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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 15.02.2024

CORAM :JUSTICE N.SESHASAYEE

CMA(TM) No.9 of 2023
and CMP.No.24057 of 2023

Sun Pharma Laboratories Ltd.
Sun House, 201 B1/Western Express Limited
Goregaon (East), Mumbai - 400 063. ... Appellant

Vs

1.The Registrar of Trade Marks
Trademarks Registry
Intellectual Property Building
GST Road, Guindy
Chennai - 600 032
Tamil Nadu.

2.Nark Pharmaceuticals Private Ltd.,
28/1270, Kezhuppilly Cross Road
Kadavanthara
Ernakulam - 682 050
Kerala. ... Respondents

PRAYER: Civil Miscellaneous Appeal (Trade Mark) filed under Section 91 of the Trade Marks Act, 1999, praying to allow this appeal by setting aside the order dated 25.07.2013 passed by the first respondent, abandoning

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Opposition No.1052047 against Application No.4442579 in class 05, and consequently directing the first respondent to restore the aforementioned opposition.

For Appellant : Mr.S.Sriraman

For Respondents : Mr.J.Madhanagopal Rao
Senior Panel Counsel for R1

Mr.Benoy K.Kadavan for R2

JUDGMENT

The appellant, having lost its opposition to an application which the second respondent herein has taken out for registration of its trade mark before the first respondent herein has come before this Court challenging the same.

2. The brief facts are :

a) The appellant is a registered proprietor of the word 'REBOSE' under class 5. The mark came to be registered on 08.03.2001. While so, the second respondent herein filed an application on 15.02.2020, seeking the registration of its word mark 'LIBOSE' with a device attached over the second letter 'I'. In its application, the second respondent claims user from 08.01.2016.

b) The Trade Mark Registry went for search and proceeded to publish

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the trademark of the second respondent in the Trademark's journal. Taking note of the same, the appellant herein has entered opposition with its notice of opposition dated 19.06.2020.

c) On 28.08.2020, the Trade Mark Registry forwarded the same to the second respondent to file its counter statement. A copy of the said mail was also served on the appellant herein. Then there was a huge lull.

d) While so, on 22.06.2023, the appellant received a show cause notice under Rule 45 of the Trade Mark Rules, 2017, through e-mail as to why the opposition of the appellant should not be declared as abandoned in view of the fact that the appellant had not filed any evidence in response to the counter statement. On further scrutiny, the appellant learnt that on 09.11.2020, the first respondent had uploaded the communication in its official web site, which informs that the counter statement of the second respondent was served on the appellant through e-mail, with a further direction requiring the latter to file its evidence.

e) According to the appellant, it was taken aback by this email since it was not served with the copy of the counter statement till then. All the same it appeared for a hearing before the Registrar on 25.07.2023.

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During hearing, the counsel for the appellant did inform the Registrar that he was not served with a copy of the counter statement of the second respondent.

f) After recording the same, the Registrar proceeded to record the statement made by the counsel for the second respondent that as per the official communication, the copy of the counter indeed had been served on the appellant and that the appellant had not filed its evidence resisting the opposition.

g) The Registrar however acted on the statement of the counsel for the applicant and declared that the opposition of the appellant as abandoned since the appellant has not produced its evidence. And, it proceeded to register the mark of the second respondent on the very date which it passed its order. This is now under challenge.

3.1 Heard both sides. The arguments of the counsel for the appellant were along the predictable lines. He submitted that the appellant has been consistent in its stands that the copy of the counter of the second respondent was not served on it. And inasmuch as the appellant makes a negative assertion, the burden is not on it to prove the impossible but on the Registry

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to demonstrate that it had actually mailed a copy of the counter to the appellant. Except a bare statement in the official website, there is nothing on record to indicate that the first respondent indeed had shared the copy of the counter of the second respondent to the appellant. The statutory obligation to furnish evidence will arise only when the copy of the counter is made available to the appellant, but not otherwise. The approach of the first respondent in breaching the rules of the procedure can never be supported in law.

3.2 The learned counsel for the second respondent submitted that:

(a) Even in the appeal memorandum, the appellant has indicated that it has given its email ID, and also had admitted that it had received two emails dated 08.08.2023 and 22.06.2023. Therefore, the Trade Mark Registry might not have any reason as to why it should withheld the communication dated 09.11.2020.

(b) Inasmuch as the Trade Mark Registry has rejected the opposition and has proceeded to register the mark of the second respondent, the only legal option open to the appellant is not to revive the lost opposition, but to seek rectification under Sec.57 of the Act.

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3.3 Mr.J.Madhanagopal Rao, learned Senior Panel Counsel appearing for the first respondent supported the line of Registry's justification as disclosed in the impugned order.

4. After carefully weighing the rival submissions, this Court is satisfied that the contentions of the appellant outweighs the merit of the submissions made on behalf of the respondents. The first respondent cannot insist the appellant to furnish evidence unless the appellant is furnished with a copy of the counter of the second respondent. And as very rightly contented by the appellant's counsel, it cannot prove the negative, which implies that the burden is squarely on the Trade Mark's Registry to prove that it had actually served the copy of the counter of the second respondent on the appellant. And no proof was provided by the Trade Mark's Registry to sustain its contention. To state it differently, a mere statement in the official website without anything more, may not be adequate to establish the correctness of the statement made in the official website. Ideally, the Trade Mark Registry should have filed the copy of the very email through which the copy of the counter was said to have been served on the appellant, as earlier stated, this was not filed.

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5. The conclusion is to state the obvious. The order of the first respondent declaring that the appellant had abandoned its opposition cannot be sustained. Accordingly, the same is set aside and the matter is remanded back to the Trade Marks Registry for denovo consideration. Here it may have to be said that a mere fact that a petition for rectification of registration could be filed by itself is not an answer when the procedural violation involving violation of principle of natural justice is noticed. No costs.

15.02.2024

ds

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

To:

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Trademarks Registry
Intellectual Property Building
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Tamil Nadu.

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N.SESHASAYEE, J.
ds

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