

**(2021) 02 IPAB CK 0007**

**Intellectual Property Appellate Board, Delhi Registry Cum Bench**

**Case No:** Original Application No. 29 Of 2018/TM/DEL

Richter-India Pvt. Ltd.

APPELLANT

Vs

Registrar Of Trade Marks

RESPONDENT

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**Date of Decision:** Feb. 9, 2021

**Acts Referred:**

- Trade Marks Act, 1999 - Section 9, 11, 57(4), 91, 128, 131
- Trademark Rules, 2017 - Rule 14, 18, 100

**Hon'ble Judges:** Lakshmidevi Somanath, Technical Member; Makyam Vijay Kumar, Technical Member; Manmohan Singh, J

**Bench:** Full Bench

**Advocate:** Ajay Shani, Rakesh Tiwari

**Final Decision:** Allowed

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**Judgement**

1. The present Appeal is filed under Section 91 against the Order dated 04/10/2018 passed by the Respondent No.1 in the matter of Cancellation of

Registered Trademark No.2412753 in class 19 pursuant to the notice under Section 57(4) of Trademarks Act, 1999 (â€œThe Impugned Orderâ€).

2. The Appellant states that this application was filed on 17thOctober2012 claiming prior usage of the mark since 18th June 2012. The Application was processed and a Registration Certificate was issued on 17th August 2016.

3. The Appellant submits that it had filed an infringement suit against the Respondent No.2 and others based on its earlier Registered mark in the year

2017 bearing TM 100/2017 for infringement and passing off in Court of Additional District Judge, South East District, Saket Courts, New Delhi. In the

said suit the interim application has been part heard as on 16/11/2017.

4. The Appellant submits that the Respondent No.2 (Defendant) in the said suit i.e. TM 100/2017 has preferred a Rectification Application with the

Respondent No.1 on 20/11/2017 on the grounds that the mark has been registered in violation of Section 9 and 11 of the Trademark Act, 1999.

5. The Appellant submits that post Rectification Application filed by the Respondent No.2, the interim application in the said suit has been heard on

23/11/2017 and a detailed speaking order were passed on 8th December 2017 granting injunction against the Respondent No.2 and others in the said

suit till the final disposal of the matter.

6. The Appellant submits that Respondent No.2 on 11/05/2018 has sent intimation to the Respondent No.1 seeking an independent action for removal

of mark under Section 57(4) and to annul the Registration under Application No.2412753 in class 19.

7. The Appellant submitted that the Appellant had also filed a Contempt proceedings before the Additional District Judge, South East District, Saket

Courts, New Delhi against the Respondent No.2 who is in violation of the Injunction orders on 10/01/2018. The Appellant submits that the intimation

letter dated. 11/05/2018 sent by Respondent No.2 to Respondent No.1 for an action under Section 57(4) is a consequence of the same.

8. The Appellant submitted that in the contempt proceedings the Court of Additional District Judge, South East District, Saket Courts, New Delhi, has

passed bailable warrants against Respondent No.2 on 01/08/2018. Subsequently consequent to the orders dated 13/08/2018 and 21/08/2018 the

Respondent No.2 withdrawn its rectification application and Respondent No.1 allowed the said withdrawal.

9. The Appellant submitted that Respondent No.2 addressed a fresh letter dated 25-08- 2018 addressed to Respondent No.1 to initiate an action

against Appellant mark under provisions of Section 57(4) of the Trademark Act, 1999 and cancel the Appellant's Registered mark under

Application No.2412753 in class 19.

10. The Appellant submitted that the Respondent No.1 acting upon such letter of Respondent No.2 had issued a notice dated 27th August 2018

dispatched on 30th August 2018 to Appellant and its earlier attorney seeking to submit a reply within 30 days thereof. The Appellant states that the

said notice is not proper as it was served to earlier attorney and not the present attorney of the Appellant since the address for service of the

Appellant was already amended and taken on record as on 23rd August 2018.

11. The Appellant further submitted that the notice issued to the earlier attorney also returned back undelivered to Respondent No.1

office on 12/09/2018. However the notice addressed to the Appellant was delivered to the office of the Appellant on

08/09/2018 and the 30 day period to respond to the Notice will be expiring on 08th October 2018.

12. The Appellant submits that it had also filed a reply to the said Notice on 4th October 2018 in the office of the Respondent No.1 vide a letter dated

29th September 2018 addressed by the Appellant present counsel on record before Respondent No.1. The Respondent No.1 despite the receipt of the

reply on 04th October 2018 on the same day passed the impugned Order with completely disregarding the reply filed by the Appellant and thus

violated the principles of Natural Justice and hence the present appeal is preferred.

