

(2014) 05 IPAB CK 0001

In the Intellectual Property Appellate Board

Case No : OA/8/2012/TM/DEL & M.P. No. 130/2012 In OA/8/2012/TM/DEL And
OA/45/2013/TM/DEL & M.P. No. 262 & 263/2013 In OA/45/2013/TM/
DEL

Nikitasha Home Appliances Limited And Others

APPELLANT

Vs

Pradeep Kapahi And Others

RESPONDENT

Date of Decision : 28-05-2014

Acts Referred:

Code Of Civil Procedure, 1908 — Order 39 Rule 1, Order 39 Rule 2, Order 39 Rule 4
Trade Marks Act, 1999 — Section 2(1)(y), 2(1)(ze), 3, 3(2), 9, 11, 18(4), 19, 20,
20(2), 20(2)(a), 21, 91

Citation : (2014) 2 MIPR 297

Hon'ble Judges : S. Usha, J; Sanjeev Kumar Chaswal, Technical Member

Bench : Division Bench

Final Decision : Dismissed/ Disposed Of

Judgement

S. Usha, J

1. The above appeals are filed against the order passed by the Assistant Registrar of Trade Marks dated 20/12/2012 dismissing the notice of opposition filed by the appellant (OA/8/2012/TM/DEL) and directing the applications to proceed for acceptance of the Registration under section 18(4) of the Trade Marks Act, 1999 (hereinafter referred to as Act), which may be re-advertised under section 20(2)(a) after due acceptance at his discretion as per the rule of law (OA/45/2013/TM/DEL).

2 . The appellants in both the appeals are partially aggrieved against the impugned order and therefore two appeals namely OA/8/2012/TM/DEL and OA/45/2013/TM/DEL arising out of a common order passed by the Assistant Registrar in opposition No. DEL 757202 against application No. 1410936. The appellant in OA/8/2012/TM/DEL is referred to as the appellant and the appellant in OA/45/2013/TM/DEL who is the respondent in OA/8/2012/TM/DEL is referred to as the respondent in the order. The instant appeal grounds and the counter

statement in OA/45/2013/TM/DEL are not given in detail for the sake of not repeating.

OA/8/2012/TM/DEL

3 . Facts of the case are that the appellant is engaged in the business of manufacturing, marketing and exporting inter alia of electrical and electronics items including home appliances, heating, cooling, refrigerating installations and apparatus etc.

4. The appellant is the true owner and lawful proprietor of the trade mark Nikitasha in respect of the aforesaid goods. The said trade mark was honestly and bonafidely adopted by M/s. Thermo Control and Instrument (a sole proprietorship firm of Mr. Deepankar Bhalla) as back as in the year 2003. The said firm was importing the said goods from abroad under various trade marks including its own trade mark Niki Tasha.

5 . The said Thermo Control & Instruments was supplying the said goods under its trade mark Niki Tasha to various persons and also supplied such goods to the respondent from 2006-2008.

6 . The aforesaid trade mark Niki Tasha has been used by the predecessors M/s. Thermo Control & Instruments till the year 2008. In the year 2008 to 2010, they had some customs problem and personal difficulties in business and hence the import activities was deferred.

7 . In the year 2010, the said Mr. Deepankar Bhalla through his fiancée and another friend's wife incorporated the appellant company under the name Nikitasha Home Appliances Pvt. Ltd. The said company was incorporated and registered under the provisions of the Indian Companies Act, 1956 on 15/04/2010.

8. The said trade mark apart from being the appellant's trade mark is also integral and conspicuous part of its corporate name Nikitasha. The said trade mark is household name of the appellant.

