
(2006) 04 IPAB CK 0002

In the Intellectual Property Appellate Board

Case No : Original Appeal No. 51/2004/TM/CH

Hindustan Lever Limited

APPELLANT

Vs

Pfizer Ltd. And Anr.

RESPONDENT

Date of Decision : 27-04-2006

Acts Referred:

General Clauses Act, 1897 — Section 27

Trade Marks Act, 1999 — Section 19, 21, 21(4), 23, 23(1)(b), 91, 143

Trade Marks Rules, 2002 — Rule 18(2), 19, 56, 56(4)

Citation : (2006) 33 PTC 205 (IPAB)

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

Bench : Division Bench

Advocate : P. Vinod Kumar, Sivaraman Vaidyanathan

Final Decision : Allowed

Judgement

Z.S. Negi, Vice-Chairman

1. This appeals have been filed by the appellant under Section 91 of the Trade Marks Act, 1999 (hereinafter referred to as the Act) challenging the

order dated 12.3.2004 of the Assistant Registrar of Trade Marks, Chennai.

2. The predecessor company, namely, M/s. Smithkline Beecham Pharmaceuticals (India) Limited of the 1st respondent herein M/s. Pfizer Limited

being successor of M/s. Smithkline Beecham Pharmaceuticals (India) Limited] filed an application No. 561479 for registration of the trade mark

'DISPECT' in respect of disinfectants in class 3. The said mark was advertised in the Trade Mark Journal No. 1235 (Supplement), dated 21.11.2000,

page 17. The appellant herein, M/s Hindustan Lever Limited, filed the notice of opposition, MAS 58601 primarily on the ground that the mark sought to

be registered is descriptive of the goods and is, therefore, not distinct. The

appellant had raised other grounds in the notice of opposition. The appellant had given Mumbai address of its agents in the notice of opposition for service. The 1st respondent filed the counter statement refuting the material averments of the appellant and the appellant, thereafter, filed evidence in support of the opposition by way of an affidavit. Thereafter, the 1st respondent filed their evidence in support of the application for registration and the appellant filed evidence in reply by way of an affidavit. The formalities were complete.

3. The Assistant Registrar of Trade Marks, Chennai issued notice on 3.2.2004 fixing the 10th day of March, 2004 for hearing of opposition No. MAS 58601 to application No. 561479 and also calling upon the parties to file Form TM-7 within 14 days from the receipt of the notice. The Assistant Registrar of Trade Marks on 12th day of March, 2004 passed the following Order:
IT IS HEREBY ORDERED THAT the opposition No. 58601 is treated as abandoned for want of prosecution and the Application No. 561479 in class 3 shall proceed to registration;

IT IS HEREBY FURTHER ORDERED THAT there shall be no order as to cost.

4. Hence, this appeal on the grounds that the order of the Assistant Registrar of Trade Marks treating the opposition as abandoned and allowing the application to proceed for registration is contrary to law, the notice of hearing sent to the address which was not the address for service given by the appellant and as such does not satisfy the requirement of a properly addressed as contemplated under the Act and the Rules made thereunder, non-filing of Form TM-7 as a result of issuance of notice at a wrong address will not attract Rule 56(4) of the Trade Marks Rules, 2002 (hereinafter referred to as the said rules) and, therefore, the order of the 2nd respondent is liable to be set aside. The 1st respondent filed the counter statement refuting the statement of appeal.

5. The main contention of the learned Counsel for the appellant is that the notice was issued at a wrong address. The appellant has given the address for service at Mumbai and said address for service was never changed but despite that the notice was issued at the Chennai address which cannot be deemed to be proper service under Rule 18(2) of the said rules. The 2nd respondent ought to have seen that Section 23 being subject to Section 19 of

the Act, dismissal or abandonment of opposition cannot automatically result in the application proceeding for registration. The 2nd respondent ought to have seen that the appellant was diligent at each stage of proceedings and had also filed evidence in reply and thereby shown keenness in prosecuting the application. The counsel for the 1st respondent contended that the impugned order of the 2nd respondent is neither improper nor contrary to the Act and is therefore not liable to be set aside because the language of the Act clearly gives the 2nd respondent the discretion to allow an opposed mark to proceed for registration where the application has been decided in favour of the applicant. Every previous communications were addressed to and served upon the Chennai address of the appellant's agent over a period of two and a half years, the appellant never found it appropriate, to the knowledge of the 1st respondent, to inform or request the 2nd respondent to correct the error or to ensure that such error is corrected and by not doing this the appellant has acquiesced to this wrongful service. Such an objection is not sustainable at this stage. Our attention was drawn to paragraph 3 of the counter statement which contained list of communications sent to the Chennai address of the appellant's agent.

6. We have carefully heard the contentions of both the counsel. The provisions of the Act and rules made thereunder (for brevity the rules), are

Sections 21(4) & (5), 23(1)(b) and 143 of the Act and Rules 18(2), 19 and 56(4) of the rules which are as under:

Section 21. Registration.-(1) xxx

(2) XXX

(3) XXX

(4) Any evidence upon which the opponent and the applicant may rely shall be submitted in the prescribed manner and within the prescribed time to

the Registrar, and the Registrar Shall give an opportunity to them to be heard, if they so desire.

(5) The Registrar shall, after hearing the parties, if so required, and considering the evidence, decide whether and subject to what conditions or

limitations, if any, the registration is to be permitted, and may take into account a ground of objection whether relied upon by the opponent or not.

