

(2009) 03 IPAB CK 0015

In the Intellectual Property Appellate Board

Case No : TA/235/2004/TM/DEL (CM (M) 599/2001)

Kenneth Cole Production, Inc

APPELLANT

Vs

Assistant Registrar Of Trade Marks And API Polymers (India)
Limited

RESPONDENT

Date of Decision : 31-03-2009

Acts Referred:

Trade Marks Rules, 2002 — Rule 30
Trade Marks Act, 1999 — Section 21, 21(1), 100
Trade Marks Act, 1940 — Section 15(2)

Citation : (2009) 03 IPAB CK 0015

Hon'ble Judges : Z.S. Negi, J;S. Usha, Technical Member

Bench : Division Bench

Advocate : Bharat, Ajay Sahni

Final Decision : Allowed

Judgement

S. Usha, Technical Member

1 . This appeal is arising out of the order dated 28/06/2001, whereby the notice of opposition dated 26/11/1999 in opposition No. DEL.T.1449 was

ordered not to be taken on record to the proceedings being barred by limitation. The said appeal was filed before the Hon'ble High Court, Delhi in

CM(M)599/2001 and the same has been transferred to this Appellate Board pursuant to the provision of Section 100 of the Trade Marks Act, 1999

and the same is renumbered as TA/235/04/TM/DEL.

2 . The 2nd respondent herein filed an application for registration of the trade mark REACTION under application No. 530229 in class 25 in respect

of footwears under the provisions of the Trade and Merchandise Marks Act 1958 (in short the Act). The said application was advertised in the Trade

Marks Journal No. 1203(S) on 21/07/1999 and was made available on the same day for sale. The Trade Mark Journal was dispatched only on

27/07/1999 and the same was received by the appellant on 31/07/1999. The appellant herein filed their notice of opposition on 26/11/1999 under the

provisions of Section 21 of the Act.

3. The 1st respondent herein objected to taking on record the notice of opposition on the ground that the notice of opposition was filed beyond the

prescribed period and as such it was time barred. The appellant opposed the same and advanced arguments before the Registrar. The appellant

contended before the Registrar that the limitation is to be calculated from the date of receipt of the Trade Mark Journal by the attorneys and/or from

the date of dispatch of the Journal from the Trade Marks Registry.

4 . The 1st respondent after hearing the appellant herein had passed an order on 28/06/2001 rejecting the notice of opposition on the ground that the

relevant date for computation of limitation is the date when the said journal was made available to the public, which is on 21/07/1999 and the relevant

date will not start from the date of dispatch or delivery. The notice of opposition being filed after the specified period was barred by limitation and

therefore rejected.

5 . Aggrieved by the said order, the appellant herein filed the appeal before the Hon'ble High Court of Delhi on the following grounds:

(a) That the Registrar had decided the issue contrary to law;

(b) That the Registrar had ignored the principle laid down in the case reported in AIR (39) 1952. Travancore-Cochin 77 to decide the date as to from

when the period of limitation starts for calculating the date of filing the notice of opposition;

(c) That the Registrar failed to appreciate the fact that the notice of opposition has been filed within the limitation period;

(d) That the Registrar failed to appreciate the other judgments cited by the appellant;

(e) That the impugned order was passed without any justification or sufficient cause and is contrary to law, equity and good conscience and is liable to

be set aside:

The appellant, therefore, prayed that the order dated 28/6/2001 be set aside and the notice of opposition be taken on record.

6. The 2nd respondent herein filed their reply to the memo of appeal and denied the various allegations made therein. The 2nd respondent stated that under the provisions of the Act, it is immaterial as to when the relevant Trade Marks Journal was either dispatched to an individual subscriber or the date when the subscriber received the Journal, the only relevant date is the date of publication and/or the availability of the Trade Marks Journal whichever is later. The 1st respondent has decided the matter according to law and has rightly held that the opposition is time barred. The ratio of the cases cited above is not applicable to the present case. Under Sub-section (1) of Section 21 of the Act, opposition was required to be filed within four months from the date of advertisement and the period cannot be extended before that time. The law necessarily has to be applied uniformly and the statutory period under law therefore is to be calculated from the date when the journal was made available to the public and in case the journal was made available to the public on the date of its publication the date of publication would be the relevant date. The impugned order is a reasoned and correct under law and is liable to be upheld by the court. The appeal be dismissed with exemplary costs for the reasons stated above.

7 . We have heard Mr. M.S. Bharat, Learned Counsel for the appellant and Mr. Ajay Sahni, learned Counsel for 2nd respondent during the Circuit

Bench sitting at New Delhi on 10.02.2009.

