

**(2006) 04 IPAB CK 0001**

**In the Intellectual Property Appellate Board**

**Case No : Original Appeal No. 31/2005/TM/CH**

Jagdish Pershad Ladda

APPELLANT

Vs

K. Ganesh Nadar And Anr.

RESPONDENT

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**Date of Decision : 27-04-2006**

**Acts Referred:**

Copyright Act, 1957 — Section 53

Trade And Merchandise Marks Act, 1958 — Section 1(a), 1(e), 9, 9(1), 9(1)(a), 9(1)(c), 11(10), 11(3), 11(3)(a), 12, 18(1)

Trade Marks Act, 1999 — Section 11(1)

Trade Marks Rules, 2003 — Rule 52

**Citation : (2006) 33 PTC 198 (IPAB)**

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

**Bench : Division Bench**

**Advocate : K. Hema Prakasa Rao, V. Veeraraghavan**

**Final Decision : Dismissed**

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## **Judgement**

Z.S. Negi, J

1. The appellant has filed this appeal against order dated 6th May, 2005 of the Assistant Registrar of Trade marks, Chennai dismissing the opposition

No. MAS-130949 filed by the appellant in opposition of application No. 1039973B and M.P. for directing the Trade Marks Registry not to proceed

with issuance of the certificate pending disposal of this appeal.

2. The 1st Respondent herein filed application No. 1039973B on 28.8.2001 in class 3 for registration of trade mark 'Super XTRA' (label) on the ground

of its continuous use since 28th March, 1998. The application for registration of trade mark was advertised, subject to disclaimer of word 'Super' and

other descriptive matters appearing on the label, in the Trade Marks Journal No. 1303 (Supplementary-II) dated 18.9.2003 at page 44. The appellant

has on 24.7.2001 also filed application No. 1030209 for registration of trade mark (label) consisting of 'Super XTRA' in class 3 in respect of detergent cake and powder claiming the period of user from 1985 in his capacity as sole proprietor and the said application was accepted for registration with restriction of the use in the place of Karimnagar. On 13th October, 2003, the appellant herein filed a notice of opposition on the grounds that opponent has been carrying on the established and reputed business in manufacturing and marketing detergent cakes and powder and has from the year 1985 been regularly and in the course of trade using a grade mark 'XTRA' adopted in its aesthetic form, as also originated and adopted as an artistic work containing a unique design, layout and colour scheme in order to indicate that the detergent cakes and/or powder packed in the wrappers/plastic bags containing the said trade mark/artistic work emanate from the appellant. The appellant submitted that the registration of impugned mark/label is prohibited by the provisions of Section 1(a) and (e) of the Trade and Merchandise Marks Act, 1958 (for brevity the repealed Act) or under Section 11(1) and (3) of the Trade Marks Act, 1999 (for brevity the new Act), bad faith of the 1st respondent should be taken into consideration while considering this application under Section 11(10) of the Act and also that neither the 1st respondent nor the impugned application qualified under the provisions of Section 18(1) of the repealed Act and the new Act. The 1st respondent filed a counter statement denying all the material averments in the notice of opposition. The appellant filed affidavit of his evidence and thereafter the 1st respondent filed affidavit of evidence in support of application.

3. The matter came up for hearing on 7.2.2004. On the request of appellant, the heading was adjourned and re-fixed for hearing on 17.3.2005 as the last chance. Both the parties were informed by letters dated 15.2.2005 that no further adjournment will be granted under any circumstances. When the matter came up for hearing on 17.3.2005, the appellant again requested for adjournment in view of an Interlocutory Petition dated March 4, 2005 filed by him to adjourn the hearing of opposition till the disposal of various suits/rectification proceedings by the Courts/tribunals in the interest of justice. The counsel for the 1st respondent had on 4th March, 2005 by registered letter informed the counsel for the appellant that any move to adjourn

the matter at the hearing will be opposed by him. On 17.3.2005, none appeared for the appellant and the counsel for the 1st respondent vehemently

opposed the adjournment of hearing as well as the facts stated in the Interlocutory Petition. The matter was heard on the day fixed for it and the

Assistant Registrar of Trade Marks passed order by dismissing the opposition of the appellant and directing the application No. 103997B of the 1st

respondent or proceed for registration.

