



2025:DHC:3152



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\* **IN THE HIGH COURT OF DELHI AT NEW DELHI**% *Date of decision: 21<sup>st</sup> April, 2025*

+ C.A.(COMM.IPD-TM) 12/2024 &amp; I.A. 3376/2024

RAJ VARDHAN PATODIA (HUF) .....Appellant

Through: Mr. C. M. Lall, Senior Advocate with  
Mr. Kunal Mimani, Mr. Prashant Alai  
& Ms. Annaya Mehan, Advocates.

versus

REGISTRAR OF TRADE MARKS &amp; ANR. ....Respondents

Through: Mr. Sumit Nagpal, SPC with Ms.  
Aastha Sood, Advocate for R-1.  
Mr. Manish Singhal & Mr. Lakshay  
Mangla, Advocates for R-2.**CORAM:****HON'BLE MR. JUSTICE AMIT BANSAL****AMIT BANSAL, J. (Oral)**

1. The present appeal has been filed under Section 91 of the Trade Marks Act, 1999 (hereinafter 'Act') challenging the order dated 3<sup>rd</sup> November 2023 passed by the respondent no.1 (hereinafter 'impugned order') in opposition no. 1032117 (hereinafter 'subject opposition') filed by the appellant against the trade mark application bearing no. 3328761 (hereinafter 'subject application') filed by the respondent no.2.

2. Brief facts, as stated by the appellant, leading up to the present appeal are as follows:

2.1. The respondent no.2, on 4<sup>th</sup> August 2016, filed the subject application and the same was advertised in the Trade Marks Journal No. 1924 dated 21<sup>st</sup>



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October 2019.

2.2. The appellant filed a notice of opposition against the subject application filed by the respondent no.2 on 20<sup>th</sup> February 2020.

2.3. A copy of the counter statement dated 15<sup>th</sup> June 2020 filed by the respondent no.2 was served upon the appellant on 13<sup>th</sup> February 2023.

2.4. The evidence affidavit in support of opposition dated 29<sup>th</sup> March 2023 (hereinafter 'EISO') under Rule 45 of the Trade Marks Rules, 2017 (hereinafter 'Rules') was sent by the appellant to the respondents under the covering letter dated 30<sup>th</sup> March 2023 through courier.

2.5. The EISO was received by the respondent no.1 on 3<sup>rd</sup> April 2023 and the same was also duly served upon the respondent no.2. Thus, service of the EISO to the respondents was well within the prescribed period of two months from the date of service of the counter statement.

2.6. The appellant, on 21<sup>st</sup> June 2023, received a courier from the respondent no.1 containing the EISO along with the aforesaid covering letter. On top of the said covering letter, the respondent no.1 had made a noting/ handwritten instruction stating '*Please provide original copy*'. It was at this stage that the appellant discovered that the original EISO was inadvertently not dispatched to the respondent no.1.

2.7. Immediately thereafter, the appellant dispatched the original EISO under the covering letter dated 28<sup>th</sup> June 2023, which was received by the respondent no.1 on 30<sup>th</sup> June 2023.

2.8. The official website of the respondent no.1 would show that the EISO was taken on record by the respondent no.1 and uploaded on its e-portal on 3<sup>rd</sup> July 2023.

2.9. Upon receipt of the EISO, the respondent no.2 also filed its evidence



affidavit in support of application under Rule 46 of the Rules (hereinafter ‘EISA’) on 8<sup>th</sup> June 2023.

2.10. The appellant was surprised to receive a hearing notice dated 11<sup>th</sup> October 2023 from the respondent no.1 alleging that the appellant had not filed the EISO within the prescribed time and therefore the subject opposition is liable to be dismissed as abandoned. The hearing was scheduled for 31<sup>st</sup> October 2023.

2.11. The appellant’s counsel thereafter addressed a letter to the respondent no.1 along with an affidavit dated 20<sup>th</sup> October 2023 providing necessary clarifications, along with supporting documents, and emphasizing that the EISO had already been filed as per the Rules. During the course of the hearing, it was explained on behalf of the appellant that a copy of the EISO was filed on 3<sup>rd</sup> April 2023 and thereafter the original EISO was filed on 30<sup>th</sup> June 2023 as per the instructions of the respondent no.1.

2.12. Subsequently, the appellant also filed an affidavit dated 3<sup>rd</sup> November 2023 re-narrating all the events that had taken place in the opposition proceedings and enclosing all relevant documents. The appellant, in the said affidavit, stated that the EISO was available on the record of the respondent no.1.

2.13. Despite the aforesaid, the respondent no.1 arbitrarily and illegally passed the impugned order treating the subject opposition as being deemed to have been abandoned under Rule 45(2) of the Rules and holding that the appellant had failed to file the EISO in compliance of Rule 45 of the Rules.