9. When the appellant company began business of the said goods, one Mr. Ajay Kumar Malhotra trading as M/s. Peak Snow Home Appliances approached and asked it to stop using the trade mark Niki Tasha as he had obtained registration of the said trade mark Niki Tasha in class 11 under No. 1001282 dated 04/04/2001, which was used since 1998. The appellant on being confronted with such circumstances, obtained assignments of the said trade mark for lawful consideration vide assignment dated 19/05/2010. The appellant is the present proprietor of the said registered trade mark Nikitasha in respect of heating, cooling, refrigeration etc. An application to bring on record the name of the appellant as proprietor has already been filed before the Trade Marks Registry. The appellant has stepped into the shoes of the said Mr. Ajay Kumar Malhotra trading as M/s. Peak Snow Home Appliances and is entitled to rely upon the said registration as well as the benefit of use of said trade mark made by him since

the year 1998.

10. The said Mr. Ajay Kumar Malhotra trading as M/s. Peak Snow Home Appliances has filed the opposition No. DEL 757202 to the subject trade mark application of the respondent. The appellant had filed a request on Form TM-16 for substituting its name as opponent in those proceedings before the Registrar of Trade Marks.

11. The appellant and its predecessors have established a good trade under the trade mark Nikitasha and carried out sufficient commercial activities under the same. The same trade mark Nikitasha is distinctive of the aforesaid goods and business of the appellant.

12. On account of continuous commercial use coupled with sales promotion activities, appellant's said trade mark has acquired goodwill and trade reputation among the public and trade. Therefore it has come to be identified and associated with appellant's goods and business. The appellant had also filed the application for registration of trade mark in various classes and the said applications are pending registration.

13 . Besides, the statutory rights to the exclusive use of the said trade mark, on account of registration, the appellant has acquired legal, vested and common law rights to the exclusive use of the said trade mark on account of its continuous and commercial use. Such right of the appellant also includes right to restrain the use and registration of a deceptively similar trade mark by another for same or similar goods and services.

14 . The respondent filed the Suit No. TM/25/2011 for the relief of permanent injunction, infringement, passing off and rendition of account of M/s. Thermo Control & Instrument etc against the appellant, before the Hon'ble District Court, New Delhi. The said suit was contested by the appellant by filing written statement along with the counter claim. The Ld. Additional District Judge, New Delhi passed an order of injunction whereby the appellant was restrained from selling goods included in class 7 while the respondent was restrained from dealing in goods in class 11.

15 . The respondent herein filed an appeal against the said order being FAO No. 511/2011 before the Hon'ble High Court of Delhi, which was disposed by the order dated 30/11/2011 issuing direction to the Registrar of Trade Marks to hear and decide the opposition.

16. The application of the respondent under No. 1410936 in class 11 was filed on 03/01/2006 with the claim of user since 2005 and the same was advertised on 16/12/2008 at page 381 in respect of toasters, press, coffee maker, pop toasters and fans with claim of user since 01/11/2002. (The date was changed after a TM 16 for amendment was allowed). The aforesaid application was opposed by Mr. Ajay Kumar Malhotra under Opposition No. DEL 757202. The said opposition was fixed for hearing on 28/12/2011.

17. An attempt was made for hearing of the aforesaid opposition behind the back and in the absence of the appellant herein who to the complete knowledge of the respondent and the Registrar was a necessary party. However, the appellant came to know about the hearing and caused appearance.

18. The appellant filed a petition under section 19 of the Act bringing to the notice of the Registrar of Trade Marks, the facts and circumstances clearly establishing that the order for advertisement of the impugned trade mark had been obtained by the respondent by making false statement and misrepresentation. The impugned trade mark has been advertised in error and without even consulting the Registrar of Trade Marks or Registrar's own records, which established that the appellant or its predecessor are prior adopter, prior user and prior registered owner of the identical and deceptively similar trade marks for same and similar goods. The appellant also pleaded that the Registrar of Trade Marks has a duty to inform and issue cross notice to a prior registered proprietor/prior applicant, but the Registrar, while passing order for advertisement of the impugned application did not issue any notice to the appellant.

19. In view of the above facts and circumstances, the advertisement of the impugned trade marks deserves to be cancelled or withdrawn/revoked and the application deserves to be rejected.

