

Torrent Pharmaceuticals Ltd. Vs. Ucb

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Court : Gujarat

Decided On : Jun-29-2005

Reported in : 2005(31)PTC14(Guj)

Judge : Dharam Singh, ARTM

Acts : [Trade Marks Act, 1999](#) - Sections 2(1), 21, 21(1), 21(2), 21(4), 101, 131, 131(1) and 157; Trade Marks Rules, 2002 - Rules 47 to 57, 79, 80(4), 101, 105, 105(1) and 106; Trade Marks Rules, 1959 - Rule 53(1) and 53(2); Trade and Merchandise Marks Rules, 1959 - Rules 53, 53(2), 54 and 56

Appeal No. : Application No. 618569 and Opposition No. AMD 61496

Appellant : Torrent Pharmaceuticals Ltd.

Respondent : Ucb

Advocate for Def. : Vishnu Mohan Rethnam, Adv. of Remfry & Sagar

Advocate for Pet/Ap. : R.R. Shah, Sr. Adv. of R.R. Shah & co.

Judgement :

ORDER

Dharam Singh, ARTM

1. This order disposes of an Interlocutory petition dated 22.12.2003 filed by the Petitioner/opponent with request for grant of leave for an affidavit of Mr. Allen

Norris alongwith evidence either under Rule 50(1) or 53 of the Trade Marks Rules, 2002. The facts of the case in brief are as under:

2. On filing of counter statement by the applicant, a copy thereof was served on the opponent vide official letter dated 18.07.2003 calling upon him to file evidence in support of opposition. But, the opponent did not file evidence within the prescribed/extended time. However, he filed the Interlocutory petition for grant of leave for the said evidence filed after expiry of the extended time and is the subject-matter of hearing held on 1.2.2005, when Mr. Vishnu Mohan Rethnam, Advocate of Remfry & Sagar for the opponent and Mr R.R. Shah, Advocate appeared for the applicant. Mr. Rethnam submitted that a copy of the Counter Statement was served on the opponent vide official letter dated 18.7.2003 inviting his attention to Rule 50(1) to file evidence in support of opposition within the period of two months from the date of receipt thereof; meanwhile, the new Trade Mark Law was implemented with effect from 15.9.2003, which had the provision only for one month extension of time to file evidence in support of opposition.

The opponent filed two requests on Form TM-56 for extension of two months time. The first request was allowed and an extension of one month time was granted from 22.10.2003 to 21.11.2003, whereas the second was refused vide official letter dated 4.12.2003. Mr. Rethnam contended that Interlocutory petition was filed on 22.12.2003 within a marginal time after expiry of the extended time. He drew the attention of this tribunal to all the grounds one after another. He referred to para 3 of Interlocutory petition and submitted that the opponents had been collecting necessary documents and information from various sources including collection of relevant material from their office worldwide including India and the process of enquiry, correspondence and collection and sorting of the relevant evidence consumed considerable time. Mr. Rethnam submitted that the process was further delayed for the reason that coordinating officer at the opponent's office was frequently kept changing. He stated that for last two months due to computer virus, the computer hard disc of the opponents attorney was crashed, which resulted into complete loss of data; and this necessitated redrafting of affidavit. The Ld. Advocate contended that since the new trade mark came in force abruptly, it took the opponent's much time to come to terms with the practice and procedure

therein, hence, delayed in filing of evidence. He vehemently argued that the evidence filed by way of IP is a quality evidence coupled with reasons pleaded above and there has been no lack of diligence on the part of the opponent; the evidence filed by way of Interlocutory Petition is vital and extremely relevant to these proceedings in all fairness and can be taken on record in exercise of discretion of this tribunal under Section 131 of the Act. He prayed that affidavit of Mr. Allen Norris filed alongwith exhibits be taken on record either under Rule 50(1) or 53 in the interest of natural justice, especially, when the applicant has not filed evidence under Rule 51; it will not prejudice to the applicant's right, as the mark sought to be registered is 'proposed to be used'. He relied on a decision of the Hon'ble High Court of Delhi in C.M.(M) 525/1994, C.M. (M) 137/1994, & CO 8/1992, (2000 PTC 24(FB)).

Mr. R.R. Shah, Sr. Advocate for the applicant present at hearing strongly protested against the grant of leave for evidence filed in support of opposition submitting that of course; it would certainly and highly prejudice the rights of the applicant, if the said evidence is taken on record. He referred to his letter dated 4.12.2003 and said that he had already vehemently objected to the invitation of the applicant's attention to Rule 51 to file evidence in support of application by the Registrar. He argued that the Ld. Advocate for the opponent admittedly knew that the new Trade Marks Rule had the provisions only for one month's extension of time to file evidence in support of opposition; despite of that he deliberately filed extension for three months, which is contrary to the new provisions of the Trade Mark Law.

