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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**
Reserved on: 8th December, 2023
Date of Pronouncement: 9th February, 2024
+ **C.A.(COMM.IPD-TM) 146/2022**

SUN PHARMA LABORATORIES LTD. Appellant

Through:

versus

DABUR INDIA LTD. & ANR. Respondents

Through:

For the parties:

Mr. Sachin Gupta, Ms. Jasleen Kaur, Ms. S. Meena, Ms. Yashi Agrawal & Ms. Oshmi Jaishshreel, Advocates (M-9811180270)

Mr. Manish Kumar Mishra, Ms. Akansha Singh & Mr. Vatsalya Vishal, Advocates for R-1 (M-9438804704)

Mr. Harish Vaidyanathan Shankar, CGSC with Mr. Srish Kumar Mishra, Mr. Alexander Mathai Paikaday & Mr. Krishnan V, Advocates

Advocates assisting the Court:

Mr. Pravin Anand, Mr. Saikrishna Rajagopal, Mr. Sushant Singh, Ms. Rajeshwari, Mr. Rahul Vidhani.

CORAM:

JUSTICE PRATHIBA M. SINGH

JUDGMENT

Prathiba M. Singh, J.

1. This hearing has been held through hybrid mode.
2. The present appeal has been filed by the Appellant – Sun Pharma Laboratories Ltd. under Section 91 of the Trade Marks Act, 1999 (hereinafter, ‘the 1999 Act’) challenging the order passed by the Trade Marks Registry



dated 21st July, 2022 dismissing Opposition No. 204995 of the Appellant/Opponent (hereinafter, '*Appellant*') under Section 21 of the 1999 Act. The Opposition was filed against trade mark application no.1309040 of Respondent No.1/ Applicant (hereinafter, '*Respondent No.1*') for the mark 'DABURGLUCORID KP (Label)' in class 5.

3. Vide the said order, the extension of time sought by the Appellant for taking the evidence on record under Rule 50(3) of the Trade Marks Rules, 2002, (hereinafter, '*2002 Rules*'), after delay in service of evidence to the Respondent No.1, was rejected by the Registrar of Trade Marks. In effect the Opposition was deemed to have been abandoned under Rule 50(2) of the 2002 Rules.

4. The legal issue that has arisen for consideration in the present appeal is as to whether the time limit for filing of evidence in support of Opposition to trade mark can be extended beyond the period prescribed in Rule 50 of the 2002 Rules.

5. The Appellant in the present appeal is the proprietor of the mark 'GLUCORED' under no. 681897 in class 5 since 1995. It is stated that the Appellant's mark continues to be valid, subsisting and is renewed up to 28th September, 2025. The same can be viewed on the Trade Marks Registry website. The Appellant is stated to have filed other Opposition proceedings against the same Respondent which subsisted and Opposition was granted in favour of the Appellant.

6. In the present appeal, the counter statement was served on the Opponent/ Appellant on 12th June, 2007. This position is not disputed by either of the parties. Evidence in Opposition was filed by the Opponent with the Trade Marks Registry on 10th August, 2007 (limitation of 2 months was



to expire on 13th August, 2007). The error / lapse on behalf of the Appellant was that before filing the hard copy of the evidence in support of the opposition in the Trade Marks Registry, a copy of the same was not served on the Respondent No.1 within the prescribed time. The same was only served via courier on 14th August, 2007 and received by the Applicant on 16th August, 2007 (delay of 3 days).

7. The Respondent No.1 then sought an extension of one month by filing the form TM-56 on 16th October, 2007 to file its evidence. However, no evidence was filed. The Appellant then wrote a letter dated 30th January, 2008 to the Registrar of Trade Marks that despite service of evidence under Rule 50 of the 2002 Rules, the evidence under Rule 51 of the 2002 Rules was not filed by Respondent No.1. Subsequently, the Appellant submitted a letter dated 15th February, 2008 to the Registrar of Trade Marks to close the evidence and put the matter for hearing. However, there was no communication from any party. On 14th August, 2017, after a lapse of almost nine years, the Appellant again wrote a letter to the Registrar of Trade Marks informing the Registry of the status of the case- i.e., pendency of Opposition. The Appellant in the said letter requested the Registrar of Trade Marks to close the evidence and fix the matter for hearing.

8. The matter was then listed for hearing. During course of the hearing, Respondent No.1 took an objection that Rule 50 evidence as per the 2002 Rules was filed belatedly, as it was sent to the Respondent No.1 one month late. This submission was accepted by the Registrar, who then held as under:

“Proceedings have taken place under Section 21 of the Trade Mark Act, 1999, by the above named opponent to oppose the registration of the trade mark applied for by the above named applicant and whereas Mr. Kanv



Saggar, Legal Executive of the applicant, appeared for the applicant as constituted attorney. Ms. Swati Meena (Adv.) Appeared for the opponent.

The Ld. constituted attorney for the applicant submits that the Opponent has not complied with the evidence U/R 50(1), of the Trade Mark Rules, 2002 within prescribed time although the opponent opposed instant application. Hence, evidence in support of opposition filed by the opponent is time barred.

The applicant filed counter statement on 04.08.2006 and copy thereof was served to the opponent under section 21 of the Trade Marks Act, 1999 to be read with Rule 50 of the Trade Marks Rules, 2002, on dated 08.06.2007 by the registry.

Ld. Counsel for the opponent submits that the opponent on 12.06.2007 received the counter statement. Thereafter, the Opponent filed evidence in support of its opposition U/R 50(1), vide letter dated 08.08.2007 on 10.08.2007, which was dispatched to the applicant on 14.08.2007. which is beyond the prescribed time as per the Rules.

