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W.P.No.5703 of 2016

IN THE HIGH COURT OF JUDICATURE AT MADRAS

DATED : 10.10.2025

CORAM

THE HONOURABLE MR.JUSTICE M.DHANDAPANI

W.P.No.5703 of 2016

Yokogawa Electric Corporation
A Corporation duly organized under the laws of Japan
9-32 Nakacho 2-chome
Musashino-shi, Tokyo 180, Japan
Represented by its Constituted Attorney -
MG Samridh Bhardwaj ... Petitioner

Vs.

1.Union of India,
Represented by its Secretary,
Department of Industrial Policy & Promotion,
Ministry of Industry and Commerce,
Government of India,
Udyog Bhavan,
New Delhi – 110 011.

2.The Deputy Registrar of Trade Marks,
Trade Marks Registry,
Boudhik Sampada Bhawan,
GST Road, Guindy,
Chennai – 600 032.

3.Centum Industries Pvt. Ltd.
233, KHB Industrial Area
Yelehanka New Town
Bangalore – 560 064.

... Respondents

Prayer:

Petition filed under Article 226 of the Constitution of India to



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issue a Writ of Certiorarified Mandamus calling for the papers and proceedings culminating in the order dated October 21, 2014 passed by the second respondent in the opposition under Interlocutory Petition No.MAS-784412 in Application No.1587782 and after considering the legality and propriety thereof quash the same and consequently take on record the additional evidence in support of opposition filed by the petitioners in the proceedings in opposition under No.MAS-784412.

For Petitioner : Mr.Rajkumar Jhabakh
For Respondents : Mr.D.Simon for R1 and R2
Mr.K.Gowtham Kumar for R3

O R D E R

The writ petition is filed praying for a writ of Certiorarified Mandamus calling for the papers and proceedings culminating in the order dated 21.10.2014 passed by the second respondent in the opposition under Interlocutory Petition No.MAS-784412 in Application No.1587782 and after considering the legality and propriety thereof quash the same and consequently take on record the additional evidence in support of opposition filed by the petitioners in the proceedings in opposition under No.MAS-784412.

2.The learned counsel appearing for the petitioner would submit



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that petitioner is a global solution provider in the field of Industrial

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Automation and Control, Test and Measurement etc., and the petitioner adopted the trademark CENTUM/ **CENTUM** and is being used worldwide. While so, the petitioner came to know that the third respondent filed an Application in Application No.1587782, for registration of the trademark in Class 09. Aggrieved by the same, the petitioner filed a Notice of Opposition dated 17.11.2011 before the Trade Marks Registry.

3.The learned counsel appearing for the petitioner would further submit that the Trade Marks Registry vide Official Letter No.TOP/3525 dated 07.12.2011 directed the third respondent to file a counter in this regard, which was served on the petitioner on 19.03.2012. Thereafter, petitioner was called upon to file evidence in support of opposition. While so, petitioner's attorneys vide Letter dated 18.05.2012 sought extension of time for a period of one month until 19.06.2012 for filing their response. Pursuant thereto, petitioner's attorneys requested for further extension of time until 19.09.2012 as petitioner's office is spread across several countries and the supportive documents/exhibits had to be collated from different sources.



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4.The learned counsel appearing for the petitioner would further submit that the petitioner thereafter proceeded to file an Interlocutory petition (hereinafter referred to as "IP") on 24.08.2012 along with appropriate fee for taking the affidavit on record, in support of opposition, a copy of which was also served on the third respondent. The IP filed by the petitioner was rejected by the second respondent vide impugned order dated 21.10.2014, the relevant portion of which is extracted below:

"I have considered the submissions of both the parties and have gone through the records. The Rule 50 evidence is a mandatory evidence which has to be filed on or before 3 months extended time after service of TM-6 along with TM-56. The Registrar has no power to extend the time limit, more particularly in cases of mandatory evidences. The Hon'ble IPAB has passed order vide Order No.120/2012 (OA/80 & 81/2009/TM/AMD) and 125/2012 stating that the Registrar has no power to extend time beyond three months in case of Rule 50 evidence and this Tribunal is a lower Court, the decision passed by the Hon'ble IPAB is binding on this lower Tribunal. Therefore, the evidence in support of opposition filed by way of Interlocutory Petition is not taken on record."



