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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

+ C.A.(COMM.IPD-TM) 143/2022 & I.A. 4245/2023

MAHESH GUPTA Appellant

Through: Ms. Rajeshwari H. and
Ms.Swapnil Gaur, Advs.

versus

REGISTRAR OF TRADEMARKS AND ANR Respondents

Through: Ms. Swathi Sukumar, Mr.
Naveen Nagarjuna, Mr. Pratyush Rao and
Mr. Ritik Raghuvanshi, Adv. for R-2

CORAM:

HON'BLE MR. JUSTICE C. HARI SHANKAR

J U D G M E N T (O R A L)

% **02.03.2023**

1. On 28th April 1998, Respondent 2 filed Application No. 800324 for registration of the device mark  under class 32 in respect of “non-alcoholic drinks and beverages aerated water, beer and porter, syrups for making beverages essences”.

2. On 15th September 2006, the appellant filed an opposition under Section 21 of the Trade Marks Act 1999, opposing the request of Respondent 2 for registration of the aforesaid device mark. Notice on the opposition was served on the Respondent 2, who filed a counter statement by way of response to the opposition on 15th April 2008. The date on which the counter statement was served on the appellant is not immediately forthcoming. However, it is not in dispute that the appellant filed its evidence in support of the opposition under Rule

50(1)¹ of the Trade Marks Rules 2002 (hereinafter referred to as “the 2002 Rules”), on 10th June 2010. On 11th June 2010, the appellant filed an application for extension of time in filing the evidence in support of the opposition. In the application, it was acknowledged that the evidence was filed after a delay of four months, for which extension was sought in the application.

3. By the following order dated 7th August 2019, the Deputy Registrar of Trade Marks held the opposition filed by the appellant to be deemed to have been abandoned under Rule 45(2)² of the Trade Marks Rule 2017 (hereinafter referred to as “the 2017 Rules”) and directed that the application would proceed further as per rules.

4. Aggrieved thereby, the appellant has preferred the present appeal under Section 91 of the Trade Marks Act before the learned Intellectual Property Appellate Board (“the learned IPAB”). Consequent to abolition of the learned IPAB by The Tribunals Reforms Act 2021, the appeal stands transferred to this Court.

5. Pleadings in the appeal have been completed and I have heard Ms. Rajeshwari H., learned Counsel for the appellant and Ms. Swathi Sukumar, learned Counsel for the Respondent 2 at length on the appeal.

6. Though there are certain averments in the appeal regarding the

¹ 50. **Evidence in support of opposition.**— (1) Within two months from services on him of a copy of the counterstatement or within such further period not exceeding one month in the aggregate thereafter as the Registrar may on request allow, the opponent shall either leave with the Registrar, such evidence by way of affidavit as he may desire to adduce in support of his opposition or shall intimate to the Registrar and to the applicant in writing that he does not desire to adduce evidence in support of his opposition but intends to rely on the facts stated in the notice of opposition. He shall deliver to the applicant copies of any evidence that he leaves with the Registrar under this sub-rule and intimate the Registrar in writing of such delivery.

² 45. **Evidence in support of opposition.**— (2) If an opponent takes no action under sub-rule (1) within the time mentioned therein, he shall be deemed to have abandoned his opposition.

merits of the respondent's application seeking registration of the  device mark and on the merits of the appellant's opposition to such registration, I do not deem it necessary to enter into the merits of the matter, as the appellant's objection was rejected by the learned Deputy Registrar as abandoned. All that this Court has to see, therefore, is whether the learned Deputy Registrar was correct in her decision to treat the appellant's opposition to the application of Respondent 2 as abandoned.

7. I may observe, at the very outset, that the learned Deputy Registrar has formally erred in law in passing the impugned order under the 2017 Rules. All proceedings before the learned Deputy Registrar, save and except for the passing of the impugned order, on 7th August 2019, took place when the 2002 Rules were in force. The application seeking registration, the opposition thereto, the counter statement filed by way of response to the opposition and the filing of the evidence in support of the opposition by the appellant along with the application seeking condonation of delay, were all prior to coming into force the 2017 Rules; in fact, much prior thereto.

8. Rule 158³ of the 2017 Rules, even while repealing the 2002 Rules, clearly holds that such repeal would be “without prejudice to anything done under such rules before the coming into force of these rules”. In other words, the repeal of the 2002 Rules by the 2017 Rules would, *inter alia*, be without prejudice to all proceedings which took place in the present case, including the filing of the evidence in support of the opposition by the appellant which, admittedly, was

³ 158. **Repeal.**— The Trade Marks Rules, 2002, are hereby repealed without prejudice to anything done under such rules before the coming into force of these rules.

under Rule 50(1) of the 2002 Rules. The repeal of the 2002 Rules by the 2017 Rules cannot, therefore, prejudice the applicability of the 2002 Rules, insofar as the issue of whether the evidence filed by the appellant under Rule 50(1) of the 2002 Rules could be taken on record, is concerned.