Sub-section (4) of Section 21 provides that any evidence upon which the opponent and the applicant may rely shall be submitted to the Registrar and

the Registrar shall give an opportunity to them to be heard, if they so desire. Sub-section (5) of that section provide that the Registrar shall after

hearing the parties, if so required, and considering the evidence, decide whether and subject to what conditions or limitations, if any, the registration is

to be permitted, and may take into account a ground of objection whether relied upon by the opponent or not. The 2nd respondent fixed the hearing for

10th March, 2004 but the agent for the opponent did not appear because the notice was not properly addressed. Though the pleadings were complete,

the 2nd respondent did not consider the ground of opposition and evidence in support thereof available on the records before him.

(emphasis provided).

Section 23. Registration.-(1) Subject to the provision of Section 19 when an application for registration of a trade mark has been accepted and either-

(a) XXX

(b) The application has been opposed and the opposition has been decided in favour of the applicant.

The 2nd respondent directed to proceed the application of the 1st respondent for registration without passing a reasoned order. Nothing prevented the

2nd respondent to pass a reasoned order on the basis of complete records. The 2nd respondent knowing fully well that his order is appeal able and as

such a reasoned order is necessary in such matters has not given reasons for such order. The Hon'ble Supreme Court in the Travancore Rayons Ltd.

v. The Union of India AIR 1971 SC 865 has held as under:

...Necessity to find sufficient reasons which disclose proper appreciation of the problem to be solved, and the mental process by which the conclusion

is reached in cases where a non-judicial authority exercises judicial functions, is obvious. When judicial power is exercised by an authority normally

performing executive or administrative functions, this Court would require to be satisfied that the decision has been reached after due consideration of

the merits of the dispute, uninfluenced by extraneous considerations of policy or expediency. The Court insists upon disclosure of reasons in support of

the order on two grounds: one, that the party aggrieved in a proceeding before the High Court has the opportunity to demonstrate that the reasons

which persuaded the authority to reject his case were erroneous: the other, that the obligation to record reasons operates as a deterrent against

possible arbitrary action by the executive authority invested with the judicial power.

Section 143. Address for service.-An address for service stated in an application or notice of opposition shall for the purposes of the application or

notice of opposition be deemed to be the address of the applicant or opponent, as the case may be, and all documents in relations to the application or

notice of opposition may be served by leaving them at or sending them by post to the address for service of the applicant or opponent, as the case may

be.

This section provides that an address for service stated in an application or notice of opposition shall for the purposes of the application or notice of

opposition be deemed to be the address of the applicant or opponent, and all documents in relations to the application or notice of opposition may be

served by leaving them at or sending them by post to the address for service of the applicant or opponent. The appellant/opponent had given its agent's

address for service at Mumbai whereas the 2nd respondent sent notice to the agent at Chennai address which, on the face of this section, cannot be

deemed to be the address of the opponent. We are unable to agree with the contention of the learned Counsel for the 1st respondent that the previous

communications were sent at the Chennai address but the wrong address was not brought to the notice of the Registrar of Trade Marks, Chennai by

the agent's branch office Chennai. When the statute provide for a specific provision for the purpose the 2nd respondent is required to comply with the

provisions of the statute.

Rule 19. Address for service in application and opposition proceedings.-An application for registration of a trade mark or an opponent filing a notice of

opposition may notwithstanding that he has a principal place of business in India, if he so desires, may specifically request in writing, the Registrar with

an address in India to which communications in relation to the application or opposition proceedings only may be sent. Such address of the applicant or

the opponent shall be deemed, unless subsequently cancelled, to be the actual address of the applicant or the opponent, as the case may be Rule 18(2)

provides that any written communication addressed to a person specified is Sub-rule (1) thereof at an address for service in India given by him shall be

deemed to be properly addressed. Though this sub-rule is applicable to person

who has no principal place of business in India but principle underlying in this sub-rule is applicable to service of communication addressed to an applicant or opponent under Rule 19 as there cannot be different mode of service of communication under Rule 18(2) and Rule 19. The opponent had given an address for service in the notice of opposition and never changed the said address subsequently, therefore in the eyes of law, that address shall be deemed to be the actual address of the opponent.

Rule 56 provide for the procedure of hearing and decision by the Registrar of Trade Marks. Under Sub-rule (1), the Registrar shall, upon completion to evidence if any, give notice to the parties of the first hearing and within fourteen days from the receipt of such notice, any party who intends to appeal shall so notify the Registrar in Form TM-7 and any party who does not so notify may be treated as not desiring to be heard and the Registrar may act accordingly in the matter. Where the opponent is not present at the date of hearing and has not notified his intention to attend the hearing in

Form TM-7, the opposition may be dismissed under Sub-rule (4) for want of prosecution. For such dismissal of opposition it is necessary that notice should have been sent at the actual address of the opponent's agent. Issue of notice at an address other than the address given in the notice of opposition is violation of the provisions of the statute. The meaning of service by post is contained in Section 27 of the General Clauses Act, 1897

which reads as under:

Where any Central Act or Regulation made after the commencement of this Act authorizes or requires any document to be served by post, whether the expression "service" or either of the expressions "give" or "send" or any other expression used, then, unless a different intention appears, the service shall be deemed to be effected by properly addressing, pre-paying and posting by registered post,...

A notice by post not properly addressed cannot be treated as notice served. Further, when the notice is not served, the order of the 2nd respondent involving such serious consequences could not be passed without complying with the elementary requirements of rule of natural justice. It is well settled that an order without regard to the principles of natural justice is void.

7. For the reasons stated above, the impugned order dated 12th March, 2004 of the Assistant Registrar of Trade Marks is set aside and we remand

the matter back to the Assistant Registrar for giving an opportunity of hearing to the appellant/opponent and the 1st respondent/applicant in the matter

within six month from the date of receipt of this order. Accordingly the appeal is allowed. No order as to costs.