

(2010) 03 IPAB CK 0005

In the Intellectual Property Appellate Board

Case No : M.P. No. 83/09 In OA/24/09/TM/DEL And OA/24/09/TM/DEL

Sachdeva And Sons Indis. Pvt. Ltd.

APPELLANT

Vs

Taco Bell Corporation C/O K And S Partners And The Registrar
Of Trade Marks

RESPONDENT

Date of Decision : 31-03-2010

Acts Referred:

Trade Marks Act, 1999 — Section 2(1)(zg), 9,11, 12
Trade Marks Rules, 2002 — Rule 50, 50(1), 50(2)

Citation : (2010) 03 IPAB CK 0005

Hon'ble Judges : S. Usha, J; Syed Obaidur Rahaman, Technical Member

Bench : Division Bench

Final Decision : Dismissed

Judgement

S. Usha, J

1. Appeal arising out of the order dated 20th January, 2009 passed by the Assistant Registrar of Trade Marks dismissing the opposition No. 158431

and allowing the application No. 918094 in class 29 to proceed to registration as per the provisions of the Trade Marks Act, 1999. (hereinafter

referred to as the Act). The Appellant has also filed a miscellaneous petition for stay of operation of the impugned order dated 20.01.2009

2. The Appellant herein is engaged in the business of processing, marketing and / or exporting of various kinds of 'Rice and / or such other cognate /

allied goods' since long. The Appellants are exporting the aforesaid goods to various major countries of the world. In the year 1980, the Appellant

honestly conceived and adopted the trade mark ""BELLS"" (word and / or device of Bells). By long and continuous use, the trade mark has been

associated in the minds of the public to the extent that the products are deemed

to belong to the Appellant and none else. The mark has earned considerable goodwill and reputation. The Appellant is the prior adopter, user and lawful proprietor of the trade mark. The mark ""BELLS"" has already been registered under No.676962 in class 30. the appellant's trade mark has become a well known trade mark within the meaning of section 2(1) (zg) of the Act.

3. The first Respondent filed an application for registration of the trade mark ""TACO BELL"" along with device of bell a label mark in respect of

Mexican foodstuffs including, but not limited to rice, beans, salsa, taco shells, tortillas and nacho chips included in class 29 under No. 918094 dated

13.4.2000 as proposed to be used mark. The said application was advertised in the trade marks journal mega 2 dated 25.09.2003 at page 4336. The

application for registration was opposed by the Appellant and had filed a notice of opposition. The first Respondent filed their counter-statement. The

Appellant received the counter-statement and were directed to file their evidence within two months by letter dated 15.4.2005. The Appellant as was

not able to trace the relevant documents within the stipulated period had by letter dated 13.5.2005 informed the Registrar that they relied on the

registration of the trade mark ""BELS"" under No. 676962 and also the notice of opposition. The matter was finally fixed for hearing. The counsel filed

Form TM-7 informing their intention to appear for the hearing. The matter was heard and the impugned order dated 20.01.2009 was passed by the

Assistant Registrar dismissing the opposition under Rule 50(2) of the Trade Marks Rules, 2002 for non-compliance of the same. Aggrieved by the said

order the Appellants filed the appeal on the following grounds:

- a) The impugned order is contrary to law and facts of the case.
- b) The second Respondent erroneously dismissed the opposition
- c) The second Respondent erred in not considering the letter dated 15.04.2005.
- d) The second Respondent erred in not granting the relief prayed for during the hearing.
- e) The second Respondent erred in dismissing the opposition as abandoned without giving any valid reason.
- f) The second Respondent erred in treating the impugned identical trade mark as accepted subject to association with the registered trade mark No.

477181 while no such condition was notified in the related Mega Trade marks Journal when the impugned mark was advertised.

g) The impugned application has been wrongly accepted to proceed to registration.

h) The second Respondent erred in not considering the letters dated 7.4.2006 and 19.10.2006.

i) The second Respondent ought to have appreciated the fact that the impugned trade mark is devoid of any distinctive character.

j) The second Respondent erred in not considering that the impugned trade mark is identical with the Appellant's registered trade mark.

k) The second Respondent failed to appreciate the dishonest adoption of the first Respondent and as such the registration is barred by the provisions

of Sections 9,11 and 12 of the Act.

l) The second Respondent ought to have appreciated that the first Respondent is not the proprietor of the impugned trade mark.

m) That in the interest of justice the appeal be allowed.

