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

% Judgment delivered on: 31.07.2025

\+ **C.A.(COMM.IPD-TM) 76/2022**

TABLETS (INDIA) LIMITED REPRESENTED BY ITS AUTHORIZED SIGNATORY
MR. T. SATHISH .....Appellant

versus

M/S. SPEY MEDICALS PRIVATE LIMITED & THE REGISTRAR OF TRADEMARKS (NEW DELHI) .....Respondents

Advocates who appeared in this case

For the Appellant : Mr. Mayank Bughani, Advocate.

For the Respondent : Ms. Radhika Bishwajit Dubey, CGSC with Ms. Gurleen Kaur Waraich, Mr. Kritarth Upadhyay & Mr. Vivek Sharma, Advocates for R-2.

CORAM:
HON'BLE MR. JUSTICE TEJAS KARIA

JUDGMENT

TEJAS KARIA, J

1. The present Appeal has been filed against the Order dated 22.05.2018 ("**Impugned Order**") passed by Respondent No. 2 in Opposition No. MAS-868102 filed by the Appellant against the Application No. 2466657 bearing Trade Mark "CEOFSPEY" ("**Impugned Trade Mark**").

FACTUAL BACKGROUND

2. The Appellant claims to be the proprietor of the Trade Mark "CEOF", bearing Application No. 2206900 in Class 5 in respect of Medical and Pharmaceutical preparations ("**Appellant's Trade Mark**"). The Appellant

has been using the Appellant's Trade Mark continuously and uninterruptedly since December 2011. It is submitted by the Appellant that the Appellant's Trade Mark is exclusive and associated only with the Appellant and has gained substantial popularity and goodwill in the market. The Appellant's Trade Mark is associated in the market solely with the Appellant.

3. Respondent No. 1 applied for the Impugned Trade Mark under Class 5 in respect of Medicinal and Pharmaceutical preparations on a proposed to be used basis. The Impugned Trade Mark has simply copied the prefix of the Appellant's Trade Mark by adding the word "SPEY", which does not in any way confer any distinctiveness, as the prefix gains importance in Trade Marks and the Impugned Trade Mark is only an extension and a copycat of the Appellant's Trade Mark.

4. The Impugned Trade Mark was advertised in Journal No. 1768 on 24.10.2016. The Appellant filed its Opposition before Respondent No. 2. The Respondent No. 2 issued a notice on the Appellant's Opposition on 22.06.2017, directing Respondent No. 1 to file its Counter Statement within two months. On 30.08.2017, the Counter Statement to the Appellant's opposition was filed by Respondent No. 1, after the expiry of a period of two months. However, the said Counter Statement filed by Respondent No. 1 was never served upon the Appellant. Consequently, the Appellant was deprived of the right to file its Evidence.

5. On 19.04.2018, Respondent No. 2 issued a notice of hearing fixed for 04.05.2018. When the Appellant was notified about the date of hearing, the Appellant filed its Written Arguments on 30.04.2018 in support of its Opposition before Respondent No. 2, categorically pointing out that the Appellant had been deprived of the right to file its Evidence, as the Counter

Statement filed by Respondent No. 1 was not served upon the Appellant, who came to know about the filing of the Counter Statement only when it received the notice of hearing. The Appellant, accordingly, requested Respondent No. 2 to consider the submissions made in the Written Arguments.

6. However, *vide* the Impugned Order, Respondent No. 2 disposed of the Opposition filed by the Appellant as deemed to have been abandoned on account of non-filing of the evidence, without considering the Written Arguments filed by the Appellant.