20 . The Ld. Registrar heard both the parties and passed impugned order. The Ld. Registrar held that the notice of opposition has been filed after 15 months from the date of advertisement published in the Trade Marks Journal and there has been an inadvertent delay of 15 months, which is not allowable under statute and therefore the notice of opposition is liable to be refused and not allowed.

21. The appellant has filed a petition under section 19. This application under section

19 may only be invoked after the acceptance granted by the Registrar to the application for registration under section 18(4) of the Act. Since the application has been advertised before acceptance, section 19 may be invoked after acceptance by the Registrar under section 18(4). Therefore the petition under section 19 is not maintainable and is liable to be refused.

22 . The Registrar also held that whether the acceptance may be ordered by this tribunal itself, while acting in the capacity of Registrar exercising his powers and discharging quasi judicial functions as Tribunal. Accepting the application under section 18(4) is procedural function, purely administrative in nature, which involves unilateral proceedings between the Registrar and the applicant. So this function may not be discharged by the Registrar, while adjudicating the quasi judicial proceedings as a Tribunal. In the interest of justice, the application for registration be placed before the Registrar for acceptance under section 18(4) which may thereafter be re-advertised if required under section 20(2) of the Act at the discretion of the Registrar.

23. Accordingly the notice of opposition was dismissed being time barred. Petition under section 19 of the Act was not maintainable before acceptance of the application and therefore it was also refused and disallowed.

24. The application shall proceed for acceptance of the Registrar under section 18(4) which may be re-advertised under section 20(2)(a) after due acceptance at his discretion as per the rule of law.

25. The respondent herein filed the counter statement stating the various facts. The present appeal has been filed under section 91 of the Act against the order of the Registrar dated 20/01/2012. The respondent has also filed cancellation proceedings against Mr. Ajay Kumar Malhotra under No. 1001282 in class 11. The said cancellation proceedings are filed on the ground of non-use as the said registration was secured by misleading the Registrar and by misrepresenting statements and that the said assignment is not a valid assignment in the eye of law.

26. The preliminary objection raised by the respondent is that the present appeal is not supported by any Board Resolution authorizing Ms. Ritu Rao, Director of NIKITASHA HOME APPLIANCES LIMITED to file this appeal and therefore the present appeal is an abuse of law and liable to be dismissed in limine with exemplary costs.

27. The present appeal is liable to be dismissed at the very outset as the impugned order passed by the Deputy Registrar after due application of mind and after considering the statutory provisions of the Trade Marks Act, 1999 including the facts and circumstances of the present case. The appellant is trying to mislead and misrepresent the Board by giving concocted facts.

28. The alleged assignee i.e., the appellant company was admittedly incorporated on 15/04/2010, however, as per the assignment deed the consideration of the said assignment was received much prior to the incorporation of the said Company. When the appellant company itself was incorporated on 15/04/2010 how the appellants could have approached Mr. Ajay Kumar Malhotra earlier to that. The respondent fails to understand the reason for Mr. Ajay Kumar Malhotra approaching the appellant and asking him to stop the use of the trade mark Nikitasha after appellant commenced its business, when admittedly the said Mr. Ajay Kumar Malhotra had already received the due consideration of the assignment in February 2010.

29. The appellant avers that M/s. Thermo Control and Instruments supplied the goods under the trade mark Nikitasha to the answering respondent from 2006-2008 whereas in the affidavit of Mr. Deepankar Bhalla filed in the suit, bearing No. TM 25 of 2011 titled as Pradeep Kapahi Vs. Nikitasha Home Appliances Pvt. Ltd. the said Mr. Deepankar Bhalla has deposed in his affidavit of alleged supplying of the goods to the answering respondent from at least the year 2004.

30. The present appeal is liable to be dismissed as impugned order has been passed after considering the principles of natural justice, fair play, equity and good conscious and also after considering the bonafide claims and averments.

