

(2009) 08 IPAB CK 0005

In the Intellectual Property Appellate Board

S.K. Janimiya Trading As Crescent Pharmaceuticals APPELLANT

Vs

Narendrer Pal Trading As Psycho Remedies And The Assistant REGISTRAR OF TRADE MARKS RESPONDENT

Date of Decision : 21-08-2009

Acts Referred:

Trade Marks Act, 1999 — Section 9, 11, 12, 18, 18(4), 34

Citation : (2010) 43 PTC 673 (IPAB)

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

Bench : Division Bench

Final Decision : Dismissed

Judgement

S. Usha, J

1. The instant appeal arises out of the order dated 13.12.2007 passed by the Deputy Registrar of Trade Marks allowing the opposition No. MAS-

163030 and refusing registration of the trade mark under application No. 1013028 in class 5 under the provisions of the Trade Marks Act, 1999

(hereinafter referred to as the Act).

2 . The appellant herein filed an application on 31.05.2001 for registration of the trade mark ""OLAPIN"" (word per se) in class 5 in respect of

pharmaceutical, veterinary and sanitary substances, infants and invalids foods, plasters, materials for bandaging, materials for stopping teeth, dental

wax, disinfectants, preparation for killing weeds and destroying vermin all being goods included in class 5, claiming user as proposed to be used.

3. The trade mark was ordered to be advertised before acceptance in the Trade Marks Journal No. Mega 3 dated 14.10.2003 at page No. 623. The

respondent No. 1 herein filed their notice of opposition on the grounds that they are engaged in manufacturing, marketing, promoting and selling

various pharmaceutical products. They have coined the trade mark OLAPIN in the year 2000 and have filed an application for registration under No.

1078878 in class 5 on 06.02.2002 claiming user since December, 2000. The appellant's trade mark is only a proposed to be used mark and refusal to

register the trade mark would not prejudice their rights. The impugned trade mark is phonetically, visually and structurally identical to the mark of

respondent No. 1. The registration of the trade mark would be in contravention of the provisions of Sections 9, 11, and 12 of the Act.

4 . The appellant herein filed their counter statement denying all the material averments made in the notice of opposition. They further stated that the

trade mark OLAPIN was invented and honestly adopted. They further stated that they had not copied the respondent's mark and also stated that the

registration of the trade mark would not be in contravention of the provisions of the Act.

5 . On completion of the formal procedures, the matter was heard and decided. The Registrar had also allowed the interlocutory petition filed by the

applicant for amending the date of user and the change of company's name and address while deciding the main opposition without giving an

opportunity to the opponent to put forth their contentions. Aggrieved by the said order, the opponent herein filed an appeal under No.

0A/41/2006/TM/CH. The said appeal was heard and remanded back to the Trade Marks Registry to hear and decide the matter in accordance with

the law.

6. The opposition was again heard and the impugned order was passed stating that in view of the citation given by the opponent the TM- 16 for

amendment is cancelled where no reason has been given. Rival marks and goods are same/similar and also they are phonetically, visually and

structurally same/similar. In such case the determining factor would be the period of use as to who is the prior user - the opponent is the prior user and

the objection under Section 11 is allowed. Under Section 18, the objection is allowed as the opponents are the proprietors of the trade mark.

7 . Aggrieved by the said order dated 13.12.2007, the applicant/appellant have filed this instant appeal to set aside the order and to allow the

application to proceed to registration.

8 . The appellant trading as M/s Crescent Pharmaceuticals, a proprietary concern

entered into a manufacturing agreement with M/s Cassel Research

Laboratories Pvt. Ltd. The appellant offered to them to manufacture the said OLAPIN tablets. The appellant filed the appeal on the following

grounds:

(a) that the order is not sustainable on a proper appreciation of the facts admitted and established in the light of the settled principle of law;

(b) that the Deputy Registrar failed to consider in correct perspective the facts;

(c) that the Deputy Registrar has not applied the mind to the various points raised and argued;

(d) that the Deputy Registrar has only considered the judgement cited by the respondent whereas the judgements cited by the appellant have not been

referred nor have been considered;

(e) that the order of the Deputy Registrar is totally confusing and only shows the non-application of mind of the Deputy Registrar, where the Registrar

has made statements which is in no way connected with the case on hand. The Registrar has passed an order which has contrary statements and

bears no meaning;

(f) that the order has been passed without any clear finding which again shows the utter confusion in the mind of the Deputy Registrar;

(g) that the order passed by the Deputy Registrar cancelling the TM-16 is illegal as no such powers are conferred on the Registrar to cancel the TM-

16;

(h) that the impugned order passed by the Deputy Registrar is without any reasons;

(i) that the finding that the respondents are prior users of the trade mark under Section 34 of the Act is a vague expression without basis;

(j) that the Deputy Registrar has misunderstood the powers conferred under the provisions of Section 18(4) of the Act;

(k) that the reasons assigned by the Registrar is not sustainable in law.