The Ld. constituted attorney for the applicant submits that the applicant received the evidence in support of opposition on 16.08.2007. That opponent's time to serve the same upon the applicant was on or before 12.08.2007. Thus, evidence in support of opposition filed by the opponent being time barred, opposition be treated as abandoned.

It is, therefore, in my opinion it is a fit case to proceed further under rule 50 (2) of the Trade Mark Rules, 2002. That opponent has filed a TM-M dated 20.07.2022 08:26 PM on 21.07.2022 seeking extension of time for filing of evidence under Rule 50 from 12.08.2007 to 12.09.2007. This has been filed after almost 15 years. Hence, it cannot be allowed in view of Rule 50(3) of the Rule 2002.

In view of the above said facts, It is hereby ordered that



the Opponent shall be deemed to have been abandoned his opposition. Resultantly, the opposition no.204995 is treated as abandoned and application no.1309040 shall proceed further as per law.

IT IS HEREBY FURTHER ORDERED that there shall be no order as to cost of these proceedings.”

This said order dated 21st July, 2022 is under challenge in the present appeal.

9. In the opinion of the Court, the present appeal raises an important question as to the time limit within which evidence is to be filed in Opposition proceedings before the Trade Marks Registry. As per Section 21(1) of the 1999 Act, the time limit for opposing a trade mark which is advertised is clearly prescribed as four months from the date of advertisement. As per Section 21(2) of the 1999 Act, upon the statement of opposition being served to the Applicant of the mark, the counter-statement has to be filed by the Applicant within two months from the receipt of the notice of Opposition.

10. Further, Section 21 of the 1999 Act contemplates filing of evidence by the Opponent and the Applicant. However, the time limit for filing of evidence is not prescribed in the 1999 Act and the same is laid down in the corresponding 2002 Rules. Rule 45 of the Trade Marks Rules, 2017 (hereinafter, '2017 Rules'), which are currently in force, requires the Opponent to file evidence by way of affidavit within two months from the service of the copy of the counter-statement. On the other hand the position under Rule 50 of the erstwhile 2002 Rules was that apart from the two-month period, an extension of one month could be granted by the Registrar if the same was sought under Form TM-56 in terms of Rule 50(3) of the 2002 Rules. The corresponding provision in 2017 Rules, i.e., Rule 45, however, has



omitted the one-month extension period. As per Rule 46 of the 2017 Rules, evidence has to be adduced by the Applicant within two months from the receipt of the evidence of the Opponent. Under Rule 47 of the 2017 Rules, within one month of receipt of evidence by the Applicant, the evidence in reply has to be filed by the Opponent. Under Rule 48 of the 2017 Rules, further evidence can be entertained if leave is sought by either of the parties. This is usually done, as per the practice of Registrar of Trade Marks, by filing of an Interlocutory Petition (I.P.). The time period for filing pleadings and evidence in opposition proceedings is therefore as under:

Notice of Opposition to Registration - Four months

[Section 21(1) of the 1999 Act]



Counter-statement- Two months

[Section 21(2) of the 1999 Act]



Evidence in support of Opposition - Two months

[Section 21(4) of the 1999 Act r/w Rule 45(1) of the 2017 Rules]



Evidence in support of Application- Two months

[Section 21(4) of the 1999 Act r/w Rule 46(1) of the 2017 Rules]



Evidence in Reply by the Opponent- One month

[Section 21(4) of the 1999 Act r/w Rule 47 of the 2017 Rules]

11. Considering that this issue would have an impact on a large number of trade mark applications/Oppositions as also considering that there are decisions of this Court as also other High Courts, which have taken different



views, submissions have been made by a number of Counsels including Mr. Sachin Gupta, Mr. Manish Kumar Mishra, Mr. Rahul Vidhani, Ms. Rajeshwari H., Mr. Pravin Anand, Mr. Saikrishna Rajagopal, and Mr. Sushant Singh, Advocates.

Submissions made by various counsels

12. Mr. Sachin Gupta, Id. Counsel for the Appellant on 15th April, 2023 submitted as under:

- (i) that there is a difference in the language between Rule 53 of the Trade Mark Rules, 1959 (hereinafter, '1959 Rules') corresponding to the Trade Marks Act, 1958 (hereinafter, 'the 1958 Act'), Rule 50 under the 2002 Rules and Rule 45 under the 2017 Rules;
- (ii) that in Rule 45 of the 2017 Rules, the specific deletion of "further period not exceeding one month" as per Rule 50 of the 2002 Rules as also the absence of "unless the Registrar otherwise directs", which was there in Rule 53 (2) of the 1959 Rules would lead to the clear inference and conclusion that the intention of the legislature is to not make the two-month period for the filing of evidence as a mandatory period;
- (ii) that the deletion of the specific clauses would in effect mean that the discretion of the Registrar to extend the period is not curtailed to one month and that now the same goes even beyond the period of one month period if a case is made out. Reliance is placed upon the decision in *Sahil Kohli v. Registrar of Trade Mark & Anr. (2018 SCC OnLine IPAB 55)* in support of this argument as also *Wyeth Holdings Corp. v. Controller General of Patents,*



Designs & Trade, (2006 SCC Online Guj620). Further reliance is placed upon the recent decision of a Coordinate Bench in *Mahesh Gupta vs. Registrar of Trademarks. & Anr. (2023 SCC OnLine Del 1324)*;

13. Mr. Manish Kumar Mishra, Id. Counsel for the Respondent No.1 on 15th April, 2023 submitted as under:

- (i) that the deletion of the clauses in the Rule 45 of the 2017 Rules would mean that the discretion of the Registrar has been taken away;
- (ii) that the subtle distinction being sought to be made in *Wyeth Holdings (supra)* which states that the period that has been ‘prescribed’ in the Rules are not mandatory would be an incorrect interpretation when the definition of ‘prescribed’ in the 1999 Act under Section 2(1)(s) of the Act is looked at;
- (iii) that the said definition specifically holds that term ‘prescribed’ would mean ‘prescribed in the Rules made under this Act’;
- (iv) that whenever any period is prescribed in the Rules, it has to be taken as having been prescribed in the Act itself. Reliance is placed upon the decision of the Id. Single Judge of this Court in *MS Aman Engineering Works v. Registrar Trade Marks, Trade Marks Registry, New Delhi & Anr. (2022/DHC/004701)*.