31 . The present appeal is only a counter blast as the respondent has filed an application under order 39 Rule 4 and order 39 Rule 1 & 2 CPC and that the registration certificate has been granted to the answering respondent and the present appeal has been filed only after coming to know that the certificate has been granted to the answering respondent.

32. The appellant in the present appeal has filed number of documents, which did not form part of the opposition proceeding and the appellant has not sought leave of the Hon'ble Board for placing those documents on record and therefore those documents cannot be considered by this Board.

33. The respondents also denied the various allegations made in the ground of appeal filed by the appellant.

OA/45/2013/TM/DEL

34 . This appeal has been filed by the respondent in OA/8/2012 against the order dated 20/01/2012. The appellant is engaged in the business of Mixer, Juicer, Grinder, Blenders, Vacuum cleaner and Electric cleaning machines and apparatus etc. bearing the trade mark NIKITASHA in class 7 and 11. The establishment of M/s. Shree Ram Enterprises relates back to the year 2002 and Mr. Pradeep Kapahi being the proprietor adopted the mark Niki Tahsha in the same year in respect of the goods in class 7 and 11.

35. The said trade mark Niki Tasha in class 7 was registered in favour of the appellant and the registration certificate was issued on 20/03/2010 and in class 11 the mark now stands registered and the certificate was issued on 03/03/2012 after the impugned order was passed.

36. The appellant honestly adopted and conceived the trade mark NIKI TASHA in the year 2002, which has been used extensively and openly since 1st November 2002. However, the application for registration in class 11 was made inadvertently with the user mentioned as 01/10/2005 instead of 01/11/2002. Later, the date of user was to be amended and a Form TM-16 was filed on 05/11/2008 for seeking amendment of the correct date of user as 01/11/2002. It is also submitted that the application under class 7 filed on the same day showed the correct date of user being 01/11/2002.

37 . The appellant in the 3rd week of November 2010 came to know that the respondents were using the trade mark Nikitasha. The appellant further came to know about the illegal trade activities of the respondent from the market survey regarding the sale of the respondents' goods bearing the impugned trade mark NIKITASHA with a view to calculate deception and confusion in the market and to trade upon the goodwill and reputation of the appellant.

38. Being aggrieved with the said activities of the respondent, the appellant filed a suit for infringement and passing off against the respondent before the District Court, Delhi and an ex-parte ad interim injunction was granted against the respondent thereby restraining it from using the trade mark Nikitasha or any other deceptively similar trade mark for the goods falling in class 7 and 11 vide order dated 06/12/2010.

39. At the time when the above suit was filed, the application of the appellant for the registration of the trade marks Niki Tasha was pending in class 11 under a frivolous opposition by respondent, which was filed after the expiry of the period of limitation by the claimed predecessor of the respondent.

40. The respondent herein filed a counter claim in the said suit claiming itself to be the subsequent proprietor of the trade mark Nikitasha under No. 1001282 by virtue of alleged assignment deed from its registered proprietor (Mr. Ajay Kumar Malhotra) in class 11.

41. The respondent claims to be the subsequent proprietor of the impugned mark by virtue of the assignment deed dated 19/05/2010. The said assignment deed is illegal and there are many defects in the said assignment deed and does not and cannot convey the title in the impugned mark in favour of the respondent. The alleged assignment deed relied upon by the respondent is not valid in law and the manner in which it is executed, is against the pleadings pleaded by the respondent before the District Court in the suit.

42. The appellant has filed a cancellation petition against the said registration and the respondent has given a statement before the Hon'ble Board that the respondent shall not use the registration against the appellant till the pendency of the cancellation petition.

43 . The claimed predecessor of the respondent had never carried on any business under any name including the alleged name claimed by him and the respondent had knowledge at the time of execution of the alleged assignment deed that respondent had not done any business and the mentioning of the same in the alleged assignment deed is false to the knowledge of the respondent.

44 . The Ld. Additional District Judge heard the arguments on merits in the cross injunction applications of the appellant and respondent and vide order dated 13/10/2011 the Ld. Additional District Judge restrained the appellant from using the mark NIKI TASHA for goods falling in class 11 of which respondent was the registered proprietor and restrained the respondent from using the trade marks NIKITASHA for goods falling in class 7.