9 . The respondent No. 1 filed their counter-statement denying the various material allegations made in the appeal. The respondent No. 1 is engaged in

manufacturing, marketing, promoting, distributing and selling various pharmaceutical products since 1995. They coined the trade mark ""OLAPIN"" in

the year 2000 and obtained drug license. They further stated that there were

various defence raised in the counter-statement which was not considered by the respondent No. 2 and the same has been considered after the matter in OA/41/2006/TM/CH was remanded back by this Appellate Board to the Trade Marks Registry.

10. The respondent No. 1 also stated that the appellant had not stated the date of user in the counter-statement filed before the Trade Marks Registry in the opposition proceedings. The Form TM-6 i.e., the counter-statement ought to have been treated as abandoned as the same has been filed by a third party which is not the applicant. With regard to the ground that the Registrar had passed the impugned order with non-application of mind, the respondent No. 1 replied that it was a mere biased personal opinion of the appellant without any justification and the same ought to be ignored by this Appellate Board.

11. We have heard the arguments of the learned Counsel for both parties on 22.07.2009 Shri Hanu Babu Koka, learned Counsel appeared for the appellant and Ms. P.V. Rajeswari, learned Counsel on behalf of the respondent No. 1.

12. The learned Counsel for the appellant submitted that the appellants herein are the applicant for registration of the trade mark "OLAPIN". They drew our attention to the impugned order at page 89 of the appeal and submitted that the order passed by the learned Deputy Registrar was totally contradictory to the earlier order. The learned Counsel further submitted that the notice of opposition was filed after the stipulated time which was not taken note of by the respondent No. 2.

13. The learned Counsel for the appellant cited two judgements in support of his contentions (i) 2006 (33) PTC-729 (IPAB) Abdul Mujeeb Abdu Wajid Pvt. Ltd., v. Ahmed Mohamed Saleh Baseshen & Co., Anr., wherein it was held that the Registrar may permit even new ground by way of amendment and submitted that the Registrar should have allowed the amendment; (ii) 2007 (34) PTC 346 (IPAB) Titan Industries Limited v. Registrar of Trade Marks and Anr., wherein it was held that the Registrar may permit amendment which does not substantially alter the mark and submitted that here there is no substantial alteration or amendment in the mark.

14. The learned Counsel for the respondent No. 1 submitted that the earlier order cannot now be gone into nor considered as the same has been set

aside by the Appellate Board. The respondent No. 2 has decided the application for amendments after going into the matter and has observed that in view of the judgement of this Board dismissed the amendment application. It is not correct to say that the Registrar jumped into a finding without any reasons. The application on Form TM-16 for amendment has been decided on merits. The notice of opposition has been filed well within the stipulated time.

15. The counsel further submitted that the application for amendment was filed only after the affidavit of evidence was filed and it only goes to show the appellants filing of an application for amendment was an after thought. The amendment was for material alteration in the application as to the date of user. The respondent No. 1 did not produce any document in proof of the change in the name of the company.

16. The counsel cited the judgement reported in 2007 (34) PTC 346 (IPAB) Titan Industries Limited v. Registrar of Trade marks and Anr., and submitted that material alterations made which affect the other party should not be allowed. The counsel submitted that the order passed by the Deputy Registrar was, therefore, maintainable.

17. The counsel brought to our notice the invoice filed by the appellant as Annexure II at page 40 of the appeal and submitted that the invoice pertains to a different company and was in no way connected with the appellants firm. The counsel, therefore, prayed that the appeal be dismissed.

18. The counsel for the appellant in rejoinder submitted that the respondent No 1 had not proved their user prior to that of the appellant. The Deputy Registrar had not considered the orders passed by this Appellate Board to decide the application for amendment. The respondent No. 2 had allowed the application based on the judgement of this Appellate Board and had not given any reasons as to how the same is applicable in the instant case. The respondent No. 2 had also not considered the provisions of Sections 9 and 11 of the Act. The impugned order, therefore, be set aside and the appeal allowed and the application to proceed for registration.

