

(2015) 03 IPAB CK 0008

In the Intellectual Property Appellate Board

Case No : M.P. No. 199/2009 In ORA/150/2007/TM/CH

Prime Plast

APPELLANT

Vs

Prime Tele Extrusions Ltd.

RESPONDENT

Date of Decision : 06-03-2015

Acts Referred:

Citation : (2015) 03 IPAB CK 0008

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

Bench : Division Bench

Advocate : K.K. Sharma, S. Balachandran

Final Decision : Allowed

Judgement

K.N. Basha, J

1 . This Miscellaneous Petition No. 199 of 2009 filed in ORA/150/2007/TM/CH, is preferred by the applicant seeking for the relief of taking additional documents on record in support of application for rectification.

2. The applicant has stated in his application that the matter was listed for hearing on 23/07/2009. It is further submitted that the applicant had filed application for registration of the trade mark "PRIME" under application No. 722255 in class 17 and in view of the objection raised by the Registrar of Trade Marks, the applicant had withdrawn the said application and filed another application under No. 1248901 in class 17 on 11/11/2003. The said application was opposed by the present respondent but the same was dismissed by the Registrar on 18/02/2009 and the said order was not challenged by the respondent by filing any appeal. Therefore, it is submitted by the applicant that the said order has become conclusive and binding upon the parties. As the said order was passed subsequent to the registration of the impugned trade mark the petitioner has not enclosed the above said order along with the original application filed for rectification.

3 . It is also stated in the petition that the infringement suit was filed by the applicant/petitioner herein and in the said suit in C.S. No. 948 of 2003 and O.A. Nos. 988 and 989 of 2003, the Hon'ble High Court of Madras granted temporary injunction against the respondent herein restraining the use of the impugned trade mark "PRIME" pending disposal of the suit as per the order dated 28/03/2006. Therefore, it is stated that those attachments are relied by the applicant herein and they are not produced earlier and they may be taken on record.

4 . The respondent filed counter to the present Miscellaneous Petition denying the averments of the petitioner. It is stated that the petitioner has suppressed the fact of pendency of the opposition proceedings at the time of filing the original application and such being the position they cannot produce the order of the said proceedings passed by the Registrar of Trade Marks as an additional document in this proceeding. It is further stated that even in respect of the Hon'ble High Court of Madras order, the same was passed on 28/03/2006 and the appeal order in OSA No. 37 of 2007 was passed in February, 2007 prior to the filing of ORA and as such the petitioner cannot produce the same at this stage.

5 . Mr. K.K. Sharma, the learned counsel for the petitioner would contend that the applicant in the present ORA is placing reliance on the above said two documents and they are only the orders of the Registrar of Trade Marks and the Hon'ble High Court of Madras and as such the same cannot be prevented on the ground of delay in producing the same. It is submitted that the delay in producing the said orders is neither willful nor wanton but only due to inadvertence.

6. Per contra Mr. S. Balachandran, learned counsel for the respondent would contend that the additional documents cannot be allowed to be taken on record as the petitioner has not assigned any reason for not producing the same earlier. It is pointed out that both the orders were very much available even at the time of filing the ORA.

7 . We have carefully considered the contentions put forward by either side and also perused the petition and the counter.

8. At the outset it is to be stated that the documents which are sought to be taken on record now as additional documents are only the orders of the Registrar of Trade Marks and the Hon'ble High Court of Madras and as such the petitioner is entitled to place reliance on such orders even without filing any Miscellaneous Petition for seeking the relief of permission to file as additional documents.

9. It is pertinent to note that the passing of the above said order by the Registrar by rejecting the opposition of the present respondent herein on the application filed by the petitioner for the registration of the trade mark "PRIME" as well as the order of the Hon'ble High Court of Madras passing the order of temporary injunction on 28/03/2006 are not disputed by the respondent herein and as such

there is no question of preventing the petitioner from producing the said documents. We are of the considered view that merely because the said documents have not been produced earlier we cannot prevent the petitioner for placing reliance on the said orders admittedly passed by the Registrar of Trade Marks and the Hon'ble High Court of Madras.

10 . In view of the above said reasons the Miscellaneous Petition No. 199/2009 in ORA/150/2007/TM/CH is allowed and the documents relied by the petitioner viz. the order of the Registrar passed in the application No. 1248901 in class 17 on 08/02/2009 dismissing the opposition filed by the respondent herein and the order of temporary injunction granted by the Hon'ble High Court of Madras dated 28/03/2006 in C.S. No. 948/2003 and OA No. 988 and 989 of 2003 are taken on record.