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CMP(TM)/2/2023
in (T)CMA(TM)/12/2023
(OA/38/2011/TM/CHN)

SENTHILKUMAR RAMAMOORTHY,J

The applicant for registration of the trade mark under Application No.690802 in Class 31 filed the appeal against the order by which the opposition was allowed and the application was rejected. This petition is filed in the said appeal for leave to exhibit additional documents. The application was filed before the Registrar of Trade Marks on 15.12.1995 asserting use from 1983. The first respondent herein lodged the notice of opposition in the year 2008 and the impugned order was issued in the year 2010.

2. Learned counsel for the petitioner submits that these additional documents are relevant and important for the adjudication of the appeal. It is further stated that all the documents relate to the period commencing from 2001. By adverting to the Madras High



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Court Intellectual Property Rights Division Rules, 2022 (the 2022 Rules) and, in particular, sub-rule 7 of Rule 7, learned counsel submits that this Court is empowered to grant leave for the production of additional evidence while adjudicating an appeal. He further submits that the provisions of Order XLI Rule 1 of the Code of Civil Procedure, 1908, (the CPC) have been made applicable by virtue of sub-rule 9 of Rule 7.

3. In order to establish that the Appellate Court should permit additional evidence in such circumstances, learned counsel referred to and relied upon the following judgments:

"(1) Bennett Coleman and Company Limited v. E1 Entertainment Television LLC and another, 2023: DHC: 8274, for the proposition that additional documents may be allowed to be filed although the IPD Rules of the Delhi High Court do not deal with the same.

(2) Sanjay Kumar Singh v. State of Jharkhand, (2022) 7 SCC 247 (Sanjay Kumar



Singh), for the proposition that Order XLI Rule 27 CPC enables the appellate court to permit additional evidence when required for purposes of adjudicating the appeal.

(3) Union of India v. Ibrahim Uddin & another (Ibrahim Uddin), (2012) 8 SCC 148, particularly paragraph 49 thereof, for the proposition that additional evidence should be permitted to be adduced if required for pronouncement of judgment or for any other substantial cause

(4) Marico Limited v. Agro Tech Foods Limited (Marico), 2010 SCC OnLine Delhi 3806, particularly paragraph 41 thereof, for the proposition that evidence of use up to the date of registration may be permitted to be adduced.

(5) Mysore Deep Perfumery Household v. Sunilkumar Amrutlal Jain (Mysore Deep), 2022 SCC OnLine Bom 1019, particularly paragraphs 43 to 45 thereof, with regard to the scope of Order XLI Rule 27 CPC."



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4. In response to these contentions, learned counsel for the respondent submitted that these are appellate proceedings and should be contrasted with a rectification petition or an infringement action, both of which are original proceedings. By turning to the judgments referred to and relied upon by learned counsel for the petitioner, learned counsel for the respondent submitted that the judgment of the Bombay High Court in *Mysore Deep* is distinguishable in as much as it dealt with the powers of the court to permit such additional evidence if required by the court to adjudicate the appeal. As regards the judgment in *Marico*, learned counsel submitted that the judgment was pronounced in the context of a suit for infringement where the validity of registration of the relevant trade mark was challenged. As regards the judgment in *Ibrahim Uddin*, learned counsel submitted that paragraph 48 thereof captures the scope of Order XLI Rule 27. Finally, learned counsel referred to the judgment of the Calcutta High Court in *E.Griffiths Hughes Ltd., v. Vick Chemical Co., AIR 1959 Cal 654*, where, at paragraph 19, the



Calcutta High Court held that the rights of the parties should be decided as of the date of application for registration of the trade mark.

5. Sub-rule 7 of Rule 7 of the 2022 Rules, is as under:

"7. No party shall be entitled to produce any additional evidence except with the leave of Court."

6. In view of the above provision, there is no doubt that this Court has the power to grant leave to produce additional documents in an appeal. Sub-rule 9 of Rule 7 makes it clear that the provisions of Order XLI of CPC shall apply to the extent that it is not inconsistent with the 2022 Rules. Order XLI, Rule 27 of CPC is as under:

"Order XLI, Rule 27: Production of additional evidence in Appellate Court--

(1) The parties to an appeal shall not be entitled to produce additional evidence, whether oral or documentary, in the Appellate Court, But if--



(a) the Court from whose decree the appeal is preferred has refused to admit evidence which ought to have been admitted, or

(aa) the party seeking to produce additional evidence, establishes that notwithstanding the exercise of due diligence, such evidence was not within his knowledge or could not, after the exercise of due diligence, be produced by him at the time when the decree appealed against was passed, or

(b) the Appellate Court requires any document to be produced or any witness to be examined to enable it to pronounce judgment, or for any other substantial cause,

the Appellate Court may allow such evidence or document to be produced, or witness to be examined.

(2) Wherever additional evidence is allowed to be produced by an Appellate Court, the Court shall record the reason for its admission."

7. From Order XLI, Rule 27 CPC, it is evident that parties to an appeal are not entitled to produce additional evidence, oral or



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documentary, and that such evidence may be permitted to be produced only upon obtaining leave of the Court. Such leave may be obtained if the party applying for leave establishes that the additional evidence could not be produced in spite of the exercise of due diligence when the matter was conducted before the Court of first instance. In addition to the above, Order XLI, Rule 27 also enables the Court to require any document to be produced or any witness to be examined, if the Court deems it necessary either to enable the Court to pronounce judgment or for any other substantial cause.

8. The question to be considered in the above statutory context is whether the petitioner has established that the case falls within the ambit of Order XLI, Rule 27. As mentioned at the outset, the application for registration of the relevant trade mark was filed by the petitioner on 15.12.1995. If granted, the registration would be effective from the date of application. The application was filed by



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asserting use from the year 1983. It appears that the opposition was primarily on the ground that the mark does not satisfy the requirement of Section 9 of the Trade Marks Act, 1999. A trade mark is either inherently distinctive or acquires distinctiveness. If inherently distinctive, it is liable to be registered irrespective of evidence of prior use. On the contrary, if the assertion is that it has acquired distinctiveness, the applicant is required to discharge the burden of establishing that it has acquired distinctiveness by use. In the case at hand, such use should be from the date of asserted use in the year 1983 up to the date of application in December 1995.

9. The petitioner had two opportunities to place on record all relevant evidence, including evidence of use for the above mentioned period, i.e. either along with the application or in response to the notice of opposition. At this juncture, the petitioner does not seek to place on record evidence relating to the above mentioned period between 1983 and 1995. Instead, the petitioner seeks to place on



record evidence of use from the year 2001. In appellate proceedings arising out of the refusal of the Registrar of Trade Marks to register the trade mark, evidence which is not forming part of the record of the Registrar of Trade Marks would be admissible only if the Court concludes that such evidence is necessary for the effective adjudication of the appeal. For reasons set out above, especially the fact that the appellant would succeed or fail based on records already placed before the Registrar of Trade Marks, these additional documents are clearly not necessary for the effective adjudication of the appeal.

10. The judgments placed on record by learned counsel for the petitioner also point in the same direction. The judgments of the Supreme Court in *Sanjai Kumar Singh* and *Ibrahim Uddin* capture the scope of Order XLI Rule 27 of CPC. Clause (aa) of sub-section 1 thereof deals with the production of additional documents which could not be produced in proceedings before the court of first



instance in spite of the exercise of due diligence. Clause (b) of sub-section 1 is wider and enables the Court to permit production of any document necessary for adjudication.

11. Since the documents sought to be relied upon by the petitioner do not fall within either category specified in Order XLI, Rule 27 CPC, this petition is dismissed without any order as to costs.

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