

4 SCOB [2015] HCD 89**HIGH COURT DIVISION
(SPECIAL STATUTORY JURISDICTION)**

Trade Mark Appeal No. 02 of 2011

**British Broadcasting Corporation
(BBC)**

.....Appellant

-Versus-

**Registrar, Department of Patents,
Designs and Trade Marks, and others.**

.....Respondents

Mr. Syed Shahid Hossain, Advocate with
Mr. Syed Imran Hossain, Advocate
.....For the appellant

No one appears

.....For the respondents

Heard on: 10.07.2014 and Judgment on:
16.07.2014.**Present:****Mr. Justice Md. Ashfaul Islam****And****Mr. Justice Md. Ashraful Kamal****Trade Marks Act, 2009****Section 24 & 30:****Section 30 of the Trade Marks Act, 2009 provides that priority of use of this mark gets paramount consideration compared to registration.****The right created in favour of a registered proprietor of a trade mark is not an absolute right and is subservient to other provisions of the Act. In other words, registration of a trade mark does not provide a defence to the proceedings for passing off as under section 24 of the Act, 2009. A prior user of trade mark can maintain an action for passing off against any subsequent user of an identical trade mark including a registered user thereof.**
...(Para 32 &33)**Judgment****Md. Ashraful Kamal, J:**

1. This is an appeal under section 100 of the Trade Marks Act, 2009 presented on 28.02.2011 and the same was accepted on 01.03.2011 against the decision and order dated 15.07.2007 (communicated on 14.09.2010) passed by the Registrar of Trademarks, Dhaka rejecting the Trade Mark Application No. 49040 dated 14.11.1996 in Class-9 filed by the appellant for registration of the Mark BBC.

2. Short facts, necessary for the disposal of this appeal, are as follows;

The British Broadcasting Corporation (BBC) a public corporation incorporated and organized under the law of England and Wales by Royal Charter whose principal address is Broadcasting house, Portland Palace, London W1A 1AA, United Kingdom filed an application before the Registrar of Trademarks on 14.11.1996 for registration of the trade mark BBC being Application No. 49040 in class 9 in respect of sound, video and date recordings; films and sound films prepared for exhibition; carriers including records, discs, tapes, cassettes, cartridges and cards bearing or for use in bearing sound recordings, video

recordings, data, images, games, graphics, text, programs or information; computer software; computer games; video games; electronic games; memory carriers; interactive compact discs; CD-ROMs; electrically, magnetically and optically recorded data for computers; instructional and teaching apparatus and instruments; sound, video and data recording and reproducing apparatus; games, apparatus for games and amusement apparatus all for use with or incorporating a television screen or video monitor; coin or token operated electrical or electronic amusement apparatus; loudspeakers; apparatus for use in recording, producing, presenting, broadcasting, transmitting, receiving, processing, reproducing, encoding and decoding of radio and television programmes, information and data; electrical and electronic broadcasting apparatus; parts and fittings for all the aforesaid goods; all other goods in class 9.

3. After receiving the appellant's trade mark application dated 14.11.1996, the respondent No.1 issued notice under section 14(1) of the Trade Marks Act, 1940 on 29.07.2004 upon the appellant to show cause as to why its application shall not be rejected under section 6(1)(e), 8(a) and 10(1) of the Trade Marks Act, 1940 for the reason of pendency of two marks namely application No. 9236 of Brown Boveri A.G. (BBC Products C/O Ramfry and son) and application No.37533 Bangladesh Brevy Centre (C/O Rajan Agency Dhaka).

4. Thereafter, as per sub-rule (2) of the rule 24 of the Trade Marks Rules, 1963, the appellant on August 02, 2004 (within two months) sent his observations to the Trade Mark Registry, which was received by the respondent No.1's office on 08.08.2004 vide memo No. 6474, the respondent No.1 on 30.04.2007 issued notice upon the appellant to appear before him on that date for hearing. Accordingly the appellant appeared on that date by giving hajira.