3. Mr. Shah pointed out that the Opponent had filed three different requests for extension of one month each and not two as Ld. Advocate for the opponent argued. He submitted that the Ld. Advocate is hiding the facts and misleading the Tribunal stating that the Opponent has filed two requests for extension of two months' time, out of that one request is allowed and another is rejected. Mr. Shah vehemently, argued that extension of time was granted by the Registrar twice, which was contrary to the law; in fact, the opponent was entitled only to one month extension i.e. from 22.9.2003 to 21.10.2003 and the Registrar was not at all empowered to grant extension of time for second month i.e. from 22.10.2003 to 21.11.2003. He stated the gravity of Rule 50 and contended that at the time of

filing TM-5, the opponents knew, that in any case, they had to file the evidence in support of opposition on filing the counter-statement by the applicant, therefore, the opponents should have kept the evidence ready; but instead of taking care of that and keeping the evidence ready for filing the same at an appropriate time; now, they have come up with the Interlocutory Petition with frivolous grounds at this belated stage which is not permissible under the provisions of Rule 50(1). He argued that Rule 50(2) refers to word 'shall' which indicates that the provisions are mandatory as held by the Hon'ble High Court of Delhi in its decision and further the expression 'unless the Registrar otherwise directs' provided in Rule 53(2) of old Rules, 1959 is omitted in Rule 50(2) of new rules, therefore, the intention of the Legislature is clear to make the provisions of Rule 50(2) mandatory and now, these no longer remain directory therefore, the decision of the Hon'ble High Court of Delhi relied by Ld. Advocate for the opponent is not applicable in the present case. He said that since the provisions of Rule 50(1) have not been complied with by the opponents within the stipulated time, Rule 50(2) automatically, operates and the opposition is deemed to have been abandoned by the opponent, and as such, the Registrar has no power to use his discretion to grant any extension of time beyond one month in aggregate, which has already been granted; therefore, the decision relied on by the Ld. Advocate for the opponent is not applicable in the present facts and circumstances. So far, as grant of leave for the opponent's said evidence under Rule 53 is concerned, Mr. Shah submitted that this was not a case of further evidence; further evidence can only be filed by the opponent or the applicant, in the circumstances when evidence in support of opposition or application is duly filed under Rule 50(1) or 51. In the present case, the opponent has not adduced any evidence under Rule 50(1), therefore, evidence filed as such by the opponent cannot be considered and taken on record under Rule 53, he said. Mr. Shah prayed that the said Interlocutory Petition be refused and appropriate order under Rule 50(2) be passed with cost.

4. In the present case, the opponent was served with a copy of counter statement vide official letter dated 18.7.2003 inviting his attention to file evidence in support of opposition under Rule 50(1). But the opponent did not file evidence as required within the prescribed period of two months from the date of receipt of a copy of counter statement. Meanwhile; he sought extension of one month from 22.9.2003

to 21.10.03 by filing a request on Form TM-56 dated 22.9.2003. However, the [Trade Marks Act, 1999](#) was implemented with immediate effect from 15.9.2003. The opponent filed the second request for extension of time for another month on 21.10.2003. Since it was a transitional period of replacement of the Trade Marks Act, the said request was inadvertently, allowed and an extension from 22.10.2003 to 21.11.2003 was wrongly granted and communicated second time to the opponents. However, the opponent's third request for extension from 22.11.2003 to 21.12.2003 was rejected and communicated to the Opponent accordingly vide official letter dated 4.12.2003 and as a result the present IP is filed by the Opponent in the matter.

5. Evidence in support of opposition under Rule 53(2) of Trade Marks Rules 1959.

The Act does not stipulate any time-limit for the evidence to be submitted by either parties. The words 'unless the Registrar otherwise directs' in Rule 53(2) indicate that the Registrar has a discretion to grant extension of time for filing evidence beyond the period of two months prescribed under Rule 53 (1), but this discretion should not be exercised arbitrarily or in a capricious manner and time should not be granted beyond reasonable limits. It is only when the Registrar wishes to direct to the contrary, keeping the opposition subsisting then he has to pass an order.

It has been held by the Delhi High Court 'that if the opponent does not take any action prescribed under Rule 53(2) and the Registrar does not otherwise direct, the operation of the rule deeming the opposition to be abandoned becomes automatic. No further order by the Registrar is necessary before it comes into play. Hence, as soon as the two months' period expires without any action being taken by the opponent, the opposition is deemed to be abandoned.' *Indian Medicines Industries v. Pharma Labs*, (1998) PTC 241.

