

(2008) 06 BOM CK 0164
In the Bombay High Court
Case No : Writ Petition No. 272 of 2008

Mapra Laboratories Pvt. Ltd.

APPELLANT

Vs

Walter Bushness Pvt. Ltd. and Others

RESPONDENT

Date of Decision : 23-06-2008

Acts Referred:

Trade Marks Act, 1999 — Section 9(1)(a)

Citation : (2008) 38 PTC 409

Hon'ble Judges : S.B. Mhase, J;A.A. Kumbhakoni, J

Bench : Division Bench

Advocate : Milind Sathe instructed by S.V. Rajeshwar, for the Appellant; Amarjeet Singh, Manoj Mehta and Sanjay Jain, instructed by L.J. Law, for the Respondent No. 1, H.V. Mehta and R.C. Mehta for the Respondents Nos. 2 and 4, for the Respondent

Final Decision : Dismissed

Judgement

1. Heard both the learned Counsel.
2. The Petitioner has adopted the trademark "DROT" which is a medicinal preparation and the Respondent No. 1 has adopted the trademark "DROTIN" which is equally a medicinal preparation. The Respondent No. 1 filed an application for, registration of his trademark in 1997 and the registration was granted in 2003. In the meanwhile, while the registration application of the Respondent No. 1 was pending, in the year 2002, the Petitioner filed an application for registration of his trademark "DROT" and that application was granted in 2004.
3. After the Petitioner's application for registration of the trademark was granted in 2004, on 7th November, 2005, the Respondent No. 1 filed a complaint and/or appeal for cancellation of the Petitioner's trademark. After service of the notice on the Petitioner, the Petitioner filed his reply on 6th March, 2006 within a period of 60 days, over which there is no dispute. Thereafter, on 17th September, 2007, the Respondent No. 1 filed a rejoinder and/or counter to the reply of the

Petitioner alongwith evidence. Admittedly it was filed beyond the permissible statutory period of 60 days.

4. On 21st September, 2007, hearing took place at Bombay before the Appellate board and at that time, the matter was argued by the Respondent No. 1. Some arguments also seem to have been advanced on 21st September, 2007 in respect of the rejoinder filed by the Respondent No. 1. However, the minutes dated 21st September, 2007, show that the counsel for the Respondent therein (present Petitioner) consented for taking the Affidavit and the documents of evidence on record, subject to an application for condonation of delay being filed seeking condonation of delay that was caused in filing the Affidavit after following due process of law. It appears that on 27th September, 2007, the delay condonation application was filed and thereafter the matter was further heard on 12th October, 2007 at Chennai before the Appellate board. After having heard both the parties, the impugned order has been passed, allowing the appeal.

5. The learned Counsel for the Petitioner before us raised an objection to the effect that first the delay condonation application should have been decided and thereafter if delay is condoned, further opportunity should have been given to the Petitioner to adduce evidence in rebuttal. In his submission only thereafter the main petition and/or the appeal should have been heard and disposed of on merits by the Appellate Board.

6. We do not find any substance in this contention raised on behalf of the Petitioner in view of peculiar facts of this case. Para 5 of the impugned order passed by the Appellate Board, reads thus:

5. Learned Counsel for the applicant completed his argument but due to paucity of time the learned Counsel for the Respondent could not begin his argument and hence the part heard matter was, with the consent of both sides, decided to be listed for hearing at Chennai. Learned Counsel for the Respondent consented in principle if the reply to counter-statement; affidavit and documents is taken on record by the Appellate Board provided that the applicant files, after due process of law, petition seeking condonation of delay for late filing of reply, affidavit and documents. Accordingly, the applicant has filed a miscellaneous petition for condonation of delay. The miscellaneous petition and the part heard application came up for hearing on 12th October, 2007 when the learned Counsel for both sides appeared and argued the application and miscellaneous petition together. (emphasis supplied)

7. The last line of the said paragraph as reproduced above shows that even though the learned Counsel for the Petitioner was aware of the fact that after delay condonation application is allowed, it will be necessary for him to lead evidence in rebuttal, he proceeded to argue the main matter along with the application for delay condonation. Actually, that was the time when he should have insisted that delay condonation application be first decided and reserved his rights to argue the main matter thereafter which are now being claimed before

this Court. Having given concession before the Appellate board and having conducted the matter without reserving such rights, it will not be open for the Petitioner to state that the Appellate board has not offered an opportunity to him to contest the delay condonation application and lead evidence in rebuttal. An opportunity, which was very much available to him before the lower authority has been waived by the Petitioner by his own conduct.

