

40/2004

INTELLECTUAL PROPERTY APPELLATE BOARD
2nd Floor, Annexe-1, Guna Complex, 443, Anna Salai, Chennai – 600 018
(Circuit Bench at Mumbai)

T.A.No.56 /2003/TM/MUM (MP No.49/2000)

THURSDAY, THIS THE 29th DAY OF JANUARY, 2004

HON'BLE SHRI JUSTICE S. JAGADEESAN .. CHAIRMAN
HON'BLE SHRI T.R. SUBRAMANIAN .. TECHNICAL MEMBER

Mohammad Iqbal,
No.1, Kotwali Road,
Ibrahimpura,
Bhopal – 462 001.

Appellant/Opponent

(By Advocate Shri Rajshekar V. Govilkar)

Vs.

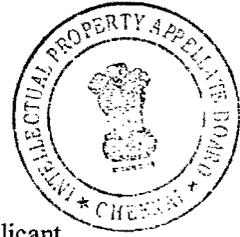
1. M/s. Kale Khan Mohammed Hanif,
Ibrahimpura,
Bhopal – 462 001.

Respondent/Applicant

2. Registrar of Trade Marks,
Mumbai.

Respondent

(By Advocate Shri Vijay Shah for Respondent No.1)



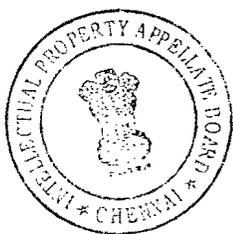
ORDER

Hon'ble Shri Justice S. Jagadeesan, Chairman :

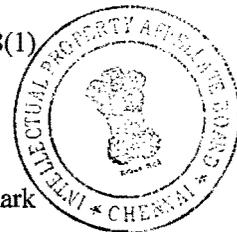
The appeal is against the order of the Assistant Registrar of Trade Marks dated 25-10-1999, rejecting the opposition filed by the appellants for the registration of the first respondent's trade mark.

2. The first respondent filed an application No.469805 before the Registrar seeking registration of the trade mark with the word 'FOHARA CHHAP" and with a device of Fountain and bearing the signature of the senior-most partner Mr. Mohammed Hanif, in respect of Beedis in class 34 claiming proprietorship of the trade mark as user since 17-1-1986. The said application was advertised for registration in the trade mark journal No.1013, dated 16-8-1991. The appellant herein filed the opposition stating that originally the trade mark belonged to one Kale Khan Mohammed Hanif. Subsequently, Mr. Kale Khan converted his proprietorship business into a partnership firm by taking his sons as partners in his firm and this was taken on record by order dated 8-12-1959 of the Registrar of trade mark. In 1966, Mr. Kale Khan died and his sons Mohammed Hanif, Mohammed Aziz, Mohammed Islam and Mohammed Iqbal (the appellant)

continued to carry on the business. The sons of Kale Khan made a request in Form TM 24 and the orders were passed thereon on 27-9-1967, whereby the said sons of Kale Khan were brought on record as subsequent proprietors of the original trade mark. There were some subsequent changes in the constitution of the firm and as per the partnership deed dated 3-8-1979, the appellant along with his brothers and their sons carried on the said business in partnership in the firm name and style of Kale Khan Mohammed Hanif. The said partnership firm had taken over the properties outstanding and all other assets and liabilities of the said firm including the trade mark and goodwill of the firm. Consequently, the partners of the said firm were the owners of the original trade mark. It was also agreed between the partners of the said firm that whenever any question of sharing the profits arises from the goodwill and the right in the trade mark and labels, such benefit will be shared only by the sons of late Kale Khan. In January, 1996, the said partnership also was dissolved and the appellant was expelled from the partnership firm on 16.1.1986. The appellant filed civil suit for rendition of accounts in RCS No.156-A/86 in the Court of District Judge, Bhopal. At the time of disposal of the opposition by the Assistant Registrar, the said suit was pending. A firm by name M/s. Kale Khan Mohammed Hanif claiming to be registered owner of the old trade mark filed the suit for injunction and other reliefs against the appellants on the file of the District Court, Bhopal, in suit No.35-A/86 which was also pending at the time of disposal of the opposition by the Assistant Registrar. Since the respondents are not the exclusive proprietors of the original trade mark, it is not open to them to seek for the registration of an identical trade mark and as such the registration of the impugned trade mark is prohibited under Sec.18 (1) of the Trade and Merchandise Marks Act, 1958. Moreover, the impugned trade mark is identical with the earlier registered original trade mark Nos.109029, 199399 which stands in the name of different proprietors and also deceptively similar. Hence, the registration of the trade mark is prohibited under Sec.12 (1) of the said Act. The registration is also prohibited under Sec.11 (e) of the Act, since it is not entitled for protection in the Court of law being an infringing trade mark. The impugned trade mark is neither distinctive of the respondents nor is capable of distinguishing the respondents' goods or adopted to distinguish the same. Consequently, the registration of the impugned trade mark is prohibited under Sec.9 of