5. After that appellant filed an application before the respondent No.1 (which was received by the respondent No.1 on 08.06.2008) requesting him for passing an early advertisement order for the process of registration of trade mark. Then on 08.02.2010 the appellant again filed an application before the respondent No.1 enquiring about his pending application.

6. Thereafter on 14.09.2010 the appellant filed another application before the respondent No.1 to inquire into the status of his trade mark. Then on 14.09.2010, the respondent No.1 informed the appellant that its application was rejected on 15.07.2007 and immediately on 20.09.2010 the appellant applied for the grounds of decision dated 15.07.2010 and the respondent No.1 supplied the said ground and decision on 01.11.2010.

7. Being aggrieved by the said orders dated 14.09.2010 and 01.11.2010 passed by the Registrar of Trademarks Dhaka in Trade Mark Application No. 49040 in Class-9 rejecting the application filed by the Appellant for registration of the Mark BBC, the appellant preferred this appeal under section 100 of the Trade Marks Act.

8. Mr. Syed Shahid Hossain alongwith Mr. Syed Imran Hossain, the learned Advocates appearing for the appellant, submits that the appellant's mark BBC is in the use in Bangladesh territory earlier than Trade Marks No. 9236 and 37533. From Wikipdia, free Encyclopedia (page 13 supplementary paper Book) it is seen that Appellant uses and broadcast Bangla Program with the Trade Name BBC from 11.10.1941 whereas from the Trade Mark Journal (Page 14 and 15 of the supplementary paper book) it is evident that the use of the Trade Mark 9236 is from 26.04.1974 and that of the Trade Mark No. 37533 is after 20.04.1993.

9. He also submits that the appellant having Agreement at the same time with respondent No.3 i.e. owner of the Trade Mark 9236 since 19.10.1987 did not object to registration of the Trade Mark BBC of the appellant. So, there is no bar in registration of the appellant's mark BBC as prayed for inspite of existence of the Trade Mark 9236 (Pg 01-08 of the supplementary paper Book). Moreover, the Respondent No.3 also issued a letter of Consent to the use and registration of the appellant's trade mark BBC. Therefore, the existing Mark 9236 does not create any bar to register the appellant's mark BBC (pg 16 of the supplementary paper book)

10. He further submits that Trade Mark Application No. 37533 has no chance to be registered in view of already registered mark 9236 which is also earlier in use than the Mark 37533 and therefore cannot stand on the way of registration of the appellant's mark who has co-existence Agreement with the mark 9236.

11. He also submits that the Appellant has co-existence Agreement with the owner of Registered Mark 9236 and also consent letter in respect of registration of the appellant's mark BBC (P-16 of supplementary paper book) and the trade Mark application No. 37533 is actually abandoned.

12. Finally, Mr. Shahid submits that the appellant's mark BBC as in use in Bangladesh since October 11, 1941 (pg 13 of the supplementary paper book) i.e. earlier to the mark 9236 which in use since 26.04.1974 and the mark 37533 which in use after 20.04.1993 (pg 14015 of the supplementary Paper Book) the appellant is entitled to registration as per section 30 of the Act 2009 as earlier user.

13. No one appears for the respondents.

14. We have gone through the Trade Mark Appeal alongwith the annexures annexed thereto, perused the record and considered the submissions made by the learned Advocate for the appellant.

15. It appears from the record that the respondent No.1 (the office of Trade Mark Registrar) on 29.07.2004 issued a notice under section 14(1) of the Trade Marks Act, 1940 upon the appellant to show cause as to why its application should not be rejected under section 6(1)(e), 8(a) and 10(1) of the Trade Marks Act, 1940 for the reason of pendency of two marks, namely, application No. 9236 of Brown Boveri A.G. (BBC Products C/O Ramfry and son) and application No. 37533 Bangladesh Brevy Centre (C/O Rajan Agency Dhaka).

