
(2013) 04 IPAB CK 0001

In the Intellectual Property Appellate Board

Case No : OA/16/2012/TM/AMD, M.P. Nos. 187, 188 of 2012 In OA/16/2012/TM/AMD, OA/17/2012/TM/AMD, M.P. Nos. 189 & 190 of 2012

M/s. Neon Laboratories Ltd.

APPELLANT

Vs

Assistant Registrar of Trade Marks And M/s. Medical Technologies Ltd.

RESPONDENT

Date of Decision : 30-04-2013

Acts Referred:

Arbitration And Conciliation Act, 1996 — Section 21(1)

Citation : (2013) 56 PTC 202 (IPAB)

Hon'ble Judges : S. Usha, J;V. Ravi, Technical Member

Bench : Division Bench

Advocate : Amit Jamsandegar, Sunil N. Nair, S. Namita, Akhil Sibil, Y.J. Trivedi, Sushant Singh

Final Decision : Dismissed

Judgement

S. Usha, J

1. Both the appeals are preferred against the order dated 14.03.2012 passed by the Assistant Registrar of Trade Marks, rejecting the notice of

opposition as time barred and allowing the application No. 803692 in class 5 to proceed to registration. The 2nd respondent herein filed an application

for registration of the trade mark ""PROFOL"" under No. 803692 in Class 5 in respect of pharmaceutical and medical preparations on 26/05/1998

claiming user since 01/04/1986. The said application was advertised in Trade Marks Journal No. 1341 dated 01/04/2006 and the same was made

available to the public on 07/07/2006. The appellant filed the notice of opposition on 31/10/2006. On 09/07/2007, the Assistant Registrar/the 1st

respondent herein issued a letter as to show cause why the notice of opposition should not be refused as it was time barred. On 23/07/2007, the

appellant had stated that the notice of opposition had been filed within 4 months time. Along with the reply they had also filed a request of extension on

Form TM-44. The request on Form TM-44 alongwith the demand draft were returned to the appellant by the 1st respondent.

2. On 20/08/2007, the appellant had written a letter to the 1st respondent stating that the Trade Marks Journal was received by the appellant only after one month from the date on which it was made available to the public. The 1st respondent i.e. the Assistant Registrar heard the appellants and passed

the impugned order refusing to take on record the notice of opposition as it was time barred. The appellants therefore filed this instant appeal.

3. The 2nd respondent filed their counter statement denying all the averments made in the appeal grounds. The respondents stated that the appeal

deserves to be dismissed for wrong statement. The request on Form TM-44 was filed after the 1st respondent had issued a letter. In fact the

impugned order was passed after hearing the appellants. The 2nd respondent submitted that as per the law, when the statute provides for a time, it

cannot be extended. The Act provides for three months and the aggregate an extension of one month thereafter. The appeal is therefore not

maintainable as no valid reason given for the delay and deserves to be dismissed.

4. We heard Shri. Amit Jamsandegar, Learned Counsel for the appellant and Shri. Akhil Sibil, Learned Counsel for the respondent during the Circuit

Bench Sitting held at Ahmedabad on 7th January, 2013.

5. The learned counsel for the appellant reiterated the facts on which the appeal was filed. The counsel relied on few judgments.

1) 2006 (33) PTC 321 (BOM.) (DB)-Sardar Gurudas Singh Bedi Vs. Union of Indian & Ors.-TM-44 for extension can be filed even on expiry of the

period of three months.

2) INTELLECTUAL PROPERTY APPELLATE BOARD ORDER NO. 171/2008 DATED 12.12.2008 (OA/9-12/2008/TM/AMD) - Glenmark

Pharmaceuticals Ltd. Vs. The Assistant Registrar of Trade Marks, Ahmedabad-The Registrar order was stayed in a matter where the notice of

opposition was refused to be taken on record as time barred.

6. The learned counsel for the 2nd respondent in reply submitted that the appellants are not clear as to whether TM-44 is required or not. The counsel

submitted that there is no valid reason for the delay and the application for

extension of time has been filed after a long delay and not within the period as per the judgment of the Bombay High Court relied on by the appellant 2006 (33) 321 (BOM.) (DB).

2000 PTC 24 (FB) - Hastimal Jain trading as Oswal Industries & Ors. Vs. Registrar of Trade Marks-If specific time was provided the Registrar had no power to extend.

2010 (4) PTC 57 (Mad.) (DB) - Allied Blenders and Distillers Pvt. Ltd. Vs. Intellectual Property Appellate Board & Ors. - The notice of opposition

has to be filed in the prescribed manner within the prescribed time and on payment of necessary fees within the time provided.

2001 (8) SCC 4010 - Union of India Vs. M/s. Popular Construction Co. - While considering the limitation under the provisions of the Arbitration and

Conciliation Act, 1996, the Apex Court held that the express exclusion can also be inferred from the scheme and objectives of the Act.

7. We have heard and considered the arguments of both and have carefully gone through the pleadings and documents.

8. Section 21(1) of the Act provides for filing of the notice of opposition within three months from the date of advertisement or re-advertisement of an

application for registration or within such further period not exceeding one month in the aggregate on an application made to him in the prescribed

manner and on payment of prescribed fees.

9. In the case on hand, the appellants have filed their notice of opposition on 13/10/2006 but had not filed any request from extension of time. The

Trade Marks Journal was dated 01/04/2006 and was made available on 07/7/2006. The appellants had time till 07/10/2006 to file their notice of

opposition. The appellants had filed their counter statement on 13/10/2006 which was not accompanied by the request on Form TM-44. On

09/07/2007, the Registrar had issued a letter stating that the notice of opposition is time barred and also issued a show cause notice. On 23/07/2007,

the request on Form TM-44 was filed. On 03/08/2007, the Assistant Registrar returned the request on Form TM-44 along with the fees, back to the

appellant. On 20/08/2007, the appellant wrote a letter giving the reasons for the delay. (1) The Trade Mark Journal was received after around one

month from the date made available to the public and (2) the signing authority was not in town to file the TM-44.

10. The appellants have filed their TM-44 only after a show cause notice was issued i.e. after nearly 9 months. The appellants heavily relied on the judgment of the Bombay High Court (Supra). In that judgment the due date for filing the notice of opposition i.e. three months time was on 01/01/2006 and the Form TM-44 was filed on 04/01/2006 before the expiry of that aggregate one month period. In this case, the request is not filed within 4 months period. In fact in the Bombay case, the notice of opposition was not filed but the request was filed and therefore the Division Bench directed that the appellants file their notice of opposition within 15 days.

11. The other judgment of this Board relied on by the appellant is not applicable as it is an order passed in the Miscellaneous Petition which is only a interim relief and we are not aware as to the final outcome of the order.

12. As has been held by the Supreme Court and various High Courts, where it is clearly stated in the Act, it has to be followed. Where the time has been specifically given, it has to be done accordingly and the Registrar has not been given the power to extend it. That apart the reasons given for the delay seems to be an after thought as these reasons were not given in the earlier letter.

13. In the appeal grounds and in the counter statement both the parties have dealt in detail the merits of the case as to the registration of the trade mark. We think it not necessary to go into that issue of registration as the notice of opposition cannot be taken on records as time barred.

14. We are also of the view that the appellants are not remediless. Their remedy lies elsewhere too. We observe that there are two oppositions for the same mark by the same party but the reasons for filing two oppositions is not clear to us. For the above mentioned reasons both the appeals are dismissed with no order as to costs.