

(2009) 09 MAD CK 0185

Madras High Court

Case No: Writ Petition No. 1571 of 2009 and M.P. No. 1 of 2009

Allied Blenders and Distillers Pvt.
Ltd.

APPELLANT

Vs

Intellectual Property Appellate
Board, The Deputy Registrar of
Trade Marks and John Distilleries
Limited

RESPONDENT

Date of Decision: Sept. 1, 2009

Acts Referred:

- Arbitration and Conciliation Act, 1996 - Section 34(3)
- Civil Procedure Code, 1908 (CPC) - Order 47 Rule 1
- Limitation Act, 1963 - Section 10, 11, 12, 13, 14
- Trade and Merchandise Marks Rules, 1959 - Rule 53, 53(2)
- Trade Marks Act, 1999 - Section 131, 18, 2, 21, 21(1)
- Trade Marks Rules, 2002 - Rule 53

Citation: AIR 2009 Mad 196 : (2010) 42 PTC 57 : (2010) 8 RCR(Civil) 2680 : (2009) WritLR 968

Hon'ble Judges: H.L. Gokhale, C.J; D. Murugesan, J

Bench: Division Bench

Advocate: P.S. Raman, General Assisted by Sanjay Chabra, for the Appellant; Sanjay Chabra, for Respondent 3, for the Respondent

Final Decision: Dismissed

Judgement

@JUDGMENTTAG-ORDER

H.L. Gokhale, C.J.

This writ petition raises a question as to whether the Registrar of Trade Marks can allow a notice of opposition to the registration of a trade mark to be given beyond the period prescribed u/s 21 of the Trade Marks Act, 1999.

2. In other words, this writ petition raises the question as to whether the Registrar of Trade Marks can receive a notice of opposition to the registration of a trade mark given beyond the period prescribed u/s 21 of the Trade Marks Act, 1999.

3. The short facts leading to the filing of this writ petition are hereunder:

The petitioner and the respondent - 3 herein are both companies engaged in the manufacture and marketing of alcoholic beverages including Indian Made Foreign Liquor (IMFL). One of the brands under which the petitioner sells its alcoholic beverages being whisky is known as "Officer"s Choice". The petitioner claims that the product under this brand name is in the market since 1988, but the petitioner became the proprietor thereof from 23rd February, 2007. The trade mark registration for the mark "Officer"s Choice" in Class No. 33 in respect of alcoholic beverages namely., whisky has been registered under Registration No. 538927B with effect from 26th October, 1990, the same has been renewed subsequently, and presently it is duly recorded in the name of the petitioner.

4. The respondent - 3 claims to be selling another alcoholic beverage being whisky under the mark "Original Choice", and it claims that it was earlier used by its predecessor viz., one National Distillery and Allied Products Private Limited since about 1995. On 4th April, 1996 the respondent - 3 applied for the trade mark registration of "Original Choice" by making Application No. 722161 in Class No. 33 in its name. The respondent - 3 had also obtained a copy right registration for that label on 04th March, 2000 by claiming the date of first use in the year 1996.

5. In May, 2002 the petitioner filed a suit bearing Civil Suit (O.S.)No.1058 of 2002 in the High Court of Delhi for passing off on the ground of deceptive similarity, but did not get the injunction as sought for. It subsequently filed one more suit in the year 2007 on the basis alleged infringement. (We have been informed that ultimately the application for interim injunction in both the suits were rejected by a common order of the Delhi High Court on 11th July, 2008, and the appeal therefrom was rejected by a Division Bench of that Court on 29th September, 2008, and the Special Leave Petitions being Special Leave to Appeal (Civil) Nos. 4601-4602/2009 were also dismissed by the Apex Court on 06th March, 2009).

6. The above referred petition of the respondent - 3 for registration of the trade mark "Original Choice" was published in the Trade Mark Journal Mega-2 on 2nd December 2003 (at page 5307) inviting the objections from the public.

