2023:MHC:3982

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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: **01.09.2023**

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THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

W.P.No.27430 of 2018
WMP. Nos.31933 & 31934 of 2018

N.C.Nanu,
Proprietor, M/s.Neeraja's Payyoli Mixture,
Mini Industrial Estate,
Koyyode P.O.,
Kannur District, Kerala-670 621. ... Petitioner

Vs

1.The Registrar of Trade Marks
Trade Marks Registry,
Intellectual Property Building,
GST Road, Guindy, Chennai.

2. The Assistant Registrar of Trade Marks
Trade Marks Registry,
Intellectual Property Building,
GST Road, Guindy, Chennai.

3. M/s.Shining Bakery
Moonukundanchalil House,
Beach Road, Payyoli,
Kozhikode, Kerala-673 522. ... Respondents

Prayer : Writ Petition has been filed under Article 226 of the Constitution of India to grant a writ of certiorarified mandamus calling for the records in Order bearing No.TOP/2723,

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2724/16/07/2018 dated 11.07.2018 on the file of the second respondent herein and quash the same and consequently direct the first respondent herein to receive the petitioner's counter statement and restore the petitioner's trade mark Application No.3053314 on his file and consider the same in accordance with the Trade Marks Act, 1999.

For Petitioner : Mr.A.Umapathy

For Respondents : Mr.P.r.Ramesh Babu,
Senior Panel Counsel for R1 & R2
No appearance for R3

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ORDER

The petitioner is engaged in the business of manufacturing and selling a bakery product under the mark "PAYYOLI MIXTURE". The petitioner applied for registration of the aforesaid mark in Class 30 under Application No.3053314 on 11.09.2015. The application was accepted and directed to be advertised on 20.06.2016. The third respondent filed Opposition No.859085 on 28.07.2016. Upon receipt of such notice of opposition, by communication dated 12.04.2017, the Registrar of Trade Marks issued a notice to the agent of the petitioner calling upon the petitioner to file its counter statement in Form TM-6,

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which was the prescribed form under the Trade Marks Rules, 2002 (the 2002 Rules). In compliance with such direction, the petitioner filed the counter statement, in Form TM-6, on 02.09.2017. On receipt thereof, by communication dated 03.10.2017, the Registrar of Trade Marks returned the counter statement both on the ground that a cheque would not be accepted and on the ground that the format had changed in view of the entry into force of the Trade Marks Rules, 2017. In those circumstances, the petitioner filed the counter statement in Form TM-O, which is the prescribed form under the Trade Marks Rules, 2017 (the 2017 Rules), on 22.07.2017. By impugned order dated 11.07.2018, the application of the petitioner for registration of its trademark was deemed to be abandoned. Hence, this writ petition.

2. In spite of service of notice on 27.10.2018, the third respondent failed to enter appearance. Therefore, the matter is proceeded with in their absence.

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3. Learned counsel for the petitioner invited my attention to the application for registration of the trademark, opposition No.859085 and the notice dated 12.04.2017. By focusing on the notice dated 12.04.2017, learned counsel pointed out that the Registrar of Trade Marks called upon the petitioner to file its counter statement in Form TM-6 and that such counter statement was required to be filed within two months from the date of receipt of the notice. Learned counsel contended that the notice dated 12.04.2017 was dispatched on 14.07.2017, and that this is evident from the impugned order. By adverting to the counter statement, which was forwarded by the agent of the petitioner on 02.09.2017, learned counsel pointed out that such counter statement was filed within two months from 14.07.2017. Consequently, learned counsel contended that the petitioner had duly complied with Section 21(2) of the Trademarks Act 1999 (the Trademarks Act).

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4. Learned counsel further submitted that the counter statement was returned on 03.10.2017 both on the ground that a cheque would not be accepted and on the ground that the format had changed under the 2017 Rules. Within two months from the date of receipt of such communication, on 22.10.2017, the petitioner filed the counter statement in the prescribed format under the 2017 Rules. Hence, learned counsel submitted that the impugned order, which is unreasoned, is liable to be quashed.

5. In response, learned counsel for the respondents submitted that Section 21(2) of the Trade Marks Act incorporates a legal fiction by which the application shall be deemed to be abandoned if the counter statement is not filed within two months from the receipt of the notice of opposition. Therefore, he submits that the impugned order does not contain any infirmity.

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6. Section 21(2) of the Trade Marks Act provides as under:

> *"(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."*

7. From the text of Section 21(2), it is evident that the time limit of two months runs from the date of receipt of the notice of opposition by the applicant. The documents on record indicate conclusively that the notice dated 12.04.2017 was dispatched to the petitioner by speed post on 14.07.2017. In fact, the impugned order records that the counter statement ought to have been filed on or before 21.09.2017. The petitioner has placed a copy of the counter statement on record. Such counter statement is dated 01.09.2017 and

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has been filed in the Trade Marks Registry on 02.09.2017. Another aspect to be taken note of is that the notice dated 12.04.2017 called upon the petitioner to file the counter statement in Form TM-6. In compliance with this direction, the petitioner filed the counter statement in Form TM-6 on 02.09.2017. In these circumstances, it is clear that the petitioner has duly complied with the obligation imposed under Section 21(2) of the Trade Marks Act. Especially in view of the incorporation of a legal fiction therein, which has the effect of defeating a substantive right of the petitioner, the petitioner's application should not have been treated as abandoned merely because the format in which the counter statement should be filed was revised under the 2017 Rules.

8. On perusal of the impugned order, the only reason cited therein for treating the application as abandoned is the filing of the counter statement, in the revised form TM-O, on 06.11.2017.

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9. For reasons set out above, the said conclusion is untenable. Consequently, the impugned order dated 11.07.2018 is quashed. As a corollary, the respondents are directed to consider Application No.3053314 on merits after providing a reasonable opportunity to the petitioner and the third respondent herein. In view of the lapse of considerable time since the said application was lodged, the respondents are directed to conclude the hearing and issue a reasoned order within a period of three months from the date of receipt of a copy of this order.

10. In the result, the writ petition is allowed. No costs. Consequently, the connected miscellaneous petitions are closed.

01.09.2023

Index : Yes / No
Internet : Yes / No
Neutral Citation: Yes / No
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To

1.The Registrar of Trade Marks
Trade Marks Registry,
Intellectual Property Building,
GST Road, Guindy, Chennai.

2. The Assistant Registrar of Trade Marks
Trade Marks Registry,
Intellectual Property Building,
GST Road, Guindy, Chennai.

SENTHILKUMAR RAMAMOORTHY,J

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