16. Thereafter, as per sub-rule (2) of rule 24 of the Trade Marks Rules, 1963, the appellant on August 02, 2004 (within two months) sent his observation to the Trade Mark Registry, which was received by the respondent No.1's office on 08.08.2004 vide memo No. 6474. The aforesaid reply dated August 02, 2004 verbatim runs as follows;

*“Bangladesh & Foreign Patents, Designs & Trade Marks
REMFROY & SON
PATENT & TRADE MARK ATTORNEYS
ESTABLISHED 1827*

*IN REPLY PLEASE QUOTE
OUR REF*

*REMFRY & SON LIMITED
56, NEW ESKATON
ROAD, 4TH FLOOR, DHAKA*

*OUR REF: SA/9666
YOUR REF.*

*The Registrar of Trade Marks
Trade Marks Registry
Dhaka.*

August 02, 2004

Dear Sir,

*Re: The British Broadcasting Corporation.
Bangladesh TM Application No. 49040 'BBC in Class 9.*

We write with reference to the show cause notice issued under your letter No. TMO/8722/04 dated the 29th July 2004 and have the honour to submit the considered reply as under:-

- 1. That the mark consist of BBC which is a part of the company and as such is registrable.*
- 2. That the mark does not conflict with the cited marks as the goods of the cited marks are different description and as such the objection raised under Section 8(a) & 10(1) in our opinion is not tenable.*
- 3. As desired, we enclose herewith a copy of the power of attorney duly executed by the applicant in our favour to act on their behalf.*

In view of the above submission an acceptance of the application is respectfully requested.

Thanking you,

Yours faithfully

*Salauddin Abdullah
(Advocate)*

17. After receipt of the appellant's observations on 08.08.2004, the Respondent No.1 did not proceed further regarding the appellant's trade mark till 30.04.2007. However, on 30.04.2007 the Respondent No. 1 issued notice upon the appellant to appear before him on that date for hearing. Accordingly, the appellant appeared before the Respondent No. 1's office on 30.04.2007. Appellant's appearance verbatim runs as follows;

*"Bangladesh & Foreign Patents, Designs & Trade Marks
REMFRY & SON
PATENT & TRADE MARK ATTORNEYS
ESTABLISHED 1827*

*IN REPLY PLEASE QUOTE
OUR REF*

*REMFRY & SON LIMITED
56, NEW ESKATON
ROAD, 4TH FLOOR, DHAKA*

OUR REF: SA
YOUR REF. 30/4

The Registrar
The Department of Patent Designs and Trademarks
The Trademarks Registry Wing
Dhaka.

Dear Sir,

Re: Bangladesh Trade Mark Application/Registration No.(s) 49040-9

We have the honour to inform you that we act on behalf of the client relating to the above matter.

Today has been fixed for hearing before your goodself and we file hajira in this regard.

Thanking you,

Yours faithfully

30.04.2007
Salauddin Abdullah
(Advocate)

18. Thereafter, H & H Company filed an application regarding his appointment as Attorney in place of M/S. K.A. Bari. The respondent No.1 approved the said change on 26.06.2007. The application filed by the H & H Company verbatim runs as follows;

H & H COMPANY
HCO Hä HCO Q;f;ef
BARISTER-AT LAW, ADVOCATES, NOTARIES, TAX
TRADE MARKS & PATENT ADVISERS

Our Ref: RH:MSU: ha/L-225

June 13, 2007

The Registrar
Department of Patents, Designs & Trade Marks
The Trade Marks Wing
Dhaka

SHAREEF MANSION
(Second Floor)
56-57, Motijheel C/A,
Dhaka-1000

Dear Sir,

Re: Application for Registration of Trade Mark "BBC" App. No. 49040 in Class-9 in the name of British Broadcasting Corporation.

We would refer to the above matter and inform that H & H Company has been appointed as Attorney of the above Applicant in place of M/S K.A. Bari.

Dear Sir,

We have the honour to bring to your kind notice that the application No. 49040 was filed in November 16th, 1996 which is pending for registration since then.

As our client is pressing very hard in the matter we would request your goodself to look into the matter concerned and pass an early advertisement order for processing of registration of the aforesaid trade mark.