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5.The learned counsel appearing for the petitioner would further submit that though the impugned order was passed in the year 2014, the petitioner received a copy of the impugned order only in the year 2015 and thereafter the writ petition was filed in the year 2015. The learned counsel would further submit that the very issue as to whether the second respondent has discretion to condone the delay beyond a period of one month came up for consideration before the Gujarat High Court in the case of **Wyeth Holding Corporation vs. Controller General of Patents, Designs & Trade** reported in **2006 SCC Online Guj 620**, wherein it was stated that condoning delay is only directory and not mandatory. Hence, the learned counsel apparently prayed for appropriate orders.

6.Per contra, the learned counsel appearing for the respondents 1 and 2 would submit that the issue that arises for consideration in this writ petition is whether Rule 45 and 50 of the Trade Marks Rules is directory or mandatory and that the same issue came up for consideration before various High Courts and finally before the Delhi High Court in the case of **Ms.Aman Engineering Works vs.**



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Registrar Trade Marks, Trade Marks Registry, New Delhi and

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another reported in **(2022/DHC/004701)**, wherein the Delhi High Court following the decisions of various High Courts held that the second respondent does not have the discretion to condone the delay beyond a period of one month. Accordingly, the learned counsel prayed for dismissal of the writ petition.

7. Heard both sides and perused the materials available on record.

8. Before advertng to the contentions advanced, it would be useful to refer to the decisions of the Gujarat High Court and Delhi High Court, which have been relied upon by the parties.

9. In the case of **Wyeth Holdings Corpn.** (cited *supra*), the Gujarat High Court held that the period is directory, the relevant portions of the order is extracted hereunder:

*"40. The Gujarat High Court in **Wyeth Holdings Corpn. And Anr. v. Controller General of Patents, Designs & Trade Marks, (2006 SCC Online Guj 620)**, however, observed that in view of the time having been*



prescribed in the Rules, which are subordinate legislation following **Salem Advocate Bar Association, Tamil Nadu v. Union of India, (2006) 2 GLR 1312**, the word 'shall' would be construed as being directory. The relevant portion of the said judgment in **Wyeth Holdings (supra)** is set out below:

"34. The learned senior counsel for the petitioners submitted that if at all the Legislature wanted to prescribe the time limit in sub-rule (2) of Rule 50 for filing of evidence in support of opposition, it could have incorporated the same in sub-section (4) of Section 21 of the Act. He submitted that the fact that the Legislature prescribed time limit for filing of opposition to the registration in sub-section (1) of Section 21 and prescribed time limit for filing the counter statement to such opposition in sub-section (3) of Section 21, there was no earthly reason for the Legislature not to prescribe a time limit and the consequences of nonobservance of such time limit for filing of the evidence in support of opposition.

35. The learned senior counsel for the petitioners submitted that the fact that in sub section (4) of Section 21 the Legislature left the matter of filing of evidence in support of opposition to be regulated by the Rules and to be implemented by the Registrar, the only inference which can be drawn in that the Legislature never wanted to put the filing of evidence on the same pedestal that of the filing of opposition to the registration. The learned senior counsel submitted that the Legislature drew specific distinction between 'filing of opposition to the registration and filing of evidence in support of registration. He further submitted that the distinction drawn between the two is intelligible. He submitted that having felt that 'filing of opposition is a substantive right, the Legislature deliberately and



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being conscious of the fact that it is a substantive right, included it in the Act itself and provided the time limit for the same in the same sub-section, i.e. (1) of Section 21. He submitted that as against, filing of evidence in support of opposition was felt to be more a procedural thing and, therefore, the same was left to be regulated by the Rules on the subject. The learned senior counsel for the petitioner submitted that while giving power to frame Rules under Section 157, the Legislature specifically provided the matter of filing of evidence in support of opposition in Clause (vii) of sub-section (2) of Section 157. Not only that, in Clause (vii) also, sub section (4) of Section 21 is specifically referred to. He submitted that, that being so, the Rule making authority has, though not specifically made it clear that sub-rule (2) of Rule 50 will be directory in nature, it has to be construed as 'directory in nature so as to see that it remains inconsonance with the intention of the Legislature expressed by Section 131 of the Act. He submitted that if at all sub-rule (2) of Rule 50 is to be read as 'mandatory', it will directly offend Section 131 of the Act and in that event, the Court will have to declare sub-rule (2) of Rule 50 as ultra virus the Act. In the alternative, being a piece of subordinate legislation to see that it does not exceed the scope of the main legislation, applying the principles of harmonious construction, it should be construed as directory. In this regard, the learned senior counsel relied upon various decisions of this Court as well as the Hon'ble the Apex Court"

