
(2004) 08 IPAB CK 0013

In the Intellectual Property Appellate Board

Case No : Transferred Appeal No. 90/2003/TM/DEL (CM (M) 374/94)

Sona Tea House

APPELLANT

Vs

Sona Spices Private Ltd. And Anr.

RESPONDENT

Date of Decision : 04-08-2004

Acts Referred:

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

Trade Marks Act, 1999 — Section 100

Citation : (2004) 29 PTC 614 (IPAB)

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

Bench : Division Bench

Advocate : Manmohan Singh, K.G. Bansal

Final Decision : Disposed Of

Judgement

S. Jagadeesan, J

1. The appellant filed an application No. 403366 on 26th March, 1983 for registration of a trademark consisting the word 'SONA' in respect of goods

TEA' in Class 30, for sale in the State of Haryana. The said application was advertised before acceptance under proviso to Section 20(1) of the Trade

and Merchandise Marks Act, 1958, (hereinafter called the Act) in Trade March Journal 991 dated 16.09.1990 at page 730. The respondents filed their

notice of objection on 17.12.1990 in opposition No. DEL - 7005, objecting the registration of the impugned mark of the appellant on the ground that the

respondents are the registered proprietors of the trademark "'SONA SPICES'" logo in respect of spices and the same is identified and associated with

the reason of its extensive use and publicity. The registration of the impugned mark is prohibited under Section 9 of the Act since the same is neither

distinctive nor capable of distinguishing. The description of goods are the same and the impugned mark is bound to cause confusion and deception

during the course of the trade and hence prohibited for registration under Section 11(a) as well as under Section 12(1) of the Act.

2. The appellants filed their counter statement on 6.5.1992 denying the averments of the respondents in their notice of opposition. The Registrar of

Trade Marks upheld the opposition under Section 9(1)(d) of the Act on the ground that the appellants failed to rely upon any evidence. On the same

grounds, the opposition under Section 12(1) was also upheld. The Registrar further rejected the objection of the respondents under Section 18(1). The

Registrar ultimately rejected the application of the appellant under the impugned order. While doing so, he further added that the grounds and reasons

of refusing the impugned application should be supplemented and read along with order passed against the very same application in opposition No.

DEL-7332 dated 9.5.1974. Aggrieved by the same, the appellant has filed an appeal in the High Court of Delhi as No. CM(M) 374 of 1994. This

appeal has been transferred to this Appellate Board by virtue of Section 100 of the Trade Marks Act, 1999.

3. The counsel for the appellant submitted that the application of the appellant for registration of their trademark was opposed by the respondent

herein as well as two other parties namely. 1. M/s. Brooke Bond India Ltd., in opposition No. DEL-7032; and 2. M/s. Soongachi Tea Industries

Private Ltd. The opposition No. 7032 filed by M/s. Brooke Bond India Ltd., was allowed and the application of the appellant for registration of the

trademark 'SONA' was rejected. By another order, the opposition filed by M/s. Soongachi Tea Industries Private Ltd., in DEL-6927 was rejected and

the application of the appellant for registration was allowed. Against these orders of the Registrar of Trade Marks, M/s. Soongachi Tea Industries

Private Ltd., filed an appeal in CM(M) 342 of 1993 against the appellant herein on the file of the Delhi High Court and the appellant herein filed

CM(M) 371 of 1994 against M/s. Brooke Bond India Ltd. Both these appeals were allowed and the application of the appellant for registration of the

trademark was remanded to the Registrar of Trade Marks for fresh disposal on merits. The learned counsel for the appellant contended that since this

impugned order makes a reference to the findings of the Registrar given in the opposition No. DEL-7032 stating that reasons for upholding the

opposition in DEL-7032 have to be supplemented along with other reasons given in the impugned order under appeal and now that the order of the

Registrar of Trade Marks in respect of upholding of the opposition No. DEL-7032 had been set aside by the Delhi High Court, in all fairness, this

appeal must also be allowed and the matter has to be remanded back to the Registrar of Trade Marks, New Delhi with a direction to consider all the

three oppositions together. He also pointed out that the evidences have been filed at the pre-advertisement stage and a memo has been filed to treat

the evidences filed against one of the oppositions as evidence in respect of the other oppositions also. Hence the statement of the Registrar of Trade

Marks that no evidence has been filed is not correct.

4. The learned counsel for the respondent vehemently opposed the submission of the learned counsel for the appellant for the remanding of the case

on the basis of the judgments of Delhi High Court in CM(M) 342 of 1993 and CM(M) 371 of 1994. He also argued on merits by referring to a number

of Judgments. The main contention of the learned counsel for the respondent opposing the submission of the learned counsel for the appellant is that

the Registrar of Trade Marks has given a finding in certain aspects in favour of the respondent and now by seeking for a remand, the appellant is

making an attempt to set aside such findings and further seeks for a fresh disposal with fresh evidence. Unless the order of the Registrar of Trade

Marks is proved to be illegal, the findings of the well considered order cannot be set aside. The last paragraph of the impugned order refers to the

supplemental reasons, which means the reasons given for upholding the opposition DEL-7032 filed by M/s. Brooke Bond India Limited are, lending

support to the upholding of the opposition in this case alongwith the supplemental reasons provided under the impugned order.

