Kavita S.J.

IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION
IN ITS COMMERCIAL DIVISION

COMMERCIAL MISCELLANEOUS PETITION (L) NO.4309 OF 2023

Coaster Shoes Company Pvt. Ltd. …Petitioner

Versus

Registrar of Trade Marks, Trade Marks Registry & Anr. …Respondents

WITH

INTERIM APPLICATION (L) NO.7301 OF 2023
IN
COMMERCIAL MISCELLANEOUS PETITION (L) NO.4309 OF 2023

AND

COMMERCIAL MISCELLANEOUS PETITION (L) NO.4305 OF 2023

Coaster Shoes Company Pvt. Ltd. …Petitioner

Versus

Registrar of Trade Marks, Trade Marks Registry & Anr. …Respondents

WITH

INTERIM APPLICATION (L) NO.7468 OF 2023
IN
COMMERCIAL MISCELLANEOUS PETITION (L) NO.4305 OF 2023

KAVITA SUSHIL JADHAV
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Mr. Hiren Kamod a/w Prem Khullar, Kunal Kanugo and Annu Sharma i/b. Venkateshwar for the Petitioner in both the Petitions.

Mr. Advait M. Sethana a/w Shreyas Deshpande, Poushali Roychoudhary, Sandeep Raman i/b. Shreyas Deshpande for Respondent No.1 in both the Petitions .

CORAM : R.I. CHAGLA, J.

DATED : 16TH AUGUST, 2024.

JUDGMENT :

1. By this Petition, the Petitioner is seeking quashing and setting aside of the impugned Order dated 7th October, 2022 passed by the Examiner of Trade Marks, Trade Marks Registry, Mumbai. Further, direction is sought to the Trademark Registrar to take the evidence in support of opposition filed by the Petitioner on record and to re-open the Opposition No.757461 and Application No.1551485.

2. Heard the arguments on behalf of the Petitioner and Respondent No.1. The Respondent No.2 was given ample opportunities to remain present before this Court and the Petition had been adjourned on prior occasions vide orders dated 26th February, 2024 and 21st March, 2024. The Respondent No.2 has

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failed to avail such opportunities and remained absent during the hearing before this Court. Accordingly, the Respondent No.2 has not been represented during the arguments.

3. The Petitioner is a company engaged in the business of *inter alia* manufacturing, marketing and sale of footwear.

4. In the year 1999, the predecessor of the Petitioner, namely its family owned company Apex Shoes Co. Pvt. Ltd., honestly and *bona fide* coined and adopted the trade mark "TRAVEL FOX" in respect of manufacture and sale of footwear. Since the year 2000, the trade mark TRAVEL FOX has been continuously and extensively used by the Petitioner through its predecessor and through itself.

5. The Petitioner has applied for and secured trade mark registration for the mark "

" in class 25. The Petitioner has reproduced a table comprising of the particulars of the Petitioner's trade mark registration bearing No.1339103 in Class 25 at paragraph 22 of the Petition. Copies of online status, registration certificate and journal copy in respect of the Petitioner's trade mark registration No.1339103 in Class 25 are at Exhibits V to V2 to the Plaint.

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6. The Petitioner's products are sold in a considerable number of department stores, other authorized specialty retail stores, with traders/wholesalers and various e-commerce retailers which deliver across all the major cities in India. The Petitioner has also widely used and extensively promoted and advertised its trade marks to the public in connection with its products. To demonstrate its goodwill and reputation in respect of its goods bearing the TRAVEL FOX trade mark, the Petitioner has furnished a statement of its nationwide sales figures in respect of its goods bearing the trade mark "TRAVEL FOX" for the years 2012-2023.

7. The Respondent No.1 is the Registrar of Trade Marks who had passed the impugned order which is being challenged by the present Petition.

8. The facts leading to the present Petition are as under:

(i) On 19th April 2007, the Respondent No. 2 filed the impugned trade mark applications under Nos. 1551485 and 1646145 in Classes 25 and 18 (hereinafter referred to as "**impugned applications**") for the impugned mark "

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" on a "***proposed to be used***" basis before the Registrar of Trade Marks, i.e. the Respondent No. 1.

(ii) On 1st November 2009, the Respondent No. 2's impugned applications in respect of the impugned mark "

" were advertised in Trade Mark Journal No. 1427-0. On 8th March 2010, the Petitioner duly filed Notice of Oppositions against Respondent No. 2's impugned applications under Nos. 1551485 and 1646145 in Classes 25 and 18.

(iii) The notices of opposition filed by the Petitioner were served by the Respondent No.1 on the Respondent No. 2 vide the Respondent No. 1's letter dated 14th November 2011.

(iv) On 30th May 2011, the Respondent No. 2 has allegedly filed its counter statement with the Respondent No. 1, however, the Petitioner claims **Respondent No.1**

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has failed to serve a copy thereof upon the Petitioner and / or its agent till date. A copy of the counter statement as uploaded on the website of the Trade Marks Registry / Respondent No. 1 is annexed to the Petition.

(v) On 6th January 2014, the Petitioner's erstwhile trade mark attorney received a letter from the Respondent No. 2's agent stating that the Respondent No. 2 has filed its counter statement.

(vi) On 21st January 2014, the Petitioner's erstwhile trade mark attorney filed a letter before the Respondent No. 1 informing about the non-service of counter statement and requested for a copy of the counter statement.

(vii) In March 2015, the Petitioner's changed its trade mark attorney and accordingly it filed an application before the Respondent No. 1 to transfer the matter to its new trade mark attorney on 19th March 2015.

(viii) Thereafter, the Petitioner's new trade mark attorney regularly and diligently followed up with the

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Respondent No. 1 for service of the counter statement filed by the Respondent No. 2. Copies of the 9 letters addressed by the Petitioner's new trade mark attorney to the Respondent No. 1 between ***30th September 2015 to 16th February 2022*** are annexed to the Petition. However, as contended by the Petitioner, despite regular follow ups, the counter statement has not been served by the Respondent No.1 on the Petitioner till date.

(ix) The Petitioner states that despite not receiving the counter statement even after continuous follow ups, the Petitioner, as a due diligent measure, filed the evidence in support of opposition with the Respondent No. 1 by way of an affidavit on 22nd November 2018 and also a served a copy on the Respondent No. 2. Followed by this, a letter in lieu of Evidence in support of Application was filed by the Respondent No. 2 on 2nd January 2019, and a letter in lieu of Evidence in Reply was filed by the Petitioner on 10th January 2019.

(x) Thereafter, the Petitioner received a notice regarding appointment of hearing dated 8th August 2022

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in the main opposition proceedings. During the course of hearing on 8th August 2022, detailed arguments were advanced on merits and various case laws and authorities were cited before the Respondent No.1. Despite the same, without going into the merits of the case, the Respondent No.1 has abandoned the oppositions filed by the Petitioner vide the Impugned Order dated 7th October 2022 (hereinafter referred to as "**Impugned Order**") **solely on the ground that the Petitioner did not file their Evidence in support of their opposition in time**. Copy of the note sheet prepared by the Respondent No.1 / Ld. Hearing Officer, written submissions filed by the Petitioner and written submissions filed by the Respondent No.2 before the Ld. Hearing Officer are annexed at ExhibitO1, P & Q respectively to the Petition.

(xi) **The Impugned Order was passed by Respondent No. 1 without going into the merits of the matter, on the premise that the counter statement was allegedly served upon the Petitioner**.

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(xii) In view thereof, on 29th November 2022, the Petitioner filed a RTI request raising specific questions regarding the purported service of the counter statement. Vide its letter dated 19th December 2022, the Respondent No. 1 responded to the question of service of the counter statement and the proof of its delivery upon the Petitioner by stating that "***No such information found in the available record***". A copy of Petitioner's erstwhile trade mark attorney's Affidavit dated 9th February 2023 affirming the non-service of the counter statement on the Petitioner is annexed at Exhibit-T to the Petition.