36. The learned senior counsel for the petitioners relied upon a decision of the Hon'ble the Apex Court in the matter of Salem Advocate Bar Association, Tamil Nadu v. Union of India, (2006) 2 GLR 1312. The learned senior counsel emphasized upon head note 'H', relevant part of it reads as under:

"The use of the word 'shall' in Order 8, Rule 1 by itself is not conclusive to determine whether the provision is mandatory or directory. The Court to



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ascertain the object which is required to be served by this provision and its design and context in which it is enacted. The use of word 'shall' is ordinarily indicative of mandatory nature of the provision, but having regard to the context in which it is used or having regard to the intention of the legislation, the same can be construed as directory."

10. In the case of **Ms.Aman Engineering Works** (cited *supra*), the Delhi High Court held that the period is mandatory, and held as under:

"41. Two Id. Single Judges of this Court had an occasion to consider Rule 50 of the 2002 Rules.

*42. In **Sunrider Corporation, U.S.A. v. Hindustan Lever Limited & Anr., (2007 SCC OnLine Del 1018)**, the Id. Single Judge holds that Rule 50 of the 2002 Rules has been validly framed, which should be treated as part of the Act following the decision of the Supreme Court in **Chief Forest Conservator (Wildlife) v. Nisar Khan, (2003) 4 SCC 595**. The Court then went on to observe that Rule 50 of the Rules is mandatory in nature. The relevant portion is set out below:*

"21. In Ramachandra (supra), the Supreme Court observed that in Taylor v. Taylor, 1875 (1) Ch D 426, Jessel M.R. adopted the rule that where a power is given to do a certain thing in a certain way, the thing must be done in that way or not at all and that other methods of performance are necessarily forbidden. The Supreme Court further observed that this rule had stood the test of time. In that very case [Ramachandra (supra)], the Supreme Court placing reliance on Craies on Statute Law, 7th Edn. observed that with regard to the question as to whether a provision was mandatory or directory, no uniform rule could be laid down as to whether mandatory enactments should be considered directory only or obligatory with an implied nullification for disobedience. The Supreme Court



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further observed that it is the duty of Courts of justice to try to get at the real intention of the Legislature by carefully attending to the whole scope. Such intention of the Legislature is, therefore, to be ascertained upon a review of the language, subject-matter and importance of the provision in relation to the general object intended to be secured, the mischief, if any, to be prevented and the remedy to be promoted by the Act. Considering the provisions and making a comparative study of the old and the new Act as well as the old and the new rules, it is more than clear that specific words have been introduced in the new provisions and/or removed from the old provisions. **Such additions and deletions are significant and bring out the true intention of the Legislature. For instance, Rule 53 of the 1959 Rules did not prescribe any maximum period of extension of time. Whereas Rule 50 of the 2002 Rules specifically provides for extension of time not exceeding one month in the aggregate. This introduces a clear stipulation that the Registrar's powers to grant extension of time are limited to one month in the aggregate beyond the two months prescribed under the said Rule. This limitation was not there in the earlier Rule, but it is definitely there in Rule 50 of the 2002 Rules. The second instance is that the words 'unless the Registrar directs' have been consciously deleted from Sub-rule (2) of Rule 53 in its new incarnation in Rule 50(2). It is obvious that the Legislature wanted to make the provision mandatory and did not want to give any discretion to the Registrar in this connection. The object is apparent that the delays be cut down in deciding the application for registration of a trade"**

43. In Sunrider Corporation (supra), the Court also observed that Rule 50 of the 2002 Rules uses the words "within such a further period not exceeding one month in the aggregate thereafter as the Registrar may on request allow." The inclusion of the word – "aggregate" in Rule 50 (1) and removal of the requirement – "unless the Registrar otherwise directs" under Rule 50(2) of the 2002 Rules, which otherwise existed in Rule 53(2) of the 1959



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Rules, shows that the time period is mandatory. This decision has also been followed recently by another coordinate Bench of this Court in **Mahesh Gupta v. Registrar of Trademarks & Anr., 2023 SCC OnLine Del 1324** where the Court holds as under:

"13. With greatest respect, I am unable to subscribe to the view expressed by the High Court of Gujarat in *Wyeth*.