Thanking you,

Yours faithfully

Salauddin Abdullah
(Advocate)

20. Despite the appellant's application dated 25.05.2008, the respondent No. 1 office kept silent about the matter. Then, on 08.02.2010 appellant filed an application before the respondent No. 1 to inquire into the matter which verbatim runs thus;

H & H COMPANY
HCQ Hä HCQ @Ljçfjef
BARISTER-AT LAW, ADVOCATES, NOTARIES, TAX
TRADE MARKS & PATENT ADVISERS

Our Ref: RH:MSU: ha/L-225

February 8, 2010

The Registrar
Department of Patents, Designs & Trade Marks
The Trade Marks Wing
Dhaka

SHAREEF MANSION
(Second Floor)
56-57, Motijheel C/A,
Dhaka-1000

Dear Sir,

Re: Application for Registration of Trade Mark

| Trade Mark | App. No. | Class |
|-------------------|-----------------|--------------|
| "BBC" | 49040 | 9 |

in the name of British Broadcasting Corporation.

We would refer to the above Application which is pending for examination since last 13 years.

The applicant of the above mark is new very anxious for such delay in getting the examination report.

We therefore request your to urgently take care of the matter and sent us the examination report to our filing address.

H & H Company
Barrister and Advocates
56/57 Motijheel C/A (Shareef Mansion)

2nd Floor, Dhaka-1000
Bangladesh

Yours faithfully,
(REZWANUL HAQUE)

21. Then, on 14.09.2010 the appellant filed another application before the respondent No. 1 to inquire about the status of the appellant's trade mark, which verbatim runs as follows;

H & H COMPANY
HCO Hä HCQ ®;f;ef
BARISTER-AT LAW, ADVOCATES, NOTARIES, TAX
TRADE MARKS & PATENT ADVISERS

Our Ref: RH:MSU: ha/L-225

February 8, 2010

The Registrar
Department of Patents, Designs & Trade Marks
The Trade Marks Wing
Dhaka

SHAREEF MANSION
(Second Floor)
56-57, Motijheel C/A,
Dhaka-1000

Dear Sir,

URGENT

Re: Application for Registration of Trade Mark

| Trade Mark | App. No. | Class |
|-------------------|-----------------|--------------|
| "BBC" | 49040 | 9 |

in the name of British Broadcasting Corporation.

We would refer to our several reminders including last letter to you dated 08.02.2010 regarding the above application. We have not been informed any development since 2007.

The applicant of the above mark has become very anxious for such delay in getting any development.

We therefore request your to urgently take care of the matter and inform us the present status to our following address to take proper steps by the applicant

H & H Company
Shareef Mansion
56/57 Motijheel C/A (Shareef Mansion)
2nd Floor, Dhaka-1000
Bangladesh

Yours faithfully,
(REZWANUL HAQUE)

22. Further, on 14.09.2010, the respondent No. 1 informed the appellant that its application was rejected on 15.07.2007. The said memo dated 14.09.2010 verbatim runs as follows;

ধোয় ট্রেডমার্কস দরখাস্ত নম্বর : ৪৯০৪০ শ্রেণী -09Z
আবেদনকারী নাম/ ট্রেডমার্কের বিবরণ.....

Sejh,

Efl;S² ধোয় আপনাকে জানানো যাইতেছে যে, আপনার দরখাস্তের ট্রেডমার্ক নিম্ন
hZLh ®V® j;Lh HI pqa pj "fV®
ট্রেড মার্কস দরখাস্ত নং পন্যের বিবরণ প্রতিষ্ঠানের নাম ও ঠিকানা

fEue fæ ew 21301/10 ajw 14-09-10 HI grounds of Decision হচ্ছে-
নথিটি পরীক্ষাতে দেখা যায় যে, সমস্ত পেভিং মার্কস রহিয়াছে তাহার সংগে মিল
রহিয়াছে। বিধায় নথিটি প্রত্যাহান করা যাইতে পারে।