14. Mr. Rahul Vidhani, Id. Counsel assisting the Court sought to distinguish *Wyeth Holdings (supra)* and submitted as under:

- (i) that the Gujarat High Court went on the presumption that Section 131 of the 1999 Act permits extension of time and this power cannot be ignored, when considering the interpretation of Rule



50(3) of the 2002 Rules;

- (ii) that inclusion of form TM-56 which was the requisite form to be filed for seeking one month extension itself prescribed that it is an exercise under Section 131 of the 1999 Act, and thus there was a fundamental flaw in the judgment of the Gujarat High Court in *Wyeth Holdings (supra)*.

15. Mr. Pravin Anand, Id. Counsel assisting the Court submitted as under:

- (i) that the settled legal position is that the subordinate legislation i.e., the Rules cannot go beyond the statute or cannot contradict the statute in any manner. Reliance is placed upon paragraph 33 of the decision of the Supreme Court in *M/s. Bhuwalka Steel Industries Ltd & Anr. Vs. Union of India & Ors. (2017 (5) SCC 598598)* to state that, firstly, a deeming fiction cannot be created in the Rules and, secondly, the Rules cannot go in a manner so as to the contrary to the parent enactment;
- (ii) that the scheme of Section 21 of the 1999 Act is that Section 21(2) provides for deemed abandonment of the application in the case of non-filing of counter statement to an opposition. However, Section 21(4) merely states that the evidence has to be filed within the prescribed period and no deeming fiction is contained in the statute itself. The deeming fiction comes and is introduced in the Rules, in particular in Rule 45 of the 2017 Rules wherein if the counter statement is served and the evidence is not filed within two months from the service, there is deemed abandonment contemplated under Rule 45(2);
- (iii) that this provision in the Rules would be contrary to the statutory



provision itself as Section 21(2) of the 1999 Act has an intention of deemed abandonment but Section 21(4) of the 1999 Act does not express such an intention. Further, Rule 45(2) of the 2017 Rules would have to be read in consonance with Section 21(4) of the 1999 Act and not in an opposing direction;

- (iv) that a Rule itself would be rendered illegal and ultra vires if the reading of the same is given contrary to the statute;
- (v) that Section 131 of the 1999 Act also permits extension of time and for the said purpose sufficient cause has to be shown by the party concerned and this would be a sufficient safeguard to ensure that unnecessary extensions are not sought for filing the evidence in opposition proceedings.

16. Mr. Saikrishna Rajagopal, Id. Counsel assisting the Court submitted as under:

- (i) that, firstly, it is to be borne in mind that there are three set of Rules that the Court is considering i.e., Rule 53 of the 1959 Rules, Rule 50 of the 2002 Rules and Rule 45 of the 2017 Rules. The corresponding Rules 106, 105 and 109 of the three sets of Rules respectively would also have to be considered;
- (ii) that the Id. full Bench in *Hastimal Jain Trading as Oswal Industries v. Registrar Of Trade Marks & Anr. (1999 SCC OnLine Del 1020)* clearly held that the absence of mention of Rule 53 in Rule 106 of the 1959 Rules reveals that the deeming fiction would not apply if the evidence is not filed;
- (iii) that the Id. full Bench decision in *Hastimal Jain* (supra) would hold good even today inasmuch as the scheme of the 2002 Rules



is completely different. As on date, Rule 45 of the 2017 Rules also does not find a mention in Rule 109 of the 2017 Rules and the same is not one of the provisions where there is a specific period for extension which is mentioned like in Rule 50(3) of 2002 Rules;

- (iv) that the decisions in *Sunrider Corporation v. Hindustan Lever Limited And Anr.*, (2007 SCC OnLine Del 1018) and *Mahesh Gupta v. Registrar of Trademarks & Anr.* (2023 SCC OnLine Del 1324) which held that evidence has to be filed within the prescribed period, mandatorily, would not be applicable;
- (v) that the comparison between the two sets of Rules i.e., 53 of the 1959 Rules, Rule 50 of the 2002 Rules and Rule 45 of the 2017 Rules on the one hand and Rules 106 of the 1959 Rules, Rule 105 of the 2002 Rules and Rule 109 of the 2017 Rules, on the other hand, would in fact clearly lead one to the conclusion that the position in Rule 45 of the 2017 Rules is similar to the position in Rule 53 of the 1959 Rules;
- (vi) on the issue of unlimited extensions being sought, the fact that in Rule 109 of the 2017 Rules, the maximum time that can be granted is one month under Rule 109(2). He, further, embraces upon the Court that the same needs to be read with Rule 45(2) of the 2017 Rules, which requires that action would have to be taken by the Opponent under Rule 45(1) of the 2017 Rules within the time mentioned i.e., within two months;
- (vii) that the Rule 45 of the 2017 Rules would have to be read as directory but the extension would have to be sought within the



prescribed two months and only an extension of one month can be granted for filing of evidence.

17. Mr. Sushant Singh, Id. Counsel assisting the Court submitted as under:

- (i) as long as action is taken within first two months period as prescribed under Rule 45 of the 2017 Rules, there cannot be any further embargo on the number of extensions that can be granted. There are several circumstances that can be envisaged wherein the Registrar may find, that there may be sufficient cause to grant further extensions;
- (ii) that Rule 109 of the 2017 Rules is a general provision for granting extension and the same ought not to be curtailed in any manner.