45. The appellant filed an appeal before the Hon'ble High Court of Delhi against the order passed by the Ld. Additional District Judge, wherein the Hon'ble High Court was pleased to direct the Registrar to pass orders in respect to the opposition filed by Mr. Ajay Kumar Malhotra against the application of the appellant under No. 1410936 in class 11 within a period of six weeks and if the

opposition was decided in favour of the appellant, to issue the registration certification within a period of three weeks thereafter and in such an event the appellant would be at liberty to seek variation in the injunction order.

46. The respondent filed an application in Form TM-16 for substituting itself as the opponent in place of original opponent namely Mr. Ajay Kumar Malhotra.

47. During the course of the proceedings, the respondent herein had filed a petition under section 19 of the Trade Marks Act for the withdrawal of the acceptance of the application.

48. The appellant objected to the respondent being substituted in the place of Mr. Ajay Kumar Malhotra.

49. The Ld. Registrar of Trade Marks passed the impugned order dated 20/01/2012 thereby inter alia has allowed the Form TM-16 to the effect that "keeping in view of incriminating facts and circumstances to advance the interest of justice and in order to afford reasonable opportunity of being heard"; dismissing the opposition as time barred and has further ordered for re-advertisement of the mark after acceptance at discretion. The Registrar has thus been pleased to issue the registration certificate on 03/03/2012.

50. The respondent thereafter filed an application under order 39 Rule 4 CPC before the Ld. Additional District Judge for vacating the order against the appellant herein on account of the changed circumstances of the issue of the registration certificate in favour of the appellant.

51. The Ld. Registrar while disposing off the opposition has held that the notice of opposition was time barred and also dismissed the petition under section 19 and has further gone into the merits of the case in the impugned order and has made certain observations with respect to the allowing of the amendment application seeking the correction of the user of the appellant and has also allowed the Form TM-16 filed by the respondent for substituting the respondent as subsequent opponent in place of original opponent based on the alleged assignment deed.

52. The Assistant Registrar has by the impugned order also directed the application to be re-advertised based on the fact that there is word "Press" in the application which does not fall in class 11. It is submitted that for such minor correction, the Registrar could have directed notification in the prescribed manner for the correction or the amendment as per Section 20 instead of directing re-advertisement of the same. However, the fact is that the application has not been re-advertised. The respondent has taken this point as bone of contention in its appeal being OA/8/2012, hence this point is agitated by the appellant.

53. The respondent has filed an appeal against the impugned order before this Hon'ble Board taking the benefit of the observation of the Ld. Registrar with

respect to the questioning the ante dating the user claim of the appellant and further making observations on the bills filed by the appellant which are beyond the scope of the opposition as the same are without the jurisdiction of the Ld. Registrar of the Trade Marks. The Ld. Registrar of Trade Marks was to decide the issues whether the opposition was within the time or not. If the opposition is beyond the time, then the Ld. Registrar of Trade Marks could not have made any observations on the merits of the case as the Ld. Registrar was not sitting in review or appeal.

54. The appellant is aggrieved by the aforesaid order and has preferred the present appeal.

55. The respondent herein filed their counter statement denying various allegations made in the appeal grounds.

56 . The Counsel for respondent had also relied on the facts stated in the appeal OA/8/2012/TM/DEL and prayed that the above appeal may be dismissed.

57. We heard Mr. Miglani learned counsel for the appellant in OA/08/2012/TM/DEL and Mr. Mohan Vidhani, learned counsel for the appellant in OA/45/2013/TM/DEL. As both the appeals are against the same order, common arguments were advanced.

