2023:MHC:3715

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IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 1**1.08.2023**

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THE HONOURABLE **MR.JUSTICE SENTHILKUMAR RAMAMOORTHY**

(T)CMA(TM)/103/2023
(OA/43/2020/TM/CH)

M/s. Goldmedal Electricals Pvt Ltd.,
A/302, Kemp Plaza, Mind Space Off. Link Road,
Chincholi Bunder Malad (W) ,
Mumbai - 400 064. ... Appellant

Vs

1.The Registrar of Trade Marks,
Intellectual property Building,
G.S.T. Road,
Guindy
Chennai - 600032

2.K. Dalpat Singh
148-150, K.K. Lane No. 1
Avinashi Road
Coimbatore - 641 018. ...Respondents

Prayer: This Transfer Civil Miscellaneous Appeal (Trademarks) filed under Section 91 of the Trade Marks Act, 1999 to (i) quash set aside the impugned order dated 09.08.2019, passed by Respondent No.1 in

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Opposition No.891715 filed by the Appellant to the trademark Application of the Respondent No.2 under No.2826665 in class 19 and registration certificate issued be withdrawn. (ii) Summon the records in respect of Opposition No. 891715 filed by the Appellant to the trademark Application of the Respondent No. 2 under 2826665 in class 19 from the office of the Respondent No.1.

For Appellant : Mr. Somnath De
for M/s.K.G.Bansal and Company

For Respondents : Mr. N. Ramesh, SPC for R1
Mrs.Devi N.
for M/s. Sanjeev Singh for R2

JUDGMENT

This appeal is directed against the order dated 09.08.2019 in respect of a notice of opposition filed by the appellant herein on 24.06.2017 in relation to an application filed by the second respondent herein for registration of the mark "GOLD MEDAL PIPE" in class 19 in respect of non-metallic building materials, non-metallic rigid pipes for buildings and the like. By the impugned order, the opposition of the appellant was deemed to be abandoned

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and A.No.2826665 was directed to be proceeded with as per the rules. The order impugned herein was assailed by the appellant originally before the Intellectual Property Appellate Board. By order dated 16.10.2020, the impugned order was stayed and the said order of stay continues to operate as on date. Meanwhile, it appears that a certificate of registration was issued to the appellant.

2. The primary ground on which the impugned order was issued was that the appellant submitted a communication dated 05.10.2017 to the Mumbai instead of the Chennai Office of the Trade Marks Registry to the effect that the appellant/opponent does not wish to rely upon evidence in support of the notice of opposition but intends to rely upon submissions made in the notice of opposition. In those circumstances, by taking recourse to Rule 8 of the Trade Marks Rules, 2017 (the Trade Marks Rules) and Rule 45(2) thereof, the opposition was treated as abandoned.

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3. Learned counsel for the appellant submitted that the appellant received the counter statement from the second respondent on 27.09.2017. The said counter statement was dispatched to the appellant by the Trade Marks Registry and the relevant e-mail set out the e-mail address of the Mumbai office of the Trade Marks Registry. Therefore, by e-mail of 05.10.2017, the appellant /opponent communicated to the said e-mail address of the Mumbai Office that it did not wish to file evidence in support of the opposition but intends to rely upon submissions made in the notice of opposition. Learned counsel also pointed out that a similar communication was sent on behalf of the 2nd respondent/applicant by communication dated 05.10.2017. Thus, he submitted that both parties decided not to rely upon evidence and to rely upon the notice of opposition and counter statement, respectively.

4. Learned counsel also pointed out that the same scenario played out in relation to trademark application No.2573910 in class

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11. Upon the appellant sending a similar letter stating that it did not intend to rely upon evidence, an order was passed treating the opposition as abandoned. The said order was assailed before the Intellectual Property Appellate Board and the said appeal was allowed by order dated 12.11.2018. Assailing the said order, the second respondent filed W.P.No.5486 of 2019. By judgment dated 02.08.2019, the writ petition was dismissed by the Division Bench of this Court.