7. Section - 21 of the Trade Marks Act requires a party opposing such registration to file a notice of opposition to the registration within three months from the date of the advertisement. The Registrar, however, has the power to extend the period by one month, if any such application is made in the prescribed manner and on payment of the prescribed fees. Accordingly, the petitioner filed the necessary application for extension of time on 01st March, 2004 in Form TM-44 along with the requisite fee of Rs. 500/- i.e., within three months period, and got the extension of

one month. The period of four months was to expire on 01st April, 2004. On 31st March, 2004, the petitioner presented a paper book with the requisite Form TM - 5 before the Registry along with the leaflet of a cheque on which the requisite fee of Rs. 2,500/- was written, but the cheque was not signed. The Trade Mark Registry sent a letter to the petitioner on the next day i.e., on 01st April, 2004 returning the cheque for compliance. The petitioner re-presented the cheque duly signed on 13th April, 2004, which was received by the Trade Mark Registry on 15th April, 2004 (enclosed on 30th April, 2004).

8. Much later, i.e., on 17th July, 2007 the respondent - 2 Deputy Registrar of Trade marks, Chennai passed the following order:

No. TOP/5603

GOVERNMENT OF INDIA
TRADE MARKS REGISTRY

IP Building, GST Road,
Guindy, Chennai - 600 032.

Dated: 17.07.2007

To

M/s. International Trade Marks Bureau, 1st Floor,
Manekji Wadia Buildings, 127, Mahatma Gandhi Road,
Fort, Mumbai - 400 001.

Sub: Proposed Opposition No. 170976 to Application No. 722161 in Class 33 advertised on Journal Mega 2, dated 25.09.2003, made available to public on 02.12.2003.

Ref: Hearing held on 10.11.2005

Sirs,

With reference to the above, I am directed to convey the following order passed by the Deputy Registrar of Trade Marks in the above referred matter:

Mr. C.S. Rao, advocate authorized by M/s. International Trade Marks Bureau appeared for the Proposed Opponents. Though TM-44 dated 01.03.2004 is filed within 3-month period, the TM-5 filed on 15.04.2004, is beyond the prescribed time limit of 4-month period, hence the TM-5 filed on 15.04.2004 cannot be taken on record.

Yours faithfully,

For Deputy Registrar of Trade Marks.

Copy to:

M/s. Harikrishna S. Holla,
34/3, V Main Road, Gandhi Nagar,
Bangalore - 3.

For Deputy Registrar of Trade Marks.

9. Since, the respondent - 2 had declined to take the opposition on record, the petitioner filed a petition for review on 21.08.2007 seeking recall of that order. As can be seen from that order, it was contended on behalf of the petitioner that erroneously the cheque had not been signed due to oversight. Reliance was placed on the judgment of the Apex Court reported in AIR 1976 SC 1977 to contend that the procedural law is not to be a tyrant but a servant, not an obstruction but an aid to justice. It was submitted that the opposition be permitted to be taken on record to maintain the purity of the Trade Mark Register.

10. The above referred review petition was opposed by the respondent - 3 by pointing out that the same could not be said to be maintainable on any of the grounds which are otherwise available under Order 47 Rule 1 of the CPC in the sense that there was no discovery of any new or important matter, there was no mistake or error apparent on the face of the record, nor any sufficient reason could be invoked. The opposition had to be filed in the prescribed form and with the fee within the time provided. Since, the requisite fee was not paid, the Deputy Registrar of Trade Marks was right in declining to take the application on record. It was submitted that this was as per the mandate of the statute and the opposition could not be entertained in breach thereof.

11. The Deputy Registrar of Trade Marks in his order merely reproduced all these submissions, and as can be seen from the order passed on 27th November, 2007 this is all that he has stated of his own viz., "in view of the above the review petition dated 21st August , 2007 filed by the opponent is disallowed, and the Application No. 722161 in Class - 33 shall proceed for registration. There shall be no order as to costs."

12. Being aggrieved by this order the petitioner filed an appeal u/s 91 of the Trade Marks Act, 1999 before the Intellectual Property Appellate Board, Chennai. It was canvassed on behalf of the petitioner/appellant before the Appellate Board that in the facts as narrated above, the opposition had been filed within the prescribed extended time along with the requisite fee in the form of a cheque, that only the cheque remained unsigned inadvertently, that the Deputy Registrar of Trade Marks ought to have received this opposition, that in any case when the review was filed, the same has been dismissed without assigning any reasons whatsoever, that the petitioner/appellant had a good case in opposition, and that it should not be allowed to be frustrated by taking such a technical approach.