'Where the Registrar has refused extension of time to the opponents to file evidence under Rule 53(1), and the period prescribed under the rule has expired, the opponents not having intimated as required under the rule that he intended to rely on the facts stated in the notice of opposition, the opposition will be automatically deemed to have been abandoned by operation of Rule 53(2) which is mandatory.' *Hindustan Embroidery v. Hernia*, PTC (Suppl)(1) 836(Del) : (1978) 3

IPLR 148 dissented in Kantilal v. Registrar, (1981) IPLR 93 of Page 101. See East India Commercial v. Collector of Customs, AIR 1962 SC 1983 at 1905 followed in Universal v. Classic, (1989) IPLR 231 (TMR). Now, Section 21(4) of [Trade Marks Act, 1999](#) lays down as follows: '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.'

Though, Section 21(4) does not expressly provide any time, but it talks about 'prescribed time', however, a time limit has been prescribed in the Rules, which is the procedural part of the statute.

The word 'Prescribed' used in Rule 50(1) in terms of time has been defined in Section 2(1)(s) of the Act, 1999 as follows:-

'Prescribed' means prescribed by rules made under this Act.'

The word 'prescribed' in terms of time means 'prescribed time' in the rules made under this Act, It means 'prescribed time' in the rules is duly sanctioned by the Act/Statute of the prescribed period of two months as well as further time of one month in aggregate to file evidence in support of opposition under Rule 50(1) has a mandate of Section 21(4) of the Act. In other words, the time expressly provided by the rules is at par to that, which is expressly provided under the Act.

6. Rules 47 to 57 of Trade Marks Rules, 2002 deal with oppositions proceedings. The relevant rule for consideration is Rule 50, which reads as follows:

Rule 50 '(1) Within two months from services on him of a copy of the counter statement or within such further period not exceeding one month in the aggregate thereafter as the Registrar may on request allows, 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 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.'

(3) 'An application for the extension of the period of one month mentioned in Sub-rule (1) shall be made in Form TM-16 accompanied by the prescribed fee before the expiry of the period of two months mentioned therein.'

Under the provisions of this rule, the Legislature has fixed the time frame to file evidence in support of opposition and even to file a request for extension under the mandate of Section 21(4) of the Act and the opponents must within two month of service on him a copy of the counter-statement or within such further period not exceeding one month in aggregate either file evidence by way of affidavit or intimate the Registrar and the applicant that he does not desire to adduce evidence in support of opposition, but, wants to rely on the facts stated in the notice of opposition. Further, in case of the extension of one month time sought under Sub-rule (1) to file evidence in support of opposition, an application on Form TM-56 shall be made before expiry of the period of two months as mentioned in Sub-rule (3) of Rule 50.

If the opponent has not adduced any evidence within the prescribed period of two months and further period of one month as required in Rule 50(1) or has not communicated to the Registrar and the applicant in writing that he does not desire to adduce evidence in support of opposition, but intends to rely upon the grounds stated in the notice of opposition and as such fails to comply with the said provision of Rule 50(1), he has no third option before him, but shall deem to have abandoned his opposition by operation of law under Rule 50(2).

7. In the present case, the question to be determined is whether the Registrar has any discretionary power to extend time beyond one month in aggregate to file evidence in support of opposition under Rule 50 (1) and the evidence filed by the opponent in support of the opposition after the prescribed fixed time can be taken on record. This would depend upon the fact whether Rule 50(2) of Rules, 2002 has become mandatory or it can still be interpreted as directory as held by the

Hon'ble High Court of Delhi in its decision under old provisions of the statute.

8. Now, let me deal with the relevant holdings of the Hon'ble High Court of Delhi in its above decision vehemently relied upon by Ld. Advocate for the opponents. The Hon'ble High Court held:

'The determination of the questions raised would depend on whether Rule 53 (2) can be said to be mandatory or merely directory. Mere 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. It must also be remembered that a legal fiction cannot be stretched beyond the purpose for which it was enacted. As seen above the legal fiction is not absolute. It is limited by the words 'unless' the Registrar otherwise directs'. In our view, it is significant 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. Undoubtedly, the intention of the Legislature was to minimize delays. For that fixed time is laid down in the statute itself. However a reading of Section 21 itself shows that for procedural matters like filing evidence the Legislature was not laying down a fixed time in the Statute. This view is supported by a reading of Section 101 and Rule 106.'..

'This interpretation is also borne out by the fact that the deeming provisions, in Rule 53(2), comes into play only if the Registrar does not otherwise directs. The fact that the legal fiction is subject to the direction of the Registrar also shows that it is not absolute but is being controlled by discretion of Registrar. In our view, Section 101 and Rule 106 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 101 as well as Rule 106.'