üjrl / üjrl/
flêrL H, BI-1

এই সামঞ্জস্যতা ও অন্যান্য কারণে ট্রেড মার্কস এ্যাক্ট ২০০৯ এর ধারা
অনুসারে আপনার ট্রেডমার্কটির নিবন্ধনে আপত্তি রহিয়াছে, বিধায় কেন আপনার দরখাস্ত
খানা প্রত্যাহান করা হইবে না তাহার উপযুক্ত কারণ দর্শাতে হইবে। এই জারীর ৩
(æe) মাসের মধ্যে দাখিল করিতে হইবে অথবা শুনানী দাবী করি-
তে হইবে। এই নির্ধারিত সময়ের মধ্যে প্রয়োজনীয় ব্যবস্থা গ্রহন না করিলে আপনার
দরখাস্তখানা পরিত্যক্ত বলিয়া গণ্য হইবে।

üjrl/A0f0
ফিফ-®S0ff,

®FV®, ®S;Ce J ®V® j;Lh AtdccI, YjLz”

24. In this trade mark appeal, the admitted position is that the application No. 49040 in Class-9 was filed on 14th November, 1996 by the appellant and the respondent No.1 issued notice under section 14(1) of the Trade Marks Act, 1940 on 29.07.2004. It is also admitted that as per sub Rule (2) of the rule 24 of the Trade Marks Rules, 1963, the appellant on 02.08.2004 sent his observations to the trade mark registrar, which was received by the respondent No.1's office on 08.08.2004 vide Memo No. 6474.

25. It is also admitted that after receiving the observations on 08.08.2004, the respondent No.1 on 30.04.2007 issued notice upon the appellant to appear before him and accordingly the appellant appeared on that date.

26. But curiously enough, the respondent No.1 even after taking hearing of the appellant on 30.04.2007 did not communicate its decision in writing to the appellant till 14.09.2010.

27. As per sub-rule (1) of Rule 25 of the Trade Marks Rules 1940, the decision of the registrar should be communicated to the applicant in writing. But, in the present case, it is crystal clear from the record that the respondent No.1 did not communicate its decision in writing to the appellant till 14.09.2010 for reasons best known to them.

28. It further appears from the record that the appellant on 08.06.2008, by filing an application requested the respondent No.1 to go for an order of advertisement or for the process of registration of trade mark. Then, again on 08.02.2010, the appellant filed another application before the respondent No.1 enquiring about the fate of the pending application and finally on 14.09.2010 the appellant filed another application before the respondent No.1

enquiring about the status of the trade mark and then the respondent No.1 on 14.09.2010 informed the appellant that his application had been rejected on 15.07.2007.

29. The appellant claims of using the trademark BBC in Bangladesh which dates back in 1941 even prior to its registration in 1949.

30. Indisputably, the appellant has been using the trade mark of the suffix BBC; since 11.01.1941 in Bangladesh. On the other hand, the respondent's trade mark application No. 9236 was registered on 26.04.1974 and trade mark application No. 37533 was registered on 20.04.1994 but, they actually have not been using the same, or for that matter even now.

31. It is also necessary to quote Section 30 of Trade Marks Act, 2009 (Same as section 25 of Trade Marks Act, 1940), which commences with a non obstante clause as under;

“30. Saving for vested rights- Nothing in this Act shall entitle the proprietor of a registered trademark or well-known mark or a registered user to interfere with or restrain any person or his predecessor from using a trademark identical with or nearly resembling it in relation to goods or services if it has continuously been used by them from a date prior to the use of the first – mentioned trademark or well – known mark in relation to those goods or services by the proprietor or a predecessor in title of his, and the Registrar shall not refuse to register the second – mentioned trademark by reason only of the registration of the first – mentioned trademark. Besides above, as earlier user the appellant has right of registration under section 30.”

32. Section 30 of the Trade Marks Act, 2009 provides that priority of use of this mark gets paramount consideration compared to registration.

33. The right created in favour of a registered proprietor of a trade mark is not an absolute right and is subservient to other provisions of the Act. In other words, registration of a trade mark does not provide a defence to the proceedings for passing of as under section 24 of the Act, 2009. A prior user of trade mark can maintain an action for passing off against any subsequent user of an identical trade mark including a registered user thereof.

