
Intellectual Property Appellate Board (IPAB) reprimand Assistant Registrar for Cryptic order in an opposition case

The observation was made in an opposition case concerning the mark NOMEX that was applied for registration by Galpha Laboratories, Mumbai (Galpha) in class 5. The mark on its publication was opposed by E.I. DuPont De Nemours & Company (Du-Pont) on the basis of its prior adoption and use of the mark NOMEX. The opposition was dismissed on the ground that a) Galpha had made a search of the records of the Trademark Registry for the trademark "NOMEX" b) conducted a survey in the market for medicinal products and there was no conflicting trademark in Class 5. Further, The Assistant Registrar held no confusion will be caused by use of the mark NOMEX in class 5.

DuPont's in its Appeal raised the following contentions:

The Assistant Registrar failed to appreciate:

- use of its trademark "NOMEX" in the international market since 1963 and in India since 1984.
- that the trademark adopted by Galpha was identical to DuPont's mark and they are the prior adopter and user in India.
- Galpha's mark is 'proposed to be used' and is yet to use the mark.

The Assistant Registrar erred:

- in holding that Galpha's use of the mark will not cause confusion and deception
- in disallowing opposition of the DuPont and further erroneously used his discretionary power under section 18(4) of the Act, which is contrary to principles of law.

Galpha in turn made the following contentions:

- They had taken care and adopted the NOMEX mark as there was no prior use of the trademark in the pharmaceutical industry.
- Galpha conceived and coined the trademark "NOMEX" for use in respect of medicinal and pharmaceutical preparations falling in Class 5.

IPAB allows DuPont Appeal and makes the following observations:

The Assistant Registrar has rendered a short cryptic order without assigning cogent reasons. Further, the order does not disclose on what grounds or on what material record Assistant Registrar has allowed the registration to proceed by rejecting the contentions of the Du Pont/opponent. Moreover, the order of the Assistant Registrar does not disclose any judicious reasoning while exercising his discretionary power vested with him under section [18](#) of the Act for granting the registration to Galpha.

In light of the above discussion, the IPAB was of the view that the impugned order was passed in gross violation of principles of natural justice. Therefore, the IPAB proceeded to set aside the impugned order and directed the Assistant Registrar of Trade Marks, Mumbai to consider the matter afresh by affording opportunity to both parties to present their arguments. IPAB further directed opposition to be decided after hearing parties within a period of three months.

Vatika Towers
10th Floor Block-B
Sector-54
Gurgaon-122002
National Capital Region (Haryana)
India

Tel. +91 124 4655999
Fax. +91 124 4045047
Email info@rnaip.com

Copyright © RNA, IP Attorneys