It is held by the Hon'ble High Court that mere word 'shall' is not sufficient to treat the Rule 53(2) as mandatory, even though, it prima facie, indicates that the rule is mandatory. According to the Hon'ble High Court, the legal fiction was also not held absolute as it was limited by words 'unless the Registrar otherwise directs'. The

Hon'ble High Court held it is significant that wherever the Legislature intended to prescribe a fixed time, which could not be extended, it has specifically so done. The necessary implications 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; therefore, the Court must ascertain the real intention of the Legislature by looking the statute as a whole.

9. In the erstwhile rules of Trade marks, if he was satisfied, it was a prerogative of the Registrar to extend the time by virtue of the words 'unless the Registrar otherwise directs', although word 'shall' was also used therein. The legal fiction was not considered absolute as the Legislature was not laying down a fixed time to file evidence. The legal fiction was subject to the discretion of the Registrar as it v/as being controlled by the discretion of the Registrar and he was empowered to grant extension of time beyond the prescribed time, if he was convinced.

10. It is amply clear from Rule 50(2) of Trade Marks Rules, 2002 that if the opponent does not work in accordance with Rule 50(1), he shall deem to have abandoned his opposition. The word 'shall' in the said Rule 50(2), prima facie, emphasizes that the provisions thereof are mandatory. Further, the words 'unless the Registrar otherwise directs' incorporated in Rule 53(2) of the old Rules, 1959 are omitted in Rule 50(2) of the new Rules, 2002. Therefore, the intention of Legislature is quite clear to make the provisions of Rule 50(2) mandatory with an absolute legal fiction. Further, the legislature has a definite intention to prescribe the fixed time of 2 months with a further time of one month in aggregate to file evidence in support of opposition and two months to file a request for extension of time as well under Rule 50(1) & 50(3) with the mandate of Section 21(4) of the Act.

The Legislature has made Rule 50(1) & 50(3) important and stringent by fixing the time limits of two months with a further period one month in aggregate to file evidence in support of opposition under Rule 50(1) and for filing a request on form TM-56 within the prescribed period of two months mentioned in Rule 50(3) and thereby the prerogative of the Registrar as enshrined in the erstwhile provisions has been curtailed, and as such he left with no option of using discretion any longer to extend the time beyond one month in aggregate to file evidence in

support of opposition under Rule 50(1) or to allow TM-56 filed after the expiry of the prescribed period of two months under Rule 50(3).

Further, the intention of the Legislature is so clear that the opponent has either to file evidence in support of opposition under Rule 50(1) or to intimate the Registrar and the applicant in writing within the prescribed period mentioned therein. That he does not desire to adduce evidence in support of opposition, but intends to rely on the facts stated in the notice of opposition. It infers, that if the opponent fails to adduce evidence under Rule 50(1) within the prescribed period mentioned therein, after the expiry of such period, he cannot say that he relies on the facts stated in the notice of opposition. In the prevailing circumstances as such, the opposition would be deemed to have been abandoned by operation of law under Rule 50(2). The Registrar has nothing to do further in the matter; except informing the opponent accordingly.

11. As far Rule 51 which talks about 'Evidence in support of application', the said provision would apply with same vigour as the provision of Rule 50(1) and, therefore, the applicant as in the case of the opponent cannot urge for extension of time beyond the maximum time limit of one month enshrined under the provisions of the law and if the Registrar accede to the request in that eventuality, the said action would be without jurisdiction and in utter/sheer abuse of the process of law.

Similarly, the provisions of Rule 47(1) and 47(6) are made stringent by fixing the time frame of three months or a further period of one month in aggregate to file opposition under Rule 47(1) and three months to file a request on Form TM-44 for extension of one month time for filing opposition with a mandate of Section 21(1) of the Act and in the same way, the Registrar has no power either to extend the time beyond one month in aggregate to file opposition or to allow the request on TM-44 filed beyond the prescribed time of three months mentioned in Rule 47(6). Rule 47(6) reads as follows:-

'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 in 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.

In the same way, the provisions of Rule 52 regarding filing of evidence in reply are also of the same vigour and spirit and the Registrar has no power to extend the time more than one month in aggregate and that is also then when the extension is applied for within statutory period of two months.

12. Now, it is crystal clear that the legislation had a definite intention not only to fix the time in Rule 50(1) and 50(3) which are the relevant rules in the present case, but at every stage right from filing for extension of time on TM-44 to file opposition to the completion of evidence stage during the opposition proceedings and it has so done by making the provisions time bound and exhaustive which are not extendable and in my view should neither be racked up with the other provisions of the law, nor the same be read in consonance with those to ascertain the real intentions of the statute.