7. Being aggrieved by the Impugned Order, the Appellant has filed the present Appeal.

SUBMISSIONS ON BEHALF OF THE APPELLANT

8. Mr. Mayank Bughani, the learned Counsel for the Appellant has submitted that the Appellant had filed the Opposition against the Application No. 2466657 for the Impugned Trade Mark filed by Respondent No. 1 on 08.11.2016. Respondent No. 2 issued a notice pursuant to Section 21(1) of the Trade Marks Act, 1999 ("**Act**") on 22.06.2017 to Respondent No. 1, informing that the Appellant had filed Opposition to the Application for registration of the Impugned Trade Mark. The said notice mentioned that in view of Section 21(2) of the Act and Rule 44 of the Trade Mark Rules, 2017 ("**Rules**"), the Counter Statement should be filed within two months from the receipt of the copy of the Opposition. The notice further directed that if the Counter Statement was not received within the prescribed period, the Application for the Impugned Trade Mark would be deemed to have been abandoned pursuant to Section 21(2) of the Act.

9. It was further submitted by the learned Counsel for the Appellant that the Counter Statement was filed on 30.08.2017 by Respondent No. 1, which is evident from the date mentioned on the Counter Statement. Accordingly, the Counter Statement was not filed within two months as stipulated under Section 21(2) of the Act. It was further submitted that the copy of the Counter Statement was never served upon the Appellant, as required under Section 21(3) of the Act. The Appellant came to know about the filing of the Counter Statement only when the notice dated 19.04.2018 was issued by Respondent No. 2 informing about the hearing scheduled on 04.05.2018 under Rule 45(2) of the Rules for not filing Evidence in support of the Opposition under Rule 45 of the Rules. The learned Counsel for the Appellant submitted that as the Counter Statement was not served upon the Appellant, it was deprived of its right to file Evidence in support of its Opposition. Accordingly, the Appellant filed Written Arguments on 30.04.2018 in support of the Opposition filed by the Appellant opposing the Impugned Trade Mark.

10. In the said Written Arguments, the Appellant provided detailed submissions in support of the Appellant's Opposition to the Impugned Trade Mark.

11. The learned Counsel for the Appellant has submitted that Section 21(4) of the Act provides that any evidence upon which the Appellant and Respondent No. 1 may rely shall be submitted in the prescribed manner and within the prescribed time to Respondent No. 2, and that Respondent No. 2 shall give an opportunity to them to be heard, if they so desire. In view of the same, the learned Counsel for the Appellant submitted that Section 21(4) of the Act uses the expression "may", which shows that it is not compulsory

for the Appellant to submit Evidence to Respondent No. 2 in support of the Opposition filed by it. The provision merely provides an option to the Appellant to submit its Evidence to Respondent No. 2 as the legislature has not used the expression "shall" for submitting any Evidence in support of the Opposition. Section 21(4) of the Act only gives an opportunity to submit any evidence which the opponent may rely upon in support of its opposition. Hence, it was not mandatory for the Appellant to submit any Evidence before Respondent No. 2.

12. The learned Counsel for the Appellant has further submitted that Respondent No. 2 has violated Rule 50(5) of the Rules, which provides that Respondent No. 2 shall consider the written arguments if submitted by a party to the proceedings. It was submitted that Rule 50(5) of the Rules does not make any distinction with regard to the written arguments being filed with or without submission of the Evidence in support of its opposition. It was further submitted that there is no discretion available with Respondent No. 2 as Rule 50(5) provides that Respondent No. 2 "shall" consider the written arguments, if submitted by a party to the proceedings.

13. Admittedly, despite the Written Arguments of the Appellant being on record, the same were not considered or dealt with in the Impugned Order, resulting in violation of Rule 50(5) of the Rules.

14. In view of the same, the learned Counsel for the Appellant prayed for setting aside of the Impugned Order and direction to Respondent No. 2 to consider the Written Arguments filed by the Appellant as mandated under Rule 50(5) of the Rules before passing any order on merits.

SUBMISSIONS ON BEHALF OF THE RESPONDENTS

15. *Vide* order dated 14.02.2024, Respondent No. 1 was proceeded *ex-*

parte as despite service, Respondent No. 1 had not entered appearance.