18. Mr. Manish Kumar Mishra, Id. Counsel for the Respondent No.2 on 8th December, 2023 submitted as under:

- (i) that under Rule 45 of the 2017 Rules, it may be even possible that a letter can be filed by an Opponent within the time prescribed i.e. two months, that it does not wish to adduce any evidence. If that contingency arises, the Opponent will also get another chance to file evidence at the Rule 45 stage in reply to the Applicant's evidence. However, the opponent ought not to be permitted any further evidence under Rule 48 of the 2017 Rules;

19. During the course of hearing by various counsels in this matter, two queries were put to the Registrar of Trade Marks and an affidavit was sought by the Id. Registrar vide order dated 15th April, 2023. In response to the same the Office of Registrar filed an affidavit dated 5th December, 2023 stating that it would not be permissible for Opponents to file evidence along with Notice



of Opposition in view of the scheme of the 1999 Act and corresponding 2017 Rules. In addition, it has been submitted that if the Opposition is abandoned, the grounds raised therein cannot be considered even for examination of the application. The relevant portions of the said affidavit filed by Mr. Vikas Punia, Head of Trade Marks Registry in Delhi reads as under:

Query Raised	Response in the Affidavit
Query (i) - Whether it would be permissible for the Opponent to file the evidence along with the notice of opposition itself, so as to avoid 'deemed abandonment'.	8. The Act envisages the following steps in respect of an Application for a Trademark: (i). The Applicant makes an application for a Trademark. (ii). Such and Application is advertised by the Registry. (iii). A person who wishes to oppose the same files his opposition. (iv). A counter-statement is filed to the said opposition. (v). Upon receipt of the counter-statement, evidence in support of the opposition is filed. 11. Resultantly, in reply to the first query, it is humbly submitted that upon a reading of the relevant provisions, it appears that the filing of evidence is a distinct event and cannot be filed along with the Opposition.
Query (ii) - Even if the notice of opposition is treated as 'abandoned' under Rule 45, whether the grounds contained in the notice of opposition can be considered for the purposes of registration of the mark in terms of Section 19 of the Trade Marks Act,	12. With respect to the second query, it is humbly submitted that Rule 45(2) of the Trade Marks Rules, 2017, is a provision for dismissal for default of the opposition proceeding. Rule 45(2) states as under: 45. Evidence in support of



1999 with the overall object of maintaining purity of the Register.

opposition. -

(1)

(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."*

.....

14. Given a conspectus of the position of law, it is humbly submitted that the grounds contained in the notice of opposition once treated as deemed abandoned cannot used further or generally relied upon.

In view of the above, it is certain that the evidence in an Opposition proceeding cannot be filed along with the Notice of Opposition as the filing of evidence is a different stage of Opposition proceeding and is considered a distinct event after the Opposition filing. Each sub-section of Section 21 of the 1999 Act as well as the 1958 Act pertains to a distinct stage in the process of Opposition. Further, it is also clear that if an Opposition is deemed abandoned, the grounds taken in the Opposition would be irrelevant to the examination of the mark and is not relied upon by the Registry. The clarification by the Trade Marks Registry provides a clear distinction in the stages of Opposition.

Findings and Analysis

20. Heard. Opposition proceedings were initially governed by Section 21 of the Trade and Merchandise Marks Act, 1958 and thereafter, by Section 21 of the Trade Marks Act, 1999. A comparative table of Section 21 under the



1958 Act and the 1999 Act are set out below:

Section 21 of the 1958 Act	Section 21 of the 1999 Act
<p>21. Opposition to registration. (1) Any person may, <u>within three months from the date of the advertisement or re- advertisement of an application for registration or within such further period, not exceeding one month in the aggregate</u>, as the Registrar, on application made to him in the prescribed manner and on payment of the prescribed fee, allows, give notice in writing in the prescribed manner to the Registrar, of opposition to the registration.</p>	<p>21. Opposition to registration. (1) <u>Any person may, within four months from the date of the advertisement or re-advertisement of an application for registration</u>, give notice in writing in the prescribed manner and on payment of such fee as may be prescribed, to the Registrar, of opposition to the registration.</p>
<p>(2) The Registrar shall serve a copy of the notice on the applicant for registration and, within two months from the receipt by the applicant of such copy of the notice of opposition, the applicant shall send to the Registrar in the prescribed manner a counter- statement of the grounds on which he relies for his application, and if he does not do so he shall be deemed to have abandoned his application.</p>	<p>(2) The Registrar shall serve a copy of the notice on the applicant for registration and, within two months from the receipt by the applicant of such copy of the notice of opposition, the applicant shall send to the Registrar in the prescribed manner a counter-statement of the grounds on which he relies for his application, and if he does not do so he shall be deemed to have abandoned his application.</p>
<p>(3) If the applicant sends such counter-statement, the Registrar shall serve a copy thereof on the person giving notice of opposition.</p>	<p>(3) If the applicant sends such counter-statement, the Registrar shall serve a copy thereof on the person giving notice of opposition.</p>
<p>(4) Any evidence upon which the opponent and the applicant may rely shall be submitted in the prescribed</p>	<p>(4) Any evidence upon which the opponent and the applicant may rely shall be submitted in the prescribed</p>