the said Act. The respondents having suppressed the pendency of litigation in the Civil Court between the parties, the application is liable to be dismissed for fraud and as such there cannot be any exercise of discretion in favour of the respondents under Sec.18(1) of the Act.



3. The respondents filed their counter statement stating that the original trade mark consisting of the word 'FOHARA CHHAP' with the device of a Fountain with the signature of Mohammed Hanif, commanded high reputation and goodwill. The respondents also admitted about their carrying on the old business of the firm under the reconstituted partnership with effect from 17-1-1986 and having taken over all the assets and liabilities of the old firm under clause 7 of the deed of partnership registered under No.96/86-87. The respondents are entitled to the use of the old trade mark and consequently the impugned trade mark need not make any difference. The appellant cannot claim any right in the impugned trade mark when he cannot claim any right for the use of the old trade mark.

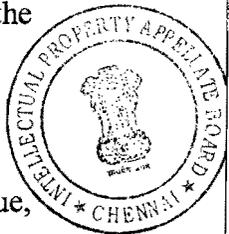
4. Both the parties filed evidence about which no details is necessary at this stage. The opposition by the appellant was mainly based on Secs.11(a), 11(e), 12(3) and 18(4) of the Act. The Assistant Registrar considered the matter in detail and rejected the opposition. The Assistant Registrar over-ruled the objection under Sec.9 on the ground that the trade mark with the word "FOHARA" along with the device of a Fountain and the signature of Shri Mohammed Hanif is a distinctive trade mark having no obvious meaning or no direct reference to the character or quality of goods. Similarly, when considering the objection under Sec.11(a), the Assistant Registrar has rejected the opposition of the appellant on the ground that the appellant failed to discharge the initial onus of proof cast on him that the opponent's mark has acquired reputation. While considering the objection of the appellant under Sec.12 (3), the Assistant Registrar held that the respondents have been continuously using the trade mark after the reconstitution of the firm in 1986. The impugned trade mark has been adopted by adding an additional distinctive feature, the signature of the senior partner Mohammed Hanif and as such, the respondents are entitled for the registration. Consequently, the

Assistant Registrar exercised his discretion in favour of the respondents and directed the registration of the trade mark under the impugned order before us.

5. The learned counsel for the respondents took a preliminary objection with regard to the maintainability of the appeal on the ground of limitation. He also referred to the averments made in the affidavit of the appellant in paragraph No.12 about the knowledge of the impugned order. He also pointed out the averments made in the plaint and contended that in view of the contradictory statements with regard to the date of the knowledge, there is absolutely no bonafide in the conduct of the appellant for entertaining the appeal. At any rate, the appeal was not presented within 90 days from the date of the order or from the date of the communication. Equally, the statement of the appellant that the respondent forwarded the copy of the impugned order sometime in July, 2000 is also false. The cover sent to the appellant was returned unserved and as such it is not clear as to the source of the knowledge of the appellant about the impugned order. Further, the petition is vague and the appellant has no right to oppose the registration of the respondent's mark in view of the civil suit ending in favour of the respondents.