5. Learned counsel also pointed out that an infringement action was instituted by the appellant against the second respondent before the District Court in Delhi and that an order of interim injunction is in force in the said suit. In conclusion, learned counsel for the appellant submitted that the impugned order is unsustainable and that the opposition of the appellant is not liable to be treated as abandoned in terms of Rule 45 of the Trade Marks Rules.

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6. In response to these contentions, learned counsel for the second respondent submitted that the present appeal is belated and that it was filed about six months after the registration certificate was granted to the second respondent. Because a certificate of registration was granted, learned counsel also submitted that the appeal is infructuous and that only a rectification petition should have been filed. Learned counsel also submitted that the Trade Marks Rules prescribe that all notices, statements or other documents should be served or sent to the appropriate office of the Trade Marks Registry. By relying upon Rules 4 to 8 of the Trade Marks Rules, learned counsel contended that the appropriate office, in this case, is the Chennai Office of the Trade Marks Registry. Since the e-mail of 05.10.2017 was admittedly sent to the Mumbai Office of the Trade Marks Registry, learned counsel contended that the opposition of the appellant was liable to be treated as abandoned in terms of Rule 45(2). Leaned counsel for the second respondent also invited my

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attention to Section 21(1) which prescribes that the opposition should be made in the prescribed manner.

7. At the outset, the contention that the appeal is infructuous should be dealt with. The appeal was filed within the prescribed time and an order of interim stay was granted by the Intellectual Property Appellate Board on 16.10.2020. In these circumstances, the grant of the certificate does not render the appeal infructuous.

8. From the rival contentions, it is evident that the case turns largely on Section 21 of the Trade Marks Act and Rule 45 of the Trade Marks Rules. While Section 21(2) prescribes the consequence of not filing a counter statement in response to a notice of opposition, it does not prescribe the consequence of not adducing evidence. In fact, sub section 4 merely enables both the applicant and the opponent to adduce evidence, if so intended. Rule 45, which deals with evidence in support of opposition, is set out below:-

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45. Evidence in support of opposition.—*(1) Within two months from service of a copy of the counterstatement, the opponent shall either leave with the Registrar, such evidence by way of affidavit as he may desire to adduce in support of his opposition or shall intimate to the Registrar and to the applicant in writing that he does not desire to adduce evidence in support of his opposition but intends to rely on the facts stated in the notice of opposition. He shall deliver to the applicant copies of any evidence including exhibits, if any, 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.

9. Rule 45(1) clearly indicates that the opponent has the option of adducing evidence or communicating to the Registrar and to the

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applicant in writing that such opponent does not desire to adduce evidence in support of his opposition but intends to rely on the facts stated in the notice of opposition.

10. The record discloses that the appellant issued a communication dated 05.10.2017, which is addressed to the Registrar of Trade Marks, Chennai, but transmitted to the e-mail address of the Trade Marks Registry at Mumbai (mumopp.tmr@nic.in). The principal ground on which the opposition was treated as abandoned by the impugned order is the transmission of this communication to the Mumbai Office. While Rule 8 specifies that notices and documents should be delivered or sent to the appropriate office, which is the Chennai Office in this case, in the factual context of the appellant having addressed the communication to the Trade Marks Office, Chennai, albeit by transmitting such communication to the e-mail id of the Mumbai Office of the Trade Marks Registry, there is substantial compliance with the mandate of Rule 45(1). It should also

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be noticed that the appeal relating to Trade Mark A.No.2573910 was allowed on almost identical facts and circumstances.

11. For reasons set out above, (T)CMA(TM)/103/2023 is allowed, the impugned order is set aside and the matter is remanded for re-consideration by the Registrar of Trade Marks. The Registrar of Trade Marks is directed to provide a reasonable opportunity to both parties and decide the matter, on merits, within a period of three months from the date of receipt of a copy of this order. The registration of Trade Mark No.2826665 shall not be relied upon by the second respondent until the matter is decided on merits and thereafter shall be subject to such decision. There shall be no order as to costs.

11.08.2023

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

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