5 8 . Learned counsel Mr. Miglani submitted that the rival marks are identical for identical goods. The appellant is the true owner and lawful proprietor of the trade mark Nikitasha in respect of goods falling in class 11 under the trading style "M/s. Thermo Control & Instruments" a sole proprietorship firm. The said firm was supplying the goods under the trade mark Nikitasha to the respondent herein from 2006-2008. In the year 2010, the present company Nikitasha Home Appliances Private Ltd. was incorporated. On an understanding between one Mr. Ajay Kumar Malhotra and the appellant company, the trade mark Nikitasha which was registered in favour of the said Ajay Kumar Malhotra was assigned to the appellant by deed dated 19/05/2010.

Thereafter a request on form TM 23 was filed before the Registrar of Trade Marks and the same is pending.

59. Mr. Ajay Kumar Malhotra had opposed the present application for registration filed by the respondents. After the assignment, the present appellant has been substituted. The appellant herein filed an application under Section 19 of the Act for withdrawal of the acceptance order. The impugned order was passed on 20/01/2012 and the certificate has been issued on 30/04/2012.

6 0 . The impugned application was filed on 03/01/2006 claiming user since 01/10/2005. Thereafter, an examination report was issued along with a search report with certain objections as to registrability of the mark under sections 9 & 11 of the Act. The respondent replied to the objection along with a request on Form TM 16 for amending the date of user to 01/11/2002 instead of 01/10/2005. The counsel also pointed out to the contents of the affidavit filed in support of

application and submitted that the sales figure are of the sales of goods bearing different trade marks including the impugned trade mark, which will not help the respondents.

61. On 09/02/2012 and 17/02/2012, the appellants had written to the Registrar of Trade Marks to find out, if the mark was placed before the Registrar for appropriate orders as per the order dated 20/01/2012. The Registrar had not replied but had issued the certificate.

62. In the impugned order, the Deputy Registrar has held that it will be placed before the Registrar for acceptance. As per Section 2(1)(y) the Registrar means Registrar of Trade Marks referred to in section 3. The counsel also referred to Section 3 of the Act. As per Section 2(1)(ze) the counsel submitted that the Tribunal means the Registrar or the Appellate Board. In this context, the counsel relied on (1) AIR 1955 SC 558--Registrar of Trade Marks Vs. Ashok Chandra Rakhit Ltd. and (2) 1998 PTC 717 (18)--Whirlpool Corporation Vs. Registrar of Trade Marks, Mumbai.

63. The counsel also relied on the judgment reported in AIR 1982 Bombay 505-M/s. Kanshiram Surinderkumar a firm, Vs. M/s. Thakurdas Deomal Rohire and others. It is essential that the register should not contain trade mark which are identical or which so clearly resembles each other.

64. In reply, learned counsel for the respondent Mr. Mohan Vidhani submitted that the Hon'ble High Court of Delhi in CM No. 21636/2011 has directed the Registrar to decide the application not confining to the opposition.

65. In the impugned order it is stated that on 15/11/2008 after hearing, the Registrar accepted the plea of the applicant and allowed the desired amendment by ante dating the date of user to be on 01/11/2002 in the place of 01/11/2005 and also allowed further amendment in the specification of goods. In support of this, the respondent placed before us the note sheet order. The counsel also submitted that the other findings at page 6 (internal) of the impugned order is a finding against the order passed in an application in Form TM 16 which is not relevant in the opposition proceedings. The TM 16 for amendment has already been allowed.

66. The petition under section 19 of the Act was sent to the Registrar as a letter and not as an interlocutory petition. The notice of opposition has been filed on 02/03/2010 which does not have the ramification nor has it been signed by the counsel and hence defective. The substitution of the opponents name, could be by filing an interlocutory petition and not by filing TM 16. It is not clear as to how the amendment/substitution has been allowed.

67. Re-advertisement is only 'may' and not 'shall' as per Section 20 of the Act. As regards the amendment of date of user, it is not necessary that reason should be given. Therefore the order as to re-advertisement does not arise.

68 . In rejoinder, the counsel for appellant submitted that filing TM 16 instead of

interlocutory petition to substitute the opponent is no irregularity. The respondent has no locus to challenge the assignment. The counsel admitted that the notice of opposition is time barred.

