



Intellectual Property Appellate Board

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OA/1/2021/TM/AMD

FRIDAY, THIS THE 29TH DAY OF JANUARY, 2021

HON'BLE SHRI JUSTICE MANMOHAN SINGH : CHAIRMAN
HON'BLE MS LAKSHMIDEVI SOMANATH : TECHNICAL MEMBER (TRADEMARKS)
HON'BLE MR. MAKYAM VIJAY KUMAR : TECHNICAL MEMBER (TRADE MARKS)

IHHR HOSPITALITY PVT.LTD.,
C-26, QUTAB INSTITUTIONAL AREA.
NEW DELHI - 110026

.....APPELLANT

(Represented by: Mr. Shantanu Sood)

Versus

1. REGISTRAR OF TRADE MARKS,
TRADE MARKS REGISTRY.
BESIDE CHANAKYAPURI OVERBRIDGE
NEXT TO AMC CITY CIVIC CENTRE
GHATLODIA, AHMEDABAD — 380061

2. GOYAL FASHIONS PVT. LTD.,
GOYAL HOUSE 24,
AJMER ROAD, JAIPUR,
RAJASTHAN

.....RESPONDENTS

(Represented by: Mr.G.D.Bansal for R2)

ORDER

Hon'ble Ms. Lakshmidevi Somanath, Technical Member (Trade Marks)

1. This is the Appeal against the Order of Registrar of Trade Marks, Ahmedabad dated 14.02.2018 in Opposition No: AMD-787012 filed against the registration of Application No. 1907198 in class 43.

FACTS OF THE CASE

2. The Appellant is a Private Limited Company and is engaged in the ownership and management of luxury business and leisure hotels, resorts and destination Spas in India. It is a well-known and established entity in the hospitality business in India and abroad. The Appellant is the owner of the ANANDA hotel and Spa resort. The Appellant's ANANDA hotel and Spa resort is regarded as one of the world's finest hotels and Spa resorts. and consequently the trade/service mark ANANDA enjoys a superlative reputation and goodwill that is exclusively associated with the Appellant and none else.

3. In and around 1998, the Appellant honestly and independently conceived and bonafidely adopted the trademark ANANDA for use in connection with the Appellant's goods and services, in particular those connected with its hospitality business including but not limited to "Health resort. Hotels and Spa" in Class 42. The Appellant duly applied for and obtained trade mark registrations for its goods/services, including goods/services in classes 03, 05, 21, 30, 41 & 42. The Appellant has applied for and acquired trade mark registration for its trade mark ANANDA in numerous jurisdictions around the world including but not limited to Argentina. Columbia. Cambodia. Europe (CTM). U.K, U.S.A. South Africa. Mauritius. New Zealand. Singapore. Mexico. Chile. Indonesia, Sri Lanka. Russia. etc. The Appellant has continuously, exclusively and extensively used its mark ANANDA on all its goods/services, including but not limited to its hotel and resort services. since 1999 - when it launched its flagship hotel and resort by the name ANANDA. The mark has been extensively advertised and promoted around the world and in India. It is well-recognized across India as a premier hotel and attracts a huge number of foreign clientele.

4. On 31/10/2011 the Appellant was alerted to the trade mark journal advertisement for the trade mark application no. 1907198 for ANANTA in Class 43 for restaurant, hotel, resort & providing of food and drink rest home & house, self-service, snack bars, bear bar, juice center in class 42 filed by the Respondent No. 2 herein. The mark was advertised for opposition in the Trade Marks Journal No. 1508 dated 31/10/2011. The advertised trade mark — ANANTA - being nearly identical and confusingly similar to the Appellant's earlier trade mark ANANDA for identical services was duly opposed by the Appellant. The Notice of Opposition on Form TM-5 was duly filed within time before the Respondent No. 1 on 22/02/2012 and was taken on record. The opposition proceeding was numbered AMD- 787012. Thereafter Respondent No. 1 served the TM-5 on the Respondent No. 2 at its address for service under cover of its letter dated 09/04/2012. The Respondent No. 2 duly filed its counterstatement on Form TM-6 which was duly served by the Respondent No. 1 on the Appellant at its address for service. Thereafter, the Appellant duly filed its Evidence in Support of Opposition under Rule 50 of the Trade Marks Rules, 2002 on 24/08/2012. A copy of the same was also duly served on the Respondent No.2. Thereafter, the Respondent No. 2 duly served its evidence in support of application under Rule 51 of the Trade Marks Rules, 2002 on the Appellant's address for service.

5. At this time while the Appellant's affidavit of evidence in Reply under Rule 52 of the Trade Marks Rules, 2002 was being prepared. the Appellant's counsel was also in the process of shifting offices to a new address. Accordingly, along with its affidavit of evidence in reply under Rule 52 of the Trade Marks Rules, 2002, the Appellant duly filed a request on Form TM-16 to bring on record its new address for service being: Quest IP 122/ I04 Silver Oaks Apartments, DLF PH-1, Gurgaon-122002, Email: email@questip.com. The same was filed on 10/12/2012 along with the Appellant's Rule 52 affidavit. Appellant duly included its foregoing new address for service in the affidavit as well so as to duly alert the Respondent No. 2 of the change as well. The Appellant's cover letter also duly mentioned the new address for service. Up until receipt of the Respondent No. 2's affidavit of evidence under Rule 52, the Appellant's address for service in the opposition proceeding was B-SE47 E. LGF. Safdarjung Enclave. New Delhi - 110029. which was the office address of its

Advocate. The aforesaid TM-16 was filed along with the Appellant's affidavit of evidence in Reply and TM-56 for extension of time on 10/12/2012. The Affidavit in reply under Rule 52 duly mentioned the Appellant's new address for service as well.

