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(T)CMA(TM) No.82 of 2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 13.03.2024

CORAM :JUSTICE N.SESHASAYEE

(T)CMA(TM) Nos.82, 85, 86, 105, 106, 107 & 175 of 2023

Alpha Foundation for Education and Research
Alpha Educational Campus
Sudhana Nagar, K.K.Nagar East Extension
Tiruchirappalli - 620 007. ... Appellant in all cases

Vs.

1.Akara Education Private Limited
III Floor, Meenakshi Apartments
7/5, P.S.Sivasamy Street
Mylapore, Chennai - 600 004.
2.The Assistant Registrar of Trade Marks
IPR Building, Industrial Estate
SIDCO EMD, GST Road
Guindy, Chennai - 600 032. .. Respondents in all cases

PRAYER in (T)CMA(TM) Nos.82 of 2023: The appeal came to be filed by transfer of IPAB cases in SR.No.104/2019/TM/CH, from the file of Intellectual Property Appellate Board, Chennai in OA/10/2020/TM/CHN praying for the following reliefs:

- (a) this appeal may be allowed;
- (b) the impugned order dated 20.06.2019 of the learned Assistant Registrar which has the effect of treating the Opposition No.877666 by the



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appellant as abandoned be reversed;

- (c) the impugned registration No.3235860 in Class 9 be removed from the Register;
- (d) that the evidence in support of the opposition be accepted and taken on record and that the opposition be restored;
- (e) pending the hearing of this appeal registration No.3235860 in Class 9 be held in abeyance;
- (f) the respondent be ordered to pay the cost of these proceedings to the appellant;
- (g) any other and further or other relief as this Court may deem fit and proper in the circumstances of the case.

PRAYER in (T)CMA(TM)No.85 of 2023 : The appeal came to be filed by transfer of IPAB case in SR.No.133/2019/TM/CH from the file of Intellectual Property Appellate Board, Chennai in OA/13/2020/TM/CHN praying for the following reliefs:

- (a) this appeal may be allowed;
- (b) the impugned order dated 26.08.2019 of the learned Assistant Registrar which has the effect of treating the Opposition No.880729 by the appellant as abandoned be reversed;
- (c) the impugned registration No.3271856 in Class 37 be removed from the Register;
- (d) that the evidence in support of the opposition be accepted and taken on record and that the opposition be restored;
- (e) pending the hearing of this appeal registration No.3271856 in Class 37 be held in abeyance and not be given effect to;



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- (f) the respondent be ordered to pay the cost of these proceedings to the appellant;
- (g) any other and further or other relief as this Court may deem fit and proper in the circumstances of the case.

PRAYER in (T)CMA(TM)No.86 of 2023: The appeal came to be filed by transfer of IPAB case in SR.No.134/2019/TM/CH from the file of Intellectual Property Appellate Board, Chennai in OA/14/2020/TM/CHN praying for the following reliefs:

- (a) this appeal may be allowed;
- (b) the impugned order dated 26.08.2019 of the learned Assistant Registrar which has the effect of treating the Opposition No.880729 by the appellant as abandoned be reversed;
- (c) the impugned registration No.3271856 in Class 37 be removed from the Register;
- (d) that the evidence in support of the opposition be accepted and taken on record and that the opposition be restored;
- (e) pending the hearing of this appeal registration No.3271856 in Class 37 be held in abeyance and not be given effect to;
- (f) the respondent be ordered to pay the cost of these proceedings to the appellant;
- (g) any other and further or other relief as this Court may deem fit and proper in the circumstances of the case.



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PRAYER in (T)CMA(TM)No.105 of 2023: The appeal came to be filed by transfer of IPAB case in SR.No.143/18/TM/CH from the file of Intellectual Property Appellate Board, Chennai in OA/3/2021/TM/CHN, praying for the following reliefs:

- (a) this appeal may be allowed;
- (b) the impugned order dated 16.07.2018 of the learned Assistant Registrar which has the effect of treating the Opposition No.880726 by the appellant as abandoned be reversed;
- (c) the impugned registration No.3271854 in Class 9 be removed from the register;
- (d) that the evidence in support of the opposition be accepted and taken on record and that the opposition be restored;
- (e) pending the hearing of this appeal registration No.3271854 in Class 9 be held in abeyance;
- (f) the respondent be ordered to pay the cost of these proceedings to the appellant;
- (g) any other and further or other relief as this Court may deem fit and proper in the circumstances of the case.

PRAYER in (T)CMA(TM)No.106 of 2023: The appeal came to be filed by transfer of IPAB case in SR.No.144/18/TM/CH from the file of Intellectual Property Appellate Board, Chennai in OA/4/2021/TM/CHN, praying for the following reliefs:

- (a) this appeal may be allowed;
- (b) the impugned order dated 05.07.2018 of the learned Assistant Registrar which has the effect of treating the Opposition No.877668 by the



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appellant as abandoned be reversed;

- (c) the impugned registration No.3235856 in Class 37 be removed from the register;
- (d) that the evidence in support of the opposition be accepted and taken on record and that the opposition be restored;
- (e) pending the hearing of this appeal registration No.3235856 in Class 37 be held in abeyance;
- (f) the respondent be ordered to pay the cost of these proceedings to the appellant;
- (g) any other and further or other relief as this Court may deem fit and proper in the circumstances of the case.

