

Bentec Electricals and Vs. Bentex Control and Switchgear Co.

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Court : Trademark

Decided On : Jun-19-2006

Reported in : (2006)(33)PTC263Reg

Judge : M Mahendra, Jrtn

Appellant : Bentec Electricals and

Respondent : Bentex Control and Switchgear Co.

Judgement :

1. This order will dispose of a proposed Opposition dated 16th November, 2005 filed by Shri Ashok Sharma trading as M/s. Bentex Control & Switchgear Co., at B-65/3, Naraina Industrial Area, Phase-II, New Delhi-110 028 (hereinafter referred to as "the Opponent") in the above matter. The facts are briefly that the applicants' trade mark inter alia "BENTEC" word per se filed under Application No. 1169904 in class 9 was advertised in the Trade Marks Journal No. 1329 Supplementary (1) dated 15th April, 2005, which was made available to the public on 2nd August 2005. The above named Opponent filed a request on Form TM-44 on 8th November, 2005 for extension of time by one month for filing a notice of opposition and followed by its notice of opposition to the aforesaid application on 16th November, 2005 under Section 21(1) of the Act. The question now only arises as to whether the aforesaid request on Form TM-44 followed by its notice of opposition filed by the Opponent on 16th November, 2005 is within the statutory period or not.

2. Pursuant to this office letter No. TL/B/2925 dated 1st December, 2005 M/s. Ashoka Trade Marks Co., Patent & Trade Mark Attorneys & Advocates, New Delhi instructed by the above named Opponent submitted a detailed reply under their Attorneys' letter dated 17th December, 2005 stating that the aforesaid Trade Marks Journal which made available to the public on 2nd August, 2005 was received by was on 8th August, 2005 and contended further that the maximum period of four months prescribed by the provisions of Sub-section (1) of Section 21 of the Trade Marks Act, 1999 read with Sub-rule (1) of Rule 47 of the Trade Marks Rules, 2002 is well within the statutory period. Hence, the request on Form TM-44 filed on 8th November, 2005 and followed by its notice of opposition filed on 16th November, 2005 to the aforesaid application may be taken on record and the matter be proceeded with in accordance with the law.

3. The above matter came up for hearing before me on 13th February, 2006, when Mr. Ashok K. Goel, Advocate instructed by M/s. Ashoka Trade Marks Co., Patent & Trade Mark Attorneys & Advocates, New Delhi appeared on behalf of the Opponent in the matter.

4. Mr. Ashok K. Goel, Advocate, the learned Counsel for the Opponent submitted that the publication of the Trade Marks Journal was changed over to CD ROM from the year 2005 onwards and on account of which the attorneys stationed at Delhi received such CD ROMs very late as compared to the Attorneys stationed at Mumbai and thereby the Trade Mark Journal mentioned above was received by him on 8th August, 2005 and, therefore, there was a considerable delay in filing the request on Form TM-44 as well as notice of opposition to the aforesaid application. The Counsel for the Opponents in this connection relied upon the case of Pavunny Ouseph v. Registrar of Trade Marks AIR 1952 Travancore 77 in support of his contention.

5. Mr. Goel, Advocate, the learned Counsel for the Opponent submitted that Sub-section (1) of Section 21 of the Trade Marks Act, 1999 permits the filing of an extension of an application beyond three months period but within such further period not exceeding one month in the aggregate. It is evidence from a plain reading of Section 21(1) of the Act that the Legislature has not intended to

prescribe the time limit of only three months for filing of a notice of opposition and certainly not prescribed any time limit for filing the application for extension of time.

6. Mr. Goel also stated that Section 21(1) of Trade Marks Act, 1999 read with Rule 47(1) of Trade Marks Rules, 2002 clearly indicates that the notice of opposition filed after three months has to be accompanied by the prescribed application for seeking an extension of time beyond three months, to file the notice of opposition.

7. Mr. Goel further submitted that Sub-rule (6) of Rule 47 of Trade Marks Rules, 2002 prescribes a procedural requirements for seeking extension of time to file a notice of opposition and submission of an extension application under Rule 47(6) within three months has not specifically prescribed either in the Act or the Rules. He also stated the word "shall" used in Sub-rule (6) of Rule 47 should be construed to be only directory provision and not mandatory. The Counsel for the Opponent relied upon the case of State of Haryana v. Raghbir Dayal and Smt. Rani Kusum Scale 545 in support of his arguments. He accordingly prayed that the Registrar may exercise his discretion in favour of the Opponents and the notice of opposition with a request on Form TM-44 filed on 8th November, 2005 and followed by its notice of opposition on 16th November, 2005 by the Opponents may be taken on record and the matter be proceeded with in accordance with the law.

