
(2010) 01 IPAB CK 0020

In the Intellectual Property Appellate Board

Case No : OA/9-12/2008/TM/AMD

Glenmark Pharmaceuticals Ltd.

APPELLANT

Vs

Assistant Registrar Of Trade Marks

RESPONDENT

Date of Decision : 07-01-2010

Acts Referred:

Trade Marks Act, 1999 — Section 21, 21(1)

Trade Mark Rules, 2003 — Rule 47, 47(6)

Trade and Merchandise Marks Rules, 1959 — Rule 53, 53(1), 51(3)

Citation : (2010) 01 IPAB CK 0020

Hon'ble Judges : S. Usha, J; Syed Obaidur Rahaman, Technical Member

Bench : Division Bench

Judgement

Name of Company, Trade Mark, Application, Date of, Trade, Date of, Trade Mark Journal

M/s. Taurus, ALZEX, 1318538, 92.11.2004, 1328, 28.02.2005, 30.05.2005

M/s. Royal, VITAROL, 1249637, 14.11.2003, 1328, 30.03.2005, 03.06.2005

M/s. Defi Healthcare, ZANID-2, 1329130, 30.12.2004, 1328, 30.03.2005, 03.06.2005

M/s. Allex India, ALLEX, 979794 B, 27.12.2000, 1328, 30.03.2005, 03.06.2005

orders be passed.,,,,,,

8. We have heard and considered the arguments of the counsel and have also gone through the pleadings and documents.,,,,,,

9. The only issue that arises for consideration is as to whether the Assistant Registrar erred by not granting extension of time on the ground that Form.,,,,,,

TM-44 was not filed before expiry of three months as provided by sub rule (6) of Rule 47 of the rules and consequently not taking the notice of.,,,,,,

opposition, where Rule 47(6) of the Rules is beyond the rule making powers to delegate and whether holding the word shall used in Rule 47(6) as",,,,,,

directory but not mandatory negates the effect of provision of Section 21 of the Act.,,,,,,

10. Section 21(1) provides that notice of opposition to be filed within three months from the date of advertisement or re-advertisement of an.,,,,,,

application for registration but not specified within what period the application for extension of time be applied and as such left it open to the Registrar.,,,,,,

of Trade Marks to exercise his discretion. Rule 47(6) provides that an application for extension of the period within which a notice of opposition may.,,,,,,

be filed on Form TM-44 before the expiry of three months under Section 21(1) of the Act.,,,,,,

11. The Hon'ble High Court of Bombay while deciding the High Court of Bombay while deciding the validity of Sub-rule (6) of Rule 47 of the rules, in",,,,,,

Sardar Gurudas Singh Bedi v. Union of India and Ors. MANU/MH/0658/2006 : 2006 (33) PTC 321 (Bom.) (DB), where Form TM-44 was filed after",,,,,,

expiry of period of limitation and the same was refused giving rise to cause of action to the Petitioner to file petition against thereto, has observed as",,,,,,

under:,,,,,

6. ...Is Rule 47(6) as now framed, in consonance with Section 21 of the Act, and if not, is it ultra vires Section 21 of the 1959 Act. Section 21 of the",,,,,,

Act states that any person may, within three months from the date of the advertisement or re-advertisement of an application for registration or 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 proscribed fee, allows, gives notice in writing in the prescribed manner to the Registrar, of opposition to the registration. Rule 47(6) provides that",,,,,,

this application for extension must be done before the expiry of the period of three months. In other words, what the rule contemplates is jurisdiction in",,,,,,

the Registrar to extend time by exercise of discretion, only if it is made before the expiry of three months period. The rule as read, confers no",,,,,,

discretion in the Registrar to accept objections filed, if the period of there months has expired. In Mahanth Ram Das. v. Ganga Das",,,,,,

MANU/SC/0172/1982 : A.I.R. 1982 S.C. 887, the issue before the Apex court was the power to extend time where the time extended to do particular",,,,,,

act had expired. In that case, the High Court had set time for payment of court fees. The fees could not be paid within the period stipulated. Even",,,,,,

though an application was made for extension of time before the time had run out, it was not considered and as on the date of hearing, the appeal",,,,,,

period had expired. The Apex Court on the facts of that case was pleased to observe as under:,,,,,

How undesirable it is to fix time peremptorily for a future happening which leaves the Court powerless to deal with events that might arise in between,",,,,,

it is not necessary to decide in this appeal.....,,,,,

In Kantilal Tulsidas Jobanputra v. The Registrar of Trade Marks and Lion Pencils Pvt. Ltd. in Misc. Petition No. 926 of 1977 and Misc. Petition No.,

1511 of 1977, in consideration, was Rule 53 of the Trade and Merchandise Marks Rules, 1959. A Notice of Opposition was filed by the Petitioner" ,,,,,,

there in the matter of application for registration of the mark. There was some dispute as to the person entitled to file opposition. In the meanwhile the, ,,,,,,

period for filing evidence in support of opposition had expired and the Registrar of Trade Marks directed that the opposition be deemed to be, ,,,,,,

abandoned by virtue of Rule 53 of the 1959 Rules. An application for review as filed was rejected. A learned Single Judge of this Court considering, ,,,,,,