6. Having complied with all due obligations under law, the Appellant was waiting for due notice from Respondent No.1 for appointment of hearing under Section 21(S) of the Trade Marks Act, 1999. Periodic checks of the application's status from the Registry website were undertaken by the Appellant's advocate. On one of its routine checks on 16/07/2018, the Appellant saw that the status of the mark had been updated from "Opposed" to "Registered". There was no document relating to the opposition proceeding on the Registry website. The Appellant duly sent a letter dated 16/07/2018 to the Respondent No.1 apprising of the discrepancy, and requested it to recall the registration under the provisions of Section 57(4) of the Trade Marks Act, 1999. The Appellant further requested the Respondent No. 1 to provide copies of any notices/orders that may have been issued. The letter was duly sent by email to the Respondent No.1 at ahmedabad.tmr@nic.in on 17/07/2018 as well as by Regd. AD on 18/07/2018. The same letter was also sent to the Respondent No. 2 counsel on 18/07/2018. Copies of the email as sent. Even though the letter was received, there was no response from the Respondent No 1. Thus the Appellant was constrained to file an RTI application via online module on 14/08/2018 to seek the information regarding its opposition to Application No. 1907198. Thereafter on 11/09/2018 the Appellant received a reply dated 05/09/2018 from the Respondent No.1 to its aforesaid RTI application. Respondent No.1 had scheduled a hearing on 21/11/2017 but notice of the hearing was wrongly sent to the Appellant's earlier address for service. Notice was also not communicated by email even though the Appellant had duly provided an email address for service and the new Trade Marks Rules, 2017 permitting service by email were in force. In such circumstances the fact that the hearing was conducted ex-parte, was in violation of the provisions of Section 21(5) of the Act as well as against principles of audi alteram partem, natural justice and equity. Under the circumstances the impugned Order dated 14/02/2018 could not be passed against the Appellant as the Appellant was not given a chance to be heard. The Appellant was to be provided due opportunity under the law before any orders could have been passed. The order is in violation of Section 21(5) of the Act and principle of natural justice and equity and the said order is liable to be quashed. Hence the present Appeal before us

ARGUMENTS MADE BY THE APPELLANT

7. The learned counsel for the Appellant Mr. Shantanu Sood submitted that the Respondent No. 1 erred by failing to give the Appellant due and valid notice of hearing as required under Rule 56(1) of the 2013 Rules as then applicable. The hearing notice should have been sent to the Appellant's address for service as amended vide TM-16 dated 10/12/2012 which was taken on record. He further erred in conducting the hearing ex-parte before passing the impugned Order. Ex-parte hearing and order was passed against the Appellant even though Appellant had complied with all due provisions of law to notify the Respondent No.1 of the change in its address for service and the same was admittedly taken on record. Therefore the impugned Order is in violation of Section

21(5) of the Trade Marks Act. 1999 as well as the principles of *audi alteram partem*, natural justice and equity.

8. Learned Counsel for the Respondent No.2, Mr. G.D. Bansal argued that the Appellant's present appeal is not maintainable for the reason of delay and also due to Appellant's application for reinstatement of the opposition proceedings which is still pending before the Hon'ble Trademark Registry. The Learned Counsel for the Respondent No.2 was in agreement that the Hearing Notice was sent to the Appellant's old address, in spite of filing the change in the address for service.

FINDINGS

9. We have examined the Order of Registrar of Trade Marks, Delhi dated 14.02.2018 in Opposition No: AMD-787012 filed against the registration of Application No. 1907198 in class 43 and reviewed the submissions of both parties. The fact stands that the impugned Order was erroneously passed without according a hearing to the Appellant. This was palpably wrong, beyond comprehension, not recognized or supported by the provisions of the Act and in gross violation of the principles of natural justice.

10. However, without considering all these aspects, the respondent No.1 has passed the impugned order in violation of principles of natural justice since it is an *ex parte* order, without due service on the Appellant, the Appellant thus being deprived of an opportunity of proper hearing and of presenting documents sought to be filed. The Order of Registrar of Trade Marks, Delhi dated 14.02.2018 in Opposition No: AMD-787012 filed against the registration of Application No. 1907198 in class 43 is therefore liable to be set aside.

11. Taking into consideration of the above, the Appeal is hereby allowed. Impugned order dated 14.02.2018 passed by Respondent No.1 in Opposition No: AMD-787012 is set aside. The matter is remanded back to Respondent No.1 which shall decide the said Opposition within a period of three months from the date of receipt of this order by giving opportunities to the parties and in accordance with law. In view of setting aside the impugned orders, Counsel for the Appellant agrees to withdraw its representation filed under section 57(4) of the Act as the Registration Certificate has now no meaning. This order is being passed with the consent of both Counsel appearing on behalf of their respective parties.

12. There is no order regarding costs.

-Sd/-

-Sd/-

-Sd/-

(Ms. Lakshmi Devi Somanath)
Technical Member (Trademarks)

(Shri. Makyam Vijay Kumar)
Technical Member (Trademarks)

(Shri Justice Manmohan Singh)
Chairman

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