4. At the hearings of the Appeal and M.P. Shri K. Hemaprakasa Rao advocate for the appellant and Shri v. Veeraraghavan advocate for the 1st

respondent appeared before this Board. Shri Rao, the learned Counsel for the appellant submitted that the 2nd respondent passed the impugned order

and, without notice to him, disposed of the Interlocutory Petition. The impugned order do not contain reasons or is non-speaking order and as such the

order is liable to be set-aside and remanded. He relied on the cases *Madhya Pradesh Industries Ltd. v. Union of India* and *Ors. Travancore Rayon*

*Ltd. v. The Union of India* and *Ors. AIR 1981 DELHI 190* (at pages 191 & 192), *Imperial Chemical Industries Limited* and *Anr. v. The Registrar of*

*Trade Marks, Bombay* and *Anr.* where the Supreme Court and the Delhi High Court while dealing with non-speaking orders have held that the

speaking order is necessary. In reply Shri Veeraraghavan, the learned Counsel for the 1st respondent submitted that it is the duty of the counsel

appearing for the appellant to appear before the hearing officer on the appointed date, i.e. 17.3.2005 in the absence of any intimation of adjournment

since the matter has been posted finally. The appellant cannot simply take it for granted that the hearing will be adjourned. He submitted that he had

also intimated to the counsel for the appellant that he will oppose any move for adjournment. Further, Shri Veeraraghavan submits that the 2nd

respondent has taken up the Interlocutory Petition first at the hearing held on 17.3.2005 and then after hearing argument that there is no stay against

the 2nd respondent in proceeding with the opposition even though there were several suits pending before various Courts and after recording the

opposition for adjournment, the opposition proceedings was taken up for hearing as the same was posted as last chance. The averments made in the

Interlocutory Petition are irrelevant to the opposition proceedings.

5. Shri Rao contended that the 2nd respondent failed to consider the primary

requisite regarding registrability of the mark under the absolute grounds for refusal of registration. The word "XTRA" is a phonetic equivalent to the word "EXTRA". In support of his contention he quoted from the book of Dr. S. Venkateswaran entitled 'The Law of Trade Marks and Passing-off (Reprint of 1999) at page 127 'if a given word is for any reason unregistrable in its proper spelling then, the objection to the registration of the properly spelt word applies equally to a word which is merely its phonetic equivalent....' He submits that dictionary meaning of 'extra' is 'more' and 'more' is also given one of the meanings of 'extra' and in view of the meaning given to 'more' as an adjective or a noun it possess the same characteristics of the word 'Extra' (as an adjective) when it is used in conjunction with the word 'Super' and/or 'Big detergent bar' and noun when it is used as a single word. The word is a laudatory/descriptive epithet when it is read in conjunction with the prefix 'Super' or suffix 'Big detergent bar' and as such unregistrable under Section 9(1)(a) of the new Act. He submits that Dr. S. Venkateswaran in his book at page 124 while dealing with the marks which consist of ordinary and commonly used descriptive terms which are likely to be used by traders in the course of their business without any improper motive stated (basing on the decisions rendered in Liverpool Electric Cable Co. Ltd.'s Appln. (1929) 46 RPC 99, Yorkshire Copper Works Ltd's Appln. (1954) 71 RPC 150 H.L. and Electric Ltd.'s Appln. (1958) RPC 176 C.A, (1959) RPC 283 H.L. stated that these marks are incapable of becoming adapted to distinguish or of acquiring the capacity of distinguish, no matter how long they are used, and no trade should be allowed to acquire a monopoly in the use of such marks. Shri Veeraraghavan opposed this contention stating that as regards applicability of the provisions of Section 9(1)(a), (b) and (c) he submitted that as long the word XTRA is not descriptive of goods for which application is made, Section 9(1)(c) will not be applicable. Therefore, the passages from Dr. Section Venkateswaran's book are not applicable to the present facts of the case, the case laws cited are also not applicable to the facts of the present case. The trade mark XTRA is a coined word and it cannot be equated to the ordinary dictionary word Extra. This Board has confirmed the registration of the trade mark THREE IN ONE for incense sticks, Besides, there are several trade marks have been registered such as NURRISH,

KWALIT and RUSH, MOODS, WAVE.

6. Shri Rao also submitted that in view of the provisions of Section 159(3) of the new Act, the 2nd respondent should have decided the notice of

opposition under the provisions of Sections 9(1), 11(3), 12 and 18(1) of the new Act but Shri Veeraraghavan opposed the submission stating that the

contention raised is only to confuse the issue on hand and a mere perusal of impugned order will clearly show that the matter has been dealt with

under the new Act only.

7. Shri Rao submitted that the 2nd respondent has not discussed the evidence filed by the appellant and merely referred to the contentions of the 1st

respondent while dealing with the user claimed by him and ignored his inconsistent claims as to the period of user before various Courts/tribunals

which has been elaborately dealt with in rectification proceedings filed before the Copyright Board which forms part of the affidavit of the appellant

filed by way of evidence in reply under Rule 52 of the Trade Marks Rules, 2003.

8. We have carefully considered the above contentions of the learned Counsels. We have also called for the original records from the Registrar of

Trade Marks and perused the same.

