
(2018) 04 IPAB CK 0005

In the Intellectual Property Appellate Board

Case No : ORA/309/2013/TM/DEL

Sunstar Overseas Limited

APPELLANT

Vs

Madan Lal

RESPONDENT

Date of Decision : 26-04-2018

Acts Referred:

Trade Marks Act, 1999 — Section 9, 11, 18, 47(1)(a), 46(1)(b), 47, 57

Citation : (2018) 74 PTC 619 (IPAB)

Hon'ble Judges : Manmohan Singh, J; Sanjeev Kumar Chaswal, Technical Member

Bench : Division Bench

Advocate : Amarjit Singh

Final Decision : Allowed

Judgement

Sanjeev Kumar Chaswal, Technical Member

1. The present Rectification Petition has been filed by the applicant for cancellation/removal of registered trade mark No. 1155201 in class 30

registered in the name of the respondents as of 03.12.2002. The trade mark, subject matter of registration No. 1155201 in class 30 is a label mark

consisting of the word HELLO as an essential feature thereof in respect of Tea, Rice, Maida and Besan. The registration certificate was issued on

18.02.2005. The applicant has filed the petition under the provisions of section 47 and section 57 of the Trade Marks Act 1999 for seeking relief of the

rectification of the register.

2. The brief facts are that

a. The applicant is a company incorporated under the provisions of the Companies Act. The applicant Company is the successor and assign in

business and title of the partnership firm M/s. Star Overseas which also carried on the same business for the process, manufacture and sale of

varieties of goods falling class 29 and 30

b. The company is engaged in the business of processing, export and sale of different varieties of goods falling class 29 and 30 including rice, pulses,

spices and other articles of human consumption.

c. That the applicant predecessor partnership firm M/s. Star Overseas and it was later incorporated on 31.01.1995 under the provisions of the

Companies Act by the aforesaid partners of the firm. M/s. Star Overseas along with other family members with the primary object to conduct the

business of inter alia process, manufacture and sale of all types and varieties of goods falling class 29 and 30 including rice, pulses, spices and other

articles of human consumption.

d. By an agreement dated 01.02.1995, the business of the partnership firm M/s. Star Overseas was taken over by the applicant company along with its

assets, liabilities, goodwill, trade mark tenancy rights, letters of credit, export supply orders, export benefits RBI Code, Importer -Exporter Code etc.

e. The applicant trade mark ""HELLO"" was originally conceived, adopted and used prior in point of time in the course of trade by the applicant

predecessor in title and interest since the year 1988.

f. The said Trade Mark ""HELLO"" was continued to be used by the applicant company in respect of process, manufacture and sale of variety of goods

falling class 29 and 30 including rice, pulses, spices since 1995 after having taken over the entire business of the said partnership firm along with its

assets, liabilities, goodwill etc.

3. It is stated by the applicant that the Trade Mark ""HELLO"", has extensively and continuously been used in the course of trade since the year 1988

by its predecessor, so much so that the purchasing public and the members of the trade have come about to exclusively identify and recognize the

goods i.e. of variety of goods falling in class 29 and 30 including rice, pulses, spices bearing the Trade mark ""HELLO"" as the quality product

originating from the source of the applicant and none else. The trade mark ""HELLO"" has acquired enviable reputation in the minds of the purchasing

public and the members of the trade to distinguish its products from those of its competitors.

4. It is claimed by the applicant that it has extensive sales of its goods under the trade mark ""HELLO"" during the past years and has also spent

considerable amount on the publicity and sales promotion thereof during the past years and by virtue of priority in adoption and use, the applicant has

acquired and retained an exclusive right to the use of the Trade Mark ""HELLO"" in respect of the goods of its process, export.

5. On 03.12.2002 when the application for registration of the impugned trade mark, ""HELLO"" which is similar to the trade mark of the applicant and in

respect of the same description of goods, was filed with a claim of user of w.e.f. 01.04.1995.

6. It is a matter of fact that the prior application for registration of identical trade mark No. 541857 dated 14.12.1990 of the applicant was already

pending for consideration. The trade mark No. 541857 was registered on 15.05.1997

7. The present petition was filed by applicant on 16.08.2013 under section 47 also seeking cancellation of registration of the impugned trade mark of

the respondent on the ground that a continuous period of 5 years and 3 months prior to the institution of the petition had passed during which the

respondent being the registered proprietor and did not make any bonafide use of the registered trade mark No. 1155201 in class 30.

8. It is submitted by the applicant that the registered proprietor had obtained registration of the trademark 'HELLO' in respect of Class 30 merely

block the mark on the Trade Marks Register. It is evident that such act involves bad faith of the registered proprietor. That the registration of the

impugned trademark application No. registered trade mark 'HELLO' No. 1155201 in class 30 has been granted in contravention of the provisions of

Section 9 of the Act.