<p>manner and within the prescribed time to the Registrar, and the Registrar shall give an opportunity to them to be heard if they so desire.</p>	<p>manner and within the prescribed time to the Registrar, and the Registrar shall give an opportunity to them to be heard, if they so desire.</p>
<p>(5) The Registrar shall, after hearing the parties, if so required, and considering the evidence, decide whether and subject to what conditions or limitations, if any, the registration is to be permitted, and may take into account a ground of objection whether relied upon by the opponent or not.</p>	<p>(5) The Registrar shall, after hearing the parties, if so required, and considering the evidence, decide whether and subject to what conditions or limitations, if any, the registration is to be permitted, and may take into account a ground of objection whether relied upon by the opponent or not.</p>
<p>(6) Where a person giving notice of opposition or an application sending a counter- statement after receipt of a copy of such notice neither resides nor carries on business in India, the Registrar may require him to give security for the costs of proceedings before him, and in default of such security being duly given, may treat the opposition or application, as the case may be, as abandoned.</p>	<p>(6) Where a person giving notice of opposition or an applicant sending a counter-statement after receipt of a copy of such notice neither resides nor carries on business in India, the Registrar may require him to give security for the costs of proceedings before him, and in default of such security being duly given, may treat the opposition or application, as the case may be, as abandoned.</p>
	<p>(7) The Registrar may, on request, permit correction of any error in, or any amendment of, a notice of opposition or a counter-statement on such terms as he thinks just.</p>



21. A perusal of above provisions shows as under:

TM Acts	Notice of Opposition	Counter Statement	Evidence by Opponent
1958	(i) The time for filing of opposition was three months + one month in aggregate (ii) Opposition was to be served by the Registrar to the Applicant.	Within 2 months from the date of receiving the notice of opposition, the counter-statement has to be filed. (The Counter Statement is to be served <u>by the Registrar</u> to the Opponent)	Evidence has to be submitted in the prescribed manner within the prescribed time
1999	(i) The timeline for filing opposition is consolidated four months' period	Within 2 months from the date of receiving the notice of opposition, the counter-statement has to be filed (Counter statement to be served by the Registrar to the Opponent)	Evidence has to be submitted in the prescribed manner within the prescribed time

22. It is also noted that as per Section 101 of the 1958 Act and Section 131 of the 1999 Act, extension of time could be granted by the Registrar in respect of all such provisions for which time is not expressly provided in the said Acts.

23. Thus, insofar as the filing of opposition and counter statement is concerned, timelines are prescribed in the 1999 Act itself. However, insofar as evidence is concerned, the same is prescribed in respect of the 1958 Act



under the 1959 Rules governing filing of evidence. With respect to the 1999 Act, there are two sets of Rules i.e. (1) Trade Marks Rules, 2002 & (2) Trade Marks Rules, 2017. The relevant Rules dealing with the evidence in all these three sets of Rules are set out below:

Rules of 1959	Rules of 2002	Rules of 2017
<p>Rule 53: (1) Within two months from the service on him of a copy of the counter-statement by the Registrar, 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.</p>	<p>Rule 50: (1) Within two months from services on him of a copy of the counterstatement or <u>within such further period not exceeding one month in the aggregate thereafter as the Registrar may on request allow,</u> 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-</p>	<p>Rule 45: (1) Within two months from service of a copy of the counterstatement, 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. <u>He shall deliver to the applicant copies of any evidence including exhibits, if any, that he leaves with the Registrar under this sub-rule</u></p>



	rule and intimate the Registrar in writing of such delivery.	<u>and intimate the Registrar in writing of such delivery.</u>
(2) If an opponent takes no action under sub-rule (1) within the time therein prescribed, he shall, unless the Registrar otherwise directs, be deemed to have abandoned his 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.	(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.
	(3) An application for <u>the extension of the period of one month mentioned in sub rule (1) shall be made in Form TM- 56</u> accompanied by the prescribed fee before the expiry of the period of two months mentioned therein.	
Extension of time		
Rule 106: (1) An application for extension of time under Sec. 101 (not being a time expressly provided in the Act or prescribed by rule 81 or by sub-rule (4) of rule 82 or a time for the extension of which provision is made	Rule 105: (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	Rule 109: (1) An application for extension of time under Section 131 (not being a time expressly provided in the Act or by rule 85 or by subrule (3) of rule 86 or a time for the extension of



in the rules) shall be made on Form TM- 56.	in the rules) shall be made in Form TM-56.	which provision is made in the rules) shall be made in Form TM-M.
(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.	(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.	(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 not exceeding one month and communicate 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.

24. A perusal of the above provisions would show that broadly, under the 1959 Rules, after the service of counter statement, evidence has to be filed by the opponent as prescribed. If evidence is not filed by the Opponent within



the time prescribed, then the opposition is deemed to have been abandoned.

25. Under Rule 50 of the 2002 Rules, evidence has to be filed by the Opponent within two months upon the copy of the counter statement being served. However, such service need not be by the Registrar but would have to be by the Applicant itself. The time period for filing of counter statement is two months from service or within such further period not exceeding one month in aggregate i.e. a total of three months. Further, Rule 50(3) of the 2002 Rules makes it clear that in order to avail of the one month extension for filing of evidence, the requisite form is to be filed within the first two months' period. If either the extension is not sought before the expiry of the first two months' period or evidence is not filed within three months in the aggregate, the opposition is deemed to have been abandoned.

26. Under Rule 45 of the 2017 Rules, the additional one month extension has been deleted and thus, the evidence has to be filed within two months after service of copy of the counter statement, which again would be by the Applicant itself and not by the Registrar.

27. Thus, under Rule 53 of the 1959 Rules, the two months period for filing evidence commenced when the counter statement was served on the Opponent by the Registrar. Under Rule 50 of the 2002 Rules, the counter statement is to be served by the Applicant itself and not by the Registrar. Under Rule 45 of the 2017 Rules, again service of counter statement is by the Applicant itself and not by the Registrar.

