
(2017) 11 DEL CK 0688

In the Delhi High Court

Case No : Civil Writ Petition No. 1625 Of 2017

Praveen Kumar Maakar

APPELLANT

Vs

Union Of India And Anr

RESPONDENT

Date of Decision : 06-11-2017

Acts Referred:

Trademarks Act, 1999 — Section 21, 21(1), 21(2)

Citation : (2017) 11 DEL CK 0688

Hon'ble Judges : Vibhu Bakhru, J

Bench : Single Bench

Advocate : Sharabh Shrivastava, Isha Mital, Shiva Lakshmi, Ruchir Ranjan Rai, Tarandeep Mahal

Final Decision : Allowed

Judgement

Vibhu Bakhru, J

1. The petitioner has filed the present petition, inter alia, impugning an order dated 05.03.2016 (hereinafter "the impugned order") passed by respondent no.2, Registrar of Trade Marks (hereinafter "the Registrar"), whereby the Registrar has held that by virtue under Section 21(2) of the Trademarks Act, 1999 (hereinafter "the Act") the petitioner is deemed to have abandoned his application for registration of the Trade Mark "FRONTIER". The impugned order is premised on the basis that the petitioner had failed to file a Counter Statement to the Notice of Opposition filed by M/s Frontier Bakery Pvt. Ltd. and was served on the petitioner on 29.05.2006.

2. It is the petitioner's case that he had not received the Notice of Opposition filed by Frontier Bakery Pvt. Ltd. and therefore, there was no question of the petitioner abandoning its application for registration of the trademark in question.

3. Briefly stated, the relevant facts necessary to address the controversy involved in the present petition are as under:

4. The petitioner filed an application bearing no. 797498 for registration of the trade mark "FRONTIER BAKERY" on 03.04.1998 in class 30 in respect of "Biscuits, Confectionary, Pastry, Cakes, Cookies, Rusks, Namkeens, Sweets, Burgers, Sandwich, Pizza, Ice cream, Bread, Buns, Kulcha, Patties and Bakery Products". The said application was advertised in the Trade Marks Journal in 2003, but the trademark was not clear and therefore was once again advertised in the Trade Marks Journal, being Trade Mark Journal no. 1333-1 dated 15.08.2005, which was published on 31.01.2006.

5. M/s Frontier Bakery Pvt. Ltd. filed an opposition to the petitioner's application under Section 21(1) of the Act on 29.05.2006. According to respondent no.2, notice of such opposition was sent to the petitioner on 19.07.2011. On the other hand, the petitioner claims that no such Notice of Opposition was received by him or his agent (Delhi Trademark Company). Thereafter, respondent no. 2 passed the impugned order on 05.03.2016. The petitioner claims that he received the impugned order on 06.06.2016. Thereafter, the petitioner caused his advocates to inspect the physical files maintained by the Intellectual Property Office to ascertain the factual position about filing of the opposition and the alleged service of the same to the petitioner.

6. The petitioner filed an application under the Right to Information Act, 2005 on 04.11.2017 about filing of the opposition and service of the same to the petitioner. By the letter dated 02.12.2016 sent in response to the said application, the petitioner became aware that the Notice of Opposition was dispatched on 20.07.2011 from the office of the Registrar, Trade Marks (bearing dispatch nos. 1671 & 1672).

7. It is the petitioner's case that he did not receive the Notice of Opposition. Mr Shrivastava, the learned counsel for the petitioner relied upon an order of Madras High Court, in M/s Allied Blenders and Distillers Pvt. Ltd. v. Intellectual Property Appellate Board & Ors: AIR 2009 Mad 196, wherein the Court considered a plea for extension of limitation period, when notice of opposition had not been filed within the prescribed time. He also relied upon an order of this Court, in Mahinder Nagpal v. Union of India & Ors: 2015 (63) PTC 387 (Del) and Rakesh Kumar v. Union of India & Ors: W.P.(C) 6093/2011, decided on 11.09.2014, wherein the Court directed the respondent to deliver the Registration Certificate to the petitioner on their inability to dispatch the same.

8. Ms Lakshmi, learned counsel appearing for the respondent contended that Notice of Opposition was sent to the petitioner on 19.07.2011 and since the petitioner failed to file the Counter Statement - which was required to be filed within 2 months from the date of receipt of the Notice of Opposition - respondent no. 2 passed the impugned order.

9. Before proceeding further, it is relevant to refer to the provisions of Section 21 of the Act, which reads as under:-

"21. Opposition to registration-[(1) Any person may, within four months from the

date of the advertisement or re-advertisement of an application for registration, give notice in writing in the prescribed manner and on payment of such fee as may be prescribed, to the Registrar, of opposition to the registration.]

(2) The Registrar shall serve a copy of the notice on the applicant for registration and, within two months from the receipt by the applicant of such copy of the notice of opposition, the applicant shall send to the Registrar in the prescribed manner a counter-statement of the grounds on which he relies for his application, and if he does not do so he shall be deemed to have abandoned his application.

