTORY mentioning the license No. L No. 1/ BM/AGT/75 from the date 27.06.1990.

6. The applicants also filed a miscellaneous petition No. 395/2012 to bring on record about the final order passed in Title Suit No. 11 of 2007 apart from filing the earlier document namely dismissal of the injunction application as per the order dated 19. 09.2007. In the said application, the father of the respondent No. 1 sought for injunction, restraining the applicants from using the impugned trade mark namely SIKHA BIRI. The Civil Judge, Senior Division Court No. 2, West Tripura, Agartala in the order dated 19.09.2007 specifically mentioned about the original partnership firm deed dated 11.11.1974 and about its dissolution and ultimately held that the respondent No. 1 are not entitled to any relief of injunction against the applicants.

7. The learned counsel for the applicant has produced a final order also in the title suit No. 11/2007 and also the dismissal of the appeal preferred by the respondent No. 1 by the judgment dated 05.08.2013 by the Additional District Judge Court No. 5 in title appeal No. 56/2011. Therefore it is claimed by the applicants that they are using the trade mark SIKHA BIRI for manufacture and sale of BIDI for long period right from the time of the life of their father Shri Haralal and continued even after the dissolution of partnership with the father of the respondent No. 1 viz. Mihirlal Saha and they are the prior and continuous, uninterrupted user of the trade mark and the impugned trademark was got to be registered by the respondents in respect of the very same trade mark in which the predecessor of the applicants had the right.

8. The respondent No. 1 filed a counter denying the averments and claim made by the applicants. It is admitted that the registered proprietor has been carrying on the business under the Trade Mark 'AGNI SIKHI BIRI' along with the photographs of the proprietor's father. It is further stated that the registered proprietor and his predecessor have honestly adopted and conceived the trade mark " No. 75 SIKHA BIRI" along with the first photograph of the proprietor's father "Label". In the counter the respondent No. 1 has also given sales figure and expenditure made towards advertisement and claimed he has earned reputation. It is also stated that the respondent No. 1 has taken actions against the infringement of the impugned trade mark. It is the case of the respondent No. 1 only the use of the impugned trade mark by the applicants is creating confusion among the public namely the consumers of the BIRI.

9. Shri. S. Majumdar, the learned counsel for the applicants in both the matter would vehemently contend that the respondent No. 1 in both the matters are deliberately ignoring and over looking the rights given up by the registered trade mark proprietor's father namely Mihirlal Shah as per the dissolution dated 01.04.1990 and the respondent No. 1 also defeated the statement made by the father of the registered proprietor before the Magistrate expressly stating that he is nothing to do with SIKHA BIRI FACTORY and undertook to use only a separate trade mark viz. 'AGNI SIKH BIRI'. The learned counsel would point out that the suit filed by the respondent No. 1 predecessor was ultimately dismissed in which the respondent No. 1 was subsequently was impleaded as a legal heir to the predecessor and he would strongly place reliance on the dismissal of the application filed for injunction as per order dated 19.09.2007 as per Exhibit-J, wherein the learned Judge has specifically pointed about the dissolution of the partnership deed holding that the respondent No. 1 predecessor has not made out a prima facie case for granting the relief of injunction against the applicants.

10. The learned counsel would submit that the applicants also filed MP No. 395/2012 to bring the final order passed in the said suit in Title Suit No. 11/2007 on record. It is contended that the respondent No. 1 has not even challenged the dismissal of the interlocutory application for injunction and ultimately even the very suit was dismissed by the Senior Civil Judge as per the judgment dated

16.05.2011 and he has also produced the judgment of the learned Additional District Judge, West Tripura, Agartala dismissing the appeal in appeal title No. 56/2011 as per the judgment dated

5. 08.2013. Therefore, it is contended by placing reliance on overwhelming documents that the applicants has proved their case and established that they are the prior user and have earned name, fame and reputation in respect of the impugned trade mark and as such the impugned trade mark is liable to be cancelled. It is also submitted that mere adding a No. 75 by using the same trade mark of the applicants will not justify the respondent No. 1 to use the impugned trade mark as the same is deceptively similar to that of the applicants trade mark and as well as the label as they are using the photograph of the predecessor of the respondent No. 1 which was in the trade mark of the applicants along with the predecessor of the applicants.

11. As far as the respondent No. 1 is concerned, we have already incorporated their counter statement in respect of their claim and denial of the claim made by the applicants.

