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* **IN THE HIGH COURT OF DELHI AT NEW DELHI**

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Date of decision: 02nd April, 2025

+ C.A.(COMM.IPD-TM) 88/2024 & I.A. 49485/2024, I.A. 8631/2025

MARS INCORPORATED

.....Appellant

Through: Mr. Pravin Anand, Ms. Vaishali Mittal & Mr. Shivang Sharma, Advocates.

versus

THE REGISTRAR OF TRADEMARKS
& ORS.

.....Respondents

Through: Ms. Nidhi Raman, CGSC with Mr. Debashish Mishra & Mr. Arnav Mittal, Advocates for R-1.
Ms. Nancy Roy, Ms. Aastha Kakkar & Ms. Nida Khanam, Advocates for R-2.
Ms. Archita Gharat, Ms. Shruti Munjal, Mr. Karan Gaba & Mr. Shreem Pathak, Advocates for R-3.**CORAM:**
HON'BLE MR. JUSTICE AMIT BANSAL**AMIT BANSAL, J. (Oral)****I.A. 8631/2025 (seeking condonation of delay in filing reply on behalf of respondent no.3)**

1. The present application has been filed on behalf of respondent no.3 seeking condonation of delay of 28 days in filing short affidavit in reply on behalf of respondent no.3.
2. For the reason stated in the application and taking into account the



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period of delay involved, the application is allowed and the delay in filing short affidavit in reply on behalf of respondent no.3 is condoned.

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3. The present appeal has been filed under Section 91 of the Trade Marks Act, 1999 challenging the order dated 25th October, 2024 (hereinafter the 'impugned order'), passed by the Deputy Registrar of Trade Marks whereby the Review Petition filed by the appellant dated 5th September, 2023 has been dismissed and the order dated 20th July, 2023 abandoning the appellant's mark in opposition proceedings has been upheld.

4. Notice in the present appeal was issued on 23rd December, 2024. On the same date, notice was accepted in Court by the counsel appearing on behalf of respondents no. 1 and 2 and notice was issued to respondent no.3.

5. A short affidavit-in-reply has been filed on behalf of respondent no.3, on 28th March, 2025.

6. The brief facts leading to the present appeal are as follows:-

7. The appellant, Mars Incorporated, is a company organised and existing under the laws of United States of America. The appellant is a multinational company engaged in creating products in mainly five categories, including chocolate and confectionary, snack foods, main meal, drinks and pet care. It is stated that the appellant's products are sold in over hundred countries throughout five continents.

8. It is stated that the appellant is the proprietor of multiple reputed marks including GALAXY, JEWELS, IAMS, M&M's, PEDIGREE, WHISKAS, MILKY WAY, BOUNTY, MARS, TWIX, SNICKERS, etc.

9. The present petition pertains to registration of the mark



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under application no. 4083355 in Class 30, which was filed on 11th February 2019.

10. The said mark was duly published in Trade Marks Journal No. 2017 on 13th September 2021, inviting opposition from the public and other interested parties.

11. Pursuant to this, respondent no.2 filed a Notice of Opposition bearing No.1141655, and respondent no.3 filed a Notice of Opposition bearing No. 1141733 against the appellant's trademark application.

12. Subsequently, on 7th March 2022, the Registrar of Trade Marks purportedly served the Notices of Opposition to the appellant, *vide* despatch no.5527006 for the opposition filed by respondent no.2, and *vide* despatch no.5527087 for the opposition filed by respondent no.3.

13. On 6th February 2023, the Trade Marks Registry issued a public notice through Journal No. 2090 whereby a number of applications, including the appellant's application, were "*deemed to have been abandoned*" for failure to file a counter-statement in accordance with Section 21(2) of the Trade Marks Act, 1999 (hereinafter the 'Act').

14. Upon discovering the inclusion of its trademark application in the abandonment list, the appellant, on 6th March 2023, submitted a representation to the Trade Marks Registry, asserting that the abandonment was erroneous. The representation was supported by affidavits of relevant personnel, confirming non-receipt of the Notice of Opposition *via* email, post, or courier. The appellant stated that the abandonment was erroneous,



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as the statutory period for filing a counterstatement had not commenced due to the absence of effective service of the Notices of Opposition on the appellant.

15. Being aggrieved by the issuance of the Public Notices and the subsequent Fresh Notices by the Controller General of Patents, Designs & Trade Marks, a Writ Petition titled ***Intellectual Property Attorneys Association (IPAA) & Anr. v. Controller General of Patents Designs & Trade Marks (CGPDTM) & Anr.***, bearing W.P.(C)-IPD 21/2023 was instituted before this Court.

