

(2011) 01 IPAB CK 0009

In the Intellectual Property Appellate Board

Case No : M.P. Nos. 209/2009 And 93/2010 In OA/52/2009/TM/AMD And
OA/52/2009/TM/AMD

WD-40 Manufacturing Company

APPELLANT

Vs

Pavan Kumar Magniram Shah And Ors

RESPONDENT

Date of Decision : 07-01-2011

Acts Referred:

Trade Marks Rules, 2002 — Rule 46, 47, 53

Trade Marks Act, 1998 — Section 21, 21(1), 21(2), 21(7)

Citation : (2011) 47 PTC 567 (IPAB)

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

Bench : Division Bench

Final Decision : Dismissed

Judgement

S. Usha, J

1. This is an appeal arising out of the order dated 22.05.2009 dismissing the notice of opposition on Form TM-5 dated 22.04.2008 as it has become

ultra-vires and not maintainable as it is also time barred under the provisions of the Trade Marks Act, 1998 (hereinafter referred to as "the Act").

2. The brief facts of the case are as follows:

The first Respondent had applied for registration of the trade mark FORCE-20 W40 in relation to lubricating oil on 20.03.2003. The Appellant herein

became aware of the trade mark application, issued a legal notice dated 15.05.2006 calling upon the Respondent No. 1 to delete the word/mark W40

from the impugned trade mark.

3. The Appellant being not aware of the fact that the trade mark was advertised had requested the Respondent No. 2 on Form TM-58 on 05.06.2006

to inform the number, date and page number of the Trademarks Journal in which

the impugned application had been advertised. Meanwhile, the impugned trade mark was advertised in Trade Marks Journal No. 1362 dated 16.02.2007. It was made available to the public on 26.07.2007.

4 . The Respondent No. 2 i.e. the Registrar had not replied to the request on Form TM-58 dated 05.06.2006, neither at the time when impugned trade mark was advertised nor on the date the Journal was made available to the public nor within four months thereafter. To the utter shock and surprise of the Appellant, the Appellant received a letter dated nil from the Respondent No. 2 on 02.02.2008 informing the Appellant that the impugned trade mark had already been advertised in the Trade Marks Journal dated 16.02.2007 at page 348.

5 . The Appellant had filed notice of opposition before the Respondent No. 1 vide letter dated 09.02.2008. In the covering letter dated 09.02.2008 the Appellant had categorically stated about the receipt of the reply from the Respondent No. 2 the letter dated 02.02.2008 whereby the Appellant was informed of the advertisement of the impugned trade mark application.

6. The Appellant filed the notice of opposition on the strength of its proprietary rights in the trade mark label WD-40 in relation to manufacture and marketing of chemical products for industrial use for lubricating and penetrating oils and agents, rust preventive agents, cleaning, polishing and scouring preparations and allied and related goods. The Appellant also claims copyright in the artistic work involved in the said trade mark. Thereafter, a hearing was appointed in the aforesaid proposed notice of opposition on 30.09.2008 and orders were reserved. After hearing the Appellant, the Respondent No. 2 disallowed the aforesaid proposed notice of opposition by order dated 22.05.2009 with the finding that the proposed notice of opposition has been filed after nine months without request on Form TM 44 for condoning the delay or for extending the time and that the Registrar have no power to condone the delay where time is prescribed in the Act.

7 . Aggrieved by the said order, the Appellants have filed the present appeal on the following grounds:

- (i) the impugned order is contrary to law and facts of the case;
- (ii) the impugned order passed by the Respondent No. 2 suffers from non-application of mind;
- (iii) the impugned order passed by the Respondent No. 2 is without considering

the facts and law of the case;

(iv) the Respondent No. 2 exercised the discretion on irrelevant and extraneous having a very strong prima-facies consideration;

(v) the impugned order is non-speaking in nature;

(vi) the respondent No. 2 ought to have considered the request on form TM- 58;

(vii) the respondent No. 2 ought to have informed the Trade Marks Journal number and the date in which the impugned trade mark application was

advertised in order to enable the appellant to file the notice of opposition within the prescribed time;

(viii) the respondent No. 2 informed the advertisement of the impugned trade mark bearing the impugned trade mark application much after the

prescribed time for filing the notice of opposition was over;

(ix) the respondent No. 2 acted in a casual way;

(x) the respondent No. 2 ought to have considered that the reason for non-filing of notice of opposition within the prescribed time was beyond the

control of the appellant;

(xi) the respondent No. 2 ought to have considered that since the appellant became aware of the advertisement on 02.02.2008, they filed the notice of

opposition without any delay vide their letter dated 09.02.2008;

(xii) in the scheme of Trade Marks Rules, 2002, rule 46 comes prior to rule 47 which indirectly casts the duty upon the Registrar to furnish details of

the Trade Marks Journal date in which the impugned application is advertised in case a request on Form TM-58 is received;

(xiii) respondent No. 2 has exercised the discretion on extraneous grounds;

(xv) it is in the interest of justice, equity and good conscience the aforesaid notice of opposition be taken on record.

