

(2008) 12 IPAB CK 0008

In the Intellectual Property Appellate Board

Case No : M.P. Nos. 26, 29/2008 In OA/9-12/2008/TM/AMD

Glenmark Pharmaceuticals Ltd.

APPELLANT

Vs

Assistant Registrar Of Trade Marks

RESPONDENT

Date of Decision : 12-12-2008

Acts Referred:

Intellectual Property Appellate Board (Procedure) Rules, 2003 — Rule 10
Trade Marks Rules, 2002 — Rule 47(6)

Citation : (2009) 39 PTC 701 (IPAB)

Hon'ble Judges : Z.S. Negi, J; S. Usha, Technical Member

Bench : Division Bench

Final Decision : Allowed

Judgement

Z.S. Negi, J

1. This order disposes four stay petitions filed by the Appellant in the above appeals, seeking stay of operation of the impugned common order dated

5th October, 2007, passed by the Assistant Registrar of Trade Marks, Ahmedabad, whereby he turned down the proposed oppositions being Nos.

AMD-206516, AMD 206512, AMD-206513 and AMD-206514 as time barred.

2. It is the case of the Appellant that it is a well known pharmaceutical company carrying on business in India and abroad in a wide range of

pharmaceutical products. Some of the Appellant's pharmaceutical products are manufactured and sold under the registered trade marks 'ALEX',

'VITARAL-G' and 'CANDID' and its series of marks. Certain applicants filed applications for registration of certain trade marks and the same were

advertised on 30.3.2005 in the Trade Marks Journal, details of the aforesaid certain applicants and certain trade marks are given below:

(i) Application No. 1318538 for registration of trade mark 'ALZEX' in class 5 in

the name of Taurus Laboratories Pvt. Ltd., Ahmedabad, advertised in the Trade Marks Journal No. 1328 Suppl. (4) at page 612.

(ii) Application No. 1249637 for registration of trade mark 'VITAROL' in class 5 in the name of Royal Labs, Vadodara, advertised in the Trade Marks Journal No. 1328 Suppl. (5) at page 1972.

(iii) Application No. 1329130 for registration of trade mark 'ZANID-2' in class 5 in the name of Defi Healthcare Pvt. Ltd., Ahmedabad, advertised in the Trade Marks Journal No. 1328 Suppl. (5) at page 2540.

(iv) Application No. 979794B for registration of trade mark 'ALLEX' in class 5 in the name of Allex India, Surat, advertised in the Trade Marks Journal No. 1328 Suppl. (5) at page 1400.

The Appellant opposed the above mentioned applications by filing opposition against each application (Opposition Nos. AMD-206516, 206512, 206513 and 206514, respectively) but the Respondent turned down those oppositions on the ground that they were filed after expiry of the period of limitation.

Aggrieved by the impugned common order, the Appellant has filed the above appeals along with petitions seeking stay of operation of the impugned order by ordering the Registrar of Trade Marks not to proceed further in any manner with the applications concerned or register the trade marks applied for and not to issue the registration certificates until further orders of this Appellate Board.

3. The petitions for stay came up before us for hearing, wherein Shri V.S. Hegde, advocate appeared on behalf of the Appellant and the Respondent remained unrepresented. Notice dated 25.2.2008 on Form No. 'C' Under Rule 10 of the Intellectual Property Appellate Board (Procedure) Rules, 2003 was sent to the Respondent and notice dated 11.8.2008 for hearing of stay petitions were sent to both the parties. Thus, the requirements of Section 95 of the Act have been fulfilled; the matters were decided to be heard ex parte. As the facts of all the petitions for stay are similar and the parties are also same, all the four petitions, with the consent of learned Counsel for the Appellant, were heard together and this common order is being passed.

4. Learned Counsel for the Appellant submitted that the Trade Marks Journal dated 30.3.2005 was made available to public on 3.6.2005 and