69. We have heard and considered the argument of both the counsel and have gone through the pleadings and documents.

70. The issues that arises for consideration are:

- (1) Whether the notice of opposition filed is within the stipulated period?
- (2) Whether the petition filed under Section 19 of the Act is maintainable?
- (3) Whether the Deputy Registrar has the power to pass an order of acceptance?
- (4) Whether the certificate of registration issued was proper when there was a direction for re-advertisement.

Issue No. 1

71. Whether the notice of opposition filed is within the stipulated period?

Section 21 provides for filing a notice of opposition within three months from the date of advertisement of an application for registration or within such further period not exceeding one month in the aggregate. The trade mark application impugned herein was published on 16/12/2008 in the Trade Marks Journal No. 1406 at page 381 and was made available to the public on the same day i.e. on 16/12/2008. The time to file the notice of opposition was upto 16/03/2009 or within the one month period i.e. by 16/04/2009. The notice of opposition was filed on 02/03/2010 which is beyond the stipulated time and therefore time barred. The notice of opposition was hence disallowed. We do not think it necessary to interfere in this finding as the Registrar was correct in holding that the notice of opposition was time barred and refused to take on record the same.

Issue No. 2

72. Whether the petition filed under Section 19 of the Act is maintainable?

The application was advertised before acceptance. Section 19 of the Act reads as hereunder:-

Section 19: Withdrawal of acceptance-Where, after the acceptance of an application for registration of a trade mark but before its registration, the Registrar is satisfied -

- (a) that the application has been accepted in error; or
- (b) that in the circumstances of the case the trade mark should not be registered or should be registered subject to conditions or limitations or to conditions additional to or different from the conditions or limitations subject to which the application has been accepted, the Registrar may, after hearing the applicant if he so desires, withdraw the acceptance and proceed as if the application had not

been accepted.

The Section is very clear that the Registrar may after hearing the applicant, if he so desires withdraw the acceptance. This issue arises only if the application has been accepted and thereafter advertised. In the instant case, the application has been advertised before acceptance and therefore the provision of Section 19 does not apply and the petition under Section 19 in view of the above is not maintainable. The Registrar rightly held that the petition is not maintainable.

Issue No. 3

73. Whether the Deputy Registrar has the power to pass an order of acceptance?

Under Sub-Section 2 of Section 3 of the Act, the Central Government is empowered to appoint such other officers with such designation as it thinks fit for the purpose of discharging under the superintendence and direction of the Registrar, such function of the Registrar under this Act as he may from time to time authorize them to discharge. The Registrar is assisted in his function under the Act by officers designated as Senior Joint Registrar, Joint Registrar, Deputy Registrar, Assistant Registrar, Senior Examiner and Examiners of Trade Marks. It is for the Registrar to delegate the function of the Registrar to such officers. Such authorization may be either general or special. The functions are given to the officers upto the level of Assistant Registrar to perform the function of the Registrar. In case of exigencies of work, the Registrar may also authorize the Senior Examiners and Examiners to carry out the functions of the Registrar. This authorization is general authorization and no specific authorization issued.

74. We think, applying the above principle, the Deputy Registrar in this case has dealt with the opposition proceedings. Having decided the opposition proceedings, it is not clear as to and under what manner the Deputy Registrar has opined that the matter be placed before the Registrar for acceptance. The Deputy Registrar functioned under the authorization issued by the Registrar and therefore ought to have passed the necessary order.

75. The Registrar is the head under whom these other officers function. The Deputy Registrar definitely has the power to pass an order of acceptance as he is to deal with the application for registration at all stages.

Issue No. 4

76. Whether the certificate of registration issued was proper when there was a direction for re-advertisement?

The order reads as-

(1) The notice of opposition No. 757202 dated 02.03.2010 is hereby refused and disallowed being time barred.