Thus, the provisions of Rule 50(2) are mandatory and exhaustive with an absolute legal fiction. If the opponent does neither under Rule 50(1), he shall be deemed to have ABANDONED his oppositions and the Registrar has nothing to do in the matter except communicating the same to the Opponent.

In view of the foregoing, the scenario of the new legislation with regard to fixing the time limits as well as to mandatory provisions and legal fiction is drastically changed and undoubtedly, the provision of Rule 50(2) no longer remain directory, therefore, the decision of the Hon'ble High Courts delivered under the provisions of the erstwhile law and relied upon by the Ld. Advocate for the opponent is not applicable in the vigor and spirit of the new legislation.

13. Now, in the present facts and circumstances and in view of the drastic change in the Legislature and the position clarified as above, though Rule 50 needs not to be read in consonance with, Section 131 or Rule 105, however, in the larger interest it is essential to go through the relevant provisions of Section 131, which are incorporated as follows 'if the Registrar is satisfied, on application made to him in the prescribed manner and accompanied by the prescribed fee, that there is sufficient cause for extending the time for doing any act (not being a time

expressly provided in this Act), whether the time so specified has expired or not, he may, subject to such conditions as he may think fit to impose, extend the time and inform the parties accordingly'.

In the provisions of Section 131(1) are amply clear that the Registrar is not empowered to extend the time for doing any act where a time has been expressly provided in the Act. Though, in the present case, which is related to extension of time in the opposition proceedings, the time 'not expressly provided in the Act, yet the time provided in Rule 50(1) in conformity with Section 21(4) of the Act as defined in Section 2(1)(s), is at par with that expressly prescribed in the Act. Further, Rule 105(1) which provides as follows:-

'An application for extension of time under Section 131 (not being a time expressly provided in the Act or prescribed by Rule 79 or by Sub-rule (4) of Rule 80 or a time for the extension of which provision is made in the rules) shall be made in Form TM-56'.

Clearly says that an application for extension of time under Section 131(1) (not being a time expressly provided in the Act or prescribed by Rule 79 or by Sub-rule (4) of Rule 80 or a time for extension of which provisions is made in the rules) shall be filed on form TM-56. In other words, the Registrar has no power to extend time where the time is expressly provided in the Act or a time for extension of which provisions is made in the Rules. This proposition is supported by the format of form TM-56 itself, which is used for seeking extension of time even in the opposition proceedings bears the application as follows:-

'An application for extension of time (not being a time expressly provided in the Act or prescribed by Rule 79 or by Rule 80(4) or a time for the extension of which provisions is made in the rules (SECTION 131 RULE 105)'. Though the time prescribed in the Rules is at par with that provided in the Act as held above, however Validity of rules cannot be challenged. It would appear that a hearing officer acting for the Registrar has no power to question the validity of any rule framed under the Act or to declare any rule ultra vires. This is the function of the Court. In *Dirk's Appln.* (1960) RPC 1 at 13 (a patent case), Lloyd-Jacob, J. observed; 'I find it no less inconceivable that the Legislature intended a hearing

officer to decide upon the validity of rules issued by the Board of Trade, of which the Patent Office is one department or to review in relation to any discretionary powers thereby given to the Comptroller-General their exercise by his official superiors.' Therefore, the provisions of Section 131(1) & Rule 105 is the exception for the opponent and the application thereof would not be available to him and as such he cannot get the relief under Section 131 of the Act & Rule 105 also.

However, rule is part of the statute as laid down in para 30.18 of law of Trade marks and Passing off by P. Narayanan, 5th Edition provides as follows.

'Instruments made under an Act which prescribes that they shall be laid before Parliament for a prescribed number of days, during which period they may be annulled by a resolution of either House, but that if not so annulled, they are to be of the same effect as if contained in the Act, and are to be judicially noticed, must be treated for all purposes of construction or obligation or otherwise exactly as if they were in the Act.' Maxwell's Interpretation of Statutes. 10th Ed., pp 50-51, quoted in Seervai's Constitutional Law. 1st Ed., p. 1054. f.n. 16.

In State of UP v. Babu Ram, Subba Rao, J. (in the majority Judgment) held that the rules made under a statute were to be treated as part of the statute. : 1961 CriLJ773 . See also Seervai's Constitutional Law, 1st Ed.,p. 1054. The intention of the Legislature by omitting the words 'unless the Registrar otherwise directs' in the new legislation prima-facie, is to make the Rule 50(2) of Trade Mark Rule, 2002 as mandatory in view of the followings:

(a) minimizing the delay in opposition/rectification proceedings by curtailing unnecessary time, which was responsible for lingering on the proceedings to the extent of 10 years in certain cases.

(b) fast disposal of opposition proceedings to facilitate early grant of registration, preferably, within a year in the public interest as well as under the obligation of GATT, TRIPS and WTO and globalization of market.