(xiii) In these facts and circumstances, on 14th February 2023, the Petitioner filed the present Petition challenging the Impugned Order dated 7th October 2022 before this Court.

9. The Respondent No.1 has controverted the fact that the Counter Statement dated 30th May, 2011 has not been served upon the Petitioner. It is the case of the Respondent No.1 in the Affidavit-in-Reply to the Petition that the Respondent No.1 had served the Petitioner with the Counter Statement dated 30th May, 2011 of

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Respondent No.2 as available in the form TM-5, vide Dispatch No. TOP-4875 dated 14th March 2012. This was dispatched by Respondent No.1 on 30th March, 2012. By way of such letter dated 14th March 2012, it was informed to the Petitioner, that in the absence of any evidence in support of Opposition filed by the Petitioner within two months, Petitioner's Opposition will be deemed to have been abandoned vide Rule 50(2) of the Trade Marks Rules 2002 ("**2002 Rules**"). Further, the copy of the Counter Statement was also uploaded at the official Website of Respondent No.1.

10. Mr. Kamod, learned Counsel appearing for the Petitioner has submitted that it is pertinent to note that the provisions in the Trade Marks Act, 1999 ("**the Act**") and 2002 Rules that lay down the procedure of service of documents in opposition proceedings. In this context, he has placed reliance upon Section 21 and in particular, Section 21(2), 21(3) and 21(4) of the Act. He has also placed reliance upon Rule 49, 50, 51 and 52 of the 2002 Rules. He has submitted that from the bare perusal of the aforesaid provisions, more particular the words "Registrar shall serve" which is evident from Section 21(2) and 21(3) of the Act, there is an express duty cast upon the Respondent No.1 / Registrar of Trade Marks to serve a copy

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of the Notice of Opposition upon the Applicant and thereafter to serve a copy of the Counter Statement on the Opponent.

11. Mr. Kamod has thereafter referred to Section 21(4) of the Act which states the manner of submission of evidence which would be in the prescribed manner i.e. as per the Rules notified under the Act. He submits that the contradistinction between Sections 21(2) and (3) of the Act and Rules 50, 51 and 52 of the 2002 Rules, elicits a notable difference in the language and manner of submission under these provisions. He has submitted that Rules 50, 51 and 52 prescribe a departure from the procedure of service of documents by the Registrar of Trade Marks as set out in Sections 21(2) and (3) of the Act, whereby the burden of serving documents is shifted from the Registrar of Trade Marks and an obligation is casted upon the parties to serve the copies of their respective evidence upon one another.

12. Mr. Kamod has in the Written Statement relied upon a table describing the manner of filing proceedings under the provisions of the Act and the 2002 Rules which is reproduced below:

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DOCUMENT	DUTY TO SERVE	RELEVANT PROVISION
1st Stage: Notice of Opposition	Registrar of Trade Marks shall serve on the Applicant	Section 21(2) of the Act
2nd Stage: Counter Statement	Registrar of Trade Marks shall serve on the Opponent	Section 21(3) of the Act r/w Rule 49 of the 2002 Rules
3rd Stage: Evidence in Support of Opposition	Opponent shall file with the Registrar and simultaneously serve it on the Applicant	Section 21(4) of the Act r/w Rule 50(1) of the 2002 Rules
4th Stage: Evidence in Support of Application	Applicant shall file with the Registrar and simultaneously serve it on the Opponent	Section 21(4) of the Act r/w Rule 51(1) of the 2002 Rules
5th Stage: Evidence in Reply by Opponent	Opponent shall file with the Registrar and simultaneously serve it on the Applicant	Section 21(4) of the Act r/w Rule 52 of the 2002 Rules

13. Mr. Kamod has submitted that once the stage of filing and serving of Notice of Opposition and Counter Statement is over,

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the Registrar does not have to serve the proceedings thereafter upon the Applicant or Opponent and it is for the parties themselves to serve their respective proceedings upon each other while filing the same with the Registrar of Trade Marks.

14. Mr. Kamod has submitted that on a plain reading and interpretation of the aforesaid provisions leaves no manner of doubt that there is a statutory obligation specifically cast upon the Registrar of Trade Marks and him alone to serve a copy of the counter statement upon the Petitioner (opponent).

15. Mr. Kamod has submitted that the prescribed time period / obligation of the Opponent / Petitioner to file its Evidence in Support of Opposition within the two months' time limit prescribed under Rule 50(1) of the 2002 Rules would start only after the Registrar of Trade Marks / Respondent No. 1 has served the counter statement upon the Opponent / Petitioner.

16. Mr. Kamod has submitted that it is a settled principle of law that when the statute lays the manner in which an act is to be done, it must be done in that manner only, and all other ways of the act are necessarily forbidden. He further submitted that it is a settled

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principle of law that if the power to do a particular act is to be exercised in a particular manner and by a particular authority under a statute, then it must be exercised in that manner or not at all. All other modes of exercise are prohibited. The Courts in India have taken judicial notice of the principle of law that when the statute expressly lays down the mode of doing something, it necessarily implies a prohibition of doing it in any other way. He has placed reliance on the decisions of the Supreme Court in ***GENE Campaign and Ors. vs. Union of India (UOI) and Ors.,***[1] in particular Paragraph 42.19 and 42.20 as well as the decision of this Court in ***Uday B. Prabhu vs. The State of Goa and Ors.,***[2] in particular Paragraphs 9, 60 and 61 and the decision of the Delhi High Court in ***Ayur United Care LLP vs. Union of India and Ors.,***[3] in particular Paragraphs 15.1 and 15.2 thereof in this context.

17. Mr. Kamod has submitted that in view of the aforementioned decisions there is no manner of doubt that Section 21(3) of the Act unambiguously casts a duty upon the Registrar of Trade Marks and him alone to serve a copy of the counter statement

1 *MANU/SC/0743/2024*
2 *MANU/MH/4246/2023*
3 *MANU/DE/7044/2023*

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upon the Opponent i.e. the Petitioner in the present case. It is only upon the Registrar of Trade Marks serving the copy of the Counter Statement on the opponent that the said provision will be complied with. In other words, the act of serving a copy of the counter statement upon the Petitioner cannot be done by any other person since service of a copy in any other manner is necessarily forbidden.

18. Mr. Kamod has submitted that the interpretation of Rule 49 of the 2002 Rules provided by the Respondent No.1 to contend that "a copy of counter statement will be ordinarily served by the Registrar of Trade Marks", but anyone else can also serve the counter statement upon the Opponent is wholly misconceived and made out of gross ignorance of law. He has submitted that the Respondent No.1 is picking and choosing words from the said Rule to provide it with a contorted and self-serving interpretation. He has submitted that a bare perusal of the provision of Section 21 of the Act shows that while Section 21(2) specifies the timeline for the Applicant to file its counter statement and Section 21(3) casts an obligation upon the Registrar of Trade Marks to serve a copy of the counter statement upon the Opponent, no time line has been stipulated for the Registrar of Trade Marks to serve the counter statement upon the Opponent.

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He has submitted that on plain reading and interpretation of Rule 49 along with Section 21(3) of the Act makes it evident that while Section 21(3) casts a duty on the Registrar of Trade Marks to serve a copy of the Counter Statement upon the Opponent, the said Section does not provide for any time frame within which the Registrar must perform that duty of serving the Counter Statement upon the Opponent. The said time frame to serve a copy of the Counter Statement by the Registrar of Trade Marks is provided for in Rule 49(1) the 2002 Rules. He has referred to the last line of Rule 49(1) which merely prescribes a time of two months within which the Registrar of Trade Marks must ordinarily serve the counter statement upon the Opponent. The said Rule 49(1) cannot and does not discharge the Registrar of Trade Marks of his duty to serve the Counter Statement as provided by Section 21(3) of the Act.

