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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 08.01.2024

CORAM : JUSTICE N.SESHASAYEE

(T) CMA(TM) No.67 of 2023
(OA/4/2018/TM/CH)

Lupin Limited
Kalpataru Inspire
III Floor, Off Western Express Highway
Santacruz (East)
Mumbai - 400 055. ..... Appellant

Vs

1.The Registrar of Trade Marks
The Trade Marks Registry
Boudhik Sampada Bhawan
G.S.T.Road, Guindy
Chennai - 600 032.

2.Mukesh Kumar P. ..... Respondents

Prayer : Transferred Civil Miscellaneous Appeal filed to set aside the impugned order dated 05.04.2017 passed by the respondent No.1 treating the opposition No.833687 to Application No.2006880 of the respondent No.2; (b) to pass an order directing the respondent No.1 to serve a copy of the counter statement purportedly filed by respondent No.1 upon the appellant under the provisions of Section 21(3) of the Act read with Rule 49(1) of the Rules.

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For Appellant : Mr.Thriyambak J.Kannan
for M/s.Khaitan and Co.

For Respondents : No appearance

JUDGMENT

The appellant herein has approached this Court with this appeal, as it felt aggrieved by the impugned proceedings of the first respondent dated 05.04.2017, in which it was held that the appellant had been abandoned of its opposition to the registration of a mark for which the second respondent herein has made an application.

2. The issue falls in a very narrow compass :

(a) The second respondent had filed its application under Class 5 to register its mark "KIDCEF". Necessary publications were made, in response to which, the appellant herein came out with its opposition dated 01.06.2015, under Section 21(1) of the Act.

(b) According to the appellant, it has registered as many as 11 trade

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marks under Class 5 for its pharmaceutical products, all of which words "CEFF". Indeed one of the mark it has registered is "CEFFKID". In other words, the word "CEFF" is common to all its registered trade marks.

(c) This apart, it has also filed two more applications for registering two other marks with similar word "CEFF", and they are stated to be pending registration at the time when the opposition was filed.

(d) The first respondent vide its impugned order states that since the appellant has not produced any evidence to support his opposition, and since he has not complied with the requirements of Rule 50(1) of the Trade Marks Rules 2002, within the extended time limit of three months, its opposition is deemed to have been abandoned.

3. The learned counsel for the appellant submitted, when once an opposition is filed under Section 21(1) of the Act, the same is required to be served by the Registrar on the applicant under Sec.21(2) of the Act read with Rule 47. And Sec.21(2) mandates that on receipt of the notice of opposition, the

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applicant is required to file his counter statement, and in terms of Sec.21(3) read with Rule 49, the Registrar is required to serve the copy of the counter statement on the one who opposes the registration of the trade mark. However, no copy of the counter statement of the applicant was ever served on the appellant. Now unless this step is crossed, there is no need for the appellant to produce evidence under Rule 50.

4. The Registrar of Trade Marks, the first respondent herein has been served with a notice, and so was the applicant before the Registrar, but neither chose to appear and defend this appeal.

5. The submissions of the counsel for the appellant makes considerable sense. After all, the need for production of evidence in support of an assertion in an enquiry arises only when there is a dispute. This dispute is raised only when a counter statement is filed by the applicant. Now if the counter statement had not been filed by the applicant, then it must be held that the applicant has abandoned his application and it shall not be let to reflect on the appellant.

6. In view of the same, this Court is constrained to allow this appeal, set aside

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the impugned order of the first respondent, and remands the matter back to him to pass such orders which the Trade Marks Act mandates. No costs.

08.01.2024

Index : Yes / No
ds

To:

The Registrar of Trade Marks
The Trade Marks Registry
Boudhik Sampada Bhawan
G.S.T.Road, Guindy
Chennai - 600 032.

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N.SESHASAYEE.J.,

ds

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