16. During the hearing of the said Writ Petition on 13th April, 2023, the respondent voluntarily undertook to withdraw the impugned Public Notices and Fresh Notices and to revert all the applications to their original status.

17. In compliance with the said directions, the respondent issued a Public Notice dated 21st April, 2023, formally withdrawing both the Public Notices and Fresh Notices, and restoring the status of all abandoned trademark applications and pending opposition proceedings to their original state, as they stood prior to the issuance of the said notices.

18. However, despite such explicit withdrawal and restoration, the appellant's trademark application was marked as '*abandoned*' on 20th July, 2023 under Section 21(2) of the Act. It is stated that the Trade Marks Registry issued abandonment orders on 20th July 2023 without considering the reply/grievance submitted by the appellant.

19. Being aggrieved by the aforesaid orders of the Trade Marks Registry, the appellant filed a review petition on 4th September 2023 (registered on 5th September 2023), seeking reconsideration of the specific facts of the case, a review of the decision rendered by the Trade Marks Registry, and



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reinstatement of the application by rectifying its status to “Opposed” to allow the filing of a counter-statement.

20. The said review petition was dismissed by the Registrar *vide* the Impugned Order on 25th October 2024, leading to the filing of the present appeal.

21. Mr. Pravin Anand, counsel appearing on behalf of the appellant, submits that the impugned order is flawed as the appellant did not receive the Notice of Opposition. In support of his submission, Mr. Anand has drawn attention to the two affidavits filed on behalf of the appellant, stating that neither any e-mail nor any other form of communication was received by the appellant’s advocates/ agents, effecting service of the notice of opposition.

21.1. Reliance is also placed on the judgments of the Co-ordinate Bench of this Court in *Rishabh Jain v. Registrar of Trade Marks*¹, *Purushottam Singhal v. Registrar of Trade Marks*², and *Samsudeen A v. Registrar of Trade Marks*³.

22. Ms. Nidhi Raman, CGSC appearing on behalf of respondent no.1 submits on instructions, that respondent no.1, i.e. Trademark Registry, did not receive any acknowledgement of the e-mail sent to the appellant, enclosing the notice of opposition.

23. In the affidavit filed on behalf of respondent no.3, the respondent no.3 has deposed that the present appeal is liable to be dismissed as the Notice of Opposition was duly served to the appellant at the email address provided in the trademark application. Further, the Trade Marks Registry’s records also

¹ 2023 SCC OnLine Del 7990

² 2023 SCC OnLine Del 1641

³ 2024 SCC OnLine Mad 6309



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confirm that the correspondence was sent to both the appellant and its agent, with no email delivery failure. The respondent has asserted that since the appellant failed to file a counter-statement within the prescribed period, the appellant's application was rightly deemed abandoned.

24. I have heard counsel for the parties and examined the record.

25. The respondent has marked the trade mark application of the appellant as '*abandoned*' on 20th July, 2023 under Section 21(2) of the Act. For the sake of convenience, Section 21 (2) of the Act is set out below:

"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."

26. A reading of the aforesaid section 21(2) of the Act would show that upon receipt of a Notice of Opposition, the Registrar is required to effect service of the same upon the applicant for registration. Further, an applicant is required to submit their counter-statement within two months from the receipt of such Notice of Opposition, as non-compliance with this timeline would result in the application being deemed abandoned.

27. Rule 18 of the Trade Marks Rules, 2017 (hereinafter the 'Trade Marks Rules') deals with the service of documents by the Registrar in relation to trademark applications. For ease of reference, Rule 18 of the Trade Marks Rules is given below:

"18. Service of Documents by the Registrar. — (1) All communications and documents in relation to application or opposition matter or registered trademark may be served by the Registrar by leaving them at, or sending them by post to the address for service of the party concerned



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or by email communication.

(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 email.

(3) To prove such service, it shall be sufficient to prove that the letter was properly addressed and put into the post or the email communication was sent to the email id provided by the party concerned.”

[Emphasis is mine]

28. The aforesaid rule prescribes that the service of the Notice of Opposition shall be deemed complete at the time when the document would ordinarily be delivered by post or at the moment the email is sent.