12. We have given our careful and anxious consideration to the rival claim made by the respondent No. 1 in respect of the impugned trade mark SIKHA BIRI and perused the entire materials, documents, judgment in the application, Interlocutory petition, final decree in Title suit No. 11/2007 and the appeal judgment in title appeal No. 56/2011 and also perused the impugned trade mark of the applicants.

13. At the outset, we are constrained to state that the impugned trade mark namely SIKHA BIRI is similar and identical to that of the applicants trade mark and label. The fact remains that originally while the predecessors of the applicants and the respondent were together doing a partnership firm business the photograph of both of them had been exhibited and the trade mark is the same namely SIKHA BIRI. Thereafter, the said partnership firm was dissolved as per the dissolution deed dated 1.04.1990 solely on the ground of voluntary retirement of Shri. Mihirlal Shah, the predecessor of the registered proprietor of the impugned trade mark. It is rightly pointed out by the learned counsel for the applicants that the predecessor of the respondent No. 1 has given up his right in respect of the trade mark SIKHA BIRI. The predecessor of the respondent No. 1 has also shown the affidavit before the Learned Magistrate specifically declaring that he has nothing to do with the trade mark SIKHA BIRI and he is using another trade mark AGNI SIKHA BIRI. In respect of such vita documents produced by the applicants, the respondent No. 1 is not able to deny the same except making a vague statement to the effect that those documents were prepared unfairly. For that, there is absolutely no basis for such allegation.

14. The yet another vital document in this case is the order and the final judgment namely the decree passed by the Civil Court. It is pertinent to note that the predecessor of the respondent No. 1 filed a Civil Suit in Title Suit No.

11/2007 and as he died during the pendency his legal heirs have been impleaded and the trial Judge dismissed the interlocutory application filed for seeking injunction restraining the applicants herein from using the impugned trade mark and same was rejected by the trial Judge holding that the respondent No. 1 has not made out a prima facie case. It is seen that the learned Judge dealt with the vital document namely the dissolution of partnership deed and other materials. It is pertinent to note that the said finding reached its finality as the respondent No. 1 has not challenged the said order. It is curious to note that the respondent No. 1 has deliberately come out with the statement in the counter to the effect that the said decision in the petition was not fair. The respondent No. 1 ought to have made a statement that the learned judge has erred in giving such finding but has no right to make such an unwarranted statement that the decision was not fair. It is also relevant to note that the said Civil Suit was ultimately dismissed by passing final decree and judgment dated 16.05.2011 by the Civil Judge, Senior Division Court No. 2., West Tirupura, Agartala.

15. The learned counsel for the applicants also filed a Miscellaneous Petition No. 395/2012 to bring the said judgment on record and the said judgment is relevant one and we are constrained to allow the said Miscellaneous Petition. The learned counsel also produced the judgment copy in the appeal filed against the said final decree and judgment in Title Appeal No. 56/2011 passed by the Hon'ble Additional District Judge, Court No. 5, West Tripura, Agartala. In the appeal judgment also all the claims made by the applicants herein are dealt by the learned Judge.

16. In view of the above said categorical and consisting documents namely the Civil Court Judgment in Title Suit No. 11/2007, the affidavit sworn by the predecessor of the respondent No. 1 before the Magistrate, the final judgment passed by the Civil Court in Title Suit No. 11/2007 and the dismissal of the appeal in Appeal No. 56/2011 which are dealt with vital documents viz. the dissolution of partnership deed and affidavit, we have no hesitation to hold that the respondent No. 1 has no right whatsoever to use the impugned trade mark. We are equally of the view merely by adding No. 75 and exhibiting the photographs of the predecessor of the respondent No. 1, there is no justification for using the impugned trade mark as the same is visually, phonetically similar and identical to the trade mark SIKHA BIRI used substantially by the applicants for a longer period as per the rights conferred on the applicants. We have no hesitation to hold that the respondent No. 1 is committing violation in respect of the provisions under Section 9(1) & 18 of the Trade Marks Act, 1999 and the said impugned trade mark is wrongly in the trade mark register of the respondent No. 2 herein.

17. In view of the aforesaid reasons, we are constrained to direct the respondent No. 2 to expunge the impugned trade mark viz. SIKHA BIRI bearing Registration Nos. 1758978 & 1758979 in Class 34 respectively from the register of trade marks.