



WEB COPY

IN THE HIGH COURT OF JUDICATURE AT MADRAS

Reserved on : 10.07.2019

Pronounced on : 02.08.2019

CORAM

THE HONOURABLE MR.JUSTICE R.SUBBIAH

and

THE HONOURABLE MR.JUSTICE C.SARAVANAN

W.P.No.5486 of 2019

and W.M.P.No.6241 of 2019

K.Dalpat Singh

.. Petitioner

vs.

1.Intellectual Property Appellate Board,

Rep.by Deputy Registrar,

443, Anna Salai, Teynampet,

Chennai 600 018.

2.The Assistant Registrar of Trade Marks,

Trade Marks Registry,

Chennai.

3. M/s.Gold Medal Electricals Pvt.Ltd.,

A/302, Kemp Plaza, Mind Space,

Off Link Road, Chincholi Bunder,

Malad (W), Mumbai 400 064.

.. Respondents

PRAYER . : Writ Petition has been filed under Article 226 of the Constitution of India to issue a Writ of Certiorari calling for the entire records of the 1st respondent pertaining to OA/5/2018/TM/CH dated 12.11.2018 and quash the same.



WEB COPY

For Petitioner : Mr.N.Nithianandan
For R1 and R2 : Mr.T.V.Krishnamachari
For R3 : Mr.Madhan Babu

O R D E R

C.SARAVANAN, J.

The petitioner is aggrieved by the impugned order dated 12.11.2018 passed by the 1st respondent Intellectual Property Appellate Board (IPAB) in OA/5/2018/TM/CH.

2. By the impugned order, the 1st respondent Intellectual Property Appellate Board (IPAB) has set aside the order dated 06.07.2018 passed by the 2nd respondent - Assistant Registrar of Trade Marks, Trade Marks Registry in Opposition No.890521 treating the said Opposition proceeding filed by the 3rd respondent as "abandoned".

3. The said Opposition proceeding was filed by the 3rd respondent against the proposed registration of the Trade Mark "Gold Mehal" in T.M.Application.No.2573910.

4. The petitioner had claimed a continuous user of the said word as a trademark since 08.12.2011 for products falling under in respect of C.P Bath Fittings in class 11.

5. After initial scrutiny the aforesaid application, the Trademark was advertised in the trademark journal on 08.05.2017. Under these circumstances, the 3rd respondent herein filed opposition proceedings vide Opposition No.890521 against the proposed registration of the aforesaid Trade Mark in T.M.Application No. 2573910.

6. The petitioner thereafter filed a counter statement to notice of Opposition No.890521. The 2nd respondent thereafter called upon the 3rd respondent to file evidence in support of the opposition in terms of Rule 45 of the Trade Marks Rules, 1999/2017 within a period of two months vide communication dated 18.09.2017.



7. By a communication dated 05.10.2017 addressed to the office of the Registrar of Trademarks, Chennai but sent to the Mumbai office of the 2nd respondent, the 3rd respondent's advocates informed that they did not wish to file evidence in support of the opposition under Rule 45 of the Trade Marks Rules, 1999 but would rely on the notice of opposition alone. A copy of the said communication was also marked to the petitioner's attorney.

8. The 3rd respondent thus decided to give up its right to file evidence in support of the opposition proceedings and confined opposition to the legality of the proposed registration of the aforesaid trademark in favour of the petitioner.

9. Though the aforesaid communication dated 05.10.2017 was addressed to the office of the Registrar of Trademarks, Chennai, it was not 2nd respondent's Chennai Office.

10. Under these circumstances, the petitioner's trademark attorney Mr.Selvarajan also sent a letter dated 05.10.2017 to the office of the Registrar of Trade Marks Chennai and stated that the petitioner was also waiving the option to file evidence in support of the registration under Rule 46 of their Trade Marks Rules, 1999/2017.

11. The 2nd respondent by a communication dated 17.5.2018 informed the petitioner, the 3rd respondent and their respective trademark agents/advocates that the opposition proceeding was deemed to have been abandoned in view of Sub Rule (2) of Rule 45 [Old Rule 50 (2)] and therefore the hearing was fixed to decide the same on 20.06.2018.

12. Taking cue from the said notice fixing personnel hearing, the petitioner's Trade Mark agent/Attorney also filed a written representation dated 20.6.2018 treating the said Opposition No.890521 as having been abandoned and requested for registration of the trademark in T.M. Application No. 2573910.

13. Curiously, the 3rd respondent did not participate in the hearing fixed on 20.6.2018 before the 2nd respondent. Thus, by an order dated 6.7.2018, the Assistant Registrar of Trade Mark concluded that the opposition initiated by the 8th respondent was



deemed to have been abandoned in view of the operation of Rule 45 (2) Trade Mark Rules, 1999.