9. The matter was fixed for hearing on 25/11/2016 before the Deputy Registrar IPAB at Delhi. The respondent was notified about the said hearing by

letter dated 24.10.2016. The respondent did not appear before the Deputy Registrar IPAB on 25.11.2016. The final hearing in the petition was fixed

before the Board on 08.02.2018 and parties were notified about the said date of hearing vide notice dated 15.01.2018. The respondent was duly

served with the notice dated 15.01.2018.

10. On 08.02.2018, when the matter was called for hearing, the applicant

appeared through its counsel. The respondent did not appear and was not represented by any counsel at the time of hearing. The learned counsel for the applicant brought that the respondent be proceeded ex-parte and the matter be heard and decided on merit in accordance with the provisions of Law. The Hon'ble Board heard arguments and reserved the order.

11. It is apparent that despite of having been given an opportunity to file the counter statement and evidences chose to remain silent in the absence of any counter statement and/or denial of any of the material averments made in the petition.

12. The respondent has also not established any bonafide use of the impugned trade mark during the period of 5 years and 3 months prior to the institution of Rectification Petition.

13. In view of averment made and material on record on that the trade mark 'HELLO' (word and label) in respect of Rice was in use on the part of the applicant prior to the date of filing of the application for registration of the impugned trade mark. The respondent was thus not the proprietor of the trade mark 'HELLO' (word and label) on the date of the filing of the application for registration of the impugned mark with the meaning of section 18 of the Act.

14. As per record maintain by the respondent No. 2, the application for registration of trade mark No. 541857 dated 14.12.1990 was an earlier mark/application in respect of identical mark and similar description of goods in the name of petitioner. The registration of the impugned mark was thus prohibited under section 11 of the Act.

15. The another case referred by the applicant in the matter of M/s. Satnam Overseas v. Sant Ram & Co., (2014) 14 SCC 782: (2015) 1 SCC (Civ)

412:2013 SCC OnLine SC 1028 at page 787 : 2014 (57) PTC 220 (SC) wherein the 8. Section 46(1)(b) provides that up to 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 bona fide use thereof in relation to the goods for which it was registered by the proprietor for the registered trade mark. The onus to prove

non-use rests upon the applicant who has filed the application for rectification. Of course, it is sufficient that the applicant who has filed the application

for rectification to give prima facie evidence for non-use of the mark during the

relevant period of five years from the date of one month before the date of the application for rectification. Once it is prima facie shown, then the onus shifts to the registered proprietor to prove the use of the trade mark during the relevant period.)

16. After going through the documents submitted by the applicant, in our considerable opinion there has been no bonafide use of the trademark

'HELLO' No. 1155201 in class 30 under the impugned registration relation to the said goods for which the mark is registered up to date three months

before the date of the application and thus the impugned registration is contrary to the provisions of Section 47(1)(a). The registration of the impugned

trademark 'HELLO' No. 1155201 in class 30 remains on the register without sufficient cause thus the existence of the impugned entry in the Register

of Trademarks affects the purity of the Register of Trademarks.

17. The applicant counsel has referred the citations to buttress his pleadings and arguments in the matter of M/s. Shell Transource Limited v. Shell

International Petroleum Company Ltd., 2012 SCC IPAB 29: [2012] Hon'ble Intellectual Property Appellate Board 25 Para 14. We have considered

the rival submissions and the materials before us. There is no disagreement with the position that he who pleads nonuser must prove it. But when the

applicant has pleaded non-user, the respondent must specifically deny it stating the facts on which he denies non-user. In the absence of specific

denial we can only hold that the allegations stands admitted.

18. Thus, the registration of the impugned trademark 'HELLO' No. 1155201 in class 30 remains on the register without sufficient cause and its

continuance of the trademark application 'HELLO' under No. 1155201 in class 30 in the Register of Trademarks is an obstruction to the continuance

of the applicant's business, thus the existence of the impugned entry in the Register of Trademarks affects the purity of the Register of Trademarks.

Therefore the entry relating to the impugned trademark was wrongly made and wrongly remains on the Register of Trademarks.

19. We are of the considered opinion that the respondent, despite having been given an opportunity to file the counter statement and evidences chose

to remain silent in the absence of any counter statement and/or denial of any of the material averments made in the petition.

20. Thus the impugned registration of trademark application No. 'HELLO' No.

1155201 in class 30 is contrary to the provisions of Section 47(1)(a).

The registration of the impugned trademark application No. 'HELLO' No. 1155201 in class 30 remains on the register without sufficient cause thus the

existence of the impugned entry in the Register of Trademarks affects the purity of the Register of Trademarks.

21. The prayer is allowed, we direct respondent No. 2 to remove trademark application No. 'HELLO' No. 1155201 in class 30 within 30 days of the

receipt of this order accordingly. Copy of order be sent to the respondent No. 2. No cost.