#### FINDING OF THIS BOARD

13. We have gone through the record before us and perused the synopses placed before us apart from the submissions made before this Board.

Further we have gone through the Counter statement and arguments of Respondent No.2 who had been impleaded in this Appeal.

14. The sum and substance of the Respondent No.2 arguments is that the Respondent No.1 had followed the due process of law in cancelling the

Registration of the Appellant and thus no appeal can be maintainable before this Board and thus prayed for dismissal of the appeal.

15. The Respondent No.2 is not connected to this appeal, however since there is a civil proceedings between Appellant and Respondent No.2, this

board impleaded Respondent No.2 and allowed filing of the Counter Statement. The Respondent No.2 further made his submission on the merit of the

matter i.e., the mark cannot be registered as it is description of goods in class 19 and forms part of NICE Classification heading itself.

16. The Respondent No.2 further stated that the Appellant despite knowledge of the notice chooses not to file the reply to the said notice; however

filed its reply on 4th October 2018 i.e., after passing the Orders in the matter at 8.13 PM late in the evening.

17. It appears to us the Conduct of the Appellant is not appropriate in filing the Reply post passing the Orders and alleging that the said reply is

disregarded while it is the matter of fact the Respondent No.1 had no knowledge or access to the reply while it was passing said orders. However as

per the law the Respondent No.1 should have waited for 30 days in passing order i.e., from 08th September 2018 till 8th October 2018 and provided

an opportunity of being heard of the Appellant before passing the impugned orders.

18. It is pertinent to provide the following provisions of law i.e., Section 128 of the Trademark Act, 1999 which read as follows: "128. Exercise of

discretionary power by Registrar." "Subject to the provisions of section 131, the Registrar shall not exercise any discretionary or other power vested

to him by this Act or the rules made thereunder adversely to a person applying for the exercise of that power without (if so required by that person

within the prescribed time) giving to the person an opportunity of being heard." and Section 57(4) which read as follows: "(4) The tribunal, of its

own motion, may, after giving notice in the prescribed manner to the parties concerned and after giving them an opportunity of being heard, make any

order referred to in sub-section (1) or sub-section (2)."

19. It is also pertinent to read Rule 14 of the Trademark Rules 2017 which read as follows: "14. Service of documents. " (1) All applications,

notices, statements, papers having representations affixed thereto, or other documents authorised or required by the Act or the rules made thereunder,

served, left or sent, at or to the Trade Marks Registry or with or to the Registrar or any other person may be delivered by hand or sent through the

post by a prepaid letter or may be submitted electronically in the manner as laid down by the Registrar. An application or any document so sent shall be

deemed to have been made, served, left or sent at the time when the letter containing the same would be delivered in the ordinary course of post. In

proving such sending, it shall be sufficient to prove that the letter was properly addressed and put into the post. After the filing of an application in the

Trade Marks Registry, any person while making any correspondence relating thereto shall furnish the following particulars, namely:â€"the application number or numbers, if any;the date and place of filing;the appropriate class or classes, as the case may be, in relation to which the application is filed;an address for communication; andthe concerned agent's code, if any, and the concerned Proprietor's code, if allotted.The Registrar after informing the public in the Journal may accept applications, notices, statements, or other documents online through the gateway provided for this purpose, or in case of documents not requiring the payment of a fee, through e-mail to a designated email address for the purpose.â€" also Rule 18 which reads as follows â€œ18. Service of Documents by the Registrar. â€" (1) All communications and documents in relation to application or opposition matter or registered trademark may be served by the Registrar by leaving them at, or sending them by post to the address for service of the party concerned or by email communication. Any communication or document so sent shall be deemed to have been served, at the time when the letter containing the same would be delivered in the ordinary course of post or at the time of sending the email. To prove such service, it shall be sufficient to prove that the letter was properly addressed and put into the post or the email communication was sent to the email id provided by the party concerned.â€" And further the Rule 100 of the Trademark Rules 2017 which read as follows: â€œ100. Rectification of the register by the Registrar of his own motion.â€" (1) The Notice, which the Registrar is required to issue under sub-section (4) of section 57, shall be sent in writing to the registered proprietor, to each registered user, if any, and to any other person who appears from the register to have any interest in the trademark, and shall state the grounds on which the Registrar proposes to rectify the register and shall also specify the time, not being less than one month from the date of such notice, within which an application for a hearing shall be made: Provided that no notice shall be required to be sent to the registered proprietor, in case the registered proprietor has requested or agreed in writing for cancellation of the registration; and thereupon register shall be rectified accordingly. (2) Unless within the time specified in the notice aforesaid, any person so notified sends to the Registrar a statement in writing