19. Mr. Kamod has submitted that it is settled principle of law that Rules cannot override the Act and any interpretation of Rule 49(1)in the manner sought for by Respondent No.1 will be in the teeth of Section 21(3) of the Act which is legally impermissible.

20. Mr. Kamod has submitted that the Respondent No.1 has

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sought to expand the scope of the present Appeal by contending that the counter statement need not be served by the Registrar of Trade Marks upon the Opponent and it is the Applicant who must serve the Counter statement on the Opponent. He has submitted that this contention is nothing but an afterthought and an attempt to supplement the reasons provided in the order, which is impermissible. He has submitted that this contention of the Respondent No.1 did not form part of the reasons given in the impugned order. He has submitted that it is a settled principle of law that an order must speak for itself and the Appellate Court must look for the reasons within the order under challenge. He has referred to the excerpts of reasons given in the impugned order and which states that without going into the merits of the case, the Registrar of Trade Marks has found that a copy of the Counter Statement was served to the Opponent's erstwhile Attorney viz. *M/s. GROVER & ASSOCIATES, 1/3 Block No. 41, Singh Sabha Road, Behind Amba Cinema, Delhi-110007 vide letter No. TOP 4875 dated 14/03/2012 at the address given for correspondence/service.* He has submitted that a bare perusal of the reasons given in the impugned order makes it evident that the Respondent No.1's finding is that the Petitioner's opposition has been dismissed only on the ground that a copy of the counter

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statement was served by the Respondent No.1 upon the Petitioner's erstwhile Trade Mark Attorney. The issue whether the Respondent No.2 / Applicant had served a copy of the counter statement upon the Petitioner was not even considered during the proceedings before the Trade Marks Registry.

21. Mr. Kamod has submitted that thus Respondent No.1's contention that the counter statement need not be served by the Registrar of Trade Marks upon the Opponent and it is the Applicant who must serve the counter statement on the Opponent, is an irrelevant consideration in the present proceedings and the same is liable to be rejected on this ground also.

22. Mr. Kamod has submitted that the Respondent No.1 had not produced any cogent or reliable document to show that it has served a copy of the counter statement on the Petitioner. He has referred to the letter dated 21st January, 2014 addressed by the Petitioner's erstwhile trade mark attorney informing Respondent No.1 about the non-service of counter statement and requested for a copy of the counter statement from the Respondent No. 1. There has been no response from Respondent No.1 to the said letter and / or service

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of a copy of the counter statement upon the Petitioner till date. He has also referred to the numerous follow-ups of the Petitioner with the Respondent No.1 for service of counter statement upon the Petitioner. However, counter statement has not been served upon the Petitioner till date.

23. Mr. Kamod has submitted that the Petitioner filed its Evidence in Support of Opposition with the Respondent No.1 on 22nd November 2018, as a due diligent measure and in order to allow the opposition proceedings to proceed further. It is relevant to note that the Respondent No. 1 permitted the Petitioner to file its Evidence in Support of Opposition and did not raise any objection to the Petitioner filing the same. This was followed by the letter in lieu of Evidence in Support of Application filed by the Respondent No.2 on 2nd January, 2019, and a letter in lieu of Evidence in Reply filed by the Petitioner on 10th January 2019. He has submitted that it is relevant to note that the Respondent No.1 permitted the completion of the pleadings and it did not raise any objection in respect thereof.

24. Mr. Kamod has submitted that the Petitioner had sought information under the Right to Information Act, 2005 and it received

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a response dated 19th December 2022 from the Respondent No. 1. This was in the context of the Petitioner not having been served the counter statement by the Respondent No. 1. In the response letter of Respondent No.1, in response to the RTI Application to a specific query viz. "Is there any proof of delivery or confirmation of delivery or for service of counter statement in Opposition No. 757461? If yes, please provide copy of such acknowledgement or proof of delivery", the response was "No such information found in the available record."

25. Mr. Kamod has submitted that thereafter in the Affidavit in Reply filed by the Respondent No.1 to the present Petition, the Respondent No.1 has only produced the copies of letter dated 14th March, 2012 bearing certain dispatch numbers allegedly sent by the Respondent No. 1 to the Petitioner. However, these dispatch numbers are only for the Respondent No. 1's internal record and they did not show actual dispatch of any letter.

26. Mr. Kamod has submitted that the Respondent No.1 has not produced a single document to show that the alleged letters or the copy of the counter statement were actually sent by it to the

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Petitioner or that the Petitioner has received the same. The Respondent No. 1 has failed to produce the acknowledgment card from the postal department / authorities proving service of the copy of the counter statement on the Petitioner. Pertinently, the Respondent No. 1 has failed to produce even a copy of a receipt showing the payment made by it towards posting a copy of the counter statement to the Petitioner. He has submitted that the dispatch numbers written on the letters dated 14th March 2012 are for the Respondent No. 1's internal record and they do not prove that the letter bearing the dispatch number or that any document bearing the same was actually sent out by the Respondent No. 1 to the Petitioner.

27. Mr. Kamod has submitted that the Petitioner has filed an Affidavit of its erstwhile trade mark attorney affirming the fact that he has not been served with a copy of the counter statement by the Respondent No. 1.

28. Mr. Kamod has objected to the Respondent No.1 placing reliance upon the page from the Trade Mark Registry's Dispatch Register on alleged tracking numbers during the oral arguments. He

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has submitted that this document was never produced inspite of the Petitioner addressing a letter dated 21st January, 2014 and thereafter nine additional letters to Respondent No.1 through its Trade Mark Attorney. However, neither the Respondent No.1 replied to the Petitioner, nor produced these documents in response to the Petitioner's letters. Further, these documents do not form a part of the reasons given in the impugned Order dated 7th October 2022. The Respondent No.1 did not produce these documents in response to the RTI Application filed by the Petitioner. Further, when the Affidavit-in-Reply to the present Petition was filed, the Respondent No.1 could not produce these documents. Thus, the Respondent No.1 tendered these documents for the first time during the course of oral submissions by tendering the same across the bar. The Respondent No.1 has not deposed to the same on Affidavit and hence, these documents cannot be accepted.

29. Mr. Kamod has submitted that instead of producing a copy of the receipt issued in respect of the parcel allegedly posted by the Respondent No.1 to the Petitioner, or a copy of the acknowledgment received in lieu of such parcel allegedly posted by it, the Respondent No. 1 has produced irrelevant documents to

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somehow substantiate its false claims.

30. Mr. Kamod has submitted that the facts and circumstances surrounding the Respondent No.1's alleged Dispatch Register and the tabular list produced by the Respondent No.1 are dubious and the same do not merit any credence and ought to disregarded.

31. Mr. Kamod has placed reliance upon the decision of this Court of the in ***Court Receiver v. Registrar of Trade Marks,***[4] where this Court observed that in the absence of any reliable evidence to show that the Registrar of Trade Marks had sent the letter to the petitioner therein, or that the Petitioner received the same from the Registrar of Trade Marks, the Division Bench refused to accept the Registrar of Trade Marks' contention that the letter was sent to the Petitioner therein. He has in particular placed reliance upon Paragraph 5 and 6 of the said decision.

