
(2005) 01 IPAB CK 0007

In the Intellectual Property Appellate Board

Case No : TA/RECTT/265/2004-TM/AMD (A. No. 9/1996)

Sukha Mal And Sons And Ors

APPELLANT

Vs

Prakash Sheshmal Jain And Ors

RESPONDENT

Date of Decision : 19-01-2005

Acts Referred:

Trade Marks Act, 1999 — Section 100

Trade And Merchandise Marks Act, 1958 — Section 9, 11, 11(a), 12(1), 18, 32, 32(a), 32(b), 32(c), 46, 46(1)(a), 46(1)(b), 56

Citation : (2005) 31 PTC 236 (IPAB)

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

Bench : Division Bench

Advocate : J.Y. Trivedi

Final Decision : Allowed

Judgement

Raghubir Singh, J

1 . Appeal No. 9/1996 filed in the High Court of Gujarat at Ahmedabad under the Trade and Merchandise Marks Act, 1958, has been transferred to

this Board in terms of Section 100 of the Trade Marks Act, 1999 and has been numbered as TA/RECTT/265/2004/TM/AMD.

2. The first respondent filed an application under Section 46 and 56 of the Trade and Merchandise Marks Act, 1958 before the Assistant Registrar of

Trade Marks, Ahmedabad for rectification of the Register in respect of the trade mark No. 419705 and accordingly the hearing was held by the

Assistant Registrar of Trade Marks on 20. 8.1993.

3. The trade mark 'VIPUL' stood registered as from 27.3.1984 in favour of Sukha Mal and Sons, trading as Vipul International, Surat, the appellant

herein, in respect of Sarees in class 24 on the basis of user claimed from

7.3.1980. The first respondent filed an application for rectification to remove the mark from the Register on 4. 11.1991. The important grounds taken for rectification are:-

(a) The first respondent had been using the trade mark VIPUL over a long period in relation to textile piece goods . The first respondent has filed an

application for registration of the mark on 30.12.1983 under No. 415249B in class 24 claiming user from December, 1980, which application has been

accepted and advertised. The appellant herein filed an opposition to that registration.

(b) The appellant herein had filed an application on 27.3.1984 in respect of Sarees under No. 419705B and falsely claimed prior user over that of the

first respondent's application.

(c) By making false representations and by filing false documents, they have got their mark registered.

(d) Owing to inadvertence, the appellant's application was not opposed and it finally got registered.

(e) The appellant's mark was wrongly registered and an entry relating thereto on the Register is without sufficient cause and is wrongly remaining on

the Register.

(f) The registration of the mark was obtained by fraud, misrepresentation and by claiming false user by producing fabricated documentary evidence.

(g) The registration of the mark was obtained in contravention of Sections 9 and 12(1) and thus, the appellants are not the real proprietors of the mark

under Section 18 of the Act.

4 . The Assistant Registrar held that the first respondent is the person aggrieved for the purposes of Section 56 of the Act. She further held that the

registration has been obtained without sufficient cause and the mark was registered on mis-representation. She further held that the mark was

registered in contravention of the provisions of Section 11 of the Act and thus, it is an entry wrongly remaining on the Register in view of the Act.

Thus, in conclusion, she held that the Register is liable to be rectified by removal of the mark from it.

5 . The appellant aggrieved by the decision of the Assistant Registrar filed a review before her which was rejected and ultimately the present appeal

was filed in the High Court of Gujarat at Ahmedabad.

6. The Board in its sitting held at Ahmedabad on 22.12.2004 heard Shri Y.J. Trivedi for the appellants and none represented the respondent.

7 . While the Board was holding its sitting at Ahmedabad, a fax message under the signature of the first respondent dated 13.12.2004 was received on

20.12.2004 making certain allegations against the appellants and certain other officials. We have carefully gone through the contents of that letter. It

shall be pertinent to mention that the hearing of the case was earlier fixed for 28.7.2004 at Ahmedabad and the Board was informed by the counsel on

record that he had not received instructions from the first respondent in the matter as the first respondent had been thinking of making alternative

arrangements. We received a fax message from the first respondent on 27.7.2004 forwarding therewith a medical certificate stating that the first

respondent has been advised rest till 20.8.2004. In view of that, the case was adjourned for which the hearing was fixed to be held at Ahmedabad on

22.12.2004.

8 . In the appeal it has been submitted that the first appellant had been trading as Vipul International and was the registered proprietor of the mark

VIPUL in No. 419705 from 27.3.1994 in respect and in relation to sarees in Class 24 on the basis of user of the mark since 7.3.1980. The first

appellant assigned the mark in favour of the second appellant. The third appellant is the subsequent assignee of the said mark VIPUL used in respect

of sarees and dress materials included in class 24. The grievance of the appellants is that the impugned order of the Assistant Registrar was passed

ex-parte in the face of the fact that the appellant had sought adjournment for certain pressing reasons and the Assistant Registrar did not allow the

adjournment. The brief facts as narrated in the appeal are as given in the subsequent paragraph.