14. To my mind, the view espoused in para 60 of the decision in *Wyeths*, if accepted, would amount to no less than re-writing of the applicable statutory provisions. Rule 50(1) of the 2002 Rules is even more peremptory, in its application, than Rule 48 of the succeeding 2017 Rules. **While providing a period of two months to an opponent opposing an application seeking registration of a trade mark file its evidence after receipt of the counter-statement of the applicant, Rule 50(1) empowers the Registrar to extend the said period only upto one month, specifically using the words "not exceeding one month". The words "not exceeding one month" are mandatory in their import. The learned Registrar could not, therefore, grant extension of more than one month beyond the period of two months from the date of service, on the opponent opposing the registration of a mark, of a copy of the counter statement.** Grant of any further extension would clearly be in the teeth of Rule 50(1).

15. **Rule 50(2) is even clearer in its import. It states, in unambiguous terms, that, if the opponent took no action under Rule 50 (1) within the time period mentioned therein - meaning two months extendable by a maximum period of one month - he shall be deemed to have abandoned his opposition.**

16. Deemed abandonment of the opposition, therefore, follows as an inexorable statutory sequitur to the failure, on the part of the opponent, in filing the evidence in support of the opposition within the



period envisaged in Rule 50(1). **Deemed abandonment, therefore, occurs by operation of the statute.** Even sans any judicial or quasi-judicial order, therefore, if the opponent opposing the application seeking grant of the trade mark fails to file its evidence in support of the opposition within a maximum of three months from the receipt, by it, of the counter- statement of the trade mark applicant, the opposition would ipso facto be deemed to be abandoned irrespective of whether any order to that effect is, or is not, passed by any judicial or quasi-judicial forum.

17. The view expressed in *Wyeth*, if accepted, would amount to rendering largely otiose Rule 50(2) of the 2002 Rules. With respect, therefore, it is not possible to accept the said view.

18. Ms. Rajeshwari also sought to place reliance on Rule 105 of the 2002 Rules read with Section 131 of the 1999 Act.

19. Though these provisions have been considered by the coordinate Bench in *Sunrider*, Ms. Rajeshwari advances a submission which, according to her, was not advanced in *Sunrider* and was not, therefore, considered. She draws attention to the parenthesized words in Rule 105 (1) reading "not being a time expressly provided in the Act or prescribed by rule 79 or by sub-rule (4) of rule 80 or a time for the extension of which provision is made in the rules". According to Ms. Rajeshwari, the import of the afore-extracted parenthesized words in Rule 105(1) was to restrict the inflexibility of the provision only to cases where the time was provided in the Act or prescribed by Rule 79 or Rule 80(4).

20. **The submission is obviously unacceptable, as the parentheses also include the words "or a time for the extension of which provision is made in the rules", As already noted, Rule 50(1) provides for extension of time and curtails the maximum period by which such extension could be granted to one month. The provision for extension of time as**



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contained in Rule 50(1), therefore, rules out the applicability of Rule 105 to the facts of the present case.

21. On all other aspects, the coordinate Bench in *Sunrider*, having examined the issue in law in detail, this Bench does not deem it necessary to reinvent the wheel. I express my respectful concurrence with the views expressed in the passages from *Sunrider* extracted hereinabove which, unfortunately for the appellant, cover the case against it on all fours."

44. In the background of these decisions, this Court has to now consider the decision of IPAB in ***Sahil Kohli v. Registrar of Trade Mark and Anr., (2018 SCC OnLine IPAB 55)***. The IPAB's reasoning is that the Rules cannot travel beyond the Act. The IPAB further held that the absence of phrase "not exceeding onemonth in aggregate" distinguished Rule 50 of 2002 Rules with Rule 45 of the 2017 Rules. The observations of the IPAB are as under:

"53. In view of the changes made in Rule 45(1) of the Trade Marks Rules, 2017 and also in view of the discussion arising at points (f) to (j) mentioned in the preceding paragraphs relating to the interpretation of Rule 45 of the Trade Marks Rules, 2017, the judgment passed in case of *Sunrider Corporation v. Hindustan Lever Ltd. (supra.)* is clearly distinguishable and is not applicable in view of the changes made in the structure of Rule 45 which omits completely the entire aspect of the registrar discretion of granting the extension and the restrictions, which were imposed earlier in rule 50 of rules of 2002 upon the Registrar's power to extend the time period.