32. Mr. Kamod has also placed reliance upon the decision of Intellectual Property Appellate Board in ***Munira Virani v. Registrar of***

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4 *2016 SCC OnLine Bom 12975*

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Trade Marks, Trade Mark Registry,[5] wherein the Tribunal has considered a case where the Registrar of Trade Marks had rejected a trade mark application on the ground that the Applicant / Appellant therein had failed to file its evidence in the prescribed time. Similar to the present, the Applicant / Appellant therein contended that since it had not been served with the evidence filed by the Opponent / Respondent therein, that the prescribed time period to file the evidence in support of the application had not started and therefore the Registrar of Trade Marks had erroneously dismissed the application. The Tribunal held that there is no clear and cogent evidence available on record to show that the Appellant had positively received the copy of evidence and since there were two possible views, the Tribunal gave the benefit of doubt to the Applicant / Appellant therein. He has particularly placed reliance upon the Paragraphs 44 and 46 of the said deision.

33. Mr. Kamod has also relied upon the decision of the Madras High Court in ***Ramya S. Moorthy v. Registrar of Trade Marks, 2023*** [6]***,*** wherein the Court was hearing an appeal filed by the

5 *2018 SCC OnLine IPAB 88*

6 *SCC OnLine Mad 5305*

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Appellant therein against the order passed by the Registrar of Trade Marks rejecting the trade mark application of the Appellant / Applicant therein for its failure to file its counter-statement within the statutory period provided under Section 21(2) of the Act. The Registrar of Trade Marks therein had relied upon Rule 18(2) of the Trade Mark Rules, 2017 which provides a deeming fiction of service of notice by e-mail once the email is sent. The Court rejected the contention of the Registrar of Trade Marks taking benefit of Rule 18(2) and held that merely sending an e-mail is not enough and there must be proof of receipt of the communication especially since a substantive right of an applicant seeking registration of trade marks is at stake. He has in particular placed reliance upon Paragraphs 5 and 6 of the said decision.

34. Mr. Kamod has submitted that it is not sufficient for Respondent No.1 to merely show that a communication may have been sent from it to the Petitioner. The statutory requirement is for the Respondent No.1 to show receipt of the communication by the Petitioner. He has submitted that the Respondent No.1 has failed to prove through any cogent or clear or reliable evidence that it has posted / sent out a copy of the counter statement, much less a copy

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of the counter statement has been positively served upon the Petitioner. He has submitted that under the provisions of Section 21(3) of the Act r/w Rule 49 of the 2002 Rules, receipt of a copy of the counter statement by the Opponent / Petitioner is an important stage of the proceedings and the time line to file the Evidence in Support of the Opposition will only be triggered once the Respondent No. 1 serves a copy of the counter statement upon the Opponent.

35. Mr. Kamod has submitted that reliance placed by the Respondent No.1 upon Rule 15 of 2002 Rules to allege that there is deemed service of the counter statement upon the Petitioner once the Respondent No.1 shows that it has put the parcel into post is a misplaced reliance as Rule 15 only lays down the procedure for sending documents to the Trade Mark Registry. He has contrasted this Rule with Rule 18 of the Trade Mark Rule, 2017 which provides for service of documents by the Registrar. Rule 15 of the 2002 Rules is *pari materia* with Rule 14 of the Trade Mark Rules, 2017. He has submitted that if Respondent No.1's submission was to be accepted viz. that Rule 15 of the 2002 Rules applied to the Respondent No.1 (Registrar of Trade Marks), then the service of documents by the Respondent No. 1 would have been covered under Rule 14 of the

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2017 Rules and there was no need for the 2017 Rules to add Rule 18 specifically providing a procedure for service of documents by the Respondent No.1. It therefore follows that the Rule 15 of the 2002 Rules did not apply to the Respondent No. 1.

36. Mr. Kamod has submitted that assuming for the sake of argument that Rule 15 of the 2002 Rules also apply to service of documents by the Respondent No. 1, the Respondent No. 1 has failed to prove service of a copy of the counter statement on the Petitioner. He has submitted that a bare perusal of Rules 15(2) and (3) of the 2002 Rules shows that they prescribe that for the deeming fiction under Rule 15(2) to come into play, the party must first "***prove that the letter was properly addressed and put into the post***". The Petitioner submits that language of Rule 15(3) of the 2002 Rules is unambiguous in its language that the letter was put into post. The Respondent No.1 has failed to prove that the counter statement was put into post as there is failure on the part of Respondent No.1 to produce the receipt much less the original receipt issued by the Postal Department or any other document proving payment made the Respondent No.1 to the postal authorities or an acknowledgement card issued by the postal authorities to the Respondent No.1.

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37. Mr. Kamod has dealt with the contention of Respondent No.1 as to the applicability of Section 27 of the General Clauses Act, 1977. This is in support of the contention of Respondent No.1 that service is deemed to be effected by properly addressing, preparing and posting by registered post a letter containing the document. He has submitted that the presumption of service itself cannot be drawn as the Respondent No.1 has failed to prove that it has properly addressed or pre-paid and posted by registered post a letter containing a copy of the counter statement to the Petitioner.

38. Mr. Kamod has submitted that it is a settled principle of law that presumption of service under Section 27 is a rebuttable presumption. Once the party rebuts the presumption by making a denial / statement on oath, and adducing other evidence, unless such denial is found to be *prima facie* incorrect, the onus will shift to the party relying upon the presumption. He has placed reliance in this context upon the decision of this Court in ***Hajrabi Abdul Gani v. Abdul Latif Azizulla,***[7] in particular Paragraph 6 thereof.

39. Mr. Kamod has submitted that there is material on record to show that the Petitioner has rebutted the presumption of service

7 *1995 SCC OnLine Bom 376*

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assuming for the sake of argument that a presumption of service can be drawn against the Petitioner. Thus, the onus of proving the service of the counter statement on the Petitioner is on the Respondent No. 1. Respondent No. 1 failed to discharge the onus of proving the service of the counter statement on the Petitioner.

40. Mr. Kamod has submitted that the Respondent No.1 has failed to abide by its duty to maintain purity of the Register of Trade Marks. He has submitted that inspite of evidence being allowed to be filed by the Petitioner in support of the opposition and the Respondent No.2 filed evidence in support of its application and that Notice dated 11th July, 2022 issued by the Respondent No.1 fixing hearing the matter on 8th August, 2022, thereafter hearing the parties on merits, Respondent No.1 passed the impugned order dismissing the Petitioner's opposition on a technical point.

41. Mr. Kamod has submitted that the notice which had been issued is the standard notice issued when the matter is to be heard on merits and he has produced a similar notice which had been issued by the Registrar of Trade Mark under Rule 15 of the 2022 Rules from which follows the hearing of the matter on merits.

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42. Mr. Kamod has submitted that the Respondent No. 1 ought to have considered the submissions made by the parties, especially in the facts of the present case where the Respondent No. 2 has dishonestly adopted the impugned trade mark. Rather than considering the detailed submissions made before it on merits, or even considering any of the aforesaid facts, the Registrar of Trade Marks has dismissed the opposition proceedings on a mere technicality. Thus, Respondent No. 1 has completely abdicated its duty to protect the interests of the parties and maintaining the purity of the Register of Trade Marks.

43. Mr. Kamod has submitted that the Respondent No.2 is a rank infringer who has dishonestly adopted the impugned trade mark which is nearly identical with and / or deceptively similar to the Petitioner's registered trade mark and hence, no prejudice would be caused to the Respondent No. 2 if the reliefs as prayed for in the present Petition are granted. On the other hand, the Petitioner is a registered Proprietor of its trade mark which it has been using since the year 2002 and has diligently prosecuted the Opposition proceedings against the impugned Applications before the Trade Marks Registry for more than 10 years. The wrongful dismissal of the

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Petitioner's opposition proceedings by the Respondent No. 1 is violative of the Petitioner's valuable statutory rights and has caused great prejudice to the Petitioner. Accordingly, the impugned order be set aside.