4. The first Respondent herein filed their counter statement denying the various allegations made in the grounds of appeal. The first Respondent

carries on a worldwide restaurant chain manufacturing and marketing inter-alia, prepared Mexican food dishes under the trade name and trade mark

'TACO BELL & BELL DEVICE' since the year 1962. The trade mark has been registered under various classes. The first Respondent filed an

application for registration of the trade mark 'TACO BELL' along with the device of a bell on 13.04.2000 under No. 918094 in class 29. The Appellant

filed notice of opposition to which the first Respondent filed the counter-statement. As the Appellant had not further complied with the requirements of

the provisions of Rule 50 of the Trade Marks Rules, 2002 (hereinafter referred to as the Rules) the hearing was fixed. The Registrar has therefore

passed the impugned order. Though the Appellant during the course of hearing had stated that he had sent a letter stating that he relied on a

registration certificate and on the facts of the notice of opposition, the same was not received by the first Respondent which is a requirement under

the rules. The letter sent to the Trade Marks Registry also is denied as there is no proof of the same. The first Respondent further denied the other

averments made there in.

5. The Appellant filed a rejoinder to the counter-statement. On completion of the procedures, the matter was set down for hearing on 02.02.2010 in

the Circuit Bench sitting at Delhi where learned counsel Shri Kamal Kishore Arora along with Shri Gaurav Arora appeared for the Appellant and

learned Counsel Shri Kenneth Benjamin and Ms. Navpreet Panjra appeared for first Respondent.

6. Learned Counsel for the Appellant reiterated the facts of the case. The counsel submitted that he relied on the registration certificate under

application No. .676962 in class 29. The letter sent to the Registry relying on the certificate of registration and the notice of opposition were not

considered by the second Respondent even though it was received by their office. The counsel also relied on judgments in support of his claim.

7. Learned Counsel for the first Respondent in reply submitted that the requirements under Rule 50 were not complied with. The rule prescribes that

evidence in support of the opposition to be filed or to inform the Registrar and the applicant that he relies on the notice of opposition. In the instant

case, it is not clear as to what was sent on 13.5.2005. Even assuming that the concerned letter was sent, no copy was sent to the first Respondent.

The goods are different and so no possibility of confusion. The first Respondent is the registered proprietor of the trade mark. The appeal therefore

deserves to be dismissed.

8. We have heard both the counsel and have also perused the documents placed before us. Here it is worthwhile to quote the provisions of Rule 50(1)

of the Rules.

50. Evidence in support of opposition. (1) Within two months from services on him of a copy of the counter statement or within such further period

not exceeding one month in the aggregate thereafter as the Registrar may on request allow, the opponent shall either leave with the Registrar, such

evidence by way of affidavit as he may desire to adduce in support of his opposition or shall intimate to the Registrar and to the applicant in writing

that he does not desire to adduce evidence in support of his opposition but intends to rely on the facts stated in the notice of opposition. He shall deliver

to the applicant copies of any evidence that he leaves with the Registrar under this sub-rule and intimate the Registrar in writing of such delivery.

9. On a plain reading of the provisions of Sub-rule (1) of Rule 50 of the Rules, it

is clear that the opponent shall file his affidavit of evidence in support of his opposition or inform the Registrar that he intends to rely on the facts stated in the notice of opposition. The opponent shall deliver the same to the applicant and inform the Registrar of such delivery.

10. In the instant case, there is no clear proof of delivering of the letter dated 13.5.2005 to the Trade Marks Registry. The receipt produced does not bear any clear date nor does it bear the date when the Trade Marks Registry received it. We have also perused the original receipt. As submitted by the counsel for the first Respondent, the Appellants have not served the letter dated 13.5.2005 - evidence in support of the opposition to the applicant i.e. the first Respondent. The Appellants have not denied the same during the course of arguments. Even if we take it that the evidence relying on the facts of the notice of opposition has been sent to the Registrar but not to the applicant, the opposition stands automatically abandoned for non-compliance of the provisions of Rule 50 of the Rules.

11. The judgments relied on by the Appellants have no relevance to the case on hand. The judgments relate to matters under the Evidence Act as also with regard to the power of the Registrar to extend time for filing of evidence.

12. We are of the view that the Registrar has the power to extend time and that can be, only if the opponent has sought for an extension. Here no affidavit of evidence has been filed nor is such extension sought. The Appellants have not complied with necessary requirements of sub rule (1) of Rule 50 of the Rules. The opposition is automatically abandoned. We, therefore, find no infirmity in the order of the Assistant Registrar. The appeal is dismissed upholding the order of the Assistant Registrar dated 20.01.2009. There shall be no order as to costs. As the main appeal has been dismissed

M.P. No. 83/09 does not survive.