Rule 53, was pleased to hold firstly that rule was directory and not mandatory and secondly, the Registrar's power to extend time for filing evidence in" ,,,,,,

support of opposition does not stand extinguished, if the application for extension of time was not filed or extension was not granted before the expiry" ,,,,,,

of period of two months prescribed by Rule 53(1) and thirdly the court held, that Rules or procedure before any Tribunal were for advancement of the" ,,,,,,

cause of justice and not to close the doors, thus preventing the parties to get determination on merits. It is not necessary to advert to other findings." ,,,,,,

This interpretation of Rule 53 also came up for consideration before a Full Bench of Delhi High Court in Hastimal Jain Trading as Oswal Industries v.,

Registrar of Trade Marks and Anr. 2000 PTC 24 (FB). The Full Bench of the Delhi High Court was pleased to hold that Rule 53 is directory and, ,,,,,,

enables the Registrar to extend time, even though the time has expired. Dealing with the issue that procedural law is meant to advance the cause of" ,,,,,,

justice, we may quote from the observations of the Apex Court in State of Punjab and Anr. v. Shamlal Murari and another AIR 1976 S.C. 1977. The" ,,,,,,

Apex Court in the matter of procedural law was pleased to observe as under: -""We must always remember that procedural law is not to be a tyrant" ,,,,,,

but a servant not an obstruction but an aid to justice. It has been wisely observed that procedural prescriptions are the hand-maid and not the mistress," ,,,,,,

a lubricant, not a resistant in the administration of justice. Where the non-compliance, though procedural, will thwart fair hearing or prejudice doing of" ,,,,,,

justice to parties, the rule is mandatory. But grammar apart, if the breach can be corrected without injury to a just disposal of the case. We should not" ,,,,,,

enthroned a regulatory requirement into a dominant desideratum. After all, Courts are to do justice, not to wreck this end product on technicalities." ,,,,,,

Viewed in this perspective, even what is regarded as mandatory traditionally may, perhaps, have to be moderated into wholesome directions to be" ,,,,,,

complied with in time or in extended time.""" ,,,,,,

7. The Law is now well settled, that a rule cannot travel beyond the scope of the Parent Act. If authorities are needed, we may refer to the case of" ,,,,,,

Laghu Udyog Bharati And Anr. v. Union of India and Ors. MANU/SC/0444/1999 : (1999) 6 SCC 418, wherein the Apex Court observed:" ,,,,,,

The rules, therefore, cannot be so framed which do not carry out the purpose of the chapter and cannot be in conflict with the same.""" ,,,,,,

Similar view is taken in Additional District Magistrate (Rev) Delhi Admn. v. Sheo Ram and Ors. MANU/SC/0369/2000 : (2000) 5 SCC 451. The ,,,,,,

Apex Court observed as under: ,,,,,,

It is a well-recognised principle of interpretation of a statute that conferment of rule-making power by an Act does not enable the rule-making" ,,,,,,

authority to make a rule which travels beyond the scope of the enabling Act or which is inconsistent therewith or repugnant thereto. From the above ,,,,,,

discussion, we have no hesitation to hold that by amending the Rules and Form P-5, the rule-making authority has exceeded the power conferred on it" ,,,,,,

by the Land Reforms Act.""" ,,,,,,

From what we have discussed above, the conclusion which emerges is that in matters of procedural law courts should normally read the provisions as" ,,,,,,

directory and the rule should sub serve the object of the Act and not defeat it or in other words be in conflict and travel beyond the scope of the ,,,,,,

enabling Act. In an exercise in subordinate legislation, it is not open to the delegate conferred with power to make subordinate legislation, to make a" ,,,,,,

rule which would be inconsistent or contrary to the provisions of the principal Act

itself. If there be a purported conflict in interpretation, to save the" ,,,,,,
rule it is, possible for the court to read down the rule to make it in conformity
with the provisions of the substantive law. Bearing this principle in mind," ,,,,,,
let us consider the issue as framed. Is Rule 47(6) in conformity with Section 21
and if it be in conflict, whether it can be read down to make it in" ,,,,,,
conformity with the mandate of Section 21. ,,,,,,

8. The power conferred to file opposition to registration is not merely to the
person who is the proprietor of the mark or claims interest in the mark. ,,,,,,

The expression ""any person"" has to be given a wider meaning. As the object of
the opposition is to maintain the purity of the register, Shavaksha in" ,,,,,,

'The Trade and Merchandise Marks Act, 1958', Third edition, has observed as
under:" ,,,,,,

The object of maintaining a trade mark register is that the public should know
whose goods they are buying and with whom the particular goods are, ,,,,,,

associated. It is, therefore, essential that the register should not contain trade
marks which are identical, or which so closely resemble each other, than" ,,,,,,

an unwary purchaser may be likely to be deceived into thinking that he is buying
the goods of a particular person whereas he is in fact buying goods of, ,,,,,,

another. ,,,,,,

It is therefore, essential that the register should not contain any trade mark
which is identical or which so closely resembles to each other, that the" ,,,,,,

common purchaser may be likely to be deceived by believing that he is buying
the goods of particular person whereas he is in fact buying the goods of, ,,,,,,

another person. That being the object, the court while interpreting the provisions
must bear that in mind so as to maintain the purity of the Register." ,,,,,,