44. Mr. Advait Sethna, learned Counsel appearing for the Respondent No.1 has submitted that the counter statement dated 30th May, 2011 of Respondent No.2 had been served by the Respondent No.1 upon the Petitioner. He has submitted that the counter statement was dispatched by Respondent No.1 on 30th March, 2012 to the address of the Petitioner as available in the form TM-5, vide Dispatch No. TOP-4875 dated 14th March 2012.

45. Mr. Sethna has submitted that the relevant Rules to be considered in these proceedings are the 2002 Rules. He has submitted that the Notice of Opposition was filed by the Petitioner on 8th March 2010 under the provisions of the 2002 Rules. The said opposition came to be adjudicated culminating into the impugned Order dated 7th October 2022. He has submitted that the repeal of the 2002 Rules by the Trade Marks Rules 2017 in the interregnum will not have any effect of applicability of 2002 Rules to these

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proceedings. He has placed reliance upon the decision of Delhi High Court in ***Mahesh Gupta v/s Registrar of Trademarks*** [8] where Delhi High Court had considered the applicability of 2002 Rules after its repeal by the Trade Mark Rules, 2017 and framed the question of law viz. Whether the Trade Marks Rules, 2017, would apply retrospectively to proceedings initiated under the Trade Marks Rules, 2002. The Delhi High Court answered that the Trade Mark Rules, 2017 would not affect the proceedings initiated under Trade Mark Rules, 2002 and the said proceedings would be governed by the Trade Mark Rules, 2002. He has submitted that the prior decision of the Madras High Court in ***Ramya S. Moorthy (supra),*** gave rise to the issue as to whether the Trade Marks Rules 2017 would impact pending proceedings which has been put to rest by the Delhi High Court in the case of ***Mahesh Gupta (supra)***.

46. Mr. Sethna has submitted that the 2002 Rules which are applicable in these proceedings contemplates service of counter statement of Respondent No.2 within two months of receipt of Notice of Opposition i.e. under Rule 49 and Affidavit of Evidence by the Petitioner within two months from service of Counter statement i.e.

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8 *Judgment dated 13th March, 2024 , LPA 429/2023*

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under Rule 50. He has submitted that Section 21(3) of the Act reveals that the Registrar shall "Serve" copy of such Counterstatement on the person giving the Notice of Opposition, i.e. the Petitioner in this case. In other words, the said provision categorically refers to the expression Serve / Service which has to be correctly interpreted in the canopy of the statutory framework of the Act.

47. Mr. Sethna has submitted that for the purpose of interpreting the expression Serve / Service, gainful reliance is placed on Rule 15 of the 2002 Rules which stipulates the manner in which documents are served. The said Rule contemplates service of documents such as Applications, notices, statements, or other documents required by the Act or the rules as contemplated in Rule 15 of the 2002 Rules. It clearly encompasses, takes into its fold, covers Service i.e. dispatch or sending (Not Receipt) of Counterstatement by the Registrar to the Opponent / Petitioner as per Rule 49 of the 2002 Rules.

48. Mr. Sethna has submitted that the said Rule 15 of the 2002 Rules applies to service of all documents stipulated in the said

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Rule and not as contemplated by the Petitioner only service of document to the Registry. He has submitted that it cannot be read down and restricted in the manner contended by the Petitioner. Such narrow, restrictive, and misconstrued interpretation, shall defeat the object and purpose of the Act and Rules. In fact, a purposive interpretation shall further the object, intent, and purpose of the said provisions. Furthermore, the Trade Marks Rules, 2002 are framed as per provisions of Section 157(2)(vii) of Trade Marks Act, 1999. Under section 157 (4), these Rules were placed before the Parliament and were duly passed. As such the said Rules have the same force and effect as that of a statutory provision.

49. Mr. Sethna has submitted that to prove such Service of counter statement, the Respondent No.1, during the course of hearing, tendered the extract of its Dispatch Register of Trademark Registry, Top Section Speed Post, where the name of the erstwhile agent of the Petitioner being “Grover and Associates” appears at Sr No.160 in the Top Section Speed Post list. The entry at Sr No.160 of the list of postal acknowledgment shows that the said Letter dated 14th March 2012 dispatched vide Dispatch No. TOP-4875 was put into post vide postal acknowledgment No. EM 915937654IN. Here, the

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Dispatch No. 4873/2012 is for the Opponent/Petitioner's copy of service and 4875/2012 is for the Applicant/Respondent No.2's copy of service of Counterstatement dated 30th May 2011 vide Letter dated 14th March 2012. Both these numbers i.e.4873/4875 are mentioned on the office copy to record the dispatch numbers of the counter statement.

50. Mr. Sethna has submitted that the Respondent No.1 adopts the following procedure in its regular course to serve documents by way of post. A list called Top section speed post list containing serial number, name and place of addressee along with the dispatch details is prepared of all the post that are ready for dispatch. Such Top section speed post list is prepared in two copies and is given to the Postal Department. The envelopes and the copies of Top section speed post list are then collected by the designated person from the Dadar Post Office, Mumbai and sent. The person from Postal Department gives the acknowledgment for the posts along with their respective consignment number. In case of undelivered post, the envelopes are returned to the Office with a remark. The Postal Department retains a copy of the Top Section Speed Post List. He has referred to extract of the Dispatch Register as

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well as Top Section Speed Post List which has been annexed and marked as **Exhibit "A"** to the Written Statement.

51. Mr. Sethna has submitted that the aforesaid sufficiently shows that the letter dated 14th March, 2012 was dispatched from the office of the Respondent No.1. Further, proof of service, sending and dispatch of the counter statement, is duly evidenced by a postal stamp bearing dispatch date of 7th April 2012 from the post office, affixed on the said Dispatch Register, thus proving the statutory requirement of such sending by Respondent No.1.

52. Mr. Sethna has submitted that one can import the provisions of Section 27 of the General Clauses Act, 1897 where the sender has dispatched the notice by post with the correct address written on it for which there is no dispute. In such situation, it can be deemed to have been served on the addressee unless the addressee proves that it was not really served or he was not responsible for such non service. He has placed reliance upon the decision of the Supreme Court in the case of ***V. Raja Kumari Vs. Subbarama Naidu and Ors.***[9] in this context.

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9 *AIR 2005 SC 109*

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53. Mr. Sethna has submitted that Section 27 of the General Clauses Act is in the nature of statutory presumption. It is settled law that such statutory presumption can be rebutted by leading cogent evidence. Except bare denial in the memo and affidavit of earlier attorney that too filed on 9th February 2023, much after passing of the Impugned Order dated 7th October 2022, nothing is placed on record to rebut the presumption.

54. Mr. Sethna has placed reliance upon the decision of the Supreme Court in ***M/s. Ajeet Seeds Ltd. v/s K. Gopala Krishnaiah*** [10] wherein Section 27 of the General Clauses Act has been considered. He has submitted that the said provision categorically uses the expression "unless the contrary is proved", service is deemed to have been effected. In the present case, the letter dated 14th March 2012 by way of which the said counter statement was served, was sent to the address of the erstwhile agent of the Petitioner which address is not disputed. The letter was put into post as is evident from the postal acknowledgment of dispatch from the Postal Department affixed on the Top Section Speed Post List of Respondent No 1. Hence, the burden shifts on the Petitioner to prove to the contrary

10 *Criminal Appeal No.1523/2014 – Judg. Dtd.16/07/2014 (Arising out of SLP(Cri.) No.8783/13)*

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which it has failed to so do.