PRAYER in (T)CMA(TM)No.107 of 2023: The appeal came to be filed by transfer of IPAB case in SR.No.145/18/TM/CH from the file of Intellectual Property Appellate Board, Chennai in OA/5/2021/TM/CHN, praying for the following reliefs:

- (a) this appeal may be allowed;
- (b) the impugned order dated 03.07.2018 of the learned Assistant Registrar which has the effect of treating the Opposition No.877669 by the appellant as abandoned be reversed;
- (c) the impugned registration No.3235864 in Class 37 be removed from the Register;
- (d) that the evidence in support of the opposition be accepted and taken on record and that the opposition be restored;
- (e) pending the hearing of this appeal registration No.3235864 in Class 37 be held in abeyance;



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- (f) the respondent be ordered to pay the cost of these proceedings to the appellant;
- (g) any other and further or other relief as this Court may deem fit and proper in the circumstances of the case.

PRAYER in (T)CMA(TM)No.175 of 2023: The appeal came to be filed by transfer of IPAB case in SR.No.142/18/TM/CH from the file of Intellectual Property Appellate Board, Chennai in COD No.01/2019 praying for the following reliefs:

- (a) this appeal may be allowed;
- (b) the impugned order dated 05.07.2018 of the learned Assistant Registrar which has the effect of treating the Opposition No.877667 by the appellant as abandoned be reversed;
- (c) the impugned registration No.3235850 in Class 9 be removed from the Register;
- (d) that the evidence in support of the opposition be accepted and taken on record and that the opposition be restored;
- (e) pending the hearing of this appeal registration No.3235850 in Class 9 be held in abeyance;
- (f) the respondent be ordered to pay the cost of these proceedings to the appellant;
- (g) any other and further or other relief as this Court may deem fit and proper in the circumstances of the case.



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For Appellant : Mr.R.Sathish Kumar
(in all cases)

For Respondents : Mr.A.R.Sakthivel
(in all cases) Central Govt. Standing Counsel for R2

R1 – No Appearance

COMMON JUDGMENT

This batch of appeals are directed against a set of Orders passed by the Trademark Registry dismissing the appellant's opposition to the registration of the mark of the first respondent.

Facts

2. The case of the appellant is as below :-

- (a) The Appellant is a charitable educational trust founded in 1993, for the purpose of promotion of all kinds of education and also establishment of educational institutions, and has established several educational institutions under the name and style Alpha Cambridge International School, Alpha Plus Matriculation, Alpha Wisdom Vidyashram and Akara Star kids etc., collectively called as “ALPHA GROUP OF



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INSTITUTIONS”

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- (b) The appellant is the original adopter and user of the Trademarks “AKARA”, ‘AKARA STAR KIDS’ and “Akara Star Kids” (it is a logo) since 2011 and is also the registered proprietor of the trademarks ‘AKARA STAR KIDS’ and “ the logo” falling under classes 41 and 16 and has been using these trademarks continuously since their adoption.
- (c) The first respondent applied for the registration of the trade mark “AKARA” (the impugned Trade Mark) in classes 9, 37 and 41 and the application was also advertised in the Trade Marks Journal No.1771 dated 14.11.2016.
- (d) The appellant filed the opposition notices dated 04.07.2017, 11.08.2017 and 12.08.2017 against the application for registration of the Respondent in respect of the impugned trademark “AKARA” on the grounds that the Impugned Trademark is similar (Viz. construction of school infrastructure, etc.) as the goods/services to the trademark of the appellant “AKARA”, ‘AKARA STAR KIDS’ and “Akara Star Kids” (it is a logo).

2. Before the 2nd Respondent the hearing was fixed on different dates for all



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the 7 cases in this batch of appeal, and the appellant has filed its evidence under Rule 45(1), but after the stipulated two months provided therefor. But they were rejected by the second respondent for filing them belatedly, and had further held that the appellant had abandoned its opposition. These order of the second respondent are now under challenge.

3. Heard both sides. The learned counsel for the appellant submitted that the Registrar has failed to comply with Section 21 (3) read with Rule 44 (1) of the Trade Marks Rules, 2017 and Rule 49(1) of the Trade Marks Rules, 2022 which required the Registrar to serve a copy of the Counter statement on the Appellant. Rule 45(2) of the Trade Marks Rules, 2017 is procedural and directory in nature and should be worked to achieve the goal of maintaining the purity of the Register and non- compliance with the period of time for filing the evidence in support of the Opposition cannot be fatal and defeat the very previous Trademarks Act 1999, and in particular the provisions of Sections 9 and 11 of the Trade Marks Act, 1999.

4. No proof of service of counter on the appellant has been produced by the second respondent. Which makes the submissions of the counsel for the appellant impressive. A mere assertion that the counter was served through



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e-mail without proof that it has actually been so served does not meet the requirements of the statute. And, even if there is a doubt cast as to whether the counter was served, benefit must be given only to the opponent, for what is in stake is the statutory right of the opponent to resist the registration of a trademark. And the Trade Marks Registrar cannot insist on producing evidence in aid of opposition without serving the copy of the counter. Indeed for the purposes of Rule 45 time for production of evidence will commence only after counter of the trademark applicant is served on the opponent.

5. In conclusion these appeals are allowed. The 2nd respondent is directed to restore to his file the opposition filed by the appellant along with the evidence submitted by it and then pass orders on merits as per law within a period of 4 months. No costs.

13.03.2024

Index : Yes / No
Speaking order/ Non-speaking order
ds

To:
The Registrar of Trade Marks
Trade Marks Registry at Chennai
Bharathi Nagar, I Block, Anna Nagar,



Chennai – 600 040.

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