

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED: 19.06.2025

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THE HONOURABLE MR.JUSTICE SENTHILKUMAR RAMAMOORTHY

(T)CMA(TM)/101/2023

(OA/41/2020/TM/CHN)

Godrej Consumer Products Limited,
a Company incorporated under the provisions of
Companies Act, 1956, having its registered
office at Pirojshanagar, Eastern Express
Highway, Vikhroli, Mumbai 400 079, India

... Appellant

-VS-

1.The Assistant Registrar of Trade Marks,
Trade Marks Registry, IPR Building,
Industrial Estate, GST Road, Guindy,
Chennai 600 032.

2.The Good Stuff Private Limited,
443, 9th Cross, 2nd Phase,
JP Nagar, Bangalore 560 078,
Karnataka, India.

... Respondents

(Amendment carried out as per Order in C.M.P(TM) No.6 of 2024 dated
29.08.2024 by SKRJ)



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PRAYER: Transfer Civil Miscellaneous Appeal (Trade Marks) is filed under Section 91 of the Trade Marks Act, 1999, pleaded to call for the records of Application No.3455894 in class 03 and of opposition thereto being Opposition No.889207 and quash and set aside the impugned order dated 24th February 2020 passed by the first respondent.

For Appellant : Mr.Arun C.Mohan
for M/s.W.S.Kane and Co.,

For Respondents : Ms.R.Mithra
for M/s.Fox Mandal & Associates for R2
Ms.V.Sudha, SPC for R1

JUDGMENT

This appeal is directed against order dated 24.02.2020 holding that the appellant / opponent is deemed to have abandoned the opposition in terms of Rule 45(2) of the Trade Marks Rules, 2017 (the TM Rules).

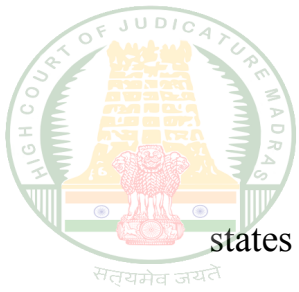
2. The second respondent herein had applied for registration of the trade mark 'DND Easy' in relation to cosmetic preparations for hair care, skin and body care, etc. under Application No.3455894 in Class 3 on a



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proposed to be used basis. Upon the advertisement relating thereto being published in the Trade Marks Journal on 13.02.2017, the appellant filed notice of opposition on or about 03.06.2017. According to the appellant, the first respondent had called upon the second respondent to file a counter statement by communication dated 26.07.2017. Thereafter, it is stated that the appellant did not receive any communication in the matter from either of the respondents. By notice dated 07.11.2019, the appellant states that the first respondent informed the appellant that the counter statement had been served earlier by e-mail dated 08.11.2017 and that the appellant had not submitted evidence upon receipt thereof. In response, the appellant filed affidavit dated 14.11.2019 stating that the counter statement was not received via e-mail of 08.11.2017. The order impugned herein was issued in the said facts and circumstances.

3. Learned counsel for the appellant invited my attention to communication dated 07.11.2019 from the Registrar of Trade Marks and submitted that the appellant became aware of the alleged service of the counter statement only upon receipt of this communication. Therefore, he



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states that affidavit dated 14.11.2019 was submitted shortly thereafter wherein the appellant categorically stated that the counter statement was not received under e-mail of 08.11.2017. By referring to paragraph 2 of the affidavit, he states that the appellant had enclosed copies of all e-mails received between 07.11.2019 and 09.11.2019. Without dealing with or discussing these aspects, he states that the first respondent refused to accept the explanation set out in the affidavit. He further submits that the appellant would be in a position to file evidence in support of the opposition within two weeks from today. He seeks a remand of the matter.

4. In response, learned counsel for the second respondent states that the affidavit was affirmed by an office assistant in the office of the agent of the appellant. She also submits that the affidavit is bereft of material particulars and the appellant should not be permitted to circumvent the requirements of Rule 45 of the TM Rules.



