

(2010) 03 IPAB CK 0006
In the Intellectual Property Appellate Board
Case No : OA/65/2008/TM/CH

Basf Aktiengesellschaft, A German Company	APPELLANT
Vs	
Micro Lab Limited And Deputy Registrar Of Trade Marks	RESPONDENT

Date of Decision : 31-03-2010

Acts Referred:

Trade Marks Act, 1999 — Section 18(1), 19, 21, 131

Citation : (2010) 03 IPAB CK 0006

Hon'ble Judges : S. Usha, J; Syed Obaidur Rahaman, Technical Member

Bench : Division Bench

Final Decision : Allowed

Judgement

S. Usha, J

1. Appeal arising out of the order dated 02.04.2008 treating the opposition as abandoned under sub- rule (2) of Rule 50 the Trade Mark Rules, 2002

(hereinafter referred to as the rules) and allowing the application No. 1268858 in class 45 to proceed to registration.

2. The first Respondent herein had filed an application for registration of the trade mark 'LUTIVIT' in class 5 claiming user as proposed to be used

mark on 25.02.2004 under application No. 1268858. The said application was advertised in the Trade Marks Journal No. 1327-S (3) at page 696 on

17.1.2005. The said application was opposed by the Appellant herein under opposition No. MAS-197921. On 26.03.2007 the Appellant received a

communication from the Trade Marks Registry along with the counter statement and was directed to file their affidavit of evidence in support of

opposition within a period of two months. On 25.05.2007, the Appellant herein filed a request on form TM-56 for extension of time and also made it

clear in their letter that the time be extended for a period of one month and in case they were unable to file evidence on or before 26.06.2007, they wish to rely on the facts stated in the notice of opposition. A copy of the letter was also marked to the first Respondent herein. The first Respondent had not filed their affidavit of evidence in support of their application thereafter. The Appellant on 08.01.2008 filed their affidavit of evidence in support of their opposition along with an interlocutory petition praying that the evidence be taken on record. The first Respondent was also given an opportunity to file their reply to the interlocutory petition but the first Respondent did not file their reply to the interlocutory petition.

3. The matter was subsequently set down for hearing on 19.03.2008. The Assistant Registrar of Trade Marks heard both the counsel and passed the impugned order stating since the interlocutory petition was filed beyond the time, i.e. extended time of three months under Rule 50(2) of the Rules, the opposition was treated as abandoned and the application to proceed for registration. Aggrieved by the said order the Appellants are here before us on appeal. The main grounds of appeal as under:

- i. The impugned order is contrary to law and orders of this Hon'ble Board and is liable to be set aside.
- ii. The second Respondent erred in not taking on record the fact that the Form TM-56 also consisted of the statement intimating the first Respondent that in case of inability to file evidence within the stipulated time, the Appellant would rely on the notice of opposition.
- iii. The second Respondent erred in not directing the first Respondent to file its evidence in support of application.
- iv. The impugned order is bad, as the interlocutory petition filed by the Appellant should have been construed as filed under Rule 53 of the Rules.
- v. The impugned order is bad as no reasons have been assigned.
- vi. The impugned order is bad as the provisions of Rule 50(2) of the rules has been held to be directory.
- vii. The impugned order is bad as giving harmonious construction of rules 56(1) and 56(4) of the Rules and Section 19 of the Trade Marks Act, 1999.
- viii. The second Respondent erred in not taking into account the prior adoption of Appellant's mark 'LUTAVIT' under registration No. 353087.
- ix. The second Respondent grossly erred in not allowing the impugned trade

mark application.

x. The second Respondent failed to take note that the first Respondent had not filed documentary evidence to establish honesty and bonafide in adoption of the mark 'LUTIVIT.'

4. The first Respondent filed their counter-statement stating various averments made in the grounds of appeal. The first Respondent stated that they are the proprietors of the trade mark LUTIVIT under Section 18(1) of the Act. Their trade mark LUTIVIT had acquired substantial reputation and good will through extensive use. Their sales figure and sales promotion expenses would prove the same. As a result of continuous and extensive use since 2004, their mark enjoys a good reputation and goodwill in the market and had acquired the status of a well-known mark. The Appellant approached this Board only to drag on the registration of the trade mark and the appeal therefore be dismissed with costs.

