

(2009) 02 IPAB CK 0005

In the Intellectual Property Appellate Board

Helix Group PLC, England

APPELLANT

Vs

Kusum Lata Goel And Lalit Kumar, Trading As Sanjeev
Engineering Works And The Assistant Registrar Of Trade
Marks, Trade Marks Registry

RESPONDENT

Date of Decision : 27-02-2009

Acts Referred:

Trade And Merchandise Marks Act, 1958 — Section 111

Citation : (2009) 02 IPAB CK 0005

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

Bench : Division Bench

Final Decision : Dismissed

Judgement

S. Usha, Technical Member

1 . The above Miscellaneous Petitions are filed by the 1st respondent in the Transferred Appeal No. 144/2003/TM/DEL. The applicant, by way of

M.P. No. 103/2008 has sought stay of the hearing of the appeal till the adjudication of the rectification matter under No. 150690 in class 16 and by

way of another M.P. No. 104/2008 sought a direction from this Appellate Board to direct the appellant to amend the petition and to provide the latest

address of the parties.

2 . The brief facts of the case are that the 1st respondent (Petitioner in the Miscellaneous Petition) filed an application for registration of the trade

mark Helix in class 16 on 24th September, 1986. The appellant herein (Respondent in the Miscellaneous Petition) opposed the said registration and the opposition was dismissed on 5th March, 1999. The instant appeal is against the said order.

3. Meanwhile, the 1st respondent filed a rectification application on 27th March

1993 for removal of the trade mark registered under No. 150690.

They also filed an interlocutory petition seeking an amendment of the rectification. Even without notice being served on the appellant herein the

Registrar had passed an order in the interlocutory Petition on 11th November, 1997. The appellant herein filed on 13th April, 1998a review petition

against the said order. On 26th August 2005 the Registrar allowed the Review Petition and set aside the order dated 11th November 1997. The 1st

respondent filed an appeal against the order dated 26th August, 2005 before this Appellate Board and is pending.

4. The appellant in the meantime, filed a civil suit No. 1751 of 1995 before the Delhi High Court against the 1st respondent and also filed an interim

application to stay the suit under Section 111 of the Trade & Merchandise Marks Act, 1958. The interim application for stay was dismissed on 2nd

May, 2002. In the year 2003, the said suit was transferred to the District Court, Delhi for lack of pecuniary jurisdiction. The appellant herein filed an

application for amendment of the plaint to include invoices showing sale of the appellant's products in India. The amendment application was dismissed

by the District Judge on 4th November, 2004 against which an appeal was preferred before the Delhi High Court. The Hon'ble High Court of Delhi,

on 9th May, 2005 stayed the operation of the order dated 4th November, 2004 and other proceedings.

5. In July 2005, the appellant herein, filed another suit being C.S. No. 179 of 2005 for infringement of trade mark and passing off before the Hon'ble

High Court of Calcutta on a fresh cause of action. On an interim application moved by the appellant, the Hon'ble High Court was pleased to pass an

order of injunction on 26th July, 2005 against the respondent restraining them from using the impugned trade mark Helix. The order of stay was

vacated on 4th October, 2005 but the same was subsequently re-instated on 24th October, 2005. The 1st respondent filed a petition for stay of the suit

and for vacating the order of injunction. The Hon'ble Calcutta High Court passed an order on 3rd August, 2007 directing the appropriate authorities to

dispose of the rectification proceedings within a period of six months and during which period an order of stay to continue. In spite of the directions of

the Hon'ble High Court, no developments have taken place.

6 . The 1st respondent along with the appellant had filed an application for

postponing the hearing of this appeal in M.P. No. 150/2007 and the same was dismissed on 15th February, 2008. The 1st respondent filed Writ Petition against the said order. The Hon'ble High Court of Delhi had granted liberty to file a petition for adjournment of the hearing of this instant appeal individually and had not gone into the merits of the matter. Pursuant to that order, the 1st respondent is before us with this M.P. No. 103/2008.

7 . The 1st respondent had filed this petition on the ground that the parallel proceedings would create multiplicity of proceedings. The rectification matter would decide the validity of the registration.

8. The appellant herein filed their reply to the Miscellaneous Petition and stated that the petition was not maintainable and that the principles of res judicata would apply.

9 . We have heard Ms. Rashmi Virmani, learned Counsel for the appellant and Shri Shailen Bhatia, learned Counsel for the 1st respondent in the Circuit Bench Sitting at New Delhi on 19th January, 2009.

10 . The learned Counsel for the 1st respondent mainly contended that the miscellaneous petition be allowed and stay be granted as it would only lead to multiplicity of proceedings. He relied on various judgments in support of his contentions. He also brought to our notice the view of this Appellate Board in granting stay in such kind of proceedings from the judgment in OA/39/2007/TM/DEL.

11. The learned Counsel for the appellant mainly contended that the 1st respondent is only trying to delay the matters by filing such frivolous applications. She further submitted that the 1st respondent has been filing several adjournment applications and now has come up with such an application which proves the intentions of the 1st respondent.

12. We have carefully considered the arguments of both the parties. On perusal and after going through the pleadings of the parties, we understood that the impugned order under appeal has been passed in the year 1999. The rectification proceedings is of the year 1998. The 1st respondent has also filed an appeal before this Appellate Board against an order passed by the Assistant Registrar in an interlocutory petition in the rectification proceedings in the year 2005 which is pending.

13 . We also find that there has been a direction from the Hon'ble High Court of

Calcutta to dispose of the rectification proceedings within a period of six months from August 2007, whereas there is no further development. The order passed in the interlocutory petition in the rectification petition is under challenge before the Appellate Board. In such a case, the rectification proceedings can be taken up only after the appeal against the Interlocutory Petition is disposed of.

14. As regards the view of this Appellate Board in OA/39/2007/TM/DEL, we are of the opinion that in that case the stay was sought when the opposition was pending, whereas, in this case, the stay is being sought after a long delay. We don't think it would be just to have the matter pending for over a decade.

15. During the course of the argument, when this Board had sought clarification as to the stage of the rectification proceedings and as to the completion of the procedural aspect, the counsel of the parties were not in a position to clarify the same.

16. In such circumstances and with the observations made above, we don't find any merit in the application for staying the appeal proceedings. Apart from this, the Act does not provide any powers to stay the rectification proceedings. We are also of the view that the rectification petition is to decide the question as to the entering in register the mark whether is valid or not, whereas in a opposition proceedings, it is to be decided whether the mark is to be entered in the register or not. We therefore dismiss the application in M.P. No. 103/2008. No order as to costs.

17. As regards the Miscellaneous Petition No. 104/2008 for direction by this Hon'ble Board to the Petitioner to amend the petition and to provide the latest address of the parties, we find no grounds made out in the application and hence dismissed.