

INTELLECTUAL PROPERTY APPELLATE BOARD

Guna Complex, Annexe-1, 2nd Floor, 443 Anna Salai, Teynampet,
Chennai-600018

OA/44/2008/TM/CH

FRIDAY, THIS THE 4TH DAY OF SEPTEMBER, 2009

Hon'ble Shri Z.S. Negi
Hon'ble Shri Syed Obaidur Rahaman

Chairman
Technical Member

Bayer AG,
A German company,
D-51368,
Leverkusen,
Germany.

Appellant

(By Advocate Shri A.Vijay Anand)

Vs.

Deputy Registrar of Trade Marks,
Trade Marks Registry,
IP Building, G. S.T. Road,
Guindy,
Chennai-600 032.



Respondent

(By Advocate- None)

ORDER No 153/09

Hon'ble Z.S. Negi, Chairman:

The appellant has filed the above appeal under section 91 of the Trade Marks Act, 1999 (hereinafter referred to as the Act) against the order dated 14.2.2008 passed by the Deputy Registrar of Trade Marks, Chennai dismissing the application for registration of trade mark.

2. Bayer AG, one of the largest German companies operating in the pharmaceutical field, filed an application No.1335868 on 2.2.2005 for registration of trade mark ODESI in class 05 in respect of preparations for

killing weeds and destroying vermin, insecticides, herbicides, fungicides. The application was officially examined on 29.3.2005 and the examiner raised objection under section 11 of the Act and the same was intimated to the appellant. The appellant filed the reply to the examination report on 30.5.2005 and the application was set down for a personal hearing on 19.6.2007. Thereafter, the appellant requested for some time to submit co-existence agreement and the hearing was accordingly posted for 12.11.2007. In the meantime co-existence agreement between the appellant and BASF Agrochemical Products B.V. was entered into on and a copy thereof submitted to the Trade Marks Registry.

3. It is stated that the Deputy Registrar of Trade Marks did not accept the co-existence agreement and refused to accept the application to proceed further and the application was refused. The respondent's non-speaking order dated 20.11.2007 refusing the application for registration was received by the appellant. The appellant filed Form TM-15 asking for the grounds of decision and the respondent has stated the grounds of refusal vide order dated 14.2.2008.

4. Aggrieved by the impugned order, the appellant has preferred this appeal on the following grounds:-

- (i) that the respondent erred in rejecting the application without giving the applicant an opportunity of being heard further; which is in violation of the principles of natural justice;
- (ii) that the respondent failed to take on record the co-existence agreement between the appellant and BASF Agrochemical Products B.V. which if taken on record, the mark would have proceeded to advertisement in the Trade Marks



Journal and thereafter resulted to acceptance as the owner of the cited trade mark itself has willingly given the agreement so that both the trade marks can co-exist in the Register of Trade Marks;

(iii) that the respondent erred in not taking on record the document filed by the appellant;

(iv) that the respondent's order is in violation of established principles of law, judgments and provisions of the Act;

(v) that the respondent erred in not allowing the application to proceed to advertisement.



5. During the course of hearing the learned counsel for the appellant mainly submitted that the conflicting mark cited by the examiner is no longer a bar for registration of the mark applied for by the appellant as the registered proprietor of the cited trade mark (BASF Agrochemical Products B.V.) and the appellant have entered into a co-existence agreement and the respondent has refused to accept the said agreement. In the said agreement, the appellant has undertaken to restrict their trade mark in respect of herbicides in class 05 and such a registration is legally valid in the light of the decision of the Apex Court in **Vishnudas trading as Vishnudas Kishendas v. Vazir Sultan Tobacco Co. Ltd., 1996 (16) PTC 512 (SC)**. He further submitted that the respondent ought to have given an opportunity to the appellant to be heard before rejecting the application. By not affording an opportunity to be heard to the appellant, the principles of natural justice have been violated by the respondent.

6. We have heard learned counsel for the appellant and perused the records on file. The examiner has in his examination report cited three registered trade marks and/or prior pending trade marks application,

namely, ODESEY, ODISI and ODYSSEY, all in class 05, which are identical with or deceptively similar to the mark applied for by the appellant. In order to meet the examination report, the appellant has entered into a co-existence agreement with the registered proprietor of trade mark ODYSSEY and it is evident from Annexure D-12 that a copy of such agreement was forwarded to the respondent by the appellant by its letter dated 14.9.2007 with a request to allow the application to proceed further. The respondent has not mentioned this fact in his impugned order and as such not at all taken into consideration. A copy of the said agreement forwarded to the respondent in September 2007 was with the office of the respondent till the day of passing the impugned order. What prompted the respondent to ignore the said agreement or on what reasons he has refused the agreement to take on record to deal with it is best known to him only. While overlooking the existence of the said copy of agreement, he has arrived at the conclusion that the impugned mark directly conflicts with the cited registered trade mark No. 1264063 (ODYSSEY) in class 5 for same and similar specification of goods and accordingly the objection raised by the Registry of Trade Marks Chennai in the examination report is refused keeping in view the bar placed to its registration under section 11 of the Act. The respondent has not given his findings on the other two conflicting marks cited in the examination report. No appellate authority can afford to sustain an order passed in such a slipshod manner by the Registrar as a tribunal. We are of the considered view that the order appealed against deserves to be set aside on this ground alone and we need not advert to the applicability or otherwise of the cited decision of the Hon'ble Apex Court.



7. The impugned order dated 14.2.2008 passed on application No.1335868 in class 05 by the respondent is set aside and we direct the

Registrar of Trade Marks to advertise the application and then decide the application, by taking the into consideration the aforementioned co-existence agreement, in accordance with law. The appeal is disposed of in the above terms. There shall be no order as to costs.

Sd/-

(Syed Obaidur Rahaman)
Technical Member

Sd/-

(Z. S. Negi)
Chairman

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Vvrk



Deputy Registrar
Intellectual Property Appellate Board
Chennai - 18