9. The dispute has, therefore, to be examined in the light of Rule 50(1) of the 2002 Rules. What has to be seen, therefore, is whether the opposition of the appellant could be treated as having deemed to have been abandoned by applying Rule 50(1) of the 2002 Rules.

10. A coordinate Single Bench of this Court of Hon'ble Mr. Justice Budar Durrez Ahmed, as he then was, has examined this aspect in detail in *Sunrider Corporation, U.S.A. v. Hindustan Lever Ltd*⁴. The relevant passages from the said decision may be reproduced thus:

“8. Reading Rule 50, it is clear that the evidence by way of affidavit in support of an opposition to the registration of a trade mark has to be filed within two months of the service of a copy of the counter-statement on the opponent. This period of two months is further extendable by a period of one month in the aggregate thereafter as the Registrar may on request allow. Clearly, in the first instance, the evidence affidavit has to be filed within two months of the receipt of a copy of the counter-statement. The Registrar may extend this period by a further one month in the aggregate if a request for the same is made in time. Sub-rule (2) of Rule 50 makes it clear that if an opponent takes no action under Sub-rule (1) within the time mentioned therein, he shall be deemed to have abandoned his opposition. It is also interesting to note that Sub-rule (3) refers to the application for extension of the period of one month mentioned in Sub-rule (1). It is also stipulated that such an application has to be made in Form TM-56 accompanied by the prescribed fee before the expiry of the period of two months mentioned therein. So, it is clear that a strict regimen has been prescribed for the filing of evidence by way of affidavit in support of an opposition. A plain reading of the provisions makes it abundantly clear that the evidence has to be filed within two

⁴ (2007) 143 DLT 148

months in the first instance and, if an appropriate application for extension of time is made before the expiry of the period of two months and if such application is allowed by the Registrar, then latest by a further month. *In other words, under no circumstances can the evidence affidavit be filed beyond the maximum three months prescribed under the said rule. In case the opponent has not taken steps within the prescribed time, then there is no option left with the Registrar but to deem that the opponent has abandoned his opposition.*”

(Emphasis Supplied)

11. Ms. Rajeshwari seeks, however, to distinguish the decision in *Sunrider*⁴ essentially on two grounds. She relies, in the first instance, on the judgment of a learned Single Judge of the High Court of Gujarat in *Wyeth Holdings Corpn. v. Controller General of Patents, Designs and Trade Marks*⁵, which holds, in paras 58 to 60 thus:

“58. In view of the nature of the prayer sought for, there is no question of any alternative remedy being available to the petitioners. Having found the submissions made by the learned senior counsel appearing for the petitioners with substance, the same are accepted. There is no question of the petition being dismissed on the ground of alternative remedy being available.

59. In view of the aforesaid discussion, in view of the settled legal position that subordinate legislation cannot travel beyond the scope of main legislation and having regard to the provisions of Section 131 which provides for extension of time, this Court has only two options, either to declare Sub-rule (2) of Rule 50 as ultra virus the Act or by employing principle of 'harmonious construction', to read Sub-rule (2) of Rule 50 to be a 'directory' one.

60. In the considered opinion of this Court, there is no reason much less a compelling reason for which the first option should be exercised and the 'Rule' be struck down by holding it to be 'mandatory'. As against that, it is a well settled position of law that principle of 'harmonious construction' should be pressed into service and Sub-rule (2) of Rule 50 be read as 'directory'. This Court is of the opinion that by declaring Sub-rule (2) of Rule 50, 'directory', no injustice or prejudice is going to be caused to any party. On the contrary, it will be serving the interest of justice. Hence, second option is exercised. Sub-rule (2) of Rule 50 is held to be 'directory' in nature.”

⁵ 2006 SCC OnLine Guj 620

12. *Wyeth*⁵, she submits, was not noticed in *Sunrider*⁴.