14. In the aforesaid order, it was recorded that the petitioner was informed by the 3rd respondent that they did not wish to file evidence in support of opposition but wanted to rely upon the submissions in the Notice of Opposition. Since, on verification, no such communication was received by the 2nd respondent at Chennai, it was deemed that the 3rd respondent had abandoned the opposition proceeding.

15. Aggrieved by the order of the Assistant Registrar of Trademark, Chennai treating Opposition No. 890521 dated 6.7.2018 as abandoned, the 3rd respondent filed an appeal before the 1st respondent Appellate Board.

16. By the impugned order dated 12.11.2018, the 1st Respondent Appellate Board has set aside the order dated 6.7.2018 passed by the Assistant Registrar of Trademark, Chennai treating Opposition No.890521 filed by the 3rd respondent against the proposed registration of the trademark "Gold Mahel" as Trade Mark vide T.M.Application No.2573910 as abandoned and has remanded the case for being reheard by the Assistant Registrar of Trademark, Chennai. Thus, no orders have been passed on the merits of the case.

17. At the outset, the learned counsel for the petitioner submitted that there was a large-scale irregularity in the proceedings before the 1st respondent Appellate Board.

18. It was submitted that the demand draft for appeal against the order dated 6.7.2018 passed by the Assistant Registrar of Trademark, Chennai treating Opposition No.890521 as abandoned is dated 26.7.2018 and therefore it remains inexplicable as to how Order sheet dated 20.7.2018 came to be issued fixing the date of hearing as 6.8.2018 at Delhi by the 1st respondent Appellate Board. It was submitted that the appeal was itself subsequent to Order sheet dated 20.7.2018.

19. The petitioner has made a serious allegation against the 1st respondent-Appellate Board even though in the Order Sheet dated 20.7.2018, the 1st respondent Appellate Board has specifically mentioned that the petitioner (2nd respondent therein) was represented by their counsel Mr.Diljit.



20. We therefore directed both the parties to file their respective affidavits. Though, the petitioner has filed an affidavit alluding to the mismatch in the dates between the Order Sheet dated 20.7.2018 and the date of filing of the appeal as 26.7.2018, we are conscious of the manner in which proceedings were taken up.

21. The Principal Bench of the 1st respondent-Appellate Board is at Chennai. It has circuit benches in other cities including New Delhi. There is a vacancy and there are no regular sittings at Chennai.

22. Therefore, the 3rd respondent had sought permission of the members of the 1st Respondent Appellate Board at Delhi to hear the appeal in Delhi. This was done after giving notice to the petitioner's representatives in New Delhi. Therefore, before formally filing an Appeal at Chennai, a permission was obtained at New Delhi after due intimation to the petitioner.

23. The petitioner's Advocate in Delhi on instruction from the petitioner also appeared before the Delhi Region of the 1st Respondent-Appellate Board on 20.7.2018.

24. It is thereafter, a hearing was fixed to 6.8.2018 vide Order sheet dated 20.7.2018. Therefore, the preliminary submission of the learned counsel for the petitioner is rejected.

25. Questioning the fixation of hearing of the appeal by the 1st respondent-Appellate Board to 6.8.2018 vide Order sheet dated 20.7.2018, it was uncalled, unnecessary and unwarranted without any basis and was intended to prejudice our minds.

26. Suffice to state that the petitioner and their counsel should have refrained from making such uncalled allegations/insinuations without any factual basis on the functioning of 1st respondent Appellate Board particularly when the petitioner was represented by their counsel on 20.7.2018.

27. In our view, the 1st Respondent -Appellate Board has acted in a fair manner while passing the Order Sheet on



20.7.2018 while fixing the date of hearing of the appeal to 06.08.2018.

28. As far as the merits of the case is concerned, it was submitted on behalf of the petitioner that the 3rd respondent had abandoned Opposition No.890521 filed against registration of the trademark "Gold Mahel" vide T.M.Application No. 2573910.

29. It was submitted that the impugned order allowing the appeal by the 3rd respondent remitting the case back to the 2nd respondent was contrary to Rule 45 (2) of the Trade Marks Rules, 1999 of 2017.

30. It has been further submitted that the impugned order was cryptic and non-speaking order and was therefore liable to be set aside. According to the petitioner, the impugned order has resulted in miscarriage of justice.

31. It was further submitted that within two months from the date of service of a copy of the counter statement in the opposition proceeding, the 3rd respondent as an opponent should have filed an affidavit in support of the opposition with the 2nd Respondent or in the alternative intimated in writing their desire not to adduce evidence in support of the opposition and intended to rely on the facts stated in the Notice of Opposition.

32. It was submitted that the 3rd respondent as an opponent in Opposition Proceeding in Opposition No.890521 failed to intimate the 2nd respondent that it did not desire adduce any evidence in support of the opposition and wanted to rely on the notice of opposition. Since there was a failure to intimate their decision, the order passed by the 2nd respondent cannot be assailed.