setting out fully the facts upon which he relies to meet the grounds stated in the notice or applies for a hearing, he may be treated as not desiring to

take part in the proceedings and the Registrar may act accordingly. (3) If the Registrar decides to rectify the register he shall communicate his

decision in writing to the registered proprietor and to each registered user, if any.â€

20. It is noted from the submission and the record placed before us by the Appellant that the notice letter was served only on 8th September 2018,

through the letter/notice addressed by the Respondent No.1 dated 28th August 2018 that is dispatched on 31st August 2018 from the office of the

Respondent No.1. Hence the 30 days period expires on 8th October 2018. The Order of the Respondent No.1 on 4th October 2018 is prematurely

passed without waiting for the expiry of mandatory statutory period of 30 days (one Month) as provided under Rule 100 of the Trademark Rules 2017

as well as the notice of the Respondent No.1 itself.

21. It need to be noted that Trade Marks Act 1999 is a Special Act and thus all Sections are to be applied strictly as per law stipulated in the Statue.

Under no circumstances self-made procedure and guidelines can be adopted even for the sake of earlier disposal of any matter. The interpretation of

any Section should not be misinterpreted for the sake of convenience. The Respondent being creation of the Act and constituted under the provisions

of the Act, is expected to follow the provisions of law meticulously in passing orders more specifically in consonance with Section 57(4) of the

Trademark Act, 1999, Rule 100 of the Trademark Rules 2017. Keeping in view of the same as well as the maxim ""Sublato Fundamento Cadit Opus"" (a

foundation being removed, the superstructure falls) the impugned orders are liable to be interfered/set aside by this Board.

22. We have no doubt that a proper notice was served on Appellant herein. The moot point, however, remains as to why the Respondent No.1 has not

waited 30 daysâ€™ time stipulated under law for Appellant to respond to such a notice. We failed to understand as to why the Respondent No.1

expedited the entire process in passing the impugned order prematurely. An opportunity of hearing is not a mere nicety but a valuable right of the

Appellant and upheld by various courts of law. We do feel that there was an endeavor to some extent by the Appellant (though after passing Orders)

in contesting the matter by filing its reply and thus proper adjudication of the matter is required.

23. Apart from the statutory provision narrated supra, an administrative/quasi-judicial order which involves civil consequences must be made consistently with the rule expressed in the Latin Maxim Audi Alteram Partem. It means that the decision maker should afford to any party to a dispute an opportunity to present his case which seems to be denied in the present case. A large number of authorities are on this point and we will not travel over the field of authorities. What is now not in dispute is that the person concerned must be informed of the case against him and the evidence support thereof and must be given a fair opportunity to meet the case before an adverse decision is taken against him. Thus Respondent No.1 should allow the Appellant to file its reply, take the same into record and hear him before passing any orders.

24. We are not inclined to go into the merits as we are fairly satisfied that the Appellant did not have an effective opportunity to state his objections and sustain his case. When it comes to the question of appreciation of rights and obligations of parties, equity and justice interfere and compel courts to afford a reasonable and effective opportunity to persons aggrieved and affected to state their objections

25. Needless to say, if Respondent No. 2 herein is aggrieved by the continuation of Registration of the mark to the Appellant, the remedy against the same lies before the IPAB in a Rectification Proceedings. We make it clear that all pleas as raised by Respondent No. 2 herein would be considered by us legal or factual in such proceeding if instituted by Respondent No.2. However we are constrained that under the present appeal we cannot entertain such pleas which are beyond the scope of the present appeal.

26. In light of the aforesaid discussion and taking into consideration of the same, the Appeal is hereby allowed. Impugned order dated 04.10.2018 passed by Respondent cancelling Registration of the Appellant under Application No.2412753 in class 19 is set aside. The matter is thus remanded back to Respondent which shall decide the said Application by giving opportunity to the Appellant in accordance with law. Let a notice be issued

afresh to the Appellant to enable them to appear and make its submissions and let orders be passed accordingly considering the submissions of the

Appellant. A copy this order is directed to be sent to Respondent No.1 for immediate implementation of this order. There is no order regarding costs.