28. Further, Rule 106 of the 1959 Rules, Rule 105 of the 2002 Rules and Rule 109 of the 2017 Rules respectively, make it clear that the application for extension of time can be filed before the Registrar in respect of such time periods for which no specific provision has been made in the Rules.



29. Another feature which needs to be noted is the absence of the phrase “*unless the Registrar otherwise directs*” in Rules 50(2) of the 2002 Rules and Rule 45(2) of the 2017 Rules as contrasted with Rule 53 of 1959 Rules, which clearly lays down – “(2) *If an opponent takes no action under sub-rule (1) within the time therein prescribed, he shall, unless the Registrar otherwise directs, be deemed to have abandoned his opposition*”.

30. Keeping in mind the above position of the Rules, the question is as to whether two plus one month- aggregate three months’ period under the 2002 Rules is directory or mandatory.

31. One of the main submissions that has been made to argue that the time period should be mandatory and not directory is absence of the phrase “*unless the Registrar otherwise directs*” in Rules 50(2) of the 2002 Rules and 45(2) of the 2017 Rules respectively as contrasted with Rule 53 of 1959 Rules.

32. The scheme of the Trade Marks Act, 1999 is clearly to provide strict timelines for the purpose of opposition proceedings. Repeated extensions to delay the process of registration through extension of time limits can hold up grant of trade mark registrations for a substantial period of time. The legislative intent behind the prescribed timelines in the Act and the Rules is to ensure that the registration of trade marks is not unduly delayed and Opponents are not able to delay the registration of marks.

33. If extension of time is granted for filing either pleadings or evidence in Opposition proceedings, without an outer deadline, the purpose of the Act and the Rules would be set at naught, inasmuch as the Opponents could indefinitely hold-up grant of registration of marks.

34. The transition from the 1959 Rules to the 2002 Rules and the 2017 Rules shows that the discretion, which was vested with the Registrar, has been



taken away and the time period for filing of evidence has also been reduced. Initially, in the 1959 Rules, evidence was to be filed within two months from service by the Registrar on the Opponent and the Registrar had the discretion to decide as to whether the opposition ought to be deemed as abandoned or not.

35. Under Rule 50 of the 2002 Rules, the time period was two plus one month from the date of service of the evidence in opposition by the Applicant upon the Opponent. Thus, the time gap or delay between service by the Applicant of the counter statement and by the Registrar of the same counter statement was also sought to be bridged and plugged. Service by the Applicant ensured certainty in service within the deadline rather than service by the Registrar. In addition, one month period was extendible provided that the extension was sought within the initial two months' period. The discretion vested with the Registrar beyond the said period, was also taken away.

36. The position in the 2017 Rules becomes much more clear towards elimination of delays - i.e., the feature of the 2002 Rules with regard to the service of the counter statement by the Applicant has been retained, the discretion vested with the Registrar has been taken away, and the period of extra one month has also been deleted.

37. The above transition and evolution of the Rules points to a clear intention to ensure that strict timelines are prescribed for conclusion of pleadings/evidence in opposition proceedings. Rules 105 and 109 of the 2002 Rules and 2017 Rules respectively, would not be an aid in granting of extension as such extensions cannot be granted, when the time periods are specifically prescribed in the Rules.

38. The case laws which have been cited by the parties and various



counselors, have to be considered in this background.

39. In *Hastimal Jain trading as Oswal Industries v. Registrar of Trade Marks & Anr.*, (1999 SCC OnLine Del 1020), the Full Bench has taken a view that the time period was directory in view of Rule 53(2) of the 1959 Rules. This order was followed in the decision in *Asian Paints Ltd. v. Assistant Registrar of Trade Marks*, (2005 SCC OnLine IPAB 19). These decisions were rendered in the context of the 1959 Rules, under which the Registrar had discretionary powers under Rule 53(2).

40. The Gujarat High Court in *Wyeth Holdings Corpn. And Anr. v. Controller General of Patents, Designs & Trade Marks*, (2006 SCC Online Guj 620), however, observed that in view of the time having been prescribed in the Rules, which are subordinate legislation following *Salem Advocate Bar Association, Tamil Nadu v. Union of India*, (2006) 2 GLR 1312, the word 'shall' would be construed as being directory. The relevant portion of the said judgment in *Wyeth Holdings (supra)* is set out below:

“34. The learned senior counsel for the petitioners submitted that if at all the Legislature wanted to prescribe the time limit in sub-rule (2) of Rule 50 for filing of evidence in support of opposition, it could have incorporated the same in sub-section (4) of Section 21 of the Act. He submitted that the fact that the Legislature prescribed time limit for filing of opposition to the registration in sub-section (1) of Section 21 and prescribed time limit for filing the counter statement to such opposition in sub-section (3) of Section 21, there was no earthly reason for the Legislature not to prescribe a time limit and the consequences of non-observance of such time limit for filing of the evidence in support of opposition.