8. There is one more aspect of the matter and that is revealed from paragraph No. 14 of the Appellate Board's Order, which reads thus:

14. Learned Counsel, in relation to the miscellaneous petition, has raised objection that the explanation given for delay by the applicant does not appear to be true as the copies of correspondences purported to be exchanged between the lawyer at Chennai and Lawmarks Naveen and Saturn, New Delhi appear to be fabricated as they do not seem to be copies of e-mail. By producing an e-mail copy before us he contended that there is a lot of characteristic difference between the copy of e-mail he has produced and copies of e-mail annexed to the petition. The second objection of the learned Counsel was that there are certain documents included in the evidence for which there is no mention in the rejoinder and that the affidavit is not verified by the authorised person. On clarification having been given by the learned Counsel for the applicant, the learned Counsel for the Respondent was satisfied and he did not press for the objection. (emphasis supplied)

9. Thus, concession has been given by the learned Counsel for the Petitioner that the clarification offered by the learned Counsel for the Respondent was satisfactory and he did not press for the objection viz. the ground stated in the miscellaneous application for condonation of delay does not appear to be true as the copies of the correspondences purported to be exchanged between the lawyer at Chennai and Lawmarks Naveen and Saturn, New Delhi appear to be fabricated as they do not seem to be copies of e-mail.

10. Apart from that, Sub-rule (2) of Rule 14, of The Intellectual Property Appellate Board (Procedure) Rules, 2003, which deal with extension of time, states that nothing in Sub-rule (1) shall be deemed to require the Appellate Board to hear the parties before disposing of an application for extension of time and no appeal shall lie from any order of the Appellate Board passed under this rule. Therefore, the Appellate Board can hear the application for condonation of delay and/or extension of time without hearing the other side. Therefore, taking the conduct of the Petitioner into account and considering Sub-rule (2) of Rule 14, we find that the matter has been rightly proceeded with by the Appellate Board in respect of extension of time and the grievance made by the Petitioner before this Court in that regard is without merit.

11. The second aspect that the learned Counsel for the Petitioner submitted is that the Board has recorded a finding that there is a violation of Section 9(1)(a) of the Trade Marks Act, 1999. The learned Counsel pointed out to us Section 9(1)

(a) and thereafter invited our attention to Section 32. This aspect has been considered by the Appellate Board and the Board has observed thus:

There is nothing in the pleadings about the expenses incurred, if any, by the Respondent towards popularising or propagating its trade mark by way of publicity or advertisements. The evidence of use is, to our view, not sufficient to prove that the impugned mark had acquired distinctiveness prior to application or even after registration up to the date of commencement of the present rectification proceedings. There is no mention in the affidavit as to the acquisition of distinctiveness during the period from registration up to the date of filing of the present application, except a bald statement at para 7(iv) to the effect that in view of continuous and extensive use of the mark since 24.5.2002, on or before the date of present application challenging the validity of registration, the mark has acquired factual distinctiveness. There is no material in the affidavit to show that the impugned mark has acquired distinctiveness after registration up to the date of filing of rectification application. In view of these, it is undisputedly admitted that the mark is descriptive of the product not qualifying to be registered u/s 9 and the protection u/s 32 of the Act as claimed by the Respondent cannot be given. However, we do not agree with the averment of the applicant that the provisions of Section 32 of the Act have no applicability to the facts and circumstances of the case. We are of the view that by virtue of provisions of Section 159(3) of the Act, for the simple reason that the mark DROT has been registered and the application made under the Act, the provisions of Section 32 is applicable, though as we have said earlier that the protection of registration is not available due to non-acquisition of distinctiveness of the mark.

12. These are all findings of facts. The defence available by way of Section 32 has been availed by the Petitioner. However, the Petitioner failed to prove the said. defence for want of evidence as observed by the Appellate Board. One more aspect requires to be recorded at this stage that the learned Counsel for the Petitioner could not point out any perversity in these finding of facts recorded by the Appellate Board. We do not desire to disturb the said finding.

13. The last ground which was raised by the learned Counsel for the Petitioner is in respect of the phonetic similarity and dissimilarity of the trademarks DROT and DROTIN. However, this aspect of the matter has also been considered by the Appellate Board in paragraph 22 of its order and the Appellate Board has rightly concluded that phonetically both the trademarks are identical and, therefore, there is a violation of the provisions of Section 11(2)(a) of the Act.

14. Except the above stated three grounds, no other ground has been raised by the counsel for the Petitioner for our consideration. We find that there is no substance in any of these three grounds.

15. The Writ Petition is rejected summarily.