13. As against this submission of the petitioner/appellant it was submitted on behalf of the respondent that the petitioner's appeal was only against the second order

declining to take the application for opposition on file, and that the same was beyond time when counted from the first order dated 17.07.2007. This is because the appeal is required to be filed within three months from the date of the impugned order. In any case, it was submitted that this was a provision in a special Act, and since, there was no provision to condone the delay, the delay could not have been condoned.

14. The Appellate Board went into the question as to whether the review was maintainable, and held that the case had not been made out under Order 47 Rule 1 of the Code of Civil Procedure, and therefore, dismissed the appeal by its order dated 14th November, 2008.

15. Being aggrieved by this order dated 14th November, 2008 as well as the earlier two orders dated 17th July, 2007 and 27th November, 2007, this writ petition is filed to quash all the three orders and to direct the respondent - 2 viz., the Deputy Registrar of Trade Marks, Chennai to take on record the notice of opposition filed by the petitioner and to decide the same, in accordance with law.

16. Mr. P.S. Raman, learned Advocate General has appeared for the petitioner and his principal submission has been that the notice of opposition has been filed within time, at the most there was a technical error in not signing the cheque, and therefore, all these orders be set aside. The Registrar should be deemed to have the power to extend the time u/s 21 read with Section 131 of the Trade Marks Act, 1999.

17. As against that, Mr. Sanjay Jain, learned Senior Counsel appearing on behalf of the respondent - 3 submitted that the Trade Marks Act is a special Act, the opposition to registration is in fact a kind of a plaint, it has to be filed within the period of limitation provided under the special Act in the manner prescribed and on payment of the prescribed fee as provided thereunder, and if that was not so done there was no power with the Registrar to extend time and receive the cheque subsequently. The Form TM-5 in which the notice of opposition is to be filed, at the top of it, specifically mentions the fee of Rs. 2,500/-. Since, the petitioner has filed a leaflet of a cheque without the signature thereon, it could not be said to be a negotiable instrument and the filing had to be held to be defective. If a statute requires a thing to be done in a particular manner, it had to be done in that particular manner only. No such power to extend the time and receive the cheque subsequently could be read in Section 21 of the Trade Marks Act, nor could Section 131 be pressed into service, because, that Section will apply only where time is not expressly provided under the statute for doing a particular act. The order of Deputy Registrar refusing to review the initial order, though not happily worded, could be understood as accepting the submissions of respondent No. 3, since they were incorporated in his order. He defended the order of the appellate board. It was dealing with the appeal against the order refusing to review the earlier order and it was correct on the touchstone of Order 47 Rule 1 of the Code of Civil Procedure. That apart, the petitioner was not without any remedy. On the trade mark of the

respondent - 3 being registered (which has been subsequently registered in December, 2007) the petitioner had the remedy to apply for rectification of the register u/s 57 of the Trade Marks Act. The petitioner had, in fact, made such a request in the proceedings before the Delhi High Court, and had filed the Rectification Application in June, 2008. Therefore, the petitioner was not remediless, and there was no reason for this Court to interfere with the orders passed by the authorities below. On merits also, it was submitted on behalf of the respondent - 3 that the respondent - 3 had a good case for registration of his trade mark and the petitioner had failed to get any injunction in the suits that the petitioner had filed in the Delhi High Court, which orders had been confirmed up to Supreme Court.

18. Inasmuch as Section 21 is a section under which this opposition to registration is filed, it would be advisable to refer to the same. This Section reads as follows:

21. Opposition to registration

(1) Any person may, 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, 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.

(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.

(3) If the applicant sends such counter-statement, the Registrar shall serve a copy thereof on the person giving notice of opposition.

(4) Any evidence upon which the opponent and the applicant may rely shall be submitted in the prescribed 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.

(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.

(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.

(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.