34. The right of good will and reputation in a trade mark was recognized at common law even before it was the subject of statutory law, prior to codification of trade mark law there was no provision in Bangladesh for registration of a trade mark . The right in a trade mark was acquired only by use thereof. This right has not been affected by the Act and is preserved and recognized by section 30.

35. Section 30 of the Trade Marks Act, 2009 is similar to Section 34 of the Trade Marks Act, 1999 of India.

36. In the case of Rolex Sa Vs. Alex Jewellery Pvt. Ltd. & Ors., 2009(41) PTC 284 (Del.), the Court concluded that there is no user of the trade mark prior to the date of registration of the trade mark in favour of the plaintiff. Hence, the Court held as follows:-

“ 11..... There is thus nothing to show user by the defendants of the mark since prior to registration in favour of plaintiff, except admitted

factum of registration having been applied for. The benefit of Section 34 is available only by continuous use since prior to user or date of registration, whichever is earlier, by/of the registered proprietor. The benefit is not available merely by applying for registration. The defendants have failed to prima facie bring their case within the ambit of section 34.”

37. In the case of Smithkline Beecham PLC & Anr. Vs. Sunil Sarmarkar & ors, 2012 (132) DRJ 880 it was held that; Registration of a trade mark cannot confer a right unless goods have been sold under the said trade mark. It was further held that a person cannot be allowed to squat on a trade mark without actually using the same.

38. A somewhat similar view was taken in the case of Allergran INC & Anr. Vs. INTAS Pharmaceuticals 2013 (53) PTC 36 (Del). Similarly in Rikhab Chand Jain & Anr. Vs. T.T. Enterprises Pvt. Ltd., 2013 (54) PTC 489 (Del) it was reiterated that no squatting on a trade mark is permissible.

39. In the present case, it further appears from the record that there is absence of user of the trade of the respondents and that a trade mark which drops out of the use, dies when there are no goods which are offered for sale as there is no use of the trade mark.

40. Apart from that, the respondents failed to appear before this Court with any affidavit-in-opposition and thereby failed to show that they have carried on any business in the relevant class i.e. class 30 or have used the concerned trade mark for the said business. In such a position, we have no choice but to accept the averments and the claims that have been laid by the appellants.

41. It is further necessary to quote the **Article 6bis** of the Paris Convention for the Protection of Industrial Property (Paris Convention for the Protection of Industrial Property of March 20, 1883, as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, and at Stockholm on July 14, 1967, and as amended on September 28, 1979) which runs thus:-

Article 6bis

Marks: Well-known Marks

- (1) *The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.*
- (2) *A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The countries*

of the Union may provide for a period within which the prohibition use must be requested.

(3) No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in bad faith.

42. The British Broadcasting Company (BBC) evolved as a life in 1922. Subsequently, in 1926, the company was dissolved and the British Broadcasting Corporation formed with a royal charter on 1st January, 1927. BBC is well known trade mark as defined under Article 6bis of the Paris Convention to which Bangladesh is a party and as a well known trade mark deserving protection against unauthorised use by various foreign courts. [Bangladesh joined WIPO (World Intellectual Property Organisation) in 1985. Accession: November 29, 1990 – Entry into force March 3, 1991.]

43. In the light of the above facts and circumstances, this appeal is allowed. We, hereby, set aside the decision and order dated 15.07.2007 (communicated on 14.09.2010) passed by the Registrar of Trade Marks, Dhaka rejecting the trade mark application No. 49040 dated 14.11.1996 in class-9. We allow the application No. 49040 dated 14.11.1996.

44. Further, we direct the respondent No. 1 to register the appellant's mark BBC in class-9. We permit the appellant to use the name BBC.

45. Communicate this judgment and order to the Registrar, Department of Patents, Designs and Trade Marks Registry Wing, Ministry of Industries, Government of the People's Republic of Bangladesh, 91, Motijheel Commercial Area, Dhaka.

46. Send down the Lower Court Records at once.