(c) controlling the piling of oppositions or meeting with challenges of expected increase in the rate of filing of opposition in view of widening the scope of the

definition of Trade Mark, liberalizing the process of registration and introducing registration of service and collective marks etc.

14. The opponent has prayed to grant leave for evidence filed in support of oppositions by way of I.P. either under Rule 50(1) or 53. So far as Rule 50(1) is concerned, the issue is categorically examined and held that the Registrar has no discretionary power to extend the time beyond one month in aggregate either to file evidence in opposition or take the same on record, if it is filed after the expiry of the prescribed time. Rule 53 deals with further/additional evidence, which is filed in furtherance of evidence filed in support of opposition or application, which is not the case here. Before dealing with the contention of Rule 50(1), the Ld. Counsel for the opponent vehemently argued that the evidence can be tendered under Rule 53 in the interest of natural justice, especially, when no evidence is led under Rule 51 by the Applicant. The question of further evidence only comes into play, if the evidence in support of opposition or application is tendered/filed within the prescribed time limit as enshrined under the provisions of the law, otherwise the said prerogative, if executed, would tantamount to act against the mandatory provisions of the law.

The provisions of Rule 53 are reproduced for proper appreciation. Further evidence:

'No further evidence shall be left on either side, but in any proceedings before the Registrar, he may at any time, if he thinks fit, given leave to either the applicant or the opponent to leave any evidence upon such terms as to costs or otherwise as he may think fit.'

The provision starts with 'No further evidence'...but in any proceedings before the Registrar, he may at any time, if he thinks fit, give leave to either...to leave any evidence...fit.

The subsequent words of the provision has to be read in consonance with the preceding provisions of Rule 50(1) and 51 and not in isolation. The provisions of Rule 53, talks about 'further evidence', which implies that the applicant as well as the opponent has filed the evidence in support of application or opposition

respectively, and then the provisions of Rule 53 would come into play and resort can be placed on Rule 53, otherwise the Registrar has no jurisdiction under Rule 53. The prerequisites to put the Rule 53 into action, is the due compliance of the Rule 50(1) and 51.

The provisions of Rule 53 are not conflicting with the provisions of Rule 50(1), 51. If the latter provisions are contradicting to earlier one, then the latter would prevail. It is a settled proposition of law, that if there is any conflict between two laws, then the later Act would prevail. But in the present case, there is no conflicting in the provisions. The provisions are amply clear and the Legislature has given wide jurisdiction to the Registrar under Rule 53, but the same is subject to the compliance of the provisions of Rule 50(1) and 51.

15. Additional Evidence:

Considerations for - Evidence in support of petition not filed -Application for additional evidence, not maintainable.

Interlocutory Petition for taking on record evidence in support of opposition at belated stage-Further evidence when no evidence on record - Meaning of- Rules 53, 54 and 56 of the Trade and Merchandise Marks Rules, 1959:

'That the plain reading of Rule 56 of the Rules depicts the material point that this Rule is not a substitute to Rules 53 and 54. It is an absolutely independent provision. The term 'further evidence' indicates compliance of Rules 53 and 54. In the absence of compliance of the said Rules, Rule 56 cannot come into operation. Hence, Applicants'/Opponents' adducing evidence under Rule 56 is inoperative and irrelevant until strict compliance of Rules 53 and 54 is made. Similarly, additional evidence is required to be filed to the main evidence already filed under Rules 53 and 54 otherwise, there would be no significance and weightage of evidence filed under Rule 56. In this view of the matter, the evidence accompanying the interlocutory petition cannot be taken on record under either Rule 53 or Rule 56 and Rule 53(2) being mandatory in nature, the opposition stands abandoned.' Jeep Corporation, Michigan, 48288, U.S.A. V. Jeep Indl. Syndicate Limited, Allahabad 1993 PTC 248 (Reg.) (Del.)

The quasi judicial body cannot create the law, it can only declare/state the law or at the most interpret the law, if required. Therefore, the Registrar has to strictly follow the provisions of the law and for the sake of reiteration if the language of the Legislature is amply clear, then there is no requirement to give new colour to the Legislature and say something, which the Legislature has specifically in clear terms said otherwise. Therefore, the contentions and legal submission of the Ld. Counsel for the opponent does not hold good in respect of applicability of Rule 53. Thus, the answer to my query raised earlier in the judgment is in negative.