8. The learned Counsel for the appellant submitted that the trade mark was published on 21/7/1999 and the same was dispatched on 27/7/1999 by the Trade Marks Registry which was received by the appellant on 31/07/1999. The three months period to file notice of opposition expired on 26.10.1999 and the four months period expired on 26/11/1999. The notice of opposition was filed on 26/11/1999 in the instant case, which was well within the limitation period. The 1st respondent i.e. the Registrar failed to consider the fact that the period of limitation starts from the date of despatch and not from the date of publication. He also submitted that the 2nd respondent had also admitted that the 1st respondent has despatched the Trade Marks Journal on 27/07/1999. The counsel further submitted it was a well settled principle of law that the date of despatch is to be the date for calculating the period of limitation for filing notice of opposition and not the date of publication of the Trade Marks Journal. He also relied on the judgment in AIR

(39) 1952 Travancore-Cochin 77 and submitted that the notice of opposition was filed within the limitation period and the same be taken on record.

The date of journal cannot be taken to be date for calculating the limitation period as it was not possible for all the persons to be aware of the same and to collect the same on the same day.

9. The counsel for the appellant further submitted that the Head Registry of the Trade Marks office was situated at Bombay and it was not possible to

get the Trade Marks Journal on the same day of issuance of the journal, when a party was outside Bombay. Moreover, the Journal is sent through

post and the day it is dispatched is the date to be taken for calculating the period of limitation.

10. The learned Counsel for the 2nd respondent vehemently opposed the contention of the appellant. The counsel contented that the notice of

opposition was filed after the limitation period and the Registrar was correct in having rejected the notice of opposition. He also pointed out that the

Registrar had made correct observations in the impugned order. The Trade Marks Journal was made available to the public on 21/07/1999 and that

was to be taken as the date for calculating the period of limitation of 4 months for filing notice of opposition. The counsel submitted that the appeal

was misconceived. The counsel also admitted that the Trade Marks Journal was dispatched on 27/07/1999.

11. We have heard both the counsel and considered the same after going through the entire pleadings.

12. The issue required to be decided in the instant case is whether the period of four months under Section 21 of the Act has to be calculated from the

date of advertisement in the Trade Marks Journal or the date on which the Journal was actually issued/dispatched by the Registrar of Trade Marks is

for the purpose of filing notice of opposition to the application. Section 21 of the Trade Marks Act, 1999 reads as under:

Section 21 Opposition to registration (1) 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 prescribed fee, allows, give notice in writing in the prescribed manner to the Registrar, of opposition to the

registration.

(2) XXX

(3) XXX

(4) XXX

(5) XXX

(6) XXX

(7) XXX

13. Section 21 Sub-section (1) of the Act stipulates the period of three months from the date of advertisement or re-advertisement of an application

for registration or within such further period, not exceeding one month in the aggregate, as the Registrar may on application made to him allow. The

three months period is to be calculated from the date of the dispatch of the Journal in which the trade mark is published, as has been held by the court

that the period should be counted from the date of dispatch of the journal containing the advertisement to the subscribers and not the date printed on

the Journal.

14. Under the Act (Act of 1958) it was clear that the date of dispatch was taken into consideration for counting the date of period of limitation. If it

was to be calculated from the date of publication of the Journal and such journal is issued on a later date, the opponent would be definitely affected.

The journal which is usually sent through post is dispatched on a date subsequent to the journal date and there is every possibility of at least one or two days of delay. So the date of dispatch was to be the date to be considered for calculating the period for filing the notice of opposition.

15. Under the new Act - Trade Marks Act, 1999, with the development of the internet facilities, the publication is on the internet, which is treated as

the advertisement of the application for registration. In such case, if the same journal which is on the internet as well sent to a party whether the date

of dispatch will be considered to be the date to calculate the period of limitation for filing notice of opposition is doubtful. In order to obviate any doubt,

under Rule 47(1), the Registrar is required to certify the date of availability as to when the Trade Marks Journal is made available to the public in such

cases.

1 6 . IN AIR 1952 (39) Travancore-Cochin 77, the court held, ""The object of

advertising that an application for the registration of a Trade Mark has been received by the Registrar is obviously to let the public know about it and to invite opposition to it, if any. That object will served only when the journal is distributed among the subscribers or otherwise made available to the public and not when it is got printed on few copies or cuttings distributed among the subordinate officers of the Trade Marks Registry or among the applicants for registration. - The four months period prescribed by Rule 30 read with Section 15(2) of Trade Marks Act (1940) for filing the notice of opposition to the registration of a trade mark should be counted from the date of dispatch of the Trade Marks Journal containing the advertisement to the subscribers.

17. In the light of the above, we have no hesitation in holding that the notice of opposition is not time barred in the case on hand and has got to be taken on record.

The 1st respondent has not rejected the contentions that the Trade Marks Journal was dispatched on 27/07/1999 and has in fact admitted that the notice of opposition was dated 26/11/1999 which was the date within which the notice of opposition was to be filed. We, therefore, are of the opinion that the matter be remitted back to the Trade Marks Registry with the direction that the Registrar should take on record the notice of opposition and decide the opposition in accordance with law at an early date.

18. Accordingly, the appeal is allowed and the notice of opposition is remanded back to the Registrar with direction that he should take the notice of opposition on record and decide the matter at the earliest in accordance with law. There shall be no order as to costs.