16. Ms. Radhika Bishwajit Dubey, the learned CGSC appearing for Respondent No. 2 submitted that the Counter Statement was served upon the Appellant. In support of the submission that the Counter Statement was served upon the Appellant, the learned CGSC has relied upon an e-mail dated 18.12.2017, a copy of which has been produced as Annexure-R2 along with Written Synopsis filed on behalf of Respondent No. 2.

17. The learned CGSC has also relied upon a copy of the Note Sheet annexed as Annexure-R1 with the Written Synopsis filed on behalf of Respondent No. 2, which states that the Counter Statement was served on 18.12.2017.

18. The learned CGSC further submitted that in accordance with Section 21(4) of the Act read with Rule 45(1) of the Rules, an opponent is required to file such evidence as the opponent may wish to rely upon, within a period of two months from the date of service of the counter statement. It was further submitted that as per Rule 45(1) of the Rules, it is provided that within two months from the service of the copy of the counter statement, the opponent shall either leave with Respondent No. 2 such evidence by way of affidavit as opponent may desire to adduce in support of its opposition or shall intimate to Respondent No. 2 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 the Opposition. Further Rule 45(2) of the Rules provides that if an opponent does not take action under Rule 45(1) of the Rules within the time mentioned therein, the opponent shall be deem to have abandoned its opposition.

19. It was submitted by the learned CGSC that it was mandatory upon the Appellant to either file the Evidence in support of its Opposition or intimate to the Respondents in writing that the Appellant did not desire to adduce Evidence. In view of no action being taken by the Appellant, the Opposition was deemed to have been abandoned in accordance with Rule 45(2) of the Rules.

20. The learned CGSC submitted that the legislative scheme of the Act and the Rules contemplates strict adherence to procedural timelines in the opposition proceedings. The object and purpose behind such timelines are to ensure expeditious disposal of the applications and to prevent inordinate delays in registration process. The learned CGSC has relied upon the decision of this Court in ***Sun Pharma Laboratories Ltd. Vs. Dabour India Ltd. & Anr.*** 2024 SCC OnLine DEL 813, which held as under:

> "*34. The scheme of the Trade Marks Act, 1999 is clearly to provide strict timelines for the purpose of opposition proceedings. Repeated extensions to delay the process of registration through extension of time limits can hold up grant of trade mark registrations for a substantial period of time. The legislative intent behind the prescribed timelines in the Act and the Rules is to ensure that the registration of trade marks is not unduly delayed and Opponents are not able to delay the registration of marks.*
> *35. If extension of time is granted for filing either pleadings or evidence in Opposition proceedings, without an outer deadline, the purpose of the Act and the Rules would be set at naught, inasmuch as the Opponents could indefinitely hold-up grant of registration of marks.*"

21. In view of the above the learned CGSC for Respondent No. 2 has submitted that there is no infirmity with the Impugned Order and the Appeal deserves to be dismissed.

ANALYSIS AND FINDINGS

22. In the facts of the present case, the following issues arise for the consideration:

i) Whether the Counter Statement was filed within the period of two months as per Section 21(2) of the Act?

ii) Whether the Counter Statement was served by Respondent No. 2?

iii) Whether it is mandatory for the Opponent to submit the Evidence in support of its Opposition? and

iv) Is it mandatory for Respondent No. 2 to consider the Written Arguments submitted by a Party prior to the hearing and decision irrespective of non-submission of the Evidence by that Party to the proceedings?

Whether the Counter Statement was filed within prescribed period

23. It is submitted by the Appellant the Counter Statement was filed beyond the period of two months as stipulated under Section 21(2) of the Act read with Rule 44 of the Rules. Section 21 of the Act provides as under:

> "***21. Opposition to registration.***—
> *(1) Any person may, within four months from the date of the advertisement or re-advertisement of an application for registration, give notice in writing in the prescribed manner and on payment of such fee as may be prescribed, to the Registrar, of opposition to the registration.*
> *(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 counterstatement 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.*