8. Under Section 21(1) of the Trade Marks Act, 1999 provides that "Any person may, within three months from the date of the advertisement or re-advertisement of an application for registration of within such further period, not exceeding one month in the aggregate, as the Registrar, on application made to him in the prescribed manner and on payment of the prescribed fee, allows, give notice in writing in the prescribed manner to the Registrar, of opposition to the registration".

9. In other words, Section 21(1) permits the filing of an extension application beyond the three months period but within such further period not exceeding one month in aggregate. It is evident from the plain reading of Section 21(1) of the Act that the Legislature has not intended to prescribe the time limit of only three months for filing of a notice of opposition and certainly not prescribed any time limit for filing the application for extension of time. Moreover, it does not contemplate

that a time period for seeking extension of time to file a notice of opposition, which merely prescribes the manner and fees thereof.

10. Similarly, Rule 47(1) of the Trade Marks Rules, 2002 reads as under: A notice of opposition to the registration of a trade mark under Sub-section (1) of Section 21 shall be given in triplicate on Form TM-5 within three months or within such further period not exceeding one month in the aggregate from the date the Journal is made available to the public (which date shall be certified by the Registrar as such). The notice shall include a statement of the grounds upon which the opponent objects to the registration. If the registration is opposed on the ground that the trade marks in question resembles trade marks already on the register, the registration numbers of such trade marks and the dates of the Journals in which they have been advertised shall be set out.

11. It is amply clear that a notice of opposition may be filed within three months or definitely within four months of the date the Journal is made available to the public. Further, on a plain reading of the Rule 47(1) read with Section 21(1) of the Act clearly establishes that a notice of opposition filed after three months has to be accompanied by the prescribed application for seeking an extension of time, beyond three months to file the notice of opposition.

An application for an extension of the period within which a notice of opposition to the registration of a trade mark may be given under Sub-section (1) of Section 21, shall be made on Form TM-44 accompanied by the fee prescribed in First Schedule before the expiry of the period of three months under Sub-section (1) of Section 21 of the Act.

13. In other words, it prescribes a procedural requirements for seeking extension of time to file a notice of opposition and it would result that the Registrar has no power to grant extension in cases where the request on Form TM-44 has been filed after three months. Further, it would also result in barring an entire species of cases whereby a bona fide proprietor of a trade mark becomes aware of a conflicting mark after three months of publication but before the four months period, from filing a notice of opposition regardless of the bona fides or genuineness of the Opponents. Further, it would not only be contrary to the

intention of the Legislature as expressed in Sub-section (1) of Section 21 of the Act but also be contrary to an established principles of law that discretion conferred by the Act cannot be taken away by the Rules.

14. I have gone through the record of this case carefully in the presence of Mr. Ashok K. Goel, who is present at the hearing. From the facts of the instant case, it is obvious that the request on Form TM-44 filed on 8th November, 2005 and followed by its notice of opposition filed by the Opponents on 16th November, 2005 is time-barred in terms of Rule 47(6) of the Trade Marks Rules, 2002. The matter is now to decide whether the said request on Form TM-44 filed on 8th November, 2005 and followed by its notice of opposition filed by the Opponents on 16th November, 2005 in this case is within the statutory period or not.

15. Firstly, the determination of the question raised would depend on whether Rule 47(6) can be said to be mandatory or merely directory. It is a settled law that the procedural requirements must be construed as directory in nature and not mandatory, unless a statute prescribes otherwise. A Full Bench of the High Court of Delhi in a case *Hastimal Jain trading as Oswal Industries v. Registrar of Trade Marks and Anr.*

2000 PTC 24 (FB), involving interpretation of the Trade & Merchandise Marks Rules, 1959 has held that the use of the word 'shall' is not sufficient to treat a Rule as mandatory. The Court further held that while determining the question of whether a Rule is mandatory, the intention of the Legislature must be ascertained from looking at the statute as a whole. Secondly, the use of the word 'shall' raises a presumption that the particular provision is imperative, but this prima facie presumption may be rebutted by other considerations such as object and scope of the enactment and the consequences flowing from such construction. Therefore, in certain cases the use of the word "shall" has been construed to mean merely directory. The whole scope of the statute need to be analysed before ascertaining the intention of the Legislature see *State of U.P. v. Babu Ram and 16*. As seen above the legal fiction is not absolute, but it is being controlled by discretion of Registrar. Further, it is limited by the word "shall" and the time limit of three months for seeking extension of time to file a notice of opposition. It is important to say

here that wherever the Legislature intended to prescribe a fixed time, which could not be extended, it has specifically so done. The necessary implication of this is that in all other cases the time was not to be fixed but one which would be within the power of the Registrar to extend. Obviously, the intention of the Legislature was to minimise delays. For that fixed time is laid down in the statute itself.