54. As seen above, **what weighed heavily before the Delhi High Court is the insertion of the wordings 'not exceeding one month in**



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aggregate thereafter' and omission of the words 'unless the Registrar otherwise directs' in the Rule 50 of the Trade Marks Rules, 2002 which curtailed the discretion of the Registrar to condone the time period by limiting it to one month in aggregate and on the other hand, now since the said discretion itself is removed from Rule 45 of the Trade Marks Rules, 2017, the Registrar by virtue of the provisions of Section 131 of the Trade Marks Act, 1999 will continue to have such discretion to condone the time period which is against the rule 45 of the Rule 2017. The registrar still enjoys discretion due to the reason that the registrars power to extend the time still flows from section 131 for the act 1999, for which there is no power to grant extension of the time in any manner are provided by the by the act not by the rules. The said power cannot require any reiteration in the rules though rules could have restricted those powers as done earlier in rule 50 by limiting the number of requests for extension of time to one month in aggregate.

55. But the altogether removal of the wordings relating to the extension of time from the Rule 45 will yield different results wherein one has to again revert to section 131 which is the parent provision which gives the room to the registrar to extend the time period. Therefore, by removal of the wordings from rule 45, the power of the registrar to grant extension of time in the matters of filing the evidence beyond two month time period cannot be taken away as the same would be contrary to section 131. The said section thus will continue to operate and the registrar will continue to have power to grant extension of time upon making of an application in a prescribed manner and prescribed fees upon furnishing of the sufficient cause.

56. In view of the changes made in the Rules and the language of the Rules including Rule 45, the interpretation rendered in the earlier Rule 50 of the Trade Marks Rules, 2002



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which restrictedly discretion of the Registrar to grant of extension of time only to one month period in aggregate is removed and consequently the applicability of the judgment of Sunrider Corporation (*supra.*) **under the new Rules the extension of power has been extinguished or have lost its significance, in view of the change in the language of the newly framed Rule 45 of the Trade Marks Rules, 2017.**

57. The above analysis clearly suggests that the provisions of Section 131 of the Trade Marks Act, 1999 would continue to apply to any time period for doing any act, as the time period is not provided under the Act or rule. **Any other interpretation to Rule 45(1) and (2) would make the operation of the Rule 45 of the Trade Marks Rules, 2017 as completely inflexible and any extension would attract the violation of the express provisions of the Act, which is Section 131 of the Trade Marks Act, 1999."**

45. A reading of all the above decisions along with the discussion above, shows that the Gujarat High Court in **Wyeth Holdings Corp (*supra*)** held in the context of the 2002 Rules that the time period is directory following **Salem Advocate Bar Association (*supra*)**. The IPAB in **Sahil Kohli (*supra*)** held that the time period is directory under Rule 45 of the 2017 Rules. Further, two coordinate Benches of this Court in **Sunrider Corporation (*supra*)** and **Mahesh Gupta (*supra*)** held that the time prescribed in Rule 50 of the 2002 Rules is mandatory.

46. In the opinion of this Court, use of the term "one month aggregate" in Rule 50 of the 2002 Rules and removal of discretion "unless the Registrar otherwise directs," in Rule 50(2) of the said Rules clearly points to the time limit prescribed as being mandatory. This position would not be different in the 2017 Rules, inasmuch as even if the one month extension period has been deleted from the said Rules, the discretion with the Registrar also continues to be deleted.



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47. *The sum and substance of the above discussion is that upon the counter statement being received by the Opponent from the **Registrar**, the two months' period **for filing evidence** begins to run. The **evidence has to be directly served by the Opponent upon the Applicant and** need not be served by the Registrar. If the evidence is not filed within the **prescribed** period, the opposition would be deemed to have been abandoned as the Registrar has no discretion either under Rule 50 of the 2002 Rules or Rule 45 of the 2017 Rules or Rules 101 and 109 of the 2002 Rules and the 2017 Rules respectively, to extend the time period.*

48. *This interpretation is also in line with the stand of the Trade Marks Registry i.e., to have strict timelines for opposition proceedings so that the Opponents cannot unduly and infinitely delay the processing of trade mark applications towards registration."*

(emphasis supplied)

11. This Court perused the decisions of the Gujarat High Court and the Delhi High Court and is in respectful agreement with the views expressed by the Delhi High Court as in the said decision, the Delhi High Court elaborately considered the issue in relation to Rule 50 of the Trade Mark Rules and arrived at a conclusion that if evidence is not filed within a period of 2 months, the power of the Registrar is only to extend the said period by a further period of one month viz., in aggregate under Rule 50 of the 2002 Rules or under Rule 45 of the 2017 Rules. The judgment of the Delhi High Court is in line with the



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