8. The Respondent No. 1 filed their counter-statement stating that they are trading in the name and style of M/s Mahalaxmi Oil Centre engaged in the

business of manufacturing and marketing of lubricating oil. They had been continuously, exclusively and uninterruptedly marketing under the distinctive

trade mark FORCE-20 W 40 from 08.06.1988. The Appellant has failed to distinguish as to how and why the order dated 22.05.2005 is contrary to

law and facts of the case. The Respondent No. 1 further states that the learned Registrar has taken due care and therefore, the belated opposition

filed after the statutory period of nine months is not maintainable and the same is time barred. The Registrar of Trade Marks has no discretion to

extend the time limit before filing the notice of opposition under Section 21 of the Act and Rule 47 of the Rules framed there under. The factor of

filing Form FM-58 dated

5. 06.2006 by the Appellant does not give any extension of time for filing notice of opposition. The Form on TM-58 is only a request made seeking

information about the publication of the trade mark in the Journal. It is also not necessary to file notice of opposition after receipt of information

against Form TM-58 filed by any person. Notice of opposition can be filed only within three months extended by one month as provided under Section

21(1) of the Act. Hence the Appellant was not under any obligation to file notice of opposition after receipt of the information on Form TM-58. The

conduct of the Appellant shows that the Appellant has neither approached the Registrar with clean hands nor has approached this Board with clean

hands. The only intention on the part of the Appellant is to delay the Registration of the Respondent's trade mark. The Respondent, therefore, prays

that the appeal may be rejected with costs and the application for registration be proceeded to registration.

9 . The matter came for hearing at the Circuit Bench Sitting at Ahmedabad on 23.11.2010. Learned Counsel Shri S.K. Bansal appeared for the

Appellant and learned Counsel Shri Akshay A. Vakil appeared for the Respondent No. 1.

10. We have heard both the counsel. Learned Counsel for the Appellant relied on Rule 46 of the Trade Marks Rule, 2003. The counsel also reiterated

the facts as to when the request on Form TM-58 was filed, and the actual date of the publication in the Trade Marks Journal and the reply received by

the Appellant from the Registrar regarding the Trade Marks Journal number and date requested by the Appellant on TM-58. The counsel submitted

that as the information was received only subsequent to the advertisement, the limitation period for filing the notice of opposition, time is to be

calculated from the date when the information was provided to the Appellant.

11. The counsel also relied on the judgment reported in AIR 1981 SC 711 State of Tamil Nadu v. Hind Stone etc., etc.

12. In reply to the Appellants arguments, the Respondent No. 1 submitted that

the time limit for filing the notice of opposition was provided under Section 21(1) of the Act and the Registrar had no powers to extend the time as the same was specified in the Act itself. So the order passed by the Registrar was according to the provision and the impugned order has been passed rightly by the Registrar.

13 . We have heard and considered the arguments of the counsel and have gone through the pleadings and documents.

14. The facts of the case and the argument of the Appellant is that they had made a request to the Registrar on Form TM-58 for the particulars of the trade mark as to the number and date of the Journal in which the trade marks was advertised, on 5. 06.2006. The same was published on 16.02.2007

which Journal was made available to the public on 26.07.2007. The Respondent No. 2 i.e. the Registrar had replied on 02.02.2008 informing the

Appellant about the advertisement made in Trade Marks Journal No. 1362 dated 16.02.2007 at page 348. On 09.02.2008, the Appellants filed the

notice of opposition after the stipulated period. The other submission was that as the request on Form TM-58 was made and the Appellants were

expecting a reply, the date of limitation period is to be calculated from the date when the reply was received and so there is no delay.

15. Section 21 (1) of the Act prescribes the period for filing the notice of opposition as three months which is extendable by one month on the request

made to that effect before the expiry of three months. It is obvious that there is no room for extending the overall period of four months. In the instant

case, the contention of the Appellant was that the Registrar had not informed about the trade mark and the delay was due to the mistake of the

Registry. In this regard we quote the observation made in Monster Munch TM - 1997 RPC 721 ""where an application for extension of time by one

day was filed on the ground that the irregularity has occurred because of the failure by the Trade Marks Registry to inform that the fax number has

ceased to be operational, was refused"". Based on this, we are of the view that there was an application made for extension of time, here in the instant

case, there was no extension sought for by the Appellant, but only the notice of opposition was filed after a delay of nine months. In such case the

notice of opposition could not be considered to be taken on record.

16. The provision is that the notice of opposition has to be filed within three

months from the date of the Trade Marks Journal made available to the public. It can be extended by one month's time provided the extension is sought before the expiry of the three months period. Here even assuming there was a delay by the Registry, the notice of opposition has not been filed along with the extension application on Form TM 44 stating the facts of the delay.

17. The Registrar, however, is empowered to grant extension of time prescribed only in the Rules. The Division Bench of the Madras High Court in

Allied Blenders and Distilleries Pvt. Ltd., v. Intellectual Property Appellate Board (2010 (42) PTC 57 MAD-DB) on a question whether it is possible

to extend the time prescribed in Section 21 for filing notice of opposition, it was held that, "If the Special Act provides for specific time, manner and

fees for filing of the plaint, it has to be done in compliance and the requirements cannot be relaxed. Sub-Section 21(7) of the Act provides only for

amendment of the notice of opposition and counter-statement, but that cannot be construed as a proviso to cure any deficiency in the requirement of

Sections 21(1) and 21(2) of the Act. Section 131 and Rule 53 can also not be pressed into rescue, since that section will apply only where time is not

expressly provided under the statute and Rule 53 is concerning the time for leading the evidence. It cannot apply to filing of notice of opposition or the

counter-statement. Any other interpretation will defeat the objective of the Act, and hence, cannot be accepted.

18. Based on the above observation, we are of the view that the Registrar has no powers to extend the time beyond the four months time limit.

Therefore, the impugned order passed by the Assistant Registrar does not require any interference by us. That apart the Appellants are not left

remediless if the appeal is not allowed.

19. Accordingly, the appeal is dismissed with no order as to costs. The Miscellaneous Petition Nos. 209/2009 and 93/2010 are also dismissed.