19. We have considered the arguments of both the counsel and have gone through the impugned order and the pleadings.

20 . Before we go into the merits of the case, we wish to comment on the non-application of mind and utter confused state of mind of the Deputy

Registrar while passing the impugned order. We shall quote the relevant portion from page 3 of the impugned order to say that the reason for such a comment of ours "... and both the parties has filed TM-7 to notify their intention to attend the hearing. Both parties have attended the hearing on the said date. In the mean time, the Hon'ble IPAB has stayed the registration of application No. 1013078 in class-5. since the Applicants have preferred on review before IPAB, the Applicants requested for certified copy of TM-5, TM-6 & evidence in support of application and the same was issued.

The IPAB has passed the order allowing the appeal and remanded back the file to fix the hearing in respect of TM-16 filed by the applicants. In compliance of principles of natural justice and in accordance with the law. The previous counsel on record has informed to this Tribunal at the time of hearing, he has no objection for allowing the request on TM-16 because he has not filed any comments to the TM-16 filed by the applicants. When there is any objection on the part of the applicant's counsel, why this tribunal has to look in the merits of TM-16 on natural justice...

21. We are not able to understand as to how the said application No. 1013078 in Class 5 is connected with this case on hand. Even assuming the same to be a typographical error in number - instead of 1013028 it is 1013078 - there was no review filed even if we take that to be an appeal was filed that was not after the hearing of this proceedings fixed and to say that"" both parties attended the hearing. In the meantime"" is totally vague and shows the confused state of mind of the Registrar. We do not find any review petition pending before this Appellate Board for the applicants to request for a certified copy of TM-5, TM-6 and evidence in support of application.

22. Further, to say that the previous counsel on record has informed to this Tribunal at the time of hearing, he has no objection for allowing the request on TM-16 because he has not filed any reply to TM-16 is absurd. If that be the case, why was it that there was no mention about the same in the earlier order. If the opponent had no objection, then on what grounds the earlier appeal was filed, which was remanded back to the Registry for hearing afresh. Moreover, the Registrar has observed ""that as there was no objection by the opponent then the Tribunal need not look into the application and decide the same on the principles of natural justice"". If that be the case, why is that the Registrar has allowed the TM-16 in view of

the judgement of this Appellate Board without assigning any reason. We also find no reasoned order has been passed. The quasi judicial authority has got to give clear and reasoned order and not such sketchy orders. Such orders affecting the interest of the society shall be put down in a more serious manner.

23. Now dealing with the merits of the case, the main issue as to allowing the TM-16 application and whether the registration would be in contravention of the provisions of Section 11 of the Act.

24. The amendment sought for is to change the date of user and to change the name and address of the company. While the date of user sought to be amended would be a material alteration affecting the rights of the parties. Even if the principles of natural justice are to be followed and amendments are to be allowed at any stage of the proceedings, the two conditions i.e., (i) not working injustice to the other side and (ii) of being necessary for the purpose of determining the real question in controversy between the parties are to be satisfied. In the instant case, the applicant/appellant is seeking to amend the date of use to set up a fresh claim of prior user which cannot be allowed. If allowed, it would definitely cause injury to the other side.

Though this issue has not been dealt with and no reasoned order given by the Deputy Registrar, we are considering the same and giving our reasoned order in the interest of justice. We find that the amendment of user cannot be allowed as it is only an after thought and it is only to gain benefit as a prior user. Amendments can be allowed at any stage of the proceedings which will not affect or cause injury to the other party. Amendments which are of such nature as to displace the other party cannot be allowed. The appellants have also not placed any records for the change like deed of assignment or any other document. The application of amendment on Form TM-16 has, therefore, to be rejected.

25 . The other issue is whether the registration would be in contravention of the provisions of Section 11 of the Act. The marks are identical and the goods are the same and also the trade channels are same. The products being medicine more care is to be taken to determine whether there will be any confusion or deception. In such cases, the prior user gets a valid right than the subsequent user. In this case on hand, the respondent No. 1 though has not placed any valid document to prove user from the year 2000 except for

some medical magazines from the year 2002, but as the appellant have themselves claimed to be proposed user on 31.05.2001 we are of the view that the mark of the respondent No. 1 is prior in use. Identical marks which tend to cause confusion cannot be allowed. The objection under Section 11 of the Act is, therefore, allowed.

26. Having answered the issues in favour of the respondent No. 1, we accordingly uphold the order dated 13.12.2007. The appeal is, therefore, dismissed with no costs.