5. The Appellants filed their reply raising some technical defects as the counter-statement to the main appeal as well as the counter affidavit to the miscellaneous petition has been filed as one set.

6. We have heard learned Counsel Ms. Ruchi Singh. D for the Appellant and learned Counsel Shri G. Ramji for the first Respondent on 24.02.2010.

7. Learned Counsel for the Appellant referred to the letter dated 25.05.07 at page 24 of the typed set of papers and stated that they had sought extension and had also made it clear that in case they did not file their evidence in time they wish to rely on the facts stated in the notice of opposition.

They also further submitted that as the first Respondent had not filed their evidence in support of application, they had taken out an interlocutory petition seeking the permission of the Registrar to take on record the evidence filed in support of opposition. Though the first Respondent was to file

their reply to the interlocutory petition, no reply was filed and the matter was heard. The counsel relied on Rule 50 of the Rules and stated that as per

Sub-rule 2 of Rule 50 of the rules the Appellant had complied with the same and taken out this interlocutory petition as there was a delay. The

Appellant finally submitted that the Registrar had powers to take on record the evidence, but had not considered the same and had not given any valid

reasons except that he had stated that the evidence was filed beyond the extended time of three months.

8. Learned Counsel for the first Respondent submitted that the classification of goods were different and there was no question of deception or confusion in case the registration was allowed. Counsel also submitted that the letter dated 25.05.07 was not clear. The counsel relied on Section 21 of the Act stating that two months period was the prescribed time within which the Appellants were to file their evidence and cannot be permitted to take their own time to file evidence in support of opposition. Learned Counsel referred to few judgments in support of his contentions. Counsel also submitted that the prayer sought in the appeal was not maintainable.

9. We have heard and considered the arguments of both the counsel.. The issue to be dealt with is regarding the powers of the Registrar to extend time to file evidence. The Act does not stipulate any time limit for the evidence to be filed by either parties, whereas the rule prescribes a time limit of two months. However, the Registrar has powers to extend time as per the provisions of Section 131 of the Act. does not stipulate any time limit for the evidence to be filed by either parties, whereas the rule prescribes a time limit of two months. However, the Registrar has powers to extend time as per the provisions of section 131 of the Act

10. In the instant case, the Appellant has in fact sent an application on Form TM-56 requesting for extension of time and at the same time had relied on the facts of notice of opposition. It is, therefore, clear that the provisions of Sub-rule (1) of Rule 50 of the Rules have been complied with. The Appellant has filed an interlocutory petition seeking the direction of the Registrar to take on record the evidence filed in support of opposition. Section 131 of the Act confers discretionary powers on the Registrar to grant extension..

11. Dealing with the issue that procedural law is meant to advance the cause of justice, we may quote from the observations of the Apex Court in State of Punjab and Anr. v. Shamlal Murari and Anr. reported in AIR 1976 SC 1977. The Apex Court in the matter of procedural law was pleased to observe as under:

We must always remember that procedural law is not to be a tyrant but a servant not an obstruction but an aid to justice. It has been wisely observed that procedural prescriptions are handmaid and not the mistress, a lubricant, not a resistant in the administration of justice. Where the non-compliance,

though procedural, will thwart fair hearing or prejudice doing justice to parties, the rule is mandatory. But grammar apart, if the breach can be

corrected without injury to a just disposal of the case. we should not enthrone a regulatory requirement into a dominant desideratum After all courts

are to do justice, not to wreck this end product or technicalities. Viewed in this perspective, even what is regarded as mandatory traditionally may

perhaps, have to be moderated into wholesome directions to be complied with time or in extended time.

12. On considering the facts and circumstances of the case, we are of the view that evidence ought to have been taken on record giving an

opportunity to the Appellant to file their evidence in support thereof. It is a well settled principle that evidence should never be shut down. The

Registrar should have taken the evidence on record with a direction to the Respondent to file their reply evidence. That apart, the first Respondent has

not filed any comment to the interlocutory petition filed by the Appellant which is to be taken that he had not opposed the same.

13. In such circumstances, we are of the view that the matter be remanded back to the Registrar to take on record the evidence filed by the Appellant

and direct the first Respondent to file their evidence and the matter be decided on merits.

14. We, therefore, allow the appeal and set aside the order dated 02.04.2008. The matter is remanded back to the Registrar to take on record the

evidence of the Appellant and the matter be disposed of in accordance with law. There shall be no order as to costs.