

High Court Patan

Division Bench

Bench No.: 12

Hon. Judge Shyamji Pradhan

Hon. Judge Sudarshanraj Pandey

Decision

Case No: - 079-DP-0823

Decision No: - 47

Case: To publish the Trademark in Industrial Property Bulletin

HAWKINS COOKERS LIMITED, INDIA representative Associate Rama Devi
Gotame of Apex Law Chamber.....Appellant/Applicant

Vs.

Department of Industries..... Defendant

Initial Decision-Making Body: Department of Industry, Tripureshwor,
Kathmandu

Date of the first decision: 2022/11/28

According to section 27 of the Patent, Design and Trademark Act, 2022, the jurisdiction falls within the court and appeal is registered to which the brief facts and decision as follows:

Facts

1. HAWKINS COOKERS LIMITED, an Indian company specializing in the production of Pressure Cookers and Cookware, is located in Mumbai with three manufacturing industries in Thane, Hoshiarpur, and Jaunpur. The company offers a range of products under brands such as Hawkins, Futura, Contura, Hevibase, Big Boy, Miss Mary, and Ventura. The CONTURA trademark, initially registered in 1883, falls under class 21 and is a prominent and widely recognized brand in India, having expanded its market to over 65 countries. The company recently applied for the trademark CONTURA under application no. 78741 on

14/01/2019. However, a computer search on the IPAS SYSTEM revealed that a prior registration for the DIAMOND CONTURA trademark, filed by Tinau Top Kitchen Industries, existed under application no. 031712 on 09/06/2008. This registration was canceled due to non-renewal, the Department of Industries (DOI) decided not to register the 'CONTURA' trademark for Hawkins Cookers Limited based on the prior filing. Subsequently, on 30/05/2017, another application (no. 068011) was submitted but not renewed for 5 years. The trademark DIAMOND CONTURA was not published in the Industrial Property Bulletin and was dismissed. The appellants argue that the decision by the Department does not align with trademark laws and fundamental principles. They emphasize that HAWKINS COOKERS LIMITED is well-known in Nepal, India, and internationally. Therefore, they request the dismissal of the Department's decision and the publication of their application no. 78741 for the registration of the CONTURA trademark in the Industrial Property Bulletin under class 21.

2. The applicant has sought registration for the trademark CONTURA under class 21, citing the decision made by the Department of Industry for DIAMOND CONTURA of Tinau Top Industries, registered under application no. 068011. It is observed that different words are used in the two trademarks. The decision was made on 29/08/2022 to which the notice shall be provided to the Public Prosecutor's Office by section 213(3) of Muluki Dewani Sanhita; order made on 05/06/2023.
3. Upon reviewing the records on the IP SYSTEM trademark, it has been determined that DIAMOND CONTURA, registered in the name of Tinau Top Kitchen Industries on 30/12/1952, has been dismissed due to non-renewal. The appellants have applied after the reprocessing of the application by Tinau Top Kitchen Industries for the registration of the trademark DIAMOND CONTURA. Before the appellants submitted their application, it was observed that the DIAMOND CONTURA trademark had already been applied for registration. This prior submitted application falls under class 21, covering similar products. This situation poses a potential impact on the reputation of the trademark and raises concerns about potential confusion among consumers due to the identical trademark name. The appeal made by the appellants is also found to be contradictory to the proviso clause of section 18(1), leading to the decision not to proceed with the registration process. In the written response submitted, it was stated that the appellants applied for the trademark after it had already been dismissed.

Decision

4. Learned Advocates Mr. Ramchandra Subedi and Ms. Nimishka Pandey put forth the following arguments:

- According to section 18(1) of the Patent, Design, and Trademark Act, 2022, if an opposition claim is filed for the registration of the trademark, and it is substantiated through the necessary investigation, the registration shall be legally granted in the name of the applicant.
 - According to the provided provision, the decision not to register the trademark, which cited the existing registration of the CONTURA trademark and the similarity to DIAMOND CONTURA, was made without proper investigation by the Department of Industry.
 - The application submitted by the company for the registration of the trademark DIAMOND CONTURA has not completed its process, leading to the dismissal of the trademark.
 - The decision made by the Department of Industries should be overturned, and the trademark application for CONTURA filed under class 21, application no. 78741, should be directed to be published in the Industrial Property Bulletin.
5. HAWKINS COOKERS LIMITED has submitted an application for trademark registration under class 21, application no. 78741. The trademark DIAMOND CONTURA, registered under application no. 31712 in the name of Tinau Top Kitchen Industries, was cancelled for the registration. The Department of Industry, on 28/11/2022, decided not to publish application no. 68011 for the same trademark filed by the same company in the Industrial Property Bulletin. An appeal has been filed to contest the decision and seek the publication of the CONTURA trademark in the Industrial Property Bulletin due to disagreements with the initial ruling by the Department.
6. Whether the decision made by the Department of Industries is

correct? Whether the claim for appeal is sufficient? The decision needs to be made in these circumstances.

