
(2009) 05 IPAB CK 0001

In the Intellectual Property Appellate Board

T.T. Industries

APPELLANT

Vs

Registrar Of Trade Marks And Ors

RESPONDENT

Date of Decision : 01-05-2009

Acts Referred:

Trade Marks Rules, 2002 — Rule 47(1), 47(6), 56(8)
Trade Marks Act, 1999 — Section 21, 21(1), 95, 131

Citation : (2009) 05 IPAB CK 0001

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

Bench : Division Bench

Final Decision : Disposed Of

Judgement

Z.S. Negi, J

1 . The above mentioned appeal is preferred against the order dated 04.12.2007 passed by the Deputy Registrar of Trade Marks, Chennai refusing to

take the Opposition No. MAS-201843 on the ground that the same is time barred and consequent thereto allowing the application No. 1231170 in class

30 to proceed for registration. The appellant has along with the appeal filed an application for stay of operation and effect of the said order dated

04.12.2007, to restrain the respondent No. 1 from issuing the registration certificate, to direct the respondent No. 3 not to abandon or dismiss the

opposition No. MAS-201843 pending decision of the appeal and to direct the respondent No. 1 not to take any advantage of the impugned order.

2 . The respondent No. 3 filed an application No. 1231170 for registration of trade mark T.T.T in class 30, which was advertised in the Trade Marks

Journal No. 1327 (S- 2) dated 10.01.2005 and the copies of the Journal were stated to be despatched to the subscribers on 11.3.2005. The attorneys'

of the appellant herein, allegedly received the copy (in CD form) on 21.4.2005

and thereafter filed notice of opposition No. MAS- 201843 to application on 28.7.2005 with a request on Form TM-44 for extension of time for filing TM-5.

3. The appellant has averred that the said Trade Marks Journal (in the Compact Disc) was sent by the Trade Marks Registry, Mumbai to the

attorneys and advocates of the appellant on 18.04.2005 under registered post No. H-616 dated 18.04.2005 (a photocopy of registered envelop filed on

record) which was ultimately received by the said attorneys on 21.04.2005. The appellant/opponent on or about 28.7.2005 forwarded the TM-5 along

with request on Form TM-44 to the Registrar of Trade Marks, Chennai. After filing the TM-5, the Registrar of Trade Marks, Chennai by letter No.

TOP/1412 dated 22.05.2006 informed that as the TM-44 filed by the opponent was beyond three months period, and is in contravention of Rule 47(6)

of the Trade Marks Rules, 2002 (hereinafter referred to as the Rules), the hearing was appointed on 03.07.2006. The appellant, on receipt of the

aforesaid hearing notice, immediately filed written submission and/or arguments under Rule 56(8) of the Rules and relied upon certain decisions and

orders. The Deputy Registrar of Trade Marks by her impugned order dated 04.12.2007 observed that the notice of opposition on TM-5 should have

been filed on or before 11.07.2005, by not taking into consideration the request filed by the appellant on TM-44 along with the notice of opposition and

also the fact that the Trade Marks Journal was despatched by the Head Registry in Mumbai on 18.04.2005. The Deputy Registrar of Trade Marks

has not given any consideration to the said written submissions/arguments filed by the appellant.

4. The stay petition came up before us for hearing on 08.04.2009 when Dr. Alok M. Saha, Advocate appeared for the appellant and Shri S.

Balachandran, Advocate appeared for the respondent No. 3.

5 . Dr. Saha, learned Counsel for the appellant contended that the date of official announcement and certificate under Rule 47 (1) of the Rules cannot

be the date of actual publication of the journal, since on the said notified date the branches of the Trade Marks Registry could not get the copies of the

Journal and it is apparent from the facts and circumstances of the present case that although the date of publication was announced under Rule 47(1)

as 11.03.2005, but the said Trade Marks Journal was despatched to the attorneys

of the appellant by the Trade Marks Registry, Mumbai only on 18.04.12005 and as such the appellant cannot be penalized for the laches on the part of the Registry of Trade Marks. The learned Counsel contended that the three months period is required to be counted not from the date of publication but from the date of despatch of the Journal containing the advertisement to the subscribers. To fortify his contention, the learned Counsel relied upon the judgement in Pavunny Ouseph v. Registrar of Trade Marks AIR 1952 TC 77 at page 78. He went on to contend that following the established practice, the date of filing the opposition is to be counted from 18.04.2005 and the provisions of Section 21(1) of the Act affords the appellant to file the notice of opposition within 18.07.2005 (counting three months time period and in case of extension of time within 18.08.2005). The learned Counsel further contended that the Deputy Registrar of Trade Marks has not given any consideration on the written submissions/arguments filed by the appellant. The learned Counsel produced the original envelope through which the Compact Disc of Trade Marks Journal No. 1327(S-2) to corroborate his contention that the copy of said Journal/CD (containing voluminous pages of advertisements) was dispatched by the Trade Marks Registry, Mumbai by registered post only on 18.04.2005 and the internet facilities were not prevalent or were very rare In the year 2005. The learned Counsel relied upon the decision of Supreme Court in the case of State of Punjab and Anr. v. Shamlal Murari and Anr. AIR 1976 SC 1177 to stress that processual law is not to be tyrant but a servant, not an obstruction but an aid to justice.

