2024:MHC:3809

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IN THE HIGH COURT OF JUDICATUE AT MADRAS

DATED: 07.11.2024

CORAM

THE HONOURABLE **MR. JUSTICE ABDUL QUDDHOSE**

C.M.A(TM).No.10 of 2024

Samsudeen A .. Appellant

Vs

1.The Registrar of Trade Marks,
Trade Mark Registry,
Intellectual Property Rights Building,
GST Road, Guindy,
Chennai – 32.

2.A1 Salama Eye Hospital Limited,
Perinthalmanna, Malappuram District,
Kerala – 679 322. .. Respondents

Prayer: This Appeal is filed under Section 91 of the Trade Marks Act, 1999, against the order dated 05.02.2024 passed by the Registrar of Trade Marks/first respondent.

For Appellant : Mr.Suresh

For R1 : Mr.S.Janarthanam

For R2 : Mr.Ramesh Ganapathy

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JUDGMENT

The question that arises for consideration in this appeal is whether it would suffice for the purpose of complying with the requirements of Rule 18(2) of the Trade Marks Rules, 2017 (in short "TM Rules"), if the first respondent (Trade Mark Registry) had despatched the email notice to the e-mail address given by the appellant in his trademark application seeking for registration of a trademark.

2. Under the impugned order, the application for registration of a trademark submitted by the appellant has been ordered to be abandoned on the ground that the appellant failed to file a counter-statement to the opposition petition filed by the second respondent within the statutory period, despite the fact that the appellant is alleged to have received the notice through email as per Rule 18(2) of the TM Rules.

3. However, the appellant in this appeal contends that the appellant never received the notice from the first respondent (Trade Mark Registry) in accordance with Rule 18(2) of the TM Rules, as the email said to have been sent by the first respondent was never received by him. The appellant also contends that in respect of three other trademark

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applications seeking for registration under different classes, the appellant had received notice from the first respondent and had also filed a counter-statement to the opposition petition within the statutory period. Therefore, according to the appellant, arbitrarily, by total non-application of mind, the impugned order has been passed by the first respondent ordering abandonment under Section 21(2) of the Trade Marks Act, 1999 (in short "TM Act") of the application submitted by the appellant seeking for trademark registration.

4. The learned counsel for the appellant drew the attention of this Court to Section 21(2) of the “TM Act” and would submit that two months' time shall commence for the appellant to file counter-statement only from the date of receipt of notice of opposition. Therefore, according to him, since the appellant did not receive notice of opposition, the question of ordering abandonment of the appellant's application seeking for registration of trademark is unjustified.

5. The learned counsel for the appellant also drew the attention of this Court to Rules 18 and 42 of the TM Rules, and would submit that as

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per Rule 42(5), the first respondent will have to serve notice of opposition on the appellant within three months of the receipt of the same by the appropriate office, the first respondent herein. According to him, unless and until the appellant receives notice of opposition from the first respondent, the time limit prescribed for filing counter-statement will not commence.

6. The learned counsel for the appellant also drew the attention of this Court to the decision of a learned Single Judge of this Court in ***Ramya S.Moorthy Vs. Registrar of Trade Marks and others [MANU/TN/5971/2023]*** and would submit that in similar circumstances, the writ petition filed by a similarly placed person was allowed.

7. On the other hand, learned Special Panel Counsel for the first respondent would submit that since the notice of opposition has been duly sent and received by the appellant as seen from the despatch details maintained by the first respondent, this appeal is not maintainable, as the impugned order has been passed only in accordance with Section 21(2) of the TM Act by following the service of notice procedure prescribed under Rule 18(2) of the TM Rules.

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8. He would also submit that the decision of the learned Single Judge relied upon by the learned counsel for the appellant referred to supra was taken up on appeal before the Division Bench of this Court and in the said appeal, even though the Division Bench had confirmed the order passed by the learned Single Judge, the Division Bench had made it clear that the order passed by the learned Single Judge cannot be treated as a precedent in other matters.

9. The learned counsel for the second respondent would reiterate that the mandatory procedure contemplated under Rules 18(2) and 18(3) of the TM Rules for service of notice was followed by the first respondent and therefore, there is no infirmity in the impugned order passed by the first respondent under Section 21(2) of the TM Act ordering for abandonment of the appellant's trade mark application.