55. Mr. Sethna has submitted that the Petitioner admittedly, has received the said counter statement of Respondent No.2 in the year 2015. Further, the Petitioner has not disclosed any details in this regard. Further, pursuant to such receipt of the counter statement the Petitioner admittedly filed his Evidence on 22nd November 2018. Thus, from any angle, the Petitioner is not prejudiced in any manner whatsoever and he has failed to comply with the strict timelines to file the evidence under the Act and Rules, which is within 2 months from date of service of the counter statement upon the Petitioner under Rule 50 of 2002 Rules. The Registrar has no power under the Act and Rules to extend such statutory timelines in any manner whatsoever. In view thereof on this ground alone, the impugned order which is passed within the statutory framework deserves no interference.

56. Mr. Sethna has placed reliance upon the decision of Delhi High Court in ***Sun Pharma Laboratories v/s Dabur India Ltd. And Ors.***[11] where the Delhi High Court had the occasion to consider Order

11 *2024 SCC OnLine Del 813*

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dated 21st July 2022 passed by the Registrar of Trade Marks which is akin to the present impugned order. He has submtited that the said Judgment makes it clear that it is only when the counter statement is received by the Opponent that the time period under Rule 50 begins to run. It is the date of receipt of the counter statement by the Petitioner, which shall be factored for deciding the issue of Abandonment under Rule 50 of the 2002 Rules.

57. Mr. Sethna has submitted that the said Judgment in ***Sun Pharma (Supra)*** has been followed in yet another decision of the Delhi High Court in the case of ***ITC Ltd v/s Deputy Registrar of Trade Marks and Others***[12] where Rule 50 of the 2002 Rules has been interpreted. It has been held that the Appellant cannot take advantage of delay in the proceedings before the Registrar, since that would amount to leveraging an institutional delay to transgress a mandatory timeline.

58. Mr. Sethna has submitted that the Respondent No.1 has sufficiently discharged the burden to show that service was done as contemplated under Section 21(3) of the Act r/w Rule 15, 19 of the 2002 Rules. Further, Section 21(3) of the Act only contemplates

12 *2024 SCC OnLine Del 1660*

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service of the counter statement upon the Opponent. The Petitioner cannot read down the expression service as it appears under Section 21(3) of the Act to infer receipt on the Petitioner. Thus, the mandatory time lines under the Act and Rules come into play which require strict compliance. He has submitted that the contention of the Petitioner that the time lines under the Act and Rules have not set in at all due to Non-Receipt of the counter statement, amounts to misreading, misinterpreting and misconstruing the said legal provisions under Section 21 of the Act read with Rule 15, 19, 49 and 50 of the 2002 Rules.

59. Mr. Sethna has submitted that Rule 50 of the 2002 Rules provides that if an Opponent takes no action under sub-rule (1) of Rule 50 of the 2002 Rules within the time mentioned therein, he shall be deemed to have abandoned his Opposition. The said provision provides for a strict regimen for filing of evidence by way of Affidavit in support of an Opposition. Thus, under no circumstances can the Affidavit of Evidence be filed beyond the prescribed time period of two months from the date of service of the counter statement. Therefore, even assuming whilst denying that the said counter statement is not served by the Respondent No.1, the fact of

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service and receipt by Petitioner of the counter statement in 2015 is not disputed. Despite such receipt, the Petitioner chose to file its Evidence only on 22nd November 2018 for which there is no explanation or justification for filing the evidence so belatedly, thereby defeating the statutory timelines under the Act and Rules.

60. Mr. Sethna has submitted that in addition to serving a copy of the counter statement by way of letter dated 14th March 2012, the said copy of the counter statement was also uploaded on the official website of the Respondent No.1. Thus, under the doctrine of Constructive Notice, the Petitioner was under notice of the fact of filing of the counter statement. Moreover, the Respondent No 1 has sufficiently proved the dispatch, service of the counter statement to the Petitioner. Also, that the same was, in fact, received by the Respondent No. 2 on 9th April 2012. Thus, the contention of the Petitioner that it was only in January 2014 that the Petitioner acquired knowledge of filing of such counter statement is a sheer after thought.

61. Mr. Sethna has submitted that the Petitioner is guilty of suppression of material facts, particularly the fact of receipt of

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counter statement and hence, no equitable relief be granted to the Petitioner. He has submitted that the Petitioner has failed to satisfy this Court as to why it slept over its rights for more than 6 years and did not file its Evidence within time. The Petitioner is diverting from the pivotal issue of not accepting the crucial fact of having received the counter statement, choosing not to disclose when it was received despite having filed its evidence, making it clear that there is no wrong doing or prejudice caused to the Petitioner. The Respondent No.1 has correctly concluded in favour of Abandonment of the Opposition of the Petitioner under Rule 50 (2) of the 2002 Rules and thus justifiably dismissed its Opposition.

62. Mr. Sethna has submitted that the impugned order clearly records that the counter statement was filed by the Applicant and the same was being served on the erstwhile Attorneys of the Petitioner who are on record i.e., M/s Grover & Associates vide a letter dated 14th March 2012, which was dispatched on 30th March 2012 vide Dispatch No. TOP4873. The Impugned Order further records that a copy of the said letter was also sent to the Applicant on the same day, i.e., 30th March 2012 and the same was received by the Applicant on 9th April 2012. The Affidavit in Evidence of Opposition

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is filed by the Petitioner much after the lapse of 2 months from the date of service of the counter statement on the Attorneys of the Petitioner and therefore such Evidence is deemed to be abandoned under Rule 50(2) of the 2002 Rules.

63. Mr. Sethna has distinguished the Judgment cited by the Petitioner viz. ***The Court Receiver Vs. Registrar of Trade Marks (supra)*** on the ground that the case deals with Section 25(3) of the Act read with Rule 64(1) of the 2002 Rules which is for O3 Notice. This is contrasted with the issue at hand which is interpretation of Section 21(3) of the Act read with Rules 15, 49 and 50 of the 2002 Rules. Therefore, the cited decision is not applicable and of no help to the Petitioner.

64. Mr. Sethna has also dealt with the case relied upon by the Petitioner viz. ***Ramya S. Moorthy (supra)*** which concerns service of Notice of Opposition through e-mail on the Applicant under Section 21(2) of the Act read with Rule 18(2) of Trade Marks Rules, 2017. In light of the Division Bench Judgment of the Delhi High Court in ***Mahesh Gupta (Supra)***, the Trade Marks Rules, 2017 are inapplicable to the present proceedings initiated under the 2002

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Rules and hence, this decision is of no relevance.

65. Mr. Sethna has submitted that the decision in ***Seiwa Kasei Co. Ltd. vs. The Registrar of Trade Marks*** [13] relied upon by the Petitioner is only on the issue whether mere placing of notice on the website constitutes compliance of the Rules under the Trade Marks Act, 1999. He has submitted that in the present case apart from uploading the counter statement on the website, the Registrar has duly served by sending, dispatching and putting into post, a copy of the counter statement to the Attorneys of the Opponent. Therefore, in the present case, there is sufficient compliance of Section 21(3) read with Rule 15 of the 2002 Rules.

66. Mr. Sethna has referred to the decision cited by the Petitioner viz. ***Uday B Prabhu (Supra)*** and has submitted that the well settled principle laid down therein is that if a statute has conferred a power to do an act and laid down the method in which the power has to be exercised, it necessarily prohibits the doing of the act in any other manner than that which has been prescribed. The Respondent No.1 vide the impugned order has followed the above statutory principle of law in letter and spirit. He has submitted

13 *Dated 14th June, 2024*

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that Section 21(3) of the Act read with Rule 15, 49 and 50 of the 2002 Rules which require to be interpreted holistically has been done in furtherance of the statutory scheme, object and purpose of the Act and Rules, to ensure its proper and effective implementation.