5. At the outset, we have to consider whether the matter has to be remanded back to the Registrar of Trade Marks in pursuance of the two judgments

of Delhi Court relied upon by the learned counsel for the appellant. In appeal No. CM(M) 342 of 1993, by order dated 12th September 2003, the

learned Judge passed the order as follows:-

To cut the controversy short, learned counsel for the respondent today makes a statement that he has no objection if the impugned order is set aside

and the matter is remanded to the Registrar of Trade Marks for consideration on

merits. It is ordered accordingly. The impugned order dated 3.6.1993 is set aside and the matter is remanded to the Registrar of Trade Marks for adjudication on merits. It is made clear that all objections as raised by the respondent in the opposition would be considered. Parties would also be permitted to file additional documents, in original, as the matter has been pending in this Court since 1993, so as to enable the Registrar of Trade Marks to have evidence of the current trading position. Ordered accordingly.

6. In the appeal No. CM(M) 371 of 1994, the learned Judge passed order on 19.9.2003 as follows:-

Since the matter pertaining to the registration of the trade mark, sought by the petitioner stands remanded for consideration vide order dated

12.9.1993 passed in CM(M) 342/93, it would be in the fitness of things that the impugned order dated 9.5.1994 in the present proceedings is also

quashed. The matter is remanded to the Registrar of Trade Marks to consider the same after giving opportunity to the parties to place on record all

evidence on which they rely with further directions that opposition No. DEL-7032 filed by the respondent herein would be considered and disposed of

alongwith opposition No. DEL-6927 filed by 'SOONGACHI TEA INDUSTRIES PVT. LTD.'" The petition is allowed subject to the directions

hereinbefore contained. No costs.

7. The learned counsel for the respondent, however, contended that the order in CM(M) 342 of 1993 is at the connivance of the parties and hence the

same may not be of any assistance for the disposal of this appeal especially to set aside the findings by the Registrar of Trade Marks so far as they

are in favour of the respondent. We are unable to agree with the contention of the learned counsel for the respondent. In fact the appellant has got a

favourable order from the Registrar of Trade Marks. When that be so, normally he may not agree for setting aside the order directing registration of

their trademark. Hence obviously, there is some error of jurisdiction or error in the procedure, which might have prevailed upon the counsel to get the

matter remanded.

8. Since the application of the appellant has been remanded in respect of one opposition in appeal CM(M) 342 of 1993, the learned Judge had thought

fit that with regard to the other opposition in respect of the appeal CM(M) 371 of 1994 also must be re-heard. In such circumstance, in the fitness of

things, we also feel that the findings of the Registrar in this appeal have to be set aside and the matter has to go back for fresh disposal when the

learned Judges of the Delhi High Court gave liberty to the parties to let in fresh evidence in both appeals CM(M) 342 of 1993 and CM(M) 371 of

1994.

9. When there are more than one opposition in respect of the same application for registration, the Registrar of Trade Marks for the convenience of all

the parties must take up all the oppositions jointly and deal with the same. It is evident that the parties are filing evidence in one case or in respect of

one opposition, and that the same can be taken up in respect of other oppositions also. Though the Act provides certain procedure for taking up such

evidence filed in one opposition as evidence for the other opposition, it is a well-known fact that neither the counsel appearing for the parties nor the

agents strictly follow the procedure. Some times they take it for granted that at the time of hearing, it can be mentioned to the authority and the

evidence filed in one opposition can be taken for consideration in respect to the other. In order to avoid these anomalies, it is always better to the

Registrar to take all the oppositions in respect of one application for registration in a consolidated manner and dispose them off by a single order. If

that had been done, this type of anomaly of allowing the application for registration by rejecting one opposition and upholding another opposition in

respect of the same application for registration, would not arise. By rejecting one opposition and upholding the opposition of another opponent in

respect of a single application for registration of the trademark, whether the applicant is entitled for registration of the trademark? In our view, it may

not be possible. On this ground also, we are of the view that the matter has to go back.

10. In the concluding paragraph of the impugned order, the Registrar of Trade Marks lend support for remanding the matter because he has

specifically stated that the grounds and reasons of refusing the impugned application for registration should be supplemented and read alongwith this

order in respect of the opposition DEL-7032 dated 9.5.1994. It is an admitted fact that the order in respect of opposition DEL-7032 has been set aside.

We have no hesitation in finding that this order is also to be set aside and the matter has to go back to the Registrar of Trade Marks for fresh disposal.

Accordingly, the appeal is allowed. The application of the appellant bearing No. 403366 for registration of the trademark ""SONA"" to be disposed of

alongwith the opposition of the respondent in opposition DEL-7005. The Registrar of Trade Marks is further directed to take the opposition No. DEL-

7032 filed by M/s. Brooke Bond India Limited and opposition No. DEL-6927 filed by M/s. Soongachi Tea Industries Private Limited, so far as it

relates to application No. 403366 of the appellant for registration of the trademark. There will be no orders for costs.

11. Since the application of the appellant is of the year 1983, we direct the Registrar of Trade Marks to dispose of the same within three months from

the date of receipt of the copy of this order.