I am cautious with the proposition that the evidence should not be shut down. But, at the same time in the circumstances, when the provision of Rule 50(2) are made mandatory with an absolute legal fiction, and Rule 50(1) has mandate of Section 21(4) in accordance with Section 2(1)(S) as stated above, the opponent should not be allowed to file his evidence at his sweet will at any point of time in violation law. However, in the today's time of electronic media and means of super fast communication, the prescribed time of two months with a further time of one month in aggregate as prescribed in Rule 50(1) is more than sufficient for a vigilant opponent to file evidence in support of opposition. In email/fax system, a huge messages, information, material or evidence comprising hundred of pages can be transferred from one corner of the word to another within minutes. Even for a foreign opponent, the processing and sorting of evidence can never take the time of three months. Further, keeping the Coordinating Officer frequently changed is the lookout of the opponent's company. The law cannot help them. The equity comes to the aid of the vigilant and not the slumbering *Vigilantibus non dormientibus jura subveniunt*. Taking excuse as one of the grounds that opponent attorney's computer data was corrupted due to computer viruses cannot be believed as they have not filed any proof to that effect. Therefore, the grounds taken in the interlocutory petition are general in nature and no importance can be attached to that.

It appears from the conduct of the opponent not submitting the evidence in support of the ground urged to refuse registration that the resultant effect would be the grounds are frivolous and it would further be said that the opponent by raising the grounds of opposition unsupported by any evidence has invoked the jurisdiction

under Section 21 of the Act wrongly and deliberately. In other words the same would amount to abusing the process of law would entail heavy penalty by awarding the exemplary costs.

I do agree with the arguments advanced by Mr. R.R. Shah, Sr. Advocate for the applicant that the provision of Rule 50(2) are mandatory in nature and the Registrar is not empowered to exercise any discretion either to allow a further request for extension beyond one month in aggregate to file evidence in support of opposition or take evidence filed by way of I.P. after the expiry of statutory period of three months on record. On the contrary, the opponent has failed to file evidence in support of opposition within the prescribed period under Rule 50(1) and has abandoned his opposition under the deemed provisions of Rule 50(2). I am also agreeable with the contention of the Ld. Sr. Advocate that on filing the opposition itself, the opponent should have taken a view that on filing the counter statement by the applicant he had to file evidence in support of opposition, therefore, he should have kept the evidence ready to adduce the same at an appropriate time to avoid the present situation and violation of law.

The contention of the Ld. Counsel for the opponent would not hold good in light of the drastic change in the provisions of the law and thereby the prerogative of the Registrar as enshrined in the erstwhile provision has been curtailed and the Registrar is not empowered under the provisions of the law or have any jurisdiction to allow the opponent to lead evidence beyond the prescribed time limit as enshrined under the new provisions of the Act. If the Registrar does not work in the same vigour and spirit, the object cannot be achieved and the purpose of the Legislature will be defeated. If the opponent fails to comply with the provision of Rule 50(1), Rule 50(2) automatically operates and the opponent is deemed to have abandoned his opposition under the deeming provisions under Rule 50(2), the Registrar or the Tribunal cannot boggle down in the middle:

'It is well settled in law that once a particular situation is deemed, one cannot boggle down in the middle. This is the dictum laid down by Lord Act on which has been approved by the Supreme Court. Therefore, once it is deemed to be abandoned, there is no question of extending something which has been

abandoned. In other words, when the application is dead by then it cannot be revived by extending limitation.' Medley Lab oratories v. Progro Pharmaceuticals, Writ Appeal No. 1151 of 1985 (Mad HC)(DB), Reversing Progro v. Dy. Registrar AIR 1986 Mad 282.

16. To sum up, the Legislature by putting an embargo 'not exceeding one month in the aggregate' has formulated Rule 50(1), it is amply clear that the Registrar is empowered and having jurisdiction to entertain the extension up to one month after the stipulated period of two months is over. Even for allowing the extension within the time frame of one month, the request has to be made and the request for the extension has to be within the mandate provided by the Legislature. When the language of the Legislature is quite clear, then no other meaning or interpretation of the statute is permitted.

17. It is pertinent to note that the provision of Section 157 of the [Trade Marks Act, 1999](#) enables the Central Government to make rules to carry out the provisions and purposes of the act and thus the Rules are made as a part of the Scheme of the Legislature and is the law in itself. The [Trade Marks Act, 1999](#) is the substantive as well as adjective/procedural law. When the Rule says something in the specific terms then the variation is not permissible by the Registrar. The Central Government has the prerogative under the provisions of Section 157 to make rules within the four corners of the Legislature, otherwise would be ultra vires, Generally, the new provisions are applicable prospectively and not retrospectively unless the Legislature says otherwise.