6 . On the other hand, the learned Counsel for the respondent No. 3 submitted that the Trade Marks Registry, Mumbai had despatched the Trade Marks Journal No. 1327 (S-2) dated 10.01.2005 on 11.03.2005 and the respondent No. 3 had received the same on 26.03.2005. He submitted that the inference can be drawn that the Registrar of Trade Marks, Mumbai has dispatched the Trade Marks Journal to all the subscribers on 11.03.2005. The learned Deputy Registrar of Trade Marks, Chennai has also recorded in her order dated 04.12.2007 that the Trade Marks Journal No. 1327 (S-2) dated 10.01.2005 was made available to public on 11.03.2005. Learned Counsel submitted that Sub-rule (1) of Rule 47 of the Rules provide that opposition be filed within three months or within such further period not

exceeding one month in aggregate from the date the Journal is made available to the public and such date is required to be certified by the Registrar. Once the Registrar has certified such date, that date can alone be date for the purpose of uniform computation of time by all persons for filing opposition, there cannot be different cut of dates for different people. The learned Counsel has further submitted that the case law relied upon by the learned Counsel for the appellant was good when there was no internet or website facility but today anybody can browse the website and see the trade marks applications advertised in the Trade Marks Journal. The learned Counsel drew to our attention to paragraph 4.12 of the appeal wherein it is stated that the appellant was on business trip in abroad, he could not convey necessary instruction to his attorneys and advocates for filing the opposition expeditiously and concluded that the appellant should not be rewarded for its laches or negligence. Relying on the decision in *Monster Munch TM application*, 1997 RPC 721 wherein extension of time for one day was refused, the learned Counsel asserted that the respondent No. 2 has rightly not taken the TM-44 on record and considered. Learned Counsel referred to a passage from the commentary on Section 21 (under the heading 'Period within which to be filed') from the book titled 'Law of Trade Marks & Geographical Indications', 2003 Edition authored by K.C. Kailasam/Ramu Vedaraman and submitted that in the era of computer/internet facilities when the Journal is published in paper form and simultaneously is put on the internet, the question of whether the date of despatch of the Journal may have any significance may be doubtful.

7. In the celebrated decision of Division Bench of High Court of Travancore-Cochin in the case of *Pavunny Ouseph* (supra) wherein an appeal was filed against the order of Registrar of Trade Marks Cochin refusing it as out of time an opposition to the application for registration of a label mark it was held as under:

4. 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 & to invite opposition to it, if any. That object will be served only when the journal is distributed among the subscribers or otherwise made available to the public & not when it is got printed or few copies or cuttings distributed among the subordinate offices of the Trade Marks

Registry or among the applicants for registration. The relevant file called for at the instance of the appellant from the Office of the Additional

Registrar of Trade Marks, Trichur, shows that it has all along been the practice of the Trade Marks Registry to count the four months' time prescribed

by R. 30 from the date of dispatch of the journal containing the advertisement. This practice commends itself to us as embodying a common sense

interpretation of the rule prescribing the period of time within which opposition should be filed. There is therefore, in our opinion, no merit what ever in

the present complaint against the Registrar's refusal to regard the opposition as out of time. When the publication of the advertisement was only on or

about 9-8-1949, the time for giving notice of opposition extended up to 8-12-1949 & a notice filed in November 1949 can by no stretch of imagination

be held to be not within time.

8. Having regard to the above referred judgment, which still holds good as the same has not so far been overruled by any competent Court, in the

instant case, from the evidence available on record and the original envelop produced before us for verification, it is clear that the copy of

advertisement containing the application (in the form of CD) was dispatched to the attorneys of the appellant/opponent only on 18. 4.2005 and the

appellant/opponent forwarded notice of application along with request for extension of time on or about 28.7.2005. Had the Registrar of Trade Marks

taken the Form TM-44 into consideration and extended the time, the appellant would have filed notice of opposition on or before 17.8.2005. The

Registrar of Trade Marks by ignoring the provisions of Section 131 of the Trade Marks Act, 1999 observed that the request on TM-44 is received

after expiry of 3 months prescribed by that section. Since there is cogent evidence proving that the Registrar dispatched the Journal on 18.4.2005, the

period should be computed from 18.4.2005 and having this fact in mind the request on Form TM-44, even forwarded on or about 28.7.2005 was

before the expiry of extendable time (not exceeding one month from the date of Journal) was made available to the appellant's attorneys. Sub-rule (6)

of Rule 47 of the Rules is no longer available on the statute book since the same has been struck down by the Division Bench of High Court of

Bombay under its writ jurisdiction. Apart from this, the respondent No. 2 has not at all considered the written arguments of the appellant, though the

same was available on record.

9. We have to satisfy ourselves as to whether a prima facie case has been made out and the balance of convenience is in favour of the appellant and

also to ensure that the requirements of the provisions of Section 95 of the Trade Marks Act is fulfilled. It is evident that the requirements of Section 95

have been complied with in the present case. The learned Counsels for the respondent No. 3 has very competently argued in the matter but we are

unable to agree with his arguments. The case law cited by him will be of no help to him as the facts are distinguishable. We also find that the prayers

made at 3 and 4 at page 3 of the stay application is not consistent with the facts of the case, we therefore are refraining from making any order with

regard to them.

10. We are satisfied that the appellant has successfully established the prima facie case and the balance of convenience is in its favour as the

respondent No. 3 can carry on its business as usual it might have been carrying on under the common law rights. Accordingly, injunction in term of

prayers 1 and 2 is granted till the disposal of the appeal by this Appellate Board, that is to say that:

(1) the operation and effect of the impugned order dated 4.12.2007 passed in opposition No. MAS- 201843 to application No. 1231170 in class 30; and

(2) the respondent No. 1 shall not issue registration certificate in favour of respondent No. 3 against the application No. 1231170 in class 30; until the

disposal of the appeal by this Appellate Board. No order as to costs.