(3) If the applicant sends such counter-statement, the Registrar shall serve a copy thereof on the person giving notice of opposition.
(4) Any evidence upon which the opponent and the applicant may rely shall be submitted in the prescribed manner and within the prescribed time to the Registrar, and the Registrar shall give an opportunity to them to be heard, if they so desire.
(5) The Registrar shall, after hearing the parties, if so required, and considering the evidence, decide whether and subject to what conditions or limitations, if any, the registration is to be permitted, and may take into account a ground of objection whether relied upon by the opponent or not.
(6) Where a person giving notice of opposition or an applicant sending a counter-statement after receipt of a copy of such notice neither resides nor carries on business in India, the Registrar may require him to give security for the costs of proceedings before him, and in default of such security being duly given, may treat the opposition or application, as the case may be, as abandoned.
(7) The Registrar may, on request, permit correction of any error in, or any amendment of, a notice of opposition or a counter-statement on such terms as he thinks just."

24. Rule 44 of the Rules provides as under:

"***44. Counterstatement.***
(1) The counterstatement required by sub-section (2) of section 21 shall be sent on Form TM-O within two months from the receipt by the applicant of the copy of the notice of opposition from the Registrar and shall set out what facts, if any, alleged in the notice of opposition, are admitted by the applicant. A copy of the counterstatement shall be ordinarily served by the Registrar to the opponent within two months from the date of receipt of the same.
(2) The counterstatement shall be verified in the manner as provided in sub-rules (2), (3) and (4) of rule 43."

25. The Appellant had submitted its Opposition on 08.11.2016. Respondent No. 2 issued notice on 22.06.2017 to Respondent No. 1 directing to file Counter Statement within two months from the service of the notice containing the Appellant's Opposition. However, as per the record the Counter Statement is dated 30.08.2017. It is the contention of the

Appellant that the Counter Statement was filed beyond the period of two months stipulated under Section 21(2) of the Act read with Rule 44 of the Rules. It was further submitted that failure to file Counter Statement within the prescribed time would not permit the same to be taken on record by Respondent No. 2. It was submitted that the timelines prescribed in the Act and the Rules are mandatory and binding on the Parties.

26. It is settled law that if any timeline is prescribed in the Act or the Rules, the same is binding and mandatory in nature and Respondent No. 2 has no power to extend the same or condone the delay in complying with the same. This Court in the case of ***Surinder Corporation, U.S.A. v. Hindustan Lever Limited & Anr.*** 2007 SCC OnLine Del 1018, has observed that Rule 50 of the Trade Mark Rules, 2002, which is *pari materia* to Rule 45 of the Rules is mandatory in nature. The legislature consciously did not give the Registrar, the discretion to extend the timeline prescribed. This Court in the case of ***Mahesh Gupta v. Registrar of Trademarks and Another*** 2023 SCC OnLine Del 1324 relied on ***Surinder Corporation, U.S.A*** (*supra*) to find that Rule 50 of the Trade Mark Rules, 2002 is mandatory in nature. The law was reiterated in the case of the ***Sun Pharma Laboratories Ltd.*** (*supra*).

27. The Counter Statement had to be filed within two months from the date of service of the notice issued by Respondent No. 2, which is dated 22.06.2017. Since the Counter Statement is dated 30.08.2017, it shows that the Counter Statement was filed eight days after the expiry of two months from the date of the notice. There is nothing on record to show that when was the notice dated 22.06.2017 was received by Respondent No. 1. Given that the Counter Statement was filed eight days beyond the prescribed period of two months to file the same, it is safe to assume that it would have taken

around that much time for the notice dated 22.06.2017 to be served upon Respondent No. 1.

28. Interestingly, the objection with regard to non-filing of the Counter Statement within the prescribed period of two months as stipulated under Section 21(2) of the Act read with Rule 44(1) of the Rules is not taken in the Written Arguments dated 07.05.2018 filed by the Appellant before Respondent No. 2.

29. In view of the same, the objection with regard to not filing of the Counter Statement within the prescribed time is rejected.