(2) The petition of opposition dated 04/01/2012 filed under Section 19 of the Act is not maintainable before acceptance of application for registration under

Section 18(4) of the Act, therefore, refused and disallowed.

(3) The application No. 1410936 dated 03/01/2006 shall proceed for the acceptance of the Registrar under Section 18(4) which may be re-advertised under Section 20(2)(a) after due acceptance at his discretion as per the rule of law.

The opposition section of Trade Marks Registry, Delhi is hereby directed to place the application dated 03/01/2006 before the Registrar for his acceptance under section 18(4) within a week from the date of this order.

77. The Deputy Registrar has also directed the opposition section to place the application before the Registrar for an acceptance order of the application within a week from the date of the impugned order i.e. 20/01/2012. This probably would have been because of the direction of the Hon'ble High Court of Delhi in FAO 511/2011.

78. The Hon'ble Delhi High Court has held in FAO 511/2011 as under -

....The Registrar, Trade Marks is accordingly directed to decide the application dated 03/01/2006 of the appellant and the objections filed by Mr. Ajay Kumar Malhotra within a period of six weeks from the date of this order.

In the event, the Registrar, Trade Marks given his decision in favour of the appellant, then necessary certificate under The Trade Marks Act shall be issued in favour of the appellant within a period three weeks from the date of decision of the Registrar Trade Marks.....

79. The impugned order has been passed on 20/01/2012 and the certificate has been issued on 04/03/2012. From the reading of the impugned order, it is understood that the certificate was issued within the time directed by the Hon'ble High Court.

80. With due respect to the orders of the High Court of Delhi, the direction is to issue the certificate no doubt in the event of the decision being in favour of the appellant. In our considered view the order is not totally in favour of the appellant. In fact the procedures are to be followed and if not followed the outcome will be unlawful. The Deputy Registrar has directed the opposition section to place the application before the Registrar for acceptance which may be re-advertised. Therefore, once it is said to be re-advertised, then unless that is done no order on its own can be passed by the Registrar. In the instant case, the Deputy Registrar has also directed for an acceptance order and re-advertisement. It is not clear whether any such order of acceptance has been passed. That apart no advertisement has been made. Even if such an advertisement has been made the certificate dated 04/03/2012 issued ought to be recalled as it is within the period of notice of opposition. However, no such acceptance order nor any advertisement has been made and therefore the certificate has to be recalled and the matter be placed before the Registrar for an order of acceptance and for re-advertisement of the application for registration.

The matter is therefore remanded back to the Registrar for dealing with the application as per the rule of law.

81. The appellants in OA/45/2013/TM/DEL have sought for an order of expunging the observations made in pages 5 & 6 of the impugned order as given hereunder:-

On 15.11.2008, after hearing, the Registrar accepted the plea of applicant and allowed the desired amendment by anti-dating the date of user to be 1.11.2002 in place of 1.11.2005 and also allowed the amendment in specification of goods. On perusal of the record it is difficult to understand under what circumstances the Registrar allowed to anti date the user since 1.11.2002 in place of 1.11.2005, whereas nothing is on record to substantiate the facts of user since 1.11.2002, except only five photocopies of receipt of sales of goods showing the sale of merely Rs. 14,210/- only from 11.6.2003 to 2.2.2004 and that too, the receipts did not bear or mention the mark NIKITASHA. Besides, the Registrar allowed the goods 'press' in class 11 which nactually comes within the description of goods of class 9. This error on face of record has also vitiated the advertisement of mark and needs be re-advertised under section 20(2)(a) after removal of the good 'Press' from class 11.

82. We are not going into this issue as the matter is being remanded back to the Trade Marks Registry for afresh consideration. The application will be decided as per the above directions. We also think that the observations made in page 5 & 6 of the impugned order will have no bearing on the application, which is to be decided afresh as per the directions given above.

83 . Consequently, OA/8/2012/TM/DEL is dismissed with no order as to costs. OA/45/2013/TM/DEL is disposed off with a direction given above. No order as to costs.