29. A perusal of the aforesaid provisions would show that the provisions create ambiguity and procedural inconsistency, particularly regarding the commencement of the time period for filing a counter-statement. Section 21(2) of the Act, provides that the applicant must file a counter-statement within two months from the date of receipt of the Notice of Opposition. However, Rule 18(2) of the Trade Marks Rules deems service to be complete at the time of sending the e-mail, which creates ambiguity regarding the commencement of the time period.

30. In a case involving similar facts as the present one, the High Court of Madras in *Samsudeen A* (supra), observed that Rule 18 (2) of the Trade Marks Rules shall be purposively interpreted to align the Rule with the legislative intent and safeguard the rights of applicants. Holding the aforesaid, the Bench in the High Court of Madras, permitted the appellant therein to file a counter-statement and directed the Registrar to consider the opposition petition on merits.

31. I am in agreement with the reasoning adopted by the Madras High Court. In my view, a literal interpretation of Rule 18 (2) of the Trade Marks



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Rules would not be in consonance with Section 21(2) of the Act, which explicitly states that the time for filing a counter-statement begins from the date of receipt of the Notice of Opposition.

32. In ***Rishabh Jain*** (supra), a similar controversy came before the Coordinate Bench of this Court where the question arose whether or not the Notice of Opposition filed under Section 21 of the Act read with Rule 42 of the Trade Mark Rules was served upon the petitioner. The petitioner therein contended that the email address on which the Notice of Opposition was served was not correct. After examining the records of the case, the Coordinate Bench came to the finding that the petitioner had not received the opposition at the e-mail address specified in the Form filed with the opposition. In view thereof, the impugned order therein was set aside and the appeal was allowed.

33. Similarly, in ***Purushottam Singhal*** (supra), the case of the appellant therein was that neither the appellant nor any of his authorized representatives were served with the Notice of Opposition, in terms of Section 21(2) of the Act. Once again, after examining the case of the opposition, the Court came to the conclusion that there was no proof of service of the Notice of Opposition on the appellant and the impugned order was set aside.

34. The ratio of the aforesaid judgments is squarely applicable in the facts and circumstances of the present case.

35. As noted above, the appellant has filed the affidavits of the concerned personnel deposing to the non-receipt of the Notice of Opposition which further substantiates the claim of the appellant.

36. It was contended on behalf of the appellant that the aforesaid



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affidavits were not considered by the Registrar while passing of the impugned order. The relevant extract of the impugned order passed by the Registrar is set out below:

“On verification of records, it is found that in the instant application, two oppositions under Nos. 1141733 & 1141655 in Class 30 were filed on 05.01.2022 by the Opponents Cadbury UK Limited & CELEBRATION respectively. On perusal of the email records of this office, it is found that the Notice of Opposition was served on 05.01.2022 under Opposition No. 1141733 & 1141655 with the corresponding acknowledgment mail along with the NOP was got served to the Opponent on his registered email address i.e legal@atbhagatandco.com, & trademarks@indiaip.com on 07/03/2022 AND the Notice of Oppositions under No. 1141733 & 1141655 was served to the Applicant in his email id trademark@anandandanand.com on 07/03/2022 as well with email sent success report and when the stipulated time for filing the Counter Statement under Opposition 1141733 & 1141655 was available, BUT The Applicant failed to file the Counter statement on time.”

[Emphasis is mine]

37. A perusal of the aforesaid extract of the impugned order shows that while the Registrar has noted that there was acknowledgement of the successful service of Notice of Opposition to the Opponent, the service to the appellant is only substantiated by an email success report. There is no such finding in the impugned order with respect to receiving an acknowledgement in respect of service of Notice of Opposition to the appellant. This creates a doubt about whether the service was effected on the appellant.

38. On the basis of the record, I am satisfied that the appellant has been able to show that the Notice of Opposition was neither served on the appellant nor on the agent of the appellant, either by e-mail or any other mode of communication.



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39. In view thereof, the impugned order dated 25th October, 2024 is set aside and the matter is remanded back to the Trademark Registry.
40. The Notice of Opposition shall be served by the Trade Marks Registry afresh, to the counsel for the appellant, within two (2) weeks.
41. The appellant shall file a reply to the Notice of Opposition, as per the prescribed statutory time limit.
42. Accordingly, the appeal is disposed of in the aforesaid terms.
43. The Registry of this Court is directed to supply a copy of the present order to the Office of the Controller General of Patents, Designs and Trade Marks on e-mail ID - llc-ipo@gov.in, for compliance.

AMIT BANSAL, J

APRIL 2, 2025

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