35. The learned senior counsel for the petitioners submitted that the fact that in sub section (4) of Section



21 the Legislature left the matter of filing of evidence in support of opposition to be regulated by the Rules and to be implemented by the Registrar, the only inference which can be drawn in that the Legislature never wanted to put the filing of evidence on the same pedestal that of the filing of opposition to the registration. The learned senior counsel submitted that the Legislature drew specific distinction between 'filing of opposition to the registration and filing of evidence in support of registration. He further submitted that the distinction drawn between the two is intelligible. He submitted that having felt that 'filing of opposition is a substantive right, the Legislature deliberately and being conscious of the fact that it is a substantive right, included it in the Act itself and provided the time limit for the same in the same sub-section, i.e. (1) of Section 21. He submitted that as against, filing of evidence in support of opposition was felt to be more a procedural thing and, therefore, the same was left to be regulated by the Rules on the subject. The learned senior counsel for the petitioner submitted that while giving power to frame Rules under Section 157, the Legislature specifically provided the matter of filing of evidence in support of opposition in Clause (vii) of sub-section (2) of Section 157. Not only that, in Clause (vii) also, sub section (4) of Section 21 is specifically referred to. He submitted that, that being so, the Rule making authority has, though not specifically made it clear that sub-rule (2) of Rule 50 will be directory in nature, it has to be construed as 'directory in nature so as to see that it remains in consonance with the intention of the Legislature expressed by Section 131 of the Act. He submitted that if at all sub-rule (2) of Rule 50 is to be read as 'mandatory', it will directly offend Section 131 of the Act and in that event, the Court will have to declare sub-rule (2) of Rule 50 as ultra virus the Act. In the alternative, being a piece of subordinate legislation to see that it does not exceed the scope of the main legislation,



applying the principles of harmonious construction, it should be construed as directory. In this regard, the learned senior counsel relied upon various decisions of this Court as well as the Hon'ble the Apex Court”

36. The learned senior counsel for the petitioners relied upon a decision of the Hon'ble the Apex Court in the matter of Salem Advocate Bar Association, Tamil Nadu v. Union of India, (2006) 2 GLR 1312. The learned senior counsel emphasized upon head note ‘H’, relevant part of it reads as under:

“The use of the word ‘shall’ in Order 8, Rule 1 by itself is not conclusive to determine whether the provision is mandatory or directory. The Court to ascertain the object which is required to be served by this provision and its design and context in which it is enacted. The use of word ‘shall’ is ordinarily indicative of mandatory nature of the provision, but having regard to the context in which it is used or having regard to the intention of the legislation, the same can be construed as directory.”

41. Two Id. Single Judges of this Court had an occasion to consider Rule 50 of the 2002 Rules.

42. In ***Sunrider Corporation, U.S.A. v. Hindustan Lever Limited & Anr., (2007 SCC OnLine Del 1018)***, the Id. Single Judge holds that Rule 50 of the 2002 Rules has been validly framed, which should be treated as part of the Act following the decision of the Supreme Court in ***Chief Forest Conservator (Wildlife) v. Nisar Khan, (2003) 4 SCC 595***. The Court then went on to observe that Rule 50 of the Rules is mandatory in nature. The relevant portion is set out below:

“21. In Ramachandra (supra), the Supreme Court observed that in Taylor v. Taylor, 1875 (1) Ch D 426, Jessel M.R. adopted the rule that where a power is given to do a certain thing in a certain way, the thing must be done in that way or not at all and that other methods of



performance are necessarily forbidden. The Supreme Court further observed that this rule had stood the test of time. In that very case [Ramachandra (supra)], the Supreme Court placing reliance on Craies on Statute Law, 7th Edn. observed that with regard to the question as to whether a provision was mandatory or directory, no uniform rule could be laid down as to whether mandatory enactments should be considered directory only or obligatory with an implied nullification for disobedience. The Supreme Court further observed that it is the duty of Courts of justice to try to get at the real intention of the Legislature by carefully attending to the whole scope. Such intention of the Legislature is, therefore, to be ascertained upon a review of the language, subject-matter and importance of the provision in relation to the general object intended to be secured, the mischief, if any, to be prevented and the remedy to be promoted by the Act. Considering the provisions and making a comparative study of the old and the new Act as well as the old and the new rules, it is more than clear that specific words have been introduced in the new provisions and/or removed from the old provisions. **Such additions and deletions are significant and bring out the true intention of the Legislature. For instance, Rule 53 of the 1959 Rules did not prescribe any maximum period of extension of time. Whereas Rule 50 of the 2002 Rules specifically provides for extension of time not exceeding one month in the aggregate. This introduces a clear stipulation that the Registrar's powers to grant extension of time are limited to one month in the aggregate beyond the two months prescribed under the said Rule. This limitation was not there in the earlier Rule, but it is definitely there in Rule 50 of the 2002 Rules. The second instance is that the words 'unless the Registrar directs' have been consciously deleted from Sub-rule (2) of Rule 53 in its new incarnation in Rule 50(2). It is obvious that the Legislature wanted to**



make the provision mandatory and did not want to give any discretion to the Registrar in this connection. The object is apparent that the delays be cut down in deciding the application for registration of a trade”

43. In *Sunrider Corporation (supra)*, the Court also observed that Rule 50 of the 2002 Rules uses the words “*within such a further period not exceeding one month in the aggregate thereafter as the Registrar may on request allow.*” The inclusion of the word – “aggregate” in Rule 50 (1) and removal of the requirement – “*unless the Registrar otherwise directs*” under Rule 50(2) of the 2002 Rules, which otherwise existed in Rule 53(2) of the 1959 Rules, shows that the time period is mandatory. This decision has also been followed recently by another coordinate Bench of this Court in *Mahesh Gupta v. Registrar of Trademarks & Anr., 2023 SCC OnLine Del 1324* where the Court holds as under:

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

14. *To my mind, the view espoused in para 60 of the decision in Wyeths, 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 peremptory, 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*, 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 105 of the 2002 Rules read with Section 131 of the 1999 Act.

19. Though these provisions have been considered by the coordinate Bench in *Sunrider*, Ms. Rajeshwari advances a submission which, according to her, was not advanced in *Sunrider* and was not, therefore, considered. She draws attention to the 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*, 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* extracted hereinabove which, unfortunately for the appellant, cover the case against it on all fours.”