67. Mr. Sethna has also dealt with the decision of ***Munira Virani (Supra)*** which has been relied upon by the Petitioner. He has submitted that in that case it was an admitted position that the address of the addressee in the courier by way of which the evidence was served, was incomplete as not completely mentioned. The Tribunal granted benefit of doubt and held that there was no clear and cogent evidence to show service of the said document to the addressee in such circumstances of incomplete address. In the present case, it is not disputed by the Petitioner that the address mentioned in the letter dated 14th March 2012 by way of which the counter statement was served, was neither incorrect nor incomplete. Thus, there is cogent evidence to show due service of the said counter statement to the Petitioner.

68. Mr. Sethna has accordingly submitted that the present Petition being devoid of merits, be dismissed by this Court.

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69. Having considered the rival submissions in my view the narrow issue which arises for determination is whether Section 21(3) of the Act contemplates receipt of Counter Statement from the Registrar of Trade Mark by the person giving Notice of Opposition.

70. In this context, it would be necessary to reproduce the relevant portion of Section 21 of the Act alongwith Rules 49, 50, 51 and 52 of the 2002 Rules as under:

Section 21 of the Act:

"*Opposition to registration.*
(1) Any person may, within four months from the date of the advertisement or re-advertisement of an application for registration, 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.

(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 counterstatement 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.***

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*(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.*

…"

(Emphasis Added by the Petitioner)

Rule 49 of the 2002 Rules

"*Counterstatement*
*(1) The counterstatement required by sub-section (2) of section 21 shall be sent in triplicate in Form TM-6 within two months from the receipt by the applicant of the copy of the notice of opposition from the Registrar and shall set out what facts, if any, alleged in the notice of opposition, are admitted by the applicant. **A copy of the counterstatement shall be ordinarily served by the Registrar to the opponent within two months from the date of receipt of the same.***

…"

(Emphasis Added by the Petitioner)

Rule 50 of the 2002 Rules

"*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*

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

…"

(Emphasis Added by the Petitioner)

Rule 51 of the 2002 Rules

"*Evidence in Support of Application.*
*(1) Within two months or within such further period not exceeding one month in the aggregate thereafter as the Registrar may on request allow, on the receipt by the applicant of the copies of affidavits in support of opposition or of the intimation that the opponent does not desire to adduce any evidence in support of his opposition, the **applicant shall leave with the Registrar** such evidence by way of affidavit as he desires to adduce in support of his application **and shall deliver to the opponent copies thereof** or shall intimate to the Registrar and the opponent that he does not desire to adduce any evidence but intends to rely on the facts stated in the counterstatement and or on the evidence already left by him in connection with the application in question. In case the applicant relies on any evidence already left by him in connection with the application, he shall deliver to the opponent copies thereof.*

…"

(Emphasis Added by the Petitioner)

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Rule 52 of the 2002 Rules

"*Evidence in Reply by Opponent.*
Within one month from the receipt by the opponent of the copies of the applicant's affidavit or within such further period not exceeding one month in the aggregate thereafter as the Registrar may on request in Form TM-56 allow, the opponent may leave with the Registrar evidence by affidavit in reply ***and shall deliver to the applicant copies thereof****. This evidence shall be confined to matters strictly in reply.*"

(Emphasis Added by the Petitioner)

71. Having perused Section 21 and in particular, Section 21(2) and Section 21(3) of the Act where the words "the Registrar shall serve" are mentioned, there is a duty cast upon the Registrar of Trade Marks to serve the Notice of Opposition on the Applicant and thereafter to serve copy of the Counter Statement on the Opponent. This duty of the Registrar of Trade Marks, in my view cannot be cast away by contending that the Notice of Opposition and the Counter Statement has been served on the Applicant and on the Opponent respectively by someone other than the Registrar of Trade Mark. This contention would be contrary to the legislative intent in enacting Sections 21(2) and (3) of the Act. Further, there is a contradistinction between Sections 21(2), (3) of the Act and Rules 50, 51 and 52 of the 2002 Rules. Rules 50, 51 and 52 prescribe a departure from the

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procedure of service of documents by the Registrar of Trade Marks as set out in Sections 21(2), (3) of the Act, whereby the burden of serving documents is shifted from the Registrar of Trade Marks and an obligation is cast upon the parties to serve the copies of their respective evidence upon one another. Thus, once the filing and serving of Notice of Opposition and Counter Statement is over, the Registrar does not have to serve the proceedings upon the Applicant or Opponent and it is for the parties themselves to serve their respective proceedings upon each other upon filing the same with the Registrar of Trade Marks.

72. Further, the duty cast upon the Registry of Trade Marks to serve the Counter Statement on the Opponent is intelligible considering Rule 50 of the 2002 Rules which lays down the timeline for filing evidence in support of the opposition. This timeline has been considered to be mandatory by the Delhi High Court in ***Sun Pharma Laboratories Ltd. v. Dabur India Ltd., (supra).*** Having perused this decision, it appears that the Delhi High Court was only concerned with the issue whether the timeline for filing evidence in support of the opposition can be extended beyond the period prescribed in Rule 50(1) of the 2002 Rules. In that case admittedly,

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the counter statement had been served by the Registrar of Trade Marks upon the Applicant / Opponent therein and the same was admitted by the Appellant / Opponent. Although, the Delhi High Court has in Paragraph 49 of the said decision held that "The counter statement may not be served by the Registrar upon the Opponent.", this does not appear to be the ratio of the said decision. In any event, I am not agreeable with the view expressed by the Delhi High Court in the said decision, in view of my above finding that there is an express duty cast upon the Registrar of Trade Marks to serve the copy of Counter Statement upon the Opponent.

73. I find much merit in the submission of Mr. Kamod who has placed reliance upon the decisions of the Supreme Court and this Court as well as the Delhi High Court in the ***GENE Campaign (supra) ; Uday B. Prabhu (supra) and Ayur United Care LLP (supra)*** respectively that it is settled law that if the power to do a particular act is to be exercised in a particular manner and by a particular authority under a statute, then it must be exercised in that manner or not at all. All other modes of exercise are prohibited. Thus, where the statute expressly lays down the mode of doing something, it necessarily implies a prohibition of doing it in any other way. In my

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view the statute has clearly laid down the procedure of service of notice of opposition and Counter Statement i.e. by the Registrar of Trade Mark and thus, other modes of service of opposition and / or counter statement are prohibited.

74. Further, in my considered view it is necessary for the Opponent to have received the Counter Statement from the Registrar of Trade Mark, considering the mandatory timeline for filing evidence under Rule 50(i) of the 2002 Rules which will commence once the Opponent has been served / received the Counter Statement. This would be the legislative intent in enacting rules 49 r/w 50 of the 2002 Rules under Section 157(2) (vii) r/w 157(4) of the Act.

75. The interpretation placed by Respondent No.1 on the words “ordinarily served by the Registrar of Trade Marks” in Rule 49 to mean that “ordinarily” a copy of counter statement would be served by the Registrar, whereas in other cases the copy of the counter statement may be served directly by the Applicant on the Opponent is misconceived. This interpretation overlooks the remaining part of Rule 49 viz. served by the Registrar to the opponent “within two months from date of receipt of the same”. This

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can only mean that the counter statement is to be served by the Registrar of Trade Marks upon receipt the Counter Statement and that too within two months from the date of receipt. Rule 49(a) cannot and does not discharge the Registrar of Trade Marks of his duty to serve the Counter Statement as provided in Section 21(3) of the Act.

76. The impugned order finds that the counter statement was served by the Registrar of Trade Marks to the Opponent vide letter dated 14th March, 2012. Thus, in any event it cannot be contended on behalf of Respondent No.1 that it was sufficient for the Applicant to serve the counter statement on the Petitioner (Opponent) as this would expand the scope of the present appeal, particularly, when there is no such finding to that effect.