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5. Rule 45 of the TM Rules reads as under:

"45. Evidence in support of opposition.- (1) *Within two months from service of a copy of the counter statement, the opponent shall either leave with the Registrar, such evidence by way of affidavit as he may desire to adduce in support of his opposition or shall intimate to the Registrar and to the applicant in writing that he does not desire to adduce evidence in support of his opposition but intends to rely on the facts stated in the notice of opposition. He shall deliver to the applicant copies of any evidence including exhibits, if any, that he leaves with the Registrar under this sub-rule and intimate the Registrar in writing of such delivery.*

(2) *If an opponent takes no action under sub-rule (1) within the time mentioned therein, he shall be deemed to have abandoned his opposition."*

6. Under sub-rule (1), the opponent is required to do one of the following within two months from the date of service of a copy of the counter statement:

(i) Leave with the Registrar evidence by way of affidavit in support of the opposition.

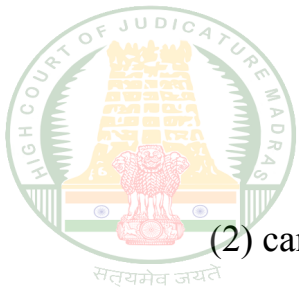
(ii) Inform the Registrar and the applicant that no evidence would be



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adduced in support of the opposition and that the opponent intends to rely on facts stated in the notice of opposition.

7. The legal fiction in sub-rule (2) is triggered only if an opponent fails to take action under sub-rule (1) within the time mentioned therein and, in such event, the opponent shall be deemed to have abandoned the opposition. As is evident from the preceding paragraph, the two options that the opponent may exercise are contingent on service of a copy of the counter statement. While Rule 18 of the TM Rules provides for deemed service at the time of sending the e-mail if such e-mail was sent to the e-mail ID provided by the party concerned, the said rule is intended to raise a presumption. In this case, shortly after being notified on 07.11.2019 that the application shall be treated as abandoned on account of the appellant / opponent not filing evidence in support of the opposition, the appellant responded by filing affidavit dated 14.11.2019. Paragraph 2 of the affidavit contains a categorical assertion that the counter statement was not received. Since receipt of the counter statement is a condition precedent to trigger the actions specified in sub-rule (1) of Rule 45, the legal fiction under sub-rule



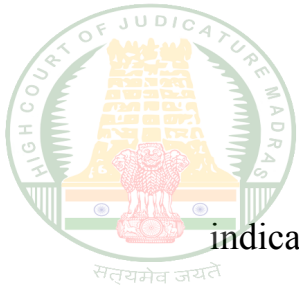
(2) cannot be pressed into service in light of the affidavit of the appellant.

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8. The order impugned herein does not deal with or discuss the reasons set out in the appellant's affidavit. As a consequence, the opposition was deemed to be abandoned and the application was allowed. For reasons set out in this and earlier paragraphs, this order cannot be sustained.

9. The impugned order is dated 24.02.2020 and the second respondent's mark has been on the register for about five years. In these circumstances, it is not just or equitable to cancel such registration at this juncture. The first respondent is empowered to rectify the register under the Trade Marks Act, 1999. Therefore, the ends of justice would be served if the matter is remanded for re-consideration. In case the first respondent concludes that the opposition is sustainable, the Register of Trade Marks shall be rectified. Otherwise, the registration shall stand.

10. (T)CMA(TM)/101/2023 is disposed of by setting aside the order dated 24.02.2020 and remanding the matter for re-consideration on terms



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indicated above. The appellant shall file evidence, if any, in support of the opposition within **two weeks** from the date a web copy of this order is uploaded. No costs.

19.06.2025

rna

Index : Yes / No

Internet : Yes / No

Neutral Citation: Yes / No

To

The Assistant Registrar of Trade Marks,
Trade Marks Registry, IPR Building,
Industrial Estate, GST Road, Guindy,
Chennai 600 032.

SENTHILKUMAR RAMAMOORTHY,J



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