It is said that the procedures are man-made and can be amended in furtherance of doing substantial justice. The said principle is kept in mind, although the same has no application in the present facts and circumstances for the reasons assigned in the preceding paragraphs. The opponent has not led evidence within the stipulated time of two months as required under Rule 50(1) and if the evidence is not led within the time frame, then also for doing substantial justice, the Rule itself provides for further extension of one month in aggregate, thereafter, thus, the substantial justice can be done within the extended time period and the Registrar is not equipped with further powers and having no jurisdiction to do something

more, which the Rule in specific terms says no. The Rule 53 would not have applicability in the present facts and circumstances and there is no confusion as to the applicability of Rule 53 as held above. First time, the provisions provide that the parties are required to act diligently and within time frame. The law aids to the vigilant and not to the slumber. Delay can be condoned in filing appeal not in preferring the Civil Suit. No where it is mentioned in the preamble of the Act that the object can be achieved by defying the law. The present Rules may be adjective but at the same time is substantive one and mandatory in nature and have statutory force. A single variation, if permitted would derail the intent and object of legislation. The Constitution has three body organs, one pertains to law makers called Legislature, second is executive authorities i.e Council of Ministers, who put the law into motion/execution and third is Judiciary, Controlling Authority and meant to safeguard the law and to see that if there is any violation of the law, then put the things in order and uphold the sanctity of law.

The Procedure cannot be laid down in the Principal law, it is always made in the procedural law, which has the sanction of the principal law and is the supplement and part of the main statute and is in conformity with the principal law as regards the time is concerned.

18. At this juncture the provision of Section 131 dealing with Extension of Time is also not to loose the sight for a moment. The provision itself makes amply clears by inserting 'not being a time expressly provided in this Act' whereby the intentions of the Legislature is very much clear and conscious inception of the said wordings so that, there is no conflict of the provisions which expressly provide for specific time. Thus, the time limits provided under Section 21 up to maximum 4 months to file opposition is not extendable. Similarly, under Section 21(2) the applicant is required to submit the counter-statement in respect of an opposition within two months and this period is not extendable and so also the provision of Section 21(4) read with Rules 50 and 51 of the Trade Marks Rules, 2002. The said provisions expressly provide the time, and therefore, Section 131 is not permitted to come to the rescue of the opponent. Thus, the subordinate legislation is in conformity with the principal legislation.

19. It is necessary to say at this juncture that the relevant Rules framed under the provisions of law are neither challenged and stay is given nor the said rules are declared as Ultra Vires by the Hon'ble Supreme Court of India or any of the Hon'ble High Court of the State and its sanctity has remained intact. Thus, the said Rules have force of law and cannot be disturbed by giving different meaning completely opposite to its contents and spirit.

'Before the Court interferes with the decision of the Registrar it ought to be satisfied that the Registrar in arriving at his decision has acted upon some wrong principle; for example, has not approached the problem in the right way, or has taken into consideration matters which he ought not to have taken into consideration, or has omitted to take into consideration matters which were proper for consideration. Unless there are some such grounds for interfering with the decision of the Registrar his decision ought not to be disturbed.' (Bailey's Appln. (1935) 52 RPC 136 at 148).

20. The Ld. Counsel for the opponent has heavily relied upon the Full Bench Judgment of the Hon'ble Delhi High Court. The said Judgment with immense respect has been properly dealt with as above. With the enactment of new provisions, the Judgment of the Hon'ble Delhi High Court has been watered down, and therefore, reliance placed on the aforesaid Judgment is quotation and would not lead the opponent's case any further. The drastic change in the new enactment puts positive embargo and the Registrar is not permitted to act in derogation of mandate as enshrined in the new act, which has come into force. Thus, the submissions and the proposition of the law urged by the Ld. Counsel for the opponent by relying upon the Full Bench Judgment of the Hon'ble Delhi High Court, pursuant to the drastic change in the provisions of new Legislature, falls to the ground.

21. It is hereby ordered that interlocutory petition dated 22.12.2003 is dismissed and the evidence filed in support of opposition beyond the prescribed time is refused to be taken on record.

It is hereby further ordered that by operation of law, the opponent deems to have abandoned his opposition No. AMD-61496 under Rule 50(2) of the Trade Marks

Rules, 2002.

It is hereby still further ordered that the opponent shall forthwith pay Rs. 25,000 (Rupees Twenty Five Thousand Only) as to costs of these proceedings to the applicant.

It is hereby still further ordered that extension of time erroneously granted from 22.10.2003 to 21.12.2003 is treated as cancelled.

It is still further ordered that the official letter No. TLA/GEN-7723 dated 4.12.2003 inviting the applicant's attention to Rule 51 to file evidence in support of application is treated as cancelled.

22. In view of the order on Interlocutory petition herein as above, since there is no opposition in the eye of law application No. 618569 in class -5 is accepted for registration and shall proceed further as per rules.

Signed and sealed at Ahmedabad this 29th day of June, 2005.

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