The expression ""any person"" would have to be given wider meaning to include
even a consumer and not necessarily the proprietor or person having" ,,,,,,

interest in the mark. If this is so understood, then the object behind Section 21
manifests itself. The ordinary period for a person to file an objection" ,,,,,,

would be three months. The period for extension of time on reading of Section
21 of the Act could be before the expiry of the period of three months, ,,,,,,

or can be even after the expiry of three months. At the first blush considering the
expression ""within such further period"" it would appear that granting" ,,,,,,

extension of time of one month in aggregate can only be before the expiry of the
period. If it is so read, then the time to file objection will have to be" ,,,,,,

before the expiry of three months and the discretion in the Registrar to extend time is only before the expiry of three months. The rule as framed, if" ,,,,,,

the construction is accepted, will be intra vires Section 21. The rule so read would mean that only a class of persons, who had knowledge or were" ,,,,,,

vigilant of the publication before the expiry of the period of three months, can alone apply for extension. The other class of persons, whose attention is" ,,,,,,

drawn after the expiry of three months, even by a day or though aware for reasons beyond their control, will be barred from filing their opposition," ,,,,,,

however sufficient their cause. Rule 47(6) as now framed is couched in the same language as Rule 51(3) under the Rules of 1959, The said rule was" ,,,,,,

omitted by S.O. 397 dated 23rd July, 1969. In other words, the delegate entrusted to make the rules, itself found that the rule was acting harshly and or" ,,,,,,

oppressive and not in conformity with the object of the Act, The language of Section 21 in the Act of 1958 and Act of 1999 is substantially the same." ,,,,,,

If that be the position, the question is, what is that made the delegate frame a rule similar in language to a rule which was omitted. No explanation has" ,,,,,,

come from the Respondents. The section uses the word three months and such further time of one month. That period can also be beyond three ,,,,,,

months. It would therefore, have to be held, that the power in the Registrar to extend the period, can be before the period of three months has expired," ,,,,,,

as also even after the period of three months has expired. In such event, the expression one month in aggregate will have to be read to mean also on" ,,,,,,

the expiry of the period of three months. The discretion in the registrar therefore, to extend the time would also be on the expiry of the period of three" ,,,,,,

months. It is not as if the Registrar is bound to give a period of one month. It is open to the Registrar considering the facts of the matter, to give such" ,,,,,,

additional period and if discretion is to be exercised to extend time, then to grant such time, so that it does not exceed in the aggregate one month. This" ,,,,,,

is how the delegate, understood the law when Rule 51(3) was omitted in 1969, in the rules of 1959. The period of one month in aggregate therefore, in" ,,,,,,

Section 21, will have to be read to mean aggregate of one month even on the expiry of the period of three months." ,,,,,,

If Rule 47(6) as it now stands has to be accepted, and then it confers power to extend time only if the application is made before the expiry of period" ,,,,,,

of three months. Such a rule will be clearly ultra vires Section 21(1) of the Act of 1999. It is also not possible to read down Rule 47(6) so as to make,,,,,,

the rule intra vires Section 21. Nothing also has been brought before us to point out any mischief that was being occasioned and which mischief was,,,,,,

required to be remedied. In the Act of 1940, Section 15(2), did not set out the period, but left it to the rule making authority. The Rule making authority",,,,,,

provided a period of four months to file opposition. Under the Act of 1958, the period was fixed by the Legislature itself, though the delegate made",,,,,,

rules in an exercise of subordinate legislation. The same is the position in the Act of 1999. In these circumstances, we are clearly of the view that",,,,,,

Rule 47(6) is clearly ultra vires of Section 21 of the Act and consequently will have to be struck down as null and void.,,,,,,

12. The above mentioned decision of Bombay High Court Division Bench squarely applies to the case on hand. The Registrar of Trade Marks ought,,,,,,

to have taken on record the notice of opposition by extending time. We also understood that the above judgment was placed before the Registrar,,,,,,

which was not considered by which the Registrar has committed an error while passing the impugned order. In such circumstances, we are of the",,,,,,

opinion that the appeals be remanded back to the Registrar to take on record the notice of opposition and to decide the matter on merits.,,,,,,

13. In view of the above, we allow the Original Appeal Nos. 9 -12 of 2008 and set aside the order of Registrar dated 05.10.2007. We therefore",,,,,,

remand the four matters to the Registrar and direct the Registrar to take on record the proposed notice of opposition Nos. AMD 206512 to application,,,,,,

No. 1249637 in class 05, AMD 206513 to application No. 1329130 in class 5, AMD 206514 to application No. 979794 in class 5 and AMD 206516 to",,,,,,

application No. 1318538 in class 5 and to dispose of the same in accordance with law. No order as to costs.,,,,,,