77. Having perused the material on record as well as the several correspondence addressed by the Petitioner to Respondent No.1 requesting for a copy of the counter statement from Respondent No.1 to which there has been no response, coupled with the fact that there is an Affidavit of the erstwhile attorney of the Petitioner *M/s. GROVER & ASSOCIATES,* that the Counter Statement had not been

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served / received leads to only one conclusion that Respondent No.1 had not served the copy of the counter statement upon the Petitioner.

78. In my considered view, the document viz. extract from the Dispatch Register of Respondent No.1 which was only produced during the oral arguments does not show that the counter statement was served upon the Petitioner. There is no receipt from the postal authority to show that there has been a dispatch and / or receipt of the counter statement by the Petitioner / Opponent. Further, to a query put in the RTI by the Petitioner as to whether there is any proof of delivery / confirmation of delivery or service of counter statement, the response is that there is no such information found in the available record. Thus, this extract from the dispatch register which is now being produced by Respondent No.1, apart from being unacceptable and/or no cognizance can be taken of the same, does not support the case of Respondent No.1 at all since it was the duty of Respondent No.1 to show that the Petitioner had received the counter statement.

79. The decision of this Court in ***Court Receiver Vs. Registrar of Trade Marks (supra),*** relied upon by the Petitioner, though

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considering the statutory requirement under Section 25(3) of the Act has held that in the absence of reliable evidence to show that the Registrar of Trade Marks has sent the letter to the Petitioner therein and / or the Petitioner had received the same from the Registrar, the contention of the Registrar of Trade Marks that the letter was sent to the Petitioner cannot be accepted.

80. Further, in the decision of the Intellectual Property Appellate Board (IPAB) in ***Munira Virani v. Registrar of Trade Marks (supra),*** relied upon by the Petitioner, it has been held after considering the material placed on record that there was no clear and cogent evidence available on record to show that the Appellants therein had positively received the copy of evidence filed under Rule 50 by the Appellant. A case where both views are possible, the IPAB was inclined to give benefit of doubt to the Appellant. In ***Ramya S. Moorthy (supra),*** relied upon by the Petitioner, the Registrar of Trade Marks relied upon Section 18(2) of the Trade Mark Rules, 2017 which provided a deeming fiction of service of notice by e-mail once the email is sent. The Court rejected the Registrar of Trade Marks' arguments to hold that merely sending an e-mail is not enough and there must be proof of receipt of the communication especially since

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a substantive right of an applicant seeking registration of trade marks is at stake. The Respondent No.1 has sought to distinguish this decision on the ground that the 2002 Rules are applicable and not 2017 Rules. However, this makes no difference considering that under Rule 49(1) of the 2002 Rules a duty is cast upon the Registrar of Trade Marks to serve the Counter Statement and it is an admitted position that the 2002 Rules are applicable in the present case.

81. In so far as the reliance placed by Respondent No.1 on Rule 15 of the 2002 Rules, having arrived at the above finding that Section 21(3) of the Act requires actual receipt of the Counter statement by the Opponent for the mandatory timelines of filing evidence in support of the opposition under Rule 50 to commence, it is not sufficient for the Registrar of Trade Marks to prove that the letter enclosing the counter statement was properly addressed and put into post for it to be deemed service.

82. Presuming that Rule 15 of the 2002 Rules can be relied upon in the present case, upon comparison of Rule 15 of the 2002 Rules with Rule 14 and Rule 18 of 2017 Rules, it is evident that Rule 15 is *pari materia* with of Rule 14 of the 2017 Rules and pertains to

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service of documents to the Trade Mark Registry and not to documents which are sent by the Registrar of Trade Marks. This is expressly covered under Rule 18 of the 2017 Rules. Thus, Rule 15 will not apply to the documents sent by the Registrar of Trade Mark. Otherwise there was no need for the 2017 Rules to add Rule 18 providing a procedure for service of documents by Respondent No.1.

83. I am of the further view that Section 27 of the General Clauses Act, 1977, relied upon by the Respondent No.1 which provides for meaning of service by post and under which service is deemed to be effected by properly addressing, preparing and posting by registered post is a rebuttable presumption. This is presuming that this provision is at all applicable given my above finding on receipt of counter claim. In the present case, there is sufficient material on record produced by the Petitioner to show that such presumption of service by dispatch by post cannot be drawn. The onus then shifts to Respondent No.1 who in my view has failed to discharge the onus of proving the service of counter statement on the Petitioner.

84. I find that, the Registrar of Trade Marks has failed in its duty to maintain the purity of the register. Inspite of issuing a notice

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of hearing dated 11th July, 2022, which in my view is a notice to hear the matter on merits, the Registrar of Trade Marks rather than considering detailed submissions on merits, has dismissed the opposition proceedings on a mere technicality. Thus, there has been an abdication of the duty of the Registrar of Trade Marks to protect the interest of parties and to maintain purity of the Register of Trade Marks.

85. I have considered the decision of the Delhi High Court which has been relied upon by Respondent No.1 viz. ***Mahesh Gupta (supra).*** The said decision merely provides that where there are pending proceedings, the Trade Mark Rules 2017 will not apply and 2002 Rules will apply under which the proceedings have been initiated.

86. Further, the Judgment in ***ITC Ltd. Vs. Registrar of Trade Marks (supra),*** relied upon by the Respondent No.1, is not applicable to the present case as in that case the Trade Mark Applicant had not shown due diligence, whereas the Petitioner in the present case has in my view diligently followed up the non-receipt of the copy of the counter statement. The said Judgment was in the context of Rule 53

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of 2002 Rules which provides for filing further evidence with the leave of the Registrar of Trade Marks and the issue was the rejection by the Registrar of the Interlocutory Petition filed by the Appellant therein to place on record further evidence under the said Rule. Thus, this Judgment is inapplicable to the facts and circumstances of the present case.

87. The other decisions cited by the Respondent No.1 viz. ***C.C. Alavi Haji Vs. Palapetty Muhammed & Anr.,***[14] and ***M/s. Ajeet Seeds Ltd. (supra)*** are on Section 27 of the General Clauses Act, 1977 and will not assist the case of Respondent No.1 in view of my above finding that the Respondent No.1 has failed to discharge the onus of proving service of Counter Statement on the Petitioner, presuming that this provision is at all applicable.

88. Thus, in my view, the Petitioner has made out a case for grant of relief sought for in the Petition. This is in view of my finding that the Petitioner had not received the counter statement from Respondent No.1 and as a result of which Section 21(3) read with Rule 49 of the 2002 Rules have not been complied with by the Registrar of Trade Marks. The impugned order accordingly requires

14 *Appeal (Crl.) 767/2007 (Arising out of SLP (Cri.) No.3910/06 dtd.18.05.2007*

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to be quashed and set aside.

89. Hence, the following order is passed :

(i) The impugned Order dated 7th October, 2022 is quashed and set aside.

(ii) The Registrar of Trade Marks shall take the Evidence in Support of the opposition filed by the Petitioner on record and re-open Opposition No.757461 under Application No.1551485.

(iii) The Commercial Miscellaneous Petition (L) No.4309 of 2023 is accordingly disposed of.

(iv) There shall be no orders as to costs.

(v) In view of this Judgment and Order, the Commercial Miscellaneous Petition (L) No.4305 of 2023 which also challenges the impugned Order dated 7th October, 2022 passed by the Registrar, Trade Marks, is made absolute in terms of prayer Clauses (a) and (b) of the Petition.

(vi) The Interim Application (L) No.7301 of 2023 filed in

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Commercial Miscellaneous Petition (L) No.4309 of 2023 and Interim Application (L) No.7468 of 2023 filed in the Commercial Miscellaneous Petition (L)No.4305 of 2023 does not survive and is accordingly disposed of.

[R.I. CHAGLA, J.]

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