19. While looking at Section 21, it is to be noted that the Trade Marks Act, 1999 is an Act to provide for registration and better protection of trade marks for goods and services and for the prevention of the use of fraudulent marks. Chapter - 3 of this Act provides for the procedure for and duration of registration. Section 25(1) of the Act lays down that the Registration of a trade mark shall be for a period of 10 years, but may be renewed from time to time, in accordance with the provisions of this Section. Amongst others Sub-section - 3 of Section - 25 provides that at the end of this period one has to obtain the renewal by paying the prescribed fee and if the same is not paid, a trade mark may be removed from the register. When it comes to application for registration Section - 18 provides for the payment of necessary fee and Sub-section - 2 thereof provides that a single application may be made for registration of a trade mark for different classes of goods and services and fee payable thereof shall be in respect of each such class of goods or services. Similarly, Section 21(1) provides that an opposition to the registration has to be filed in the prescribed manner and on payment of prescribed fee. It also provides that such opposition is to be filed within three months from the date of advertisement, though the Registrar on an application made to him may extend the time not exceeding one month in the aggregate. Sub-section (2) of Section 21 provides that the counter statement has to be filed within two months from the receipt of the copy of the notice of opposition or else it shall be deemed to have been abandoned. Only as far as the evidence upon which the parties are relying upon is concerned Sub-section (4) of Section 21 provides that it shall be submitted in the prescribed manner and within the prescribed time. As far as the submitting of evidence is concerned there is no specific period laid down for that.

20. These provisions have come to be considered by different High Courts from time to time. Thus, a single Judge of the Bombay High Court in Kantilal Tulsidas Jobanputra v. The Registrar of Trade Marks reported in 1982 PTC 127 while considering the requirement of filing of the evidence held that for filing of the evidence the benefit of Rule 53(2) of the earlier Trade and Merchandise Marks Rules, 1959 will be available. That was a case under the old Rules and was decided on 27th March, 1980. The Court held that the legislature never intended to lay down rigid rule. Same is the provision in the Rule 53 under the present Trade Marks Rules, 2002, which permits the Registrar to give leave to either of the parties to lead any evidence upon such terms as to costs or otherwise as he may think fit.

21. The distinction between the provisions under the Sub-sections (1) and (2) of Section 21 on the one hand and Sub-section (4) on the other was considered by a Full Bench of the Delhi High Court in Hastimal Jain v. Registrar of Trade Marks reported in 2000 PTC 24. Speaking for the Full Bench S.N. Variava, C.J. (as he then

was) held that where legislature intended to prescribe a fixed time, it has specifically so done u/s 21(1) and 21(2) of the Act, but it has not so done u/s 21(4), and the benefit of Rule 53 would be available for Registrar to give extended time to the parties to file evidence. The Full Bench quoted with approval the judgment of the Bombay High Court in Kantilal Tulsidas Jobanputra (supra).

22. In [Seiko Cables of India Vs. Hattori Seiko Company Limited and Another](#), a learned single Judge of the Delhi High Court was concerned with the situation where the counter statement u/s 21(2) was filed within the prescribed period, but was deficient in fee by Rs. 20/-, and it was not made good in time. Relying upon the dicta in Hastimal Jain (supra) the learned single Judge held that the Registrar was justified in making an order about abandonment. This view also stands to reason for the simple reason otherwise it will mean that there will be a separate and extended time limit for filing prescribed fee. As seen earlier the Form TM-5 clearly states at the top of it that the fee prescribed is Rs. 2,500/-. It is a special Act and one has to be vigilant and careful about one's right and steps to be taken. To oppose the registration of a trade mark, one has to go in the particular manner as prescribed under the Act.

23. This is also in consonance with the proposition long laid down in Taylor v. Taylor 1875 (1) Ch.D. 426 where Jessel, M.R. laid down 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. This dicta has been followed in a number of judgments and to cite one, in [Ramchandra Keshav Adke \(Dead\) by Lrs. and Others Vs. Govind Joti Chavare and Others](#), the question before the Apex Court was with respect to surrender of a tenancy by a tenant in order to be valid and effective under the Bombay Tenancy and Agricultural Lands Act, 1948. The Apex Court held that the surrender had to be done in the manner prescribed under the Act and then only it would be effective.