44. In the background of these decisions, this Court has to now consider the decision of IPAB in *Sahil Kohli v. Registrar of Trade Mark and Anr.*, (2018 SCC OnLine IPAB 55). The IPAB’s reasoning is that the Rules cannot travel beyond the Act. The IPAB further held that the absence of phrase “not exceeding one month in aggregate” distinguished Rule 50 of 2002 Rules with Rule 45 of the 2017 Rules. The observations of the IPAB are as under:

53. In view of the changes made in Rule 45(1) of the Trade Marks Rules, 2017 and also in view of the discussion arising at points (f) to (j) mentioned in the preceding paragraphs relating to the interpretation of



Rule 45 of the Trade Marks Rules, 2017, the judgment passed in case of Sunrider Corporation v. Hindustan Lever Ltd. (supra.) is clearly distinguishable and is not applicable in view of the changes made in the structure of Rule 45 which omits completely the entire aspect of the registrar discretion of granting the extension and the restrictions, which were imposed earlier in rule 50 of rules of 2002 upon the Registrar's power to extend the time period.

54. As seen above, what weighed heavily before the Delhi High Court is the insertion of the wordings 'not exceeding one month in aggregate thereafter' and omission of the words 'unless the Registrar otherwise directs' in the Rule 50 of the Trade Marks Rules, 2002 which curtailed the discretion of the Registrar to condone the time period by limiting it to one month in aggregate and on the other hand, now since the said discretion itself is removed from Rule 45 of the Trade Marks Rules, 2017, the Registrar by virtue of the provisions of Section 131 of the Trade Marks Act, 1999 will continue to have such discretion to condone the time period which is against the rule 45 of the Rule 2017.

The registrar still enjoys discretion due to the reason that the registrars power to extend the time still flows from section 131 for the act 1999, for which there is no power to grant extension of the time in any manner are provided by the by the act not by the rules. The said power cannot require any reiteration in the rules though rules could have restricted those powers as done earlier in rule 50 by limiting the number of requests for extension of time to one month in aggregate.

55. But the altogether removal of the wordings relating to the extension of time from the Rule 45 will yield different results wherein one has to again revert to section 131 which is the parent provision which gives the room to the registrar to extend the time period. Therefore, by removal of the wordings from rule 45, the



power of the registrar to grant extension of time in the matters of filing the evidence beyond two month time period cannot be taken away as the same would be contrary to section 131. The said section thus will continue to operate and the registrar will continue to have power to grant extension of time upon making of an application in a prescribed manner and prescribed fees upon furnishing of the sufficient cause.

56. In view of the changes made in the Rules and the language of the Rules including Rule 45, the interpretation rendered in the earlier Rule 50 of the Trade Marks Rules, 2002 which restrictedly discretion of the Registrar to grant of extension of time only to one month period in aggregate is removed and consequently the applicability of the judgment of Sunrider Corporation (supra.) under the new Rules the extension of power has been extinguished or have lost its significance, in view of the change in the language of the newly framed Rule 45 of the Trade Marks Rules, 2017.

57. The above analysis clearly suggests that the provisions of Section 131 of the Trade Marks Act, 1999 would continue to apply to any time period for doing any act, as the time period is not provided under the Act or rule. Any other interpretation to Rule 45(1) and (2) would make the operation of the Rule 45 of the Trade Marks Rules, 2017 as completely inflexible and any extension would attract the violation of the express provisions of the Act, which is Section 131 of the Trade Marks Act, 1999.

45. A reading of all the above decisions along with the discussion above, shows that the Gujarat High Court in *Wyeth Holdings Corp (supra)* held in the context of the 2002 Rules that the time period is directory following *Salem Advocate Bar Association (supra)*. The IPAB in *Sahil Kohli (supra)* held that the time period is directory under Rule 45 of the 2017 Rules. Further, two



coordinate Benches of this Court in *Sunrider Corporation (supra)* and *Mahesh Gupta (supra)* held that the time prescribed in Rule 50 of the 2002 Rules is mandatory.

46. In the opinion of this Court, use of the term “one month aggregate” in Rule 50 of the 2002 Rules and removal of discretion “unless the Registrar otherwise directs,” in Rule 50(2) of the said Rules clearly points to the time limit prescribed as being mandatory. This position would not be different in the 2017 Rules, inasmuch as even if the one month extension period has been deleted from the said Rules, the discretion with the Registrar also continues to be deleted.

47. The sum and substance of the above discussion is that upon the counter statement being received by the Opponent from the Applicant, the two months’ period begins to run. The counter statement need not be served by the Registrar upon the Opponent. If the evidence is not filed within the two months’ period, the opposition would be deemed to have been abandoned as the Registrar has no discretion either under Rule 50 of the 2002 Rules or Rule 45 of the 2017 Rules or Rules 101 and 109 of the 2002 Rules and the 2017 Rules respectively, to extend the time period.

48. This interpretation is also in line with the stand of the Trade Marks Registry i.e., to have strict timelines for opposition proceedings so that the Opponents cannot unduly and infinitely delay the processing of trade mark applications towards registration.

49. In the facts of the present case, the chronology of events would show that the counter statement was received by the Opponent on 12th June, 2007. Within two months’ period i.e., on 10th August, 2007, Rule 50 evidence was filed by the Opponent. There was merely a delay in sending the copy of the



same to the Applicant.

50. The Applicant sought extension to file evidence, which it failed to do. In these facts, the opposition could not have been held as having been abandoned.

51. Vide order dated 8th August, 2022, it was directed by this Court that the decision in the opposition would be rendered. It is unclear as to whether any order has been passed. The Registrar of Trade Marks shall accordingly proceed to pass orders in the opposition proceedings on merits. Needless to add, the remedies of all parties are left open in respect of the decision in the Opposition.

52. The appeal is disposed of in the above terms.

PRATHIBA M. SINGH
JUDGE

FEBRUARY 09, 2024/dk/bh