DISCUSSION:

10. Insofar as the case on hand is concerned, a purposive interpretation will have to be given to Rule 18(2) of the TM Rules in order to meet the ends of justice. With regard to issuance of notice to the

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appellant in respect of a petition filed for opposition of a trademark registration, Rule 42(5) of the TM Rules makes it clear that notice of opposition shall be ordinarily served by the Registrar to the applicant within three months of the receipt of the same by the appropriate office (first respondent). Rule 42 of the TM Rules reads as follows:-

42. Notice of Opposition.

(1) A notice of opposition to the registration of a trademark under sub-section (1) of section 21, with such particulars as specified in Rule 43, shall be filed in form TM-O within four months from the date of publication of the trademark journal in which the application for registration of the trademark was advertised or re advertised.

(2) Where a notice of opposition has been filed in respect of a single application for the registration of a trademark for different classes of goods and services, it shall bear the fee in respect of each class in relation to which the opposition is filed.

(3) Where an opposition is filed only for a particular class or classes in respect of a single application made under sub-section (2) of section

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18, the application for remaining class or classes shall not proceed to registration until a request in Form TM-M for division of the application together with the divisional fee is made by the applicant.

(4) Where in respect of a single application for the registration of a trademark no notice of opposition is filed in a class or classes, the application in respect of such class or classes shall, subject to section 19 and sub-section (1) of section 23, proceed to registration after the division of the application in the class or classes in respect of which an opposition is pending.

(5) A copy of notice of opposition shall be ordinarily served by the Registrar to the applicants within three months of the receipt of the same by the appropriate office:

Provided that where the applicant has already filed the counter statement on the basis of the copy of notice of opposition made available in the electronic records on the official website, the requirement of service of copy of the notice of opposition to the applicant shall be dispensed with.

11.Therefore, only from the date of receipt of notice by the

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appellant as per Rule 42(5) of the TM Rules, the time for filing counter statement by the appellant commences. However, Rule 18(2) of the TM Rules, which pertains to service of documents by the Registrar, which is relied upon by the first respondent under the impugned order, stipulates that any communication or document sent by the first respondent shall be deemed to have been served at the time when the letter containing the same would be delivered in the ordinary course of post or at the time of sending the e-mail.

12.In the case on hand, the appellant has categorically pleaded that he has not received the notice in the opposition petition filed by the second respondent from the first respondent. He has also contended that in respect of three other registrations applied for, he had received notice and he had also filed counter-statements. It is also contended that only for the opposition petition filed by the second respondent herein in respect of another application submitted by the appellant seeking for registration, he was unable to file a counter-statement to the opposition petition, since he had not received notice of opposition from the first respondent.

13. Section 21(2) of the TM Act stipulates that the first respondent

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(Registrar) shall serve a copy of the notice on the applicant for registration and within two months from the receipt of the same by the applicant of such a 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 upon for his application, and if he does not do so, he shall be deemed to have abandoned his application.

14. In the case on hand, the appellant contends that he had not received the notice from the first respondent. However, the first respondent, excepting for producing despatch details and opposition details, which are self-serving documents, has not placed on record before this Court any other proper acknowledgment from the appellant for having received the notice in the opposition petition filed by the second respondent.

15. The appellant, having filed counter-statement in other three opposition petitions pertaining to three different applications for trademark registration, should not be left high and dry, that too, when he categorically contends before this Court that he has never received notice from the first respondent as per Rule 18(2) of the TM Rules.

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16. A purposive interpretation was already given by this Court in *Ramya S.Moorthy's case (cited supra)*. However, though the said decision cannot be cited as a precedent but, however, considering the facts and circumstances of the present case, this Court has independently taken a view that in the ends of justice a purposive interpretation will have to be given to Rule 18(2) of the TM Rules. In the interest of justice, this Court will have to necessarily quash the impugned order, as the same has been passed by total non-application of mind to the fact that the appellant, in respect of three other opposition petitions, had filed counter-statements, but, only is respect of the case on hand, he did not file counter-statement. It is also possible that the first respondent may have sent notice and the recipient may not have opened his inbox and would not have noticed the email sent by the first respondent.

17.For the foregoing reasons, this Court after giving due consideration to the facts of the case on hand regarding service of notice has come to the conclusion that the appellant is deemed to have not received the notice from the first respondent.

18.In the result, the impugned order dated 05.02.2024 passed by

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the first respondent is quashed and the appellant is permitted to file a counter-statement to the opposition petition filed by the second respondent within a period of three weeks from the date of receipt of a copy of this order. On receipt of the same, the first respondent shall decide the opposition petition on merits and in accordance with law, after affording a fair hearing to the appellant as well as the second respondent. In the result, this appeal is allowed. No Costs.

07.11.2024

rkm
Index:yes/no
Neutral citation: yes/no

To

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ABDUL QUDDHOSE,J.

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