However, on a plain reading of Section 21(1) itself shows that the Legislature has not intended to prescribe the time limit of only three months for filing of a notice of opposition and certainly not prescribed any time limit for filing the application for extension of time. Besides, Section 21(1) of the Act specifically allows filing of a notice of opposition beyond the period of three months as long as it not exceeding one month in the aggregate. Therefore, a natural corollary is the Act would support all that is required to be done for filing of an opposition in such time period prescribed by the Legislature in the Act and the same is also clearly set out in Rule 47(1), which clearly establishes that a notice of opposition may be filed within three months or definitely within four months of the date the Journal is made available to the public.

17. The rule requiring the procedural requirements for seeking extension of time mentioned in Rule 47(6) of Trade Marks Rules, 2002 along with a notice of opposition in fact strikes a mandatory note is intended to prescribed the time limit of only three months for filing the application for extension of time. In this sense, the needs of the rule transcend the directory level and may perhaps be considered a mandatory need and hence the intention of the Legislature would not be served and, therefore, Rule 47(6) would be repugnant to the provisions of Sub-section (1) of Section 21 of the Trade Marks Act, 1999.

18. Further, it is also mentioned that it is not the intention of the Legislature to allow the Central Government to prescribe rules limiting the time period for filing of an extension of time period within which a notice of opposition may be filed. In other words, it would result in barring an entire species of cases whereby a bona fide proprietor of a trade mark becomes aware of a conflicting mark after three months of publication but before the four months period, from filing a notice of opposition regardless of the bona fides or genuineness of the Opponents.

Moreover, it would also result in fettering the discretionary power conferred on the Registrar by Section 21(1) of the Act in as much as it would result on the Registrar having no power to grant extension in cases where the request on Form TM-44 has been filed after three months and the same would go against an established principles of law that discretion conferred by the Act cannot be taken away by the Rules. Furthermore, this would also cause serious inconvenience to innocent persons and or general public without much furthering the object of the Act and the same would be construed directory as is held in the case State of Haryana v. Raghbir Dayal .

19. Applying the well established rules of statutory interpretation especially the rule of harmonious construction to the Act and Rules, it would mean that an application for extension of time period for filing of an opposition is allowed beyond the three months period prescribed by Rule 47(6) since this is only a directory provision and not mandatory. Considering the overall facts of the case and having regard to provisions in Section 21(1) read with Section 131(1) of the Act enabling the Registrar to extend the time, whether the time so specified has expired or not and in the light of the decision of the Delhi High Court (Supra) and holding that "the use of the word "shall" is not sufficient to treat the Rule as mandatory. Even though the word "shall" prima facie indicates that it is mandatory, still the Court must ascertain the real intention of the Legislature by looking to the statute as a whole". In my view, Section 21(1) of the Act read with Rule 47(1) of the Trade Marks Rules, 2002 permit the Registrar to extend time, even though the time has expired. To hold otherwise would be to negate the words to that effect used both in Section 21(1) of the Act as well as Rule 47(1) of the Rules. Therefore, I am of the view that the word "shall" used in Sub-rule (6) of Rule 47 should also be construed to be only directory, but not mandatory.

20. In view of the reasons mentioned above and having regard to the fact that the time limit of three months for filing of an application for extension request, being not prescribed by the Act and having regard to the provisions in Section 21(1) enabling the Registrar to permit the filing of an extension application beyond the three months period but within such further period not exceeding one month in the aggregate; I consider that this is a fit case where the Registrar ought to exercise

his discretion in condoning the delay for filing of an extension application as sought for.

21. From the foregoing, it is apparent that the delay in filing the notice of opposition in this case is merely on account of late receipt of journals as well as irregular notification issued under Section 47(1) of Trade Marks Rules, 2002, which is a clearly a rule of procedure and cannot work the hardship of the Application or the Opponent. Moreover, an interpretation of statute cannot be to the detriment of the public and rather such narrow interpretation would shake judicial conscience and adversely affect the cause of justice. On a careful consideration of the above matter and having regard to the submissions made by the deponent on a sworn affidavit, I take a view that a request on Form TM-44 for extension of time by one month for filing a notice of opposition on 8th November, 2005 and followed by its notice of opposition to the aforesaid application on 16th November, 2005 is within the statutory period although the period mentioned in Rule 47(6) has expired and even though an application for extension of time is made beyond that period. It is hereby further ordered that a request of Form TM-44 filed on 8th November, 2005 is allowed and the notice of opposition filed by the Opponents on 16th November, 2005 is taken on record.

22. It is also ordered that the matter will be proceeded with in accordance with the provisions of the Act and Rules.

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