(3) If the applicant sends such counter-statement, the Registrar shall serve a copy thereof on the person giving notice of opposition.

(4) 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.

(5) The Registrar shall, after hearing the parties, if so required, and considering the evidence, decide whether and subject to what conditions or limitations, if any, the registration is to be permitted, and may take into account a ground of objection whether relied upon by the opponent or not.

(6) Where a person giving notice of opposition or an applicant sending a counter-statement after receipt of a copy of such notice neither resides nor carries on business in India, the Registrar may require him to give security for the costs of proceedings before him, and in default of such security being duly given, may treat the opposition or application, as the case may be, as abandoned.

(7) The Registrar may, on request, permit correction of any error in, or any amendment of, a notice of opposition or a counter-statement on such terms as he thinks just."

10. In terms of sub section (2) of Section 21 of the Act, the Registrar is required to serve a copy of the notice of opposition to the applicant and the applicant is required to send it to the Registrar in the prescribed manner a counter-statement of the grounds on which he relies for his application, within two months from the receipt of such copy of the notice of opposition. It is only if the applicant fails to send a counter - statement within the specified period of the receipt of the notice of opposition that his application can be treated as abandoned.

11. Plainly, if the petitioner was not served with the Notice of Opposition, the question of the petitioner abandoning his application for registration of the trademark does not arise as the period of two months provided for responding to such opposition commences only from the receipt of notice of opposition.

12. It was contended on behalf of respondent no.2 that even if the petitioner had not received a Notice of Opposition, the petitioner was required to be diligent and

make suitable enquiries from the Trademark Registry. The said contention is unmerited. It is seen that the petitioner had applied for registration of the trademark in 1998. The said application was advertised first in 2003, however, the Court is informed that the trademark was not clear and therefore, the application was again advertised in the Trademark Journal dated 15.08.2005 which was published on 31.01.2006; that is, almost eight years after the petitioner had filed his application. Further, the Opposition was filed on 29.05.2006 and according to respondent no.2; it was dispatched on 19.07.2011 which is more than five years after such opposition had been received by the Trademark Registry. Given the delays endemic in the Trademark Registry, the contention that petitioner was required to be diligent and ought to have enquired about the filing of any notice of opposition and dispatch thereof and on failure to do so should be visited with the consequence of deemed abandonment of his application, is unsustainable. Even otherwise, the conclusion that the applicant is deemed to have abandoned his application can only follow once the notice of opposition is served on the applicant and he fails to respond to the same.

13. In view of the above, the only question that needs to be addressed is whether the Notice of Opposition was dispatched to the petitioner and whether the petitioner had an opportunity to respond to the same.

14. With the view to address the aforesaid controversy, Ms Lakshmi, the learned counsel for respondent no.2 had produced the Despatch Register indicating that the Notice of Opposition had been dispatched to the petitioner on 20.07.2011. The learned counsel had also drawn the attention of this Court to entry at Serial No. 1671, which is stated to record the dispatch to the petitioner. A photocopy of the relevant page of the Despatch Register is taken on record. The said register shows the name / designation of the addressee to be Delhi Registration Service (the word 'Registration' has been scribbled as 'Regi' and the word 'Service' has been scribbled as 'Ser'). Thus, the register, at best, indicates that a communication was sent to M/s Delhi Registration Service. However, Delhi Registration Service is not the petitioner's agent; the petitioner's agent is M/s Delhi Trademark Company. Thus, the Despatch Register is of little assistance to respondent no.2 and on the contrary indicates that the Notice of Opposition was not sent to the petitioner but to a third party who is not involved in the matter.

15. Ms Shiva Lakshmi, the learned counsel appearing for respondent no.2 contended that although the Despatch Register recorded the name of the addressee as Delhi Registration Service, the same was an inadvertent error and, infact, the Notice of Opposition was sent to M/s Delhi Trademark Company as the notice indicates that it is addressed to Delhi Trademark Company and not Delhi Registration Service. It is possible that Ms Lakshmi is correct in her submission that an incorrect entry had been recorded in the Despatch Register and the notice was, in fact, sent to the correct address. However, there is no material which would substantiate the same. It is equally possible that there is no error in the Despatch Register and the notice of opposition was, in fact, dispatched to M/

s Delhi Registration Service erroneously. Further, given that the petitioner has affirmed that he had never received the Notice of Opposition, the same has to be accepted.

16. In view of the above, the petitioner's contention that it was not provided any opportunity to counter the opposition to registration of the trademark is merited. Thus, the impugned order treating the petitioner as having abandoned his application on the ground that the petitioner had failed to file a counter-statement to the opposition cannot be sustained.

17. In view of the above, the petition is allowed and the impugned order is set aside. The petitioner may file his counter-statement to the Notice of Opposition within a further period of eight weeks from today. Respondent no.2 shall consider the same in accordance with law.

18. The parties are left to bear their own costs.