
(2014) 11 IPAB CK 0002

In the Intellectual Property Appellate Board

Case No : ORA/169/2009/TM/MUM, M.P. No. 107/2011 And 338/2013 In
ORA/169/2009/TM/MUM

Jayaar Remedies

APPELLANT

Vs

Abbott Healthcare Pvt. Ltd

RESPONDENT

Date of Decision : 20-11-2014

Acts Referred:

Trade Marks Act, 1999 — Section 33, 57

Citation : (2014) 11 IPAB CK 0002

Hon'ble Judges : K.N. Basha, J; Sanjeev Kumar Chaswal, Technical Member

Bench : Division Bench

Advocate : Vijayaraghavan, P.S. Raman, Abraham Jacob

Final Decision : Allowed/Disposed Of

Judgement

K.N. Basha, J

1 . This application is filed by the applicant for removal of the registered trademark NERVUP under No. 1162808 in class 5 from the register or rectification of the register under section 57 of the Trade Marks Act, 1999.

2. Mr. Vijayaraghavan, learned counsel for the applicant and Mr. P.S. Raman, learned senior counsel appearing for the respondent along with Mr. Abraham Jacob, the learned counsel are present today.

3. Mr. Vijayaraghavan, learned counsel appearing for the applicant would submit that their main contention is based on the strength of prior user. Mr. P.S. Raman, learned senior counsel would fairly submit that they are not disputing the prior use, however, the respondent stands on a better footing on the basis of section 33 of the Trade Marks Act, 1999 on the ground of acquiescence.

4. It is contended by the learned senior counsel for the respondent that the applicant was given the legal notice but has not taken further steps to initiate the further proceedings for more than five years and as such the respondent entitled

to place reliance on the provisions of section 33.

5. Irrespective of the contention on merits Mr. Vijayaraghavan, learned counsel for the applicant and Mr. P.S. Raman, learned senior counsel for the respondent would submit that the matter is likely to be settled in view of the offer made by both the parties today.

6. The learned senior counsel for the respondent and learned counsel for the applicant would now happily submit that both the parties today reached mutual understanding of amicable settlement between them. The applicant is also present today before this Bench and endorsed the submission made by the learned counsel for the applicant as well as learned senior counsel for the respondent. Accordingly, the applicant as well as the respondent shall file a joint compromise memo on the agreed terms today itself and this Bench will pass orders on the basis of the terms of compromise. This application would be disposed of by passing orders.

7 . In view of the above said development, the applicant and respondent filed joint memo of settlement dated 20/11/2014 in the afternoon before this Bench. The said joint memo is signed by the applicant and by the respondent as well as their respective learned counsel. The joint memo reads here under:

JOINT MEMO OF SETTLEMENT

"The Parties herein jointly submit as follows:

1. The Applicant agrees and undertakes to assign perpetually, irrevocable, exclusively in favour of Abbott Healthcare Pvt. Ltd. (hereinafter referred to as "AHPL"), [the successors in title and incumbent brought on record in the present matter by an order of date], the mark NERVUP under Registration No. 1198231 in class 5 by a separate Deed of Assignment and further undertakes to execute it simultaneously on the receipt of the payment mentioned in paragraph 7 herein.

2. The applicant shall produce as evidence all documents viz. Original Registration Certificate, Drug licenses if any, product literature, sample products of the mark NERVUP of the Applicant from the period 01.01.1986 till date.

3 . The applicant agrees and undertakes to stop usage of its trade mark NERVUP and further undertakes not to use the trade mark or any deceptive variations thereof in any manner from the date of execution of these terms and/or deed of assignment. The products bearing the mark NERVUP lying with the Applicant on execution here hereof shall be handed over to the Advocates of AHPL on compliance of the term in paragraph 7 herein below.

4 . The Applicant shall not interfere with the registrations and/or use of the mark NERVUP or any of its extensions of the said AHPL and its successors or assigns from the date hereof. The applicant shall also not oppose or object to fresh applications or brand extensions of the trademark NERVUP or similar marks of AHPL its successors and assigns.

5 . The applicant shall cease to manufacture any preparation bearing the composition which is used in respect of its NERVUP or any preparation containing the composition of NERVUP of AHPL in perpetuity.

6 . The Applicant shall execute all and every document necessary to be filed before the Registrar of Trademarks so as to enable the said Registration No. 1198231 in respect of the mark NERVUP to effectively stand transferred in the name of AHPL.

7 . The said AHPL shall in consideration of the said assignment pay a sum of Rs. 35,00,000 (Thirty Five Lakhs only) by way of Demand Draft/Pay order in favour of R. Rajagopalan on the execution of the Deed of assignment and handing over of the papers and documents specified in paragraph 2 above and paragraph 8 below within 3 weeks hereof.

8. The applicant shall apply for cancellation of its valid Drug License if any, and shall hand over copies of such application and order thereon to the Advocates of AHPL.

9 . In view of the terms hereinabove the Application ORA/169/2009/TM/MUM be disposed off as withdrawn.

Dated at Chennai on this 20th day of November, 2014."

8 . By recording the above said settlement arrived at between the applicant and the respondent as per the joint memo, this application is hereby disposed of as withdrawn.

9 . In view of the above said happy development in this matter the Miscellaneous Petition No. 107/2011 filed by the respondent for bringing the subsequent assignees on record is also allowed. Miscellaneous Petition No. 338 of 2013 is closed.