accordingly the notice of opposition could be filed on or before 3.9.2005 and thereafter within such further period, not exceeding one month in the aggregate, as the Registrar may allow, that is to say latest by 3.10.2005. The Appellants themselves though prepared the notice of oppositions, letter addressed to Registrar as well as the cheque towards the fee, all dated 31.8.2005 were kept ready but due to oversight and shifting of office of the Appellants, the same could be sent to the Trade Marks Registry through courier on 6.9.2005 and the Registry issued receipt No. 362455 dated 7.9.2005 therefor. Learned Counsel submitted that the Respondent issued a notice dated 9.5.2006 to the Appellants to show cause as to why the notice of opposition should not be refused and thereupon the Appellant filed reply by way of affidavit dated 26.5.2006 stating that he notice of opposition could not be filed within the statutory period of three months due to shifting of their office premises and the delay is genuine, not intentional and beyond their control and the Respondent heard the matter on 3.10.2007. It is contended that during the course of hearing the counsel for the opponent (Appellant herein) had submitted to the Respondent that the delay of four days falls within the extendable period of fourth month and Sub-rule (6) of Rule 47 of the Trade Marks Rules, 2002 (hereinafter referred to as the Rules) which required that application on Form TM-44 for extension of time shall be filed before expiry of period of three months under Sub-section (1) of Section 21 of the Act has been struck down by the Division Bench of High Court of Bombay, as null and void in the judgment in Sardar Gurudas Singh Bedi v. Union of India and Ors., 2006 (33) PTC 321 (Bom.) (DB) and as such the Respondent has no jurisdiction to proceed under Sub-rule (6) of Rule 47 but to consider the requirements of Section 21 of the Act but the Respondent has not at all taken note of this submission and the cited judgments, copies of which were given to him. Apart from this, the Respondent, by ignoring the averments made by the Appellants and submissions made by the counsel during the course of hearing, has seriously erred in casting unnecessary and unfounded aspersions, as detailed in the appeal, on the conduct of Appellant's advocate. Learned Counsel also submitted that the Appellant has a good case on merits and law and if the Respondent proceeds to register the trade marks applications, serious hardship and injury would be caused to the Appellant which cannot be compensated in terms money but on the other hand if operation of the impugned

order dated 5.10.2007 is stayed by the Appellate Board, no prejudice or hardship will be caused to the Respondent or the Appellant. By submitting a copy of 'TMR Application Status as on 18.9.2008 taken from the Official Website of the Trade Marks Registry, the learned Counsel informed us that the status of application No. 1318538 for registration of 'ALZEX' trade mark is shown as opposed. He urged that the balance of convenience is in favour of the Appellant, therefore, all the Stay petitions may be allowed.

5. After having heard the learned Counsel for the Appellant and having perused the documents available on record, the cardinal issue for our consideration is Whether stay as prayed for can be granted. Section 95 of the Act dealing with conditions as to making interim orders provide that no interim order shall be made on, or in any proceedings relating to, an appeal unless copies of such appeal and of all documents in support of the plea for such interim order are furnished to the party against whom such appeal is made or proposed to be made and opportunity is given to such party to be heard in the matter. In the present case stay is sought against the operation of the orders passed by the Assistant Registrar, restraining the Assistant Registrar to proceed further in any manner in the matters. As we have already stated that the notice on Form 'C' and the notice of hearing have been sent to the Assistant Registrar of Trade Marks, Ahmedabad and thus the requirements of Section 95 have been met. Now for considering the prayers made in the stay petitions, we are required to consider prima facie case, balance of convenience and irreparable injury. These well established principles govern the exercise of discretionary power of issuing interim injunction or stay order as may be sought for by the Petitioner. In the impugned orders, the Assistant Registrar has noted that the Appellant ought to have filed notice of opposition, within three months with no extension of time, on or before 3.9.2005 and in fourth month with extension of time on or before 3.10.2005, but filing of same without extension of time on 7.9.2005 in contravention of Sub-section (1) of Section 21 of the Act is clear violation of the statutory law and as such is left with no option but to be declared time barred, Averments made in the appeals are that the Assistant Registrar issued notices dated 9.5.2006 in respect of opposition Nos. AMD-206516, AMD-206512 and AMD-206513, and notice dated 28.4.2006 in respect of opposition No. AMD-206514 to the Appellant to show cause why the

notices of opposition should not be refused. The undisputed positions that emerge is the oppositions were filed within the fourth month but without

applications on Form TM-44 seeking extension of time and the Assistant Registrar issued notices to show cause after a year. Had the Assistant

Registrar/Registry of Trade Marks taken timely action and directed the Appellant to file Form TM-44, these appeals would not have arisen. Even

during the course of hearing, the Assistant Registrar ought to have directed the Appellant to make applications for extension of time, as the notices of

opposition were received within the extendable time and pending in the Registry of Trade Marks. With the striking down of Sub-rule (6) of Rule 47 of

the Rules, the condition that the application for extension of time should be filed before the expiry of three month no longer exist on the statute book.

The learned Counsel has rightly submitted that no prejudice or hardship will be caused to the Respondent. We do not visualise any prejudice or

hardship that may be caused to the Assistant Registrar by the stay order. The learned Counsel has submitted that serious hardship and injury would be

caused to the Appellant which cannot be compensated in terms of money. In the absence of any opposition or rebuttal to this submission, we see no

reason to disincline with the same. We are of the view that the applicants for registration can continue to use the trade marks, as have been using till

now, under the common law even without registration certificates.

6. The result is that prima facie case is established and the balance of convenience is in favour of the Appellant. We, therefore, allow all the stay

petitions and stay the operation of the impugned orders passed on 5.10.2007 in respect of opposition Nos. AMD-206516, AMD-206512, AMD-

206513 and AMD-206514 and direct the Registrar not to proceed further in any manner with the applications for registration against which the

aforementioned oppositions were filed. There shall be no order as to costs.