Whether the Counter Statement was served upon the Appellant

30. The learned Counsel for the Appellant submitted that the Courter Statement was never served upon the Appellant. Hence, the consequence of abandonment under Rule 45 (2) of the Rules does not arise.

31. It was submitted that it was incumbent upon Respondent No. 2 to serve the Counter Statement upon the Appellant as per Section 21 (3) of the Act.

32. The learned CGSC has produced an e-mail dated 18.12.2017 at Annexure-R2 filed with Written Synopsis, which shows that the Counter Statement was served upon the Appellant. The said fact is also corroborated by the Note Sheet annexed as Annexure-R1 filed with the Written Synopsis, which states that the Counter Statement was served on 18.12.2017.

33. Surprisingly, the Written Arguments filed by the Appellant before Respondent No. 2 raises the objection with respect to non-service of the Counter Statement at the end. If the Counter Statement was not served in accordance with law, the same goes to the root of the matter and the objection about the same would have been taken as a preliminary objection.

In any case, there is no denial by the Appellant to the documents produced at Annexure R1 and Annexure R2 filed along with the Written Synopsis, which clearly show service of Counter Statement upon the Appellant.

34. In view of the same, the objection regarding non-service of the Counter Statement cannot be accepted.

Whether the submission of the Evidence by the Opponent is optional

35. It is submitted by the Appellant that under Section 21(4) of the Act submission of the evidence is not compulsory, but optional in view of the expression "may" in the said provision.

36. From the perusal of the provision, any evidence upon which the opponent may rely has to be submitted in the prescribed manner and within the prescribed time to Respondent No. 2 and Respondent No. 2 has to give an opportunity to the opponent to be heard, if the opponent so desires. As the provision mentions about prescribed manner and within prescribed time, the same is provided in Rule 45 of the Rules, which is reproduced as under:

> "***45. Evidence in support of opposition.***
> *(1) Within two months from service of a copy of the counterstatement, 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.*"

37. A conjoint reading of Section 21(4) of the Act and Rule 45 of the Rules shows that the manner prescribed for submission of evidence as contemplated under Section 21(4) of the Act is provided in Rule 45(1) of the Rules. The Rule 45(1) prescribes two options for the Appellant. First, if the Appellant wishes to submit evidence in support of its Opposition, it may do so within two months from the service of copy of the Counter Statement. Secondly, if the Appellant does not desire to adduce evidence in support of its Opposition, the Appellant has to intimate the Respondents in writing that the Appellant intends to rely on the facts stated in the notice of Opposition without adducing the Evidence in support of its Opposition. Further, Rule 45(2) provides that if the Appellant fails to take any action i.e., adducing the Evidence or intimating that it shall rely on the facts stated in the notice of Opposition, the Opposition shall be deemed to have been abandoned.

38. It is clear from the above that it is not compulsory for the Appellant to adduce Evidence in support of its Opposition. However, if the Appellant chooses not to adduce Evidence, it is incumbent upon the Appellant to intimate the Respondents that it does not desire to adduce Evidence and, instead, rely upon the facts stated in the notice of Opposition. As the Appellant has not taken either of the actions as contemplated under Rule 45(1) of the Rules, the deemed abandonment of the Opposition as provided in Rule 45(2) shall be effected in absence of any intimation to the Respondents by the Appellant. Hence, even though Section 21(4) of the Act mentions that the Appellant "may" rely upon any Evidence, the same has to be in the prescribed manner and within the prescribed time as stipulated in Rule 45(1) of the Rules.

39. Failure to comply with the manner and the timeline as prescribed under Rule 45(1) of the Rules, the consequences as contemplated under Rule 45(2) of the Rules shall be effective. Hence, it was not mandatory for the Appellant to adduce its Evidence, however, to intimate the Respondents about not adducing the Evidence was mandatory.

40. As the Appellant has failed to intimate under Rule 45 (1) of the Rules within prescribed time of 2 months, the consequence of abandonment of the Opposition under Rule 45 (2) shall follow.