7. According to Section 17 of the Patent, Design, and Trademark Act, 2022, an individual intending to register a trademark for their business under Section 18 must submit an application in the specified format as outlined in Schedule 1(c). Alongside the application, four specimens of the trademarks should be provided. The Department is required to conduct the necessary investigation, offer an opportunity for the applicant to defend themselves, and, if deemed appropriate based on the findings, proceed with registration. The proviso clause of Section 18, as per Schedule 2, mandates a thorough investigation, providing the applicant with sufficient defense opportunities, and further inquiry as needed. However, registration is not allowed if the trademark is perceived to harm the reputation of an individual or institution, adversely affect public conduct or morality, undermine national interest, damage the reputation of another person's trademark already registered, or if it is found to have already been registered by someone else.

According to the fundamental principles of trademark laws, generic terms and deceptive signs are considered absolute grounds. Any usage contrary to national benefit, social norms, or involving a breach of religious criteria is prohibited for trademark purposes. Similarly, trademarks that are already registered are not to be approved to avoid confusion among consumers, based on relative grounds. Upon examining the trademarks on both absolute and relative grounds, if it is discovered that a trademark has already been registered, the application for the registration of that trademark is not to be considered.

Upon search in IP SYSTEM records, it was found that the trademark DIAMOND CONTURA, registered in the name of Tinau Industries on 30/12/1952, was dismissed due to non-renewal. Subsequently, on 14/09/1960, the same company filed a new application for the registration of the identical trademark under application no. 68011. Despite the significant time elapsed since the application was submitted by Tinau Top Kitchen Industries for the trademark DIAMOND CONTURA, the registration process has not been completed. In response, the appellant company filed a new application under class 21, with application no. 78714, on 26/04/1962.

8. The application submitted by Tinau Top Industries for the DIAMOND CONTURA trademark and the CONTURA trademark appear to be distinct. However, the appellant company has contested the registration of the CONTURA trademark even after its publication in the Industrial Property Bulletin. The company argued that the DIAMOND CONTURA trademark, for which they applied, and the appellant company's application for the CONTURA trademark could have adverse effects and potentially confuse consumers. Such confusion may result in a negative

impact on Tinau Top Kitchen Industries, leading to the possibility of an opposition claim under section 18 of the Patent, Design, and Trademark Act, 2022.

9. The application submitted by Tinau Top Industries for the DIAMOND CONTURA trademark and the CONTURA trademark appear to be distinct. However, the appellant company has contested the registration of the CONTURA trademark even after its publication in the Industrial Property Bulletin. The company argued that the DIAMOND CONTURA trademark, for which they applied, and the appellant company's application for the CONTURA trademark could have adverse effects and potentially confuse consumers. Such confusion may result in a negative impact on Tinau Top Kitchen Industries, leading to the possibility of an opposition claim under section 18 of the Patent, Design, and Trademark Act, 2022. A thorough investigation and examination are necessary for both the original claim and the opposition claim concerning the CONTURA trademark. The department should provide a decision based on this examination to determine whether the appellant company should be allowed to proceed with the registration process for the CONTURA trademark under class 21, application no. 78741. The decision made by the Department, which suggests not allowing the appellant company to enter the registration process for the CONTURA trademark, is deemed incorrect. Therefore, the given decision cannot be upheld.
10. Appellant HAWKINS COOKERS LIMITED applied for the registration of the trademark DIAMOND CONTURA under class 21, with application number 31712, in the name of Tinau Top Industries. However, it could not be renewed, citing that the same trademark was filed by the same company and was not eligible for publication in the Industrial Property Bulletin. This decision was made by the Department of Industry on 28/11/2022. The appeal requested for the CONTURA trademark is currently not registered. Considering that it has been a considerable amount of time since Tinau Kitchen Industries applied for the DIAMOND CONTURA trademark, and as per section 18 of the Patent, Design, and Trademark Act, 2022, necessary examination is required if an opposition claim is raised against the trademark requested by the appellants. The decision made by the Department on 28/11/2022 is deemed to be inconsistent with the law. Therefore, the appeal filed by the appellant for the registration of the trademark CONTURA under class 21, application no. 78741, should be allowed to proceed, and the trademark should be published in the Industrial Property Bulletin. For other purposes, follow the specified particulars.

Particulars

- The decision made on 28/11/2022 by the Department is found by the law. Thus, the registration process of trademark CONTURA under class 21, application no. 78741 shall proceed further and be published in the Industrial Property Bulletin. Provide a copy of the decision to the Department of Industry through the Public Prosecutors Office, Patan.
- Provide a copy of the decision to the opponent fulfilling the criteria of rule 120 of Patan High Court regulations.
- According to section 198(3) of the Muluki Civil Code, 2074 information on the certification of the decision shall be published on the website and the notice board.
- Upload the digital copy decision on the internet and send the file to the Department after collection of the required fees and submit the file to the record section.

Sudarshanraj Pandey

Judge

I agree with the decision.

Shyamji Pradhan

Judge

Section Officer: Pratima Gyawali

Computer Operator: Rati Lama

Dated 15/08/2023 on Tuesday.

Certified Date: 31/08/2023

Court's Stamp