6. The learned counsel for the appellant, while replying to the preliminary issue, advanced the arguments on merits also. He contended that the impugned copy of the order of the Assistant Registrar was not communicated to the appellant. Consequently, the limitation starts from the date of the knowledge of the appellant. Even though three dates 19.5.2000, middle of June, 2000 and middle of July, 2000 have been given in various proceedings, as per any one of the dates, the appeal is within time. Even if we take the earliest date, still the appeal is within time and as such, the discrepancy of the dates with regard to the knowledge of the appeal does not have any bearing.

7. On merits, the learned counsel for the appellant contended that when the civil suits are pending between the parties, the respondents cannot be considered to be the registered proprietors of the trade mark. Even though the respondents have obtained a decree in their favour, still they are liable to render accounts in respect of the old trade mark. If the respondents are permitted to register the impugned trade mark which is identical to that of the old trade mark, then there is every possibility that the respondents

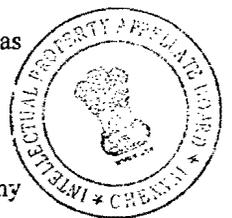


may evade rendering of the accounts in respect of the turnover after the registration of the impugned trade mark. On this ground also, the respondents are not entitled for the registration.

8. We have carefully considered the above contentions of both the counsel.

9. At the outset, we are not inclined to go into the preliminary objection raised by the learned counsel for the respondents for the simple reason that the original records are not available with the Trade Mark Registry. In the absence of the original records, we have to presume that the statement made by the appellant that he was not served with the impugned copy of the order of the Assistant Registrar is true, in the interest of justice. Hence, we have to take it especially in the absence of any evidence to the contrary, that the appellant was not served with the copy of the order. The High Court of Bombay accepted the plea of the appellant and has numbered the main appeal and as such, we do not want to re-open this issue.

10. So far as the merits are concerned, here again, there is no need for us for any elaborate discussion. It is an admitted fact that the original owner of the trade mark is one Shri Kale Khan Mohammed Hanif. The respondent firm is having the partners who are the sons of the said Kale Khan. The appellant is also one of the sons of the said Kale Khan. Even during the life time of the said Kale Khan Mohammed Hanif, he took his sons as the partners and the partnership was constituted. Consequently, after his death, the partnership was reconstituted in 1986. Thereafter, some dispute arose. The parties went to the Court to get their redressals. Now, the appellant has got a decree for rendition of accounts by the respondents as admittedly the partnership is now dissolved due to the dispute between the partners. The appellant is entitled to use the original trade mark and this was not objected to by the respondents at the hearing. The only objection raised by the appellant is that the impugned trade mark only consists of the signature of the seniormost partner and that the two marks are more or less similar and the respondents may evade rendition of account in respect of the impugned mark and so the mark should not be registered. At the hearing the counsel for the respondent referred to the judgment of the VII Additional District Judge, Bhopal, dated 4th November, 1996, in Civil Suit No.69-A/90 filed by the appellant, wherein it has been



ordered that the appellant is entitled to rendition of accounts. Further, the counsel for the respondents claimed that their trade mark is distinctive as it consists of the signature of the seniormost partner and the same has been ordered to be associated with registered trade mark 409447. It is admitted that the partnership was reconstituted and the first respondent is to use the original trade mark by taking over the assets and liabilities of the firm. We hold that as per the terms of the reconstitution of the partnership, the first respondent is entitled for the use of the original trade mark. In such circumstances, the respondent is now seeking the registration of the impugned trade mark similar to that of the original trade mark by adding an additional distinctive feature, the signature of the seniormost partner. The Registrar has also rightly allowed the same and has ordered at the admission stage that it should be associated with trade mark No.109029, 199399 and 409447 in view of similarity between the marks under Section 16 of the Act. Application No.469805 has not been allowed by the Registrar to proceed as an independent application and as the trade mark application No.469805 is associated with registered trade mark No.109029 and others, because of its similarity with them. The appellant can take up the question of rendition of accounts in respect of trade mark application No.469805 in the different suits pending at present. Consequently, the impugned order of the Assistant Registrar need not be interfered with. Appeal is dismissed with no order as to costs.

Sdl-
(T.R. SUBRAMANIAN)
TECHNICAL MEMBER

Sdl-
(JUSTICE S. JAGADEESAN)
CHAIRMAN



psp.

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Deputy Registrar
Intellectual Property Appellate Board
Chennai - 18