9. As regards non-intimation of hearing of the Interlocutory Petition and non-speaking order passed therein is concerned, we have perused the original

records and found that the intimation for hearing of the opposition was given on 15th February, 2005 making it clear that no further adjournment will be

granted henceforth under any circumstances. When the notice for hearing made it clear a month before the hearing the counsel should have appeared

without taking it granted that adjournment will be granted. The counsel for the appellant is too technical which, in our view, deserves no consideration

for the simple reason that justice cannot be denied on too much technicalities. The I.P. was examined as it is notice that many portions of the petition

are sidelined and remarks written against them. There does not appear to be required to give elaborate reasons than what the 2nd respondent has

given because the crux of the elaborate reasons also would have been the same as the 2nd respondent has recorded that is to say there is no stay

against the proceedings before the 2nd respondent and the petition is no way connected with the opposition proceedings, and hence rejected. The

submissions made by Shri Veeraraghavan in this regard also corroborate with the

original records.

10. As regards non-registrability of the mark is concerned, a similar trade mark applied for registration for similar goods by the appellant was accepted

for registration with restriction of use in the place of Karimnagar. The counsel who is raising this contention has been the counsel for the registration

of here before referred to trade mark. He is supposed to assist the Court not to confuse the Court by blowing cold for his client and blowing hot for

others. The submission of the counsel for 1st respondent that 'XTRA' is a coined word which cannot be equated to an ordinary dictionary word extra

has some force. To this submission the counsel on the other side has not disputed. Once a similar trade mark for similar goods and class has earlier

been accepted for registration with area restriction it will be unjust to reject for the other on the ground of unregistrability unless the mark, subject to

Section 12 of the new Act is similar to that earlier mark and there exist a likelihood of confusion on the part of the public. The matter on hand does not

fall in this category. Further, if submission of the counsel for the appellant is accepted, there will be enormous difficulty in coining a word mark for

Pharmaceuticals without any phonetic similarity with an unregistrable word.

11. The reading of order of the 2nd respondent shows that he was decided the matter under the provisions of the new Act. The 2nd respondent has

dealt with Section 9 and has recorded that there is no pleading on the records filed by the opponents stating any reason as to why the trade mark is not

distinctive one. The counsel for the appellant also admits this when he states that when a mark is liable to be refused registration under section 9 the

further question whether it should be refused registration under Section 11(3)(a) and (b) becomes nugatory but however since the 2nd respondent has

dealt with these questions by relying on the registration of the label under the Copyright Act but there is neither any discussion nor any finding on this

ground. We are of the view no finding was required by the 2nd respondent at that point to time because the 1st respondent was the owner of

copyright and it was not required to be discussed as to how it was obtained. Besides, the appellant has filed rectification proceeding before the

Copyright Board and as such it would not have been proper to discuss that issue by the 2nd respondent forming part of his order.

12. Now coming to the contention of that the impugned order shows that there is

no discussion of the evidence filed by the appellant, we are of the view that the 2nd respondent has discussed all the evidence filed by the appellant except that part of evidence which is connected with the proceeding before the Copyright Board for rectification of entries made in the register under Section 53 of the Copyright Act, 1957. The 2nd respondent has discussed about the cash and credit bills submitted in evidence to prove user from 1985. The bills do not contain any printed serial number (only hand written) and no indication of sales tax registration. The counsel for the appellant submitted that sales tax registration was not required as the appellant is a petty businessman doing business as a cottage industry till he gave permission/licence to Vaishnavi Chemicals and his turn over at any point of time not crossed more than Rs. 50,000. The counsel for the 1st respondent has submitted copies of relevant provisions of the Sales Tax laws in Andhra Pradesh which provide that every dealer carrying on business in all or any goods mentioned in the First, Second.... Schedules shall get himself registered under that Act irrespective of quantum of his turnover. The detergent cakes, power, soap, etc. are covered under First Schedule and are taxable. To prove his user during the period (year 2001 onwards) for which no documentary evidence is submitted, the appellant states he has permitted/licensed Vaishnavi Chemicals of which he is one of the partners and that he was selling and marketing the soaps bearing the trade mark EXTRA, manufactured by the partnership firm (Vaishnavi Chemicals) to use the mark but no agreement for such permission/licence has been produced. It is not acceptable that such a permission/licence can be granted without any agreement in writing. Regarding non-production of evidence as to the use of the mark after 3.9.2001, Shri Rao submitted that as many as about ten criminal complaints were filed against the appellant or his power of attorney holder or dealers during the years 2002-2004 apart from suit O.S. No. 103/2001 on the file District Court Guntur and getting the Commissioner appointed in I.A. No. 1129 of 2001 in the suit, who seized all the wrappers from the appellant making him disabled to continue his business. This shows that there was a prima facie case of infringement of trade mark to issue such direction by the Court. To prove that the appellant got the artistic work 'Super Extra White' created in 1985, an affidavit affirmed by one Akbar has been filed. Shri Akbar is not the purchaser of then

non-judicial stamp paper often rupees but some K.M. Kumar for Rao & Rao. So, it is clear that the affidavit is a procured one for the purpose. The

veracity of such an affidavit itself is doubtful. In conclusion we do not find any merit in the appeal.

13. In view of the above reasons, we uphold the order of the Assistant Registrar of Trade Marks. Accordingly, the appeal is dismissed. As the main appeal itself has been disposed of, the MP becomes infructuous. No order as to costs.