9. The first appellant applied for registration of the trade mark VIPUL on 27.3.1984 in respect of sarees in class 24 and the same was registered as

No. 419705. The first respondent filed rectification application on 4.11.1991 and the Office of the Assistant Registrar is located at Ahmedabad and for

that matter, the hearing was to be done at Ahmedabad. The matter was fixed for hearing on 13.8.1993. The counsel of the appellant was from Delhi

and the counsel for the first respondent was from Bombay. With a view to accommodate the convenience of the counsel of the first respondent, the

learned Assistant Registrar changed the date of hearing from 13.8.1993 to 20. 8.1993. When the changed date was conveyed to the counsel of the appellants at Delhi to the effect that the date of hearing has been adjourned from 13.8.1993 to 20. 8.1993, the counsel for the appellant requested to keep it in September as he had some personal difficulty in his family and he was not in a position to attend the hearing on 20.8.1993. In any case, the Assistant Registrar chose to hold the hearing ex-parte on 20.8.1993. The Assistant Registrar identified the following four points to be the issues arising for consideration:

Whether the first respondent is a 'person aggrieved' under section 56 of the Act.

Whether the registration has been obtained without sufficient cause and the mark was registered on misrepresentation.

Whether the impugned mark is liable to be removed from the Register for the alleged non user under section 46(1)(a) & (1)(b) and as (sic) the mark was registered in contravention of section 11.

Whether the impugned mark is liable to be rectified and if so in what manner?

10. In so far as the issue No. 1 is concerned, there is not much for us to dispute the position taken by the Assistant Registrar in view of the settled law in that area. We conclude that she has rightly decided that the first respondent is the person aggrieved under Section 56 of the Act.

11. First respondent had applied for registration of his mark VIPUL on 30.12.1983 and the first appellant had applied for registration of the mark

VIPUL on 27.3.1984. The Assistant Registrar feels that an objection should have been raised in the examination report under Section 11(a) in relation

to the application filed later in time, that is, the application of the appellants. It is pertinent to note that this examination report is given by the office of

Trade Marks Registry out of records available with them. The Assistant Registrar has pointed out some conflict in matter of the user claimed as

mentioned in TM 6 and the application on Form TM 1 of the appellants. The Assistant Registrar has also mentioned about the affidavit filed by the

appellant in support of the evidence as user wherein advertisements published in the Hindi Hindustan, Hindustan Times and Nav Bharat, had been

submitted as evidence. The entire burden of arguments in what the Assistant Registrar has stated in the order as to the quantification of the evidence

given in support of the claim for rectification is nothing whereby we can infer that

there had been any material mis- representation on the part of the appellants in support of their application. It is true that the appellant is later in his application for registration of the mark VIPUL vis-À-vis the first respondent and for that matter, a reference of the earlier application should have been given in the examination report. We fail to comprehend and appreciate the comment of the Assistant Registrar on this score. If she is commenting upon the working of the Trade Marks Registry, the blame lies at their door step to provide the information or can it be someone's case that the burden in this regard is upon the appellant who was the applicant under the impugned mark. It is needless to re-emphasize here that in a matter of rectification of an existing mark on the Register, the burden is upon the aggrieved person to adduce the evidence to support his claim. The registered proprietor of the mark impugned cannot be a scapegoat of the failings of the Trade Mark Registry.

12. In matter of the third issue culled out by the Assistant Registrar, she has chosen to examine the mark at the anvil of clauses (a),(b) and (c) of Section 32 of the Act. The impugned mark was put on the Register on 31.7.1991 and the application for rectification was filed on 4.11.1991. The date of registration of the mark is 27. 3.1984. It is in a sense she feels that the mark is qualified for the protection of general provisions of Section 32 in view of the same having been on the Register for 7 years, which run from the date when the mark is actually put on the Register. Here in this case, according to the Assistant Registrar, the mark was put on the Register on 31. 7.1991 and the date of filing of the application for rectification is 4.11.1991. Thus, the immunizing benefit of 7 years as envisaged under Section 32 is not available to the appellant. In view of that, the existence of the mark on the Register is to be tested by clauses (a) and (b) of sub section (1) of Section 46. Again, we want to put a note of caution that the burden is cast upon the person who moved the application to prove the existence of circumstances envisaged under clauses (a) and (b) of sub section 1 of Section 46, that is, the mark was registered without any bonafide intention on the part of the applicant for registration that it should be used in relation to those goods by him or in the alternative, that upto a date one month before the date of the application, a continuous period of five years or longer had elapsed during which the trade mark was registered and during which there

was no bonafide use thereof in relation to those goods by any proprietor thereof for the time being. We do not find anything in the order of the Assistant Registrar to substantiate all these claims having been put by the first respondent before the Assistant Registrar on the basis of which, she could arrive at the conclusion that there had been a compliance of the provisions of Section 46 of the Act with a view to arrive at a conclusion for ordering rectification of the Register.

13. In view of our findings in relation to issue Nos.2 and 3 of the matter, we feel that the Assistant Registrar has wrongly arrived at the conclusion that the Register needs correction with a view to remove the mark therefrom under Sections 46 and 56 of the Act.

14. Accordingly, the order dated 24.8.1993 of the second respondent is set aside and the appeal is allowed with no order as to costs.