24. The other submission of Mr. P.S. Raman, learned Advocate General for the petitioner was that this was a fit case where period of limitation deserved to be extended. We are afraid that it will be difficult to accept this proposition when considered on the touchstone of Section 29(2) of the Limitation Act. Section 29(2) of the Limitation Act lays down that where a special Act provides a period of limitation different from the period specified under the Limitation Act, the provisions of Section 4 to 24 of the Limitation Act will apply only so far as and to the extent to which, they are not expressly excluded by such special or local law to the suits, appeals or applications under the special law.

25. In [Mukri Gopalan Vs. Cheppilat Puthanpurayil Aboobacker](#), the Apex Court was concerned with the special provision of limitation provided u/s 18 of the Kerala Rent Control Act. Although there was no express exclusion of any provision, in view of this special provision the Apex Court held that the provisions of the Special Rent Act on limitation will apply.

26. Similarly, in [Union of India Vs. M/s Popular Construction Co.](#), while considering the limitation u/s 34(3) and its proviso as occurring in the Arbitration and Conciliation Act, 1996, the Apex Court held that the express exclusion can also be inferred from the scheme and objectives of the Act, one of which was to restrict judicial intervention in arbitral matters as much as possible.

27. In the instant case, the Trade Marks Act, 1999 is a special Act. It gives a special right to the parties who want their goods and services to be protected by getting a registration of the trade mark. Anybody who is keen to oppose any such registration has also to be vigilant and has to oppose the registration in the prescribed manner, in the prescribed time, and on payment of prescribed fee within the time provided for that purpose. The counter statement is also to be filed in the prescribed time and in the prescribed manner. The notice of opposition and the counter statement are like the plaint and the written statement of the proceeding. If the Special Act provides for specific time, manner and fees for filing of the plaint, it has to be so done in compliance and the requirements cannot be relaxed. Sub-section 21(7) of the Act provides only for amendment of the notice of opposition and counter statement, but that cannot be construed as a provision to cure any deficiency in the requirement of Sections 21(1) and 21(2) of the Act. Section 131 and Rule 53 can also not be pressed into service, since that Section will apply only where time is not expressly provided under the statute and Rule 53 is concerning the time for leading the evidence. It cannot apply to filing of notice of opposition or the counter statement. Any other interpretation will defeat the objective of the Act, and hence, cannot be accepted.

28. The last submission of Mr. P.S. Raman, learned Advocate General is that a litigant should not be made to suffer on account of the failure on the part of its counsel or power of attorney holder as in the present case. Mr. Raman, relied upon the observations of the Apex Court in *Lala Mata Din v. A. Narayanan* reported in (1969) 2 SCC 770. That was a case concerning a suite for rendition of accounts and an error had crept up in the manner in which the valuation of the reliefs was done, which was because of the mistake of their counsel. It was in that background that the time was extended by invoking Section 5 of the Limitation Act. In the present case, as seen above, we are concerned with a special Act, where there are specific provisions to act in a particular manner for filing the notice of opposition to the registration as well as for filing the counter statement. It may also be noted that it is a specialized field where specialized attorneys appear for the parties. That apart, an effective alternative remedy is very much available to the petitioner under the statute by filing a rectification application u/s 57 of the Act, which the petitioner has already filed. The only difference between the two proceedings will be that in the rectification proceedings the burden of proof will be on the petitioner, whereas in the opposition proceedings the burden of proof will be on the respondent - 3.

29. For the reasons stated above, we do not see any error in the order passed by the Deputy Registrar of Trade Marks, Chennai in returning the notice of opposition filed by the petitioner, nor do we see any error on the part of the Appellate Board in rejecting the appeal against the refusal to review that order. No case is made out to review the order passed by the Deputy Registrar of Trade Marks, Chennai, and therefore, there was no error in rejecting the appeal. In the circumstances, we hereby dismiss this writ petition, however, without any order as to costs. Consequently, connected miscellaneous petition is also dismissed.