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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

+ **W.P.(C) 10373/2015 & CM No.25964/2015**

MODI- MUNDIPHARMA PVT. LTD

..... Petitioner

Through Mr. Pravin Anand, Ms. Prachi Aggarwal
Ms. Mrinali Menon, Advocates.

versus

UNION OF INDIA & ANR.

..... Respondents

Through Mr. Ananta Prasad Mishra for respondent
no. 2.

Mr. Amit Mahajan for CGSC/UOI

CORAM:

HON'BLE MR. JUSTICE VIBHU BAKHRU

ORDER

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17.07.2017

VIBHU BAKHRU, J

1. The petitioner has filed the present writ petition impugning the order dated 11.09.2015 (hereafter 'the impugned order') passed by the Intellectual Property Appellate Board (IPAB) allowing respondent no.2's application for rectification and de-registration of the trade mark 'FECONTIN' on account of its non-user.

2. The petitioner (hereafter 'Modi') is a company engaged in the manufacture, development and marketing of high quality pharmaceutical formulations. It is stated that Modi is the registered proprietor of the trade mark 'CONTIN'. It also claims to be the proprietor of a series of various other trade marks - as mentioned in paragraph 11(iv) of the petition - with the mark 'CONTIN' as a common feature.

3. Modi had filed an application for registration of the mark 'FECONTIN' for pharmaceutical and medicinal preparations which was

granted on 17.07.2000. The same was further renewed for a period up to 17.07.2020.

4. The trade mark 'FECONTIN' is stated to have been advertised on 28.10.2003 in the Trade Marks Journal with the note that the said mark is associated with the trade mark 'FECONTIN F', belonging to Modi. The e-register of the Trade Marks Registry also mentions that the trade mark 'FECONTIN' is associated with the trade mark 'FECONTIN F'.

5. Speciality Meditech Pvt. Ltd., respondent no.2 (hereafter 'SM') filed an application on 22.02.2010 for rectification before the IPAB seeking cancellation of the trade mark 'FECONTIN'. It was SM's case that it is a *bonafide* user of the trade mark 'FEMICONTIN', used in manufacturing and trading of pharmaceutical products from the year 1999. It was contended that the word 'CONTIN' is not an invented word and cannot be used by Modi exclusively as a suffix or prefix viz. 'FECONTIN'. SM sought the cancellation of the trade mark 'FECONTIN' on the ground that the said trade mark has not been used by Modi before or after registration, rendering it liable to be removed from the Trade Marks Registry under Section 47(1) of the Trade Marks Act, 1999 (hereafter 'the Act').

6. On the other hand, Modi disputed the aforesaid allegation of non-user. It contested the rectification application on the grounds of limitation as it was admitted that SM was aware of the registration granted to Modi from the year 2000. A cease and desist notice dated 10.07.1999 was also served on SM to restrain it from using the mark 'FEMICONTIN' as according to Modi such use amounted to infringement of Modi's trade mark 'FECONTIN F'. However, in its reply dated 05.08.1999, SM refused to acknowledge the proprietary rights of Modi. Further, it was stated that the application for rectification had been filed as a counterblast to the suit (CS(OS) 2176/2007)

filed by Modi against SM for an injunction before this Court, to restrain SM from using the trade mark 'FEMICONTIN' or any other similar word/mark leading to infringement of Modi's trade mark 'CONTIN' and the series of trade marks containing the word 'CONTIN'. By an order dated 03.12.2009, an interim injunction was granted against SM, restraining it from using the trade mark 'FEMICONTIN' in respect of pharmaceutical preparations. Modi also filed its opposition to the registration of the trade mark 'FEMICONTIN' before the Trade Marks Registry.

7. In the appeal filed against the order dated 03.12.2009 (FAO(OS)197/2010), the Division Bench had, by an order dated 16.04.2010, stayed the order impugned therein. The appeal was disposed of on 10.01.2013, *inter alia* directing that the order dated 16.04.2010 would continue to enure to the benefit of SM till the disposal of CS(OS)2176/2007. The said suit for infringement is still pending.

8. On a perusal of the counter statement, IPAB held that Modi is not using the trade mark 'FECONTIN' and mere registration without *bonafide* use rendered the trade mark liable to be removed from the register. It was observed that the counter statement did not contain a word with respect to the use of the trade mark 'FECONTIN' and rather it was stated that the 'CONTIN' series of trade marks including 'FECONTIN F' had been continuously and extensively used and the use of associated or substantially identical trade mark is equivalent to the use of the other as per Section 55 of the Act.

9. After examining Section 55 read with Section 15(1) of the Act, it was held that use of part of the registered trade mark is not a conclusive evidence of its distinctiveness. There is also a provision in the Act for registration of associated trade marks and such remedy has not been availed by Modi.

10. Insofar as the ground of limitation was concerned, IPAB relied on a decision given by the Division Bench of this Court in *Fedders Lloyd Corporation Ltd. & Anr. v. Fedders Corporation & Anr.*: (2005) 119 DLT 410 and concluded that the rectification application is not barred by limitation as non-user of trade mark gives rise to a fresh cause of action everyday.

11. Thereafter, the IPAB proceeded to pass the impugned order, allowing the rectification application and accordingly, the trade mark 'FECONTIN' was directed to be expunged from the Register of Trade Marks.

12. Before proceeding further, it is relevant to refer to Section 55(1) of Act, which reads as under:-

"55. Use of one of associated or substantially identical trade marks equivalent to use of another.—(1) Where under the provisions of this Act, use of a registered trade mark is required to be proved for any purpose, the tribunal may, if and, so far as it shall think right, accept use of a registered associated trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for the use required to be proved."

13. The trade mark 'FECONTIN' was registered under Registration no. 939544 in Class 05 but as an associate trade mark to the trade mark 'FECONTIN F' registered under the Registration no. 518596. This is recorded in the Trade Marks Journal which expressly indicates the same by use of the words "*to be associated with 518596*". This is also indicated in the website of the Trade Marks Registry.

14. Thus, undisputedly, in terms of Section 55(1) of the Act, the use of an associated registered trade mark may also be accepted as use of a registered trade mark. The fact that 'FECONTIN' was registered as associated with the

trademark 'FECONTIN F' seems to have been overlooked by the IPAB in its impugned order. In paragraph 19 of the impugned order, IPAB has expressly noticed that there is a provision under the Act for registration of associated trade mark, however, it concluded that Modi (first respondent therein) has not availed of the said remedies. This is an apparent error as Modi has registered its trade mark 'FECONTIN' as an associated trade mark of 'FECONTIN F'.

15. In view of the above, the impugned order is set aside and the matter is remanded to the IPAB to be considered afresh.

16. The petition and the pending application are disposed of.

JULY 17, 2017

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VIBHU BAKHRU, J