33. Learned counsel for the petitioner relied on the decision passed by the same bench of the 1st Respondent-Appellate Board New Delhi in its order dated 18.10.2018 in O.A/6-8/2018/TM/DEL between Sahil Kohli Vs The Registrar of Trademarks and Anil Verma.

34. Per contra, the learned counsel for the 3rd respondent submits that the impugned order has not determined the rights



but has merely remitted the case to the 2nd respondent and therefore requires no interference.

35. It was submitted that the 1st Respondent-Appellate Board has merely remitted the case back to proper determination in the light of the fact that the 3rd respondent had indeed intimated to the office of the 2nd respondent's counter part at Mumbai regarding their decision to not to file any evidence in support of the opposition proceeding and instead intended to rely on the notice of opposition filed by them in Opposition No. 890521.

36. We have considered the submissions of the learned counsel for the petitioner (applicant) and the 3rd respondent (opponent). There are no dispute on facts.

37. Though the 3rd respondent failed to appear before the 2nd respondent in the hearing fixed before the 2nd respondent on 20.6.2018 in the Opposition No.890521, there is no denying of the fact that on 5.10.2017, the 3rd respondent had informed the 2nd respondent's counterpart at Mumbai regarding their intention to not to file evidence in support of the opposition. This has also been mentioned in the letter addressed by the petitioner's trademark agent on 5.10.2017 to the 2nd respondent while exercising their rights under Rule 46 of the Trademark Rules, 1999.

38. We have no quarrel with the proposition of the Appellate Board in Sahil Kohli vs The Registrar of Trademarks and Anil Verma in the decision cited by the learned counsel for the petitioner that when a party fails to exercise the option under Rule 131 for extension of time for filing evidence in support of opposition accompanied by prescribed fee, the consequence under the provisions of Rule 45 (2) will be attracted.

39. However, that decision is not applicable to the facts of the present case, as the 3rd respondent had exercised the option to not to file evidence in support of opposition and wanted to rely on the Notice of Opposition and had sent an email on 05.10.2017 to the 2nd respondent's counterpart at Mumbai exercising to that effect with a copy marked to the petitioner's Trade Mark Attorney.



40. In that case, when a letter dated 13.3.2018 was filed and it was already time-barred and therefore there was a failure to comply with the provisions of Rule 45 of the Trademark Rules, 2017.

WEB COPY

41. It is therefore invited the consequences under Rule 45 (2). Therefore, we are of the view that the decision of the Appellate Board cannot be applied to the facts of the present case.

42. The 2nd respondent's counterpart at Mumbai received a copy of the E-mail dated 05.10.2017 of the 3rd respondent regarding the 3rd respondent's intention to not to file evidence in support of opposition under Section 45 (2) of the Trade Mark Rules, 1999/2017. A copy of the said E-mail was also marked by the petitioner's Trade Mark Agent as well.

43. Further, both the parties have waived the right to file evidence in support of opposition and evidence in support of application. Therefore, the 2nd respondent could have decided the case on merits in the opposition proceeding based on the Notice of Opposition filed by the 3rd respondent and the counter filed by the petitioner in the said proceeding. Instead, the 2nd respondent Assistant Registrar has treated the opposition filed by the 3rd respondent as abandoned.

44. Perhaps, the absence of the 3rd respondent in the personal hearing held on 20.06.2018 and failure of the 2nd respondent's counterpart at Mumbai to transmit the communication dated 05.10.2017 of the 3rd respondent led the passing of the order dated 06.07.2018 by the 2nd respondent.

45. In our view, the Assistant Registrar of Trademark could not have passed the order dated 06.07.2018 treating the opposition proceeding as "abandoned" particularly, in the light of the fact that the petitioner's Trade Mark Attorney had also by a letter dated 05.10.2017 intimated the same position to the 2nd respondent regarding the decision of the 3rd respondent to not to file evidence in support of the opposition proceedings.

46. We do not find any infirmity in the impugned order dated 12.11.2018 passed by the 1st Respondent-Appellate Board. In any event, the impugned order, the 1st respondent has merely set



aside the order dated 06.07.2018 passed by the 2nd respondent and has directed the 2nd respondent to decide the case on merits.

47. In view of the above discussion, we are dismissing the above writ petition. No cost. Consequently, connected miscellaneous petition is closed.

Sd/-
Assistant Registrar(CS VIII)

//True Copy//

Sub Assistant Registrar

kkd

To

1.Intellectual Property Appellate Board,
Rep.by Deputy Registrar,
443, Anna Salai, Teynampet,
Chennai 600 018.

2.The Assistant Registrar of Trade Marks,
Trade Marks Registry,
Chennai.

+2cc to Mr.N.Nithianandam, Advocate Sr.66599 and 66693

+1cc to Mr.R.Parthasarathy, Advocate Sr.66496

W.P.No.5486 of 2019
and W.M.P.No.6241 of 2019

pa[co]
srg 13/09/2019