13. With greatest respect, I am unable to subscribe to the view expressed by the High Court of Gujarat in *Wyeth*⁵.

14. To my mind, the view espoused in para 60 of the decision in *Wyeth*⁵, if accepted, would amount to no less than re-writing of the applicable statutory provisions. Rule 50(1) of the 2002 Rules is even more preemptory, in its application, than Rule 48 of the succeeding 2017 Rules. While providing a period of two months to an opponent opposing an application seeking registration of a trade mark file its evidence after receipt of the counter-statement of the applicant, Rule 50(1) empowers the Registrar to extend the said period only upto one month, specifically using the words “not exceeding one month”. The words “not exceeding one month” are mandatory in their import. The learned Registrar could not, therefore, grant extension of more than one month beyond the period of two months from the date of service, on the opponent opposing the registration of a mark, of a copy of the counter statement. Grant of any further extension would clearly be in the teeth of Rule 50(1).

15. Rule 50(2) is even clearer in its import. It states, in unambiguous terms, that, if the opponent took no action under Rule 50(1) within the time period mentioned therein – meaning two months extendable by a maximum period of one month – he shall be deemed to have abandoned his opposition.

16. *Deemed abandonment of the opposition, therefore, follows as an inexorable statutory sequitur to the failure, on the part of the*

opponent, in filing the evidence in support of the opposition within the period envisaged in Rule 50(1). Deemed abandonment, therefore, occurs by operation of the statute. Even sans any judicial or quasi-judicial order, therefore, if the opponent opposing the application seeking grant of the trade mark fails to file its evidence in support of the opposition within a maximum of three months from the receipt, by it, of the counter-statement of the trade mark applicant, the opposition would ipso facto be deemed to be abandoned irrespective of whether any order to that effect is, or is not, passed by any judicial or quasi-judicial forum.

17. The view expressed in *Wyeth*⁵, if accepted, would amount to rendering largely otiose Rule 50(2) of the 2002 Rules. With respect, therefore, it is not possible to accept the said view.

18. Ms. Rajeshwari also sought to place reliance on Rule 105⁶ of the 2002 Rules read with Section 131⁷ of the 1999 Act.

19. Though these provisions have been considered by the coordinate Bench in *Sunrider*⁴, Ms. Rajeshwari advances a submission which, according to her, was not advanced in *Sunrider*⁴ and was not, therefore, considered. She draws attention to the

⁶ 105. **Extension of time.**— (1) An application for extension of time under Section 131 (not being a time expressly provided in the Act or prescribed by Rule 79 or by sub-rule (4) of Rule 80 or a time for the extension of which provision is made in the rules) shall be made in Form TM-56.

(2) Upon an application made under sub-rule (1) the Registrar, if satisfied that the circumstances are such as to justify the extension of the time applied for, may, subject to the provisions of the rules where a maximum time limit is prescribed and subject to such conditions as he may think fit to impose, extend the time and notify the parties accordingly and the extension may be granted though the time for doing the act or taking the proceeding for which it is applied for has already expired.

⁷131. **Extension of time.**— (1) If the Registrar is satisfied, on application made to him in the prescribed manner and accompanied by the prescribed fee, that there is sufficient cause for extending the time for doing any act (not being a time expressly provided in this Act), whether the time so specified has expired or not, he may, subject to such conditions as he may think fit to impose, extend the time and inform the parties accordingly.

(2) Nothing in sub-section (1) shall be deemed to require the Registrar to hear the parties before disposing of an application for extension of time, and no appeal shall lie from any order of the Registrar under this section.

parenthesized words in Rule 105(1) reading “not being a time expressly provided in the Act or prescribed by rule 79 or by sub-rule (4) of rule 80 or a time for the extension of which provision is made in the rules”. According to Ms. Rajeshwari, the import of the afore-extracted parenthesized words in Rule 105(1) was to restrict the inflexibility of the provision only to cases where the time was provided in the Act or prescribed by Rule 79 or Rule 80(4).

20. The submission is obviously unacceptable, as the parentheses also include the words “or a time for the extension of which provision is made in the rules”. As already noted, Rule 50(1) provides for extension of time and curtails the maximum period by which such extension could be granted to one month. The provision for extension of time as contained in Rule 50(1), therefore, rules out the applicability of Rule 105 to the facts of the present case.

21. On all other aspects, the coordinate Bench in *Sunrider*⁴, having examined the issue in law in detail, this Bench does not deem it necessary to reinvent the wheel. I express my respectful concurrence with the views expressed in the passages from *Sunrider*⁴ extracted hereinabove which, unfortunately for the appellant, cover the case against it on all fours.

22. I see no reason, therefore, to differ with the ultimate decision, of the Deputy Registrar, to deem the opposition of the appellant as having been abandoned. The deemed abandonment would, however, be under Rule 50(1) of the 2002 Rules, and not Rule 45(1) of the 2017 Rules.

23. Subject to that modification, the impugned order dated 7th August 2019 is, therefore, upheld.

24. The appeal is dismissed.

C. HARI SHANKAR, J.

MARCH 2, 2023

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