Whether Consideration of Written Arguments mandatory under Rule 50 (5) of the Rules

41. It was submitted by the learned Counsel for the Appellant that when Respondent No. 2 had issued the notice for hearing and when the Appellant had submitted Written Arguments prior to the said hearing, it was mandatory for Respondent No. 2 to consider the Written Arguments submitted by the Appellant while deciding the Opposition, even though the Appellant had not adduced Evidence in support of its Opposition.

42. Rule 50 of the Rules provides as under:

> "***50. Hearing and decision.***
> *(1) The Registrar, after the closure of the evidence, shall give notice to the parties of the first date of hearing. The date of hearing shall be for a date at least one month after the date of the first notice.*
> *(2) A party to a proceeding may make a request for adjournment of the hearing with reasonable cause in Form TM-M accompanied by the prescribed fee, at least three days before the date of hearing and the Registrar, if he thinks fit to do so, and upon such terms as he may direct, may adjourn the hearing and intimate the parties accordingly:*
> *Provided that no party shall be given more than two adjournments and each adjournment shall not be for more than thirty days.*

(3) If the applicant is not present at the adjourned date of hearing and at the time mentioned in the notice, the application may be treated as abandoned.
(4) If the opponent is not present at the adjourned date of hearing and at time mentioned in the notice, the opposition may be dismissed for want of prosecution and the application may proceed to registration subject to section 19.
(5) The Registrar shall consider written arguments if submitted by a party to the proceeding.
(6) The decision of the Registrar shall be communicated to the parties in writing at the address given for service."

43. It is the submission of the Appellant that even though the Appellant had neither adduced Evidence in support of its Opposition nor intimated to the Respondents in writing that the Appellant did not desire to adduce Evidence and intended to rely upon the facts stated in the notice of the Opposition, Respondent No. 2 was obligated to consider Written Arguments submitted by the Appellant while deciding whether the Opposition of the Appellant had deemed to have been abandoned.

44. Rule 50(1) of the Rules provides that Respondent No. 2 shall give notice to the parties of the first hearing after the closure of the evidence. Hence, the hearing and decision as contemplated in Rule 50 would be only if the Appellant had submitted Evidence in support of its Opposition and Respondent No. 1 had submitted Evidence in support of its Application. However, as the Appellant had failed to adduce Evidence and also intimate to the Respondents about not adducing the Evidence, the hearing conducted by Respondent No. 2 was not as contemplated under Rule 50 of the Rules as Rule 50(1) of the Rules clearly provides that "after the closure of the evidence". As there was no closure of the Evidence as stipulated under Rule

50(1) of the Rules, the consideration of the Written Arguments as provided under Rule 50(5) of the Rules was not required.

45. The Appellant having not adduced the Evidence or intimating the Respondents about the same under Rule 45(1) of the Rules, cannot bypass the consequence under Rule 45(2) of the Rules of abandonment of its Opposition by filing Written Arguments and rely upon Rule 50 (5) of the Rules to assail the Impugned Order.

46. As Rule 45(2) of the Rules provides that in case of no action under Rule 45(1) of the Rules the Opposition shall be deemed to have abandoned, Rule 50(5) of the Rules shall not come to the rescue of the Appellant to oppose the Application by filing Written Arguments.

47. As Rule 50(1) clearly provides that the hearing would be after the closure of the evidence, the hearing scheduled in the present case on 04.05.2018 was not in terms of Rule 50 of the Rules. As Rule 45(2) of the Rules provides that within a period of two months from the service of copy of the Counter Statement, which period is mandatory, since the Appellant had not adduced Evidence or intimated about the same to the Respondents, the Opposition had deemed to have been abandoned and it was not mandatory for Respondent No. 2 to consider the Written Arguments submitted by the Appellant before passing the Impugned Order.

48. In view of the above, there is no infirmity in the Impugned Order and the same is upheld. The Appeal is hereby dismissed. No order as to costs.

TEJAS KARIA, J

JULY 31, 2025*/ap*