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W.P.(IPD).Nos.3 & 4 of 2023

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 10.08.2023

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THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

W.P.(IPD).No.3 of 2023
(WMP.(IPD) Nos.1 & 2 of 2023
&
W.P.(IPD).No.4 of 2023
(WMP.(IPD) Nos.3 & 4 of 2023

1.Ramya S.Moorthy,
2B, Krishna Sarathy Apartments,
194-196. Royapettah High Road,
Mylapore,
Chennai-600 004.

... Petitioner in both WPs

Vs

1.Registrar of Trade Marks
Trade Marks Registry,
Intellectual Property Building,
GST Road, Guindy, Chennai-600 032.
2.Nirma Ltd.,
Nirma House, Ashram Road,
Ahmedabad,
Gujarat-380 009.

... Respondents in both WPs

Prayer in WP(ID)No.3 of 2023: Writ Petitions (IPD) has been filed under Article 226 of the Constitution of India to grant a writ of certiorarified mandamus calling for the records contained in order



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dated 28.04.2023 passed by the 1st respondent in respect of Application No. 5314494 filed by the petitioner under the Trade Marks Act, 1999 and to quash the same as illegal, unjust , arbitrary and contrary to principles of natural justice and to consequently direct the 1st respondent to grant the petitioner an opportunity to file a counter statement to Notice of Opposition bearing Nos. 1202542.

Prayer in WP(ID)No.3 of 2023: Writ Petitions (IPD) has been filed under Article 226 of the Constitution of India to grant a writ of certiorarified mandamus calling for the records contained in order dated 28.04.2023 passed by the 1st respondent in respect of Application No. 5314494 filed by the petitioner under the Trade Marks Act, 1999 and to quash the same as illegal, unjust , arbitrary and contrary to principles of natural justice and to consequently direct the 1st respondent to grant the petitioner an opportunity to file a counter statement to Notice of Opposition bearing Nos. 1202543.

For Petitioner : Mr.Arun Karthik Mohan &
Mr.Suhrith Parthasarathy

For Respondents : Mr.S.Janarthanam, SPC for R1

COMMON ORDER

In both writ petitions, the petitioner assails two orders, both dated 28.04.2023, by which the application for registration of the relevant marks was deemed to be abandoned. The petitioner filed the



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two trade mark applications on 04.02.2022 under different classes.

On 08.03.2022, the petitioner was notified of the examination report in respect of the respective application. The applications were accepted for advertisement and such advertisement was published on 12.09.2022. Thereafter, it appears that an opposition was filed by the second respondent herein on 12.01.2023. While the Trade Marks Registry asserts that the notice of opposition was electronically transmitted to the petitioner on 19.01.2023, the petitioner denies receipt thereof. On account of non-receipt of the notice of opposition, the petitioner asserts that the counter statement to the notices of opposition could not be filed within the two month period specified in Section 21(2) of the Trade Marks Act, 1999 (The Trade Marks Act). In these circumstances, the Trade Mark Registry issued the impugned orders dated 28.04.2023 holding that the petitioner is deemed to have abandoned the two applications. Hence, these writ petitions.

2. Learned counsel for the petitioner places reliance on the text of Section 21(2) and contends that the clock starts ticking only upon



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receipt by the applicant of a copy of the notice of opposition. Since the notice of opposition was not received by the applicant/petitioner, it is further contended that the conclusion that the applicant abandoned the applications is untenable. Although the Trade Mark Registry relies upon a document indicating transmission of the opposition notice on 19.01.2023 to the agent of the applicant, learned counsel contends that this document does not evidence receipt of the notice of opposition by the applicant.

3. Mr.S.Janarthanam, learned Special Panel Counsel, relies on Rules 17 and 18 of the Trade Marks Rules, 2017, and contends that notice may be served through e-mail to the address provided by the applicant, and that service of notice by e-mail is deemed to be proper service upon dispatching the e-mail. By drawing reference to the document evidencing dispatch of the opposition notice to the applicant / petitioner on 19.01.2023, he points out that the status specified therein is “success”.



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4. The case turns on Section 21 (2), which is set out below:

“(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.”

5. Rules 17 and 18 deal with the address for service and service of notice, respectively, and Rule 18(2), which is of particular relevance, is set out below:

“(2) Any communication or document so sent shall be deemed to have been served, at the time when the letter containing the same would be delivered in the ordinary course of post or at the time of sending the e-mail.”

6. Rule 18(2) incorporates a legal fiction with regard to service of notice by post and e-mail. As regards service of notice by e-mail, it provides that notice would be deemed to be served “at the time of



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sending the e-mail". If construed literally, this would mean no more than proof of transmission of the e-mail. Especially in the context of the non-incorporation of the provision for deemed receipt in the statute, if so construed, Rule 18(2) would not be in consonance with Section 21(2) which provides that the time limit for filing the counter statement would run from the date of receipt by the applicant of the notice of opposition. In this regard, it should also be borne in mind that the substantive right of an applicant seeking registration of trade marks is at stake. Therefore, I conclude that the prescribed time limit would only run from the date of receipt of the e-mail, and the document relied on by the Registrar of Trade Marks does not qualify as evidence of receipt by the petitioner. The petitioner, however, acknowledges receipt of the notices of opposition after the impugned orders were passed.

7. For reasons set out below, WP(IPD) Nos.3 and 4 of 2023 are allowed by quashing the orders impugned in these writ petitions. As a corollary, the two applications are restored to the file of the Registrar of Trade Marks and the matter is remanded for



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reconsideration by the Registrar of Trade Marks. The petitioner shall file the counter statement in respect of the respective notices of opposition within a maximum period of one month from the date of receipt of a copy of this order. The Registrar of Trade Marks is directed to re-consider and decide the matter on merits after providing a reasonable opportunity to both the petitioner and the second respondent herein. Consequently, connected miscellaneous petitions are closed. No costs.

10.08.2023

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SENTHILKUMAR RAMAMOORTHY,J

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