3. For ease of reference, the relevant extract of the impugned order is set out below:

*“Hearing was fixed under Rule 45(2) of the Trademark Rules 2017. The*



Counter Statement was filed by the applicant was served to the opponent on 13/02/2023 by the Registry. **However, within the time prescribed under the rules, no evidence in support of opposition was filed by the Opponent.**

An opportunity has been provided to the opponent by fixing a hearing on 31/10/2023, to explain why the above opposition should not be abandoned under rule 45(2). **Advocate on behalf of the opponent stated that the evidence has been filed before the Registry.** It is submitted that the applicant has also filed his evidence under Rule 46 after receiving opponent's evidence. The counsel for the Opponent has sought time to file proof of filing evidence before the Registry. Time was granted to the counsel and it was made clear that the records of the present application will be perused on 03/11/2023, till then the opponent may upload the necessary documents, if any. On the other hand, the counsel for the applicant submitted that the opponent has failed to file his evidence before the Registry, hence the present opposition be deemed abandoned under Rule 45(2).

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I have checked the records of the case. The opponent's evidence is not filed before Trademark Registry. Despite seeking time, counsel for the Opponent has also failed to file any proof of delivery of his evidence, allegedly filed by him before Trademark Registry. As per Rule 45, the opponent shall have to **leave with the Registrar**, his evidence in support of opposition and deliver copies of the evidence left with the Registrar to the applicant. If opponent fails to take action within two months after receipt of counter statement, he shall be deemed to have abandoned his opposition.

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**The burden of proof was on the opponent to prove that he has left/delivered is evidence to the Registrar.** Despite taking time, the opponent has failed to discharge the said burden. Without proof of delivery of his evidence, the opponent cannot be believed that he has filed evidence before Registry in compliance of Rule 45(1).”

[emphasis supplied]

4. After hearing the submissions of the parties, this Court on 18<sup>th</sup> March, 2025 had passed a detailed order, the relevant extracts of which are set out below:

“7. In view of the aforesaid submissions, Mr. Sumit Nagpal, counsel appearing on behalf of the respondent no.1, shall take instructions from the Trade Marks Registry in respect of the aforesaid cover letter dated 30<sup>th</sup> March, 2023 (page no.142 of the appeal paperbook). The instructions shall be taken with regard to the following aspects:

I. Whether the aforesaid cover letter is available in the record of the



*Trade Marks Registry?*

II. *If the aforesaid letter is available, then:*

a. *When was the aforesaid cover letter received by the Trade Marks Registry?*

b. *Whether a copy of the evidence affidavit in support of opposition was sent along with the aforesaid cover letter?*

c. *Whether the handwritten endorsement on the aforesaid cover letter was made by the Trade Marks Registry?*

III. *Whether the envelope at page no.143 of the appeal paperbook allegedly containing the aforesaid cover letter with the handwritten endorsement was sent by the Trade Marks Registry to the appellants?*

8. *After examining the records, an affidavit shall be filed on behalf of the respondent no.1 within two (2) weeks from today clarifying its stand with regard to the aforesaid."*

5. Pursuant to the aforesaid order, an affidavit dated 18<sup>th</sup> April 2025 has been tendered on behalf of the respondent no.1 in Court today. The relevant extracts of the said affidavit are set out below:

*"3. The letter dated 30.03.2023 given on Page 141 of the Petition was NOT TAKEN ON RECORD by the Trademark Registry. The letter was sent back to the Applicant with the noting that original copy should be filed before the Registry. It is clarified that this letter dated 30.03.2023 on Page 141 was NOT a part of the record of the Trademark Registry. However, an impression is being created by the Petitioner that it was a part of record which is being explained in the following paragraphs.*

*4. The same letter dated 30.03.2023 on page 141 was again sent as a part of the Evidence with covering letter dated 28.06.2023 given on page 143. The Registry took this letter on record. However, an attempt is being made now to create an impression before Hon'ble High Court that the old letter dated 30.03.2023 on page 141 was "ON RECORD" and the Evidence was sent in continuation with the communication in the letter on Page 141.*

*5. As the letter dated 30.03.2023 on page 141 was NOT taken on record, the Evidence cannot be considered to have been "DELIVERED" to the Trademark Registry. The Petitioner is trying to bring the letter on page 141 on record by annexing the same with letter on Page 143.*

*6. That as per the records available with the Trademark Registry, I am placing on record the information sought by this Hon'ble Court.*



*Question*

- I. *Whether the aforesaid cover letter is available in the record of the Trade Marks Registry?*

*The letter on Page 141 of the paper book is not available in the office of the Trademark Registry. The Evidence under Rule 45 was received on in the month of March/April, 2023. However, as the Opponent had failed to send the original Copy of the Evidence, the same was returned to the sender. As the Evidence was returned to the sender, the letter is not available with the trademarks Registry. Also to be noted that as the Trademark Registry did not accept the Evidence, it cannot be treated as "delivered".*

- II. *If the aforesaid letter is available, then:*

- a. *When was the aforesaid cover letter received by the Trade Marks Registry?*

*The letter was received in the month of March/April, 2023. It is a standard practice that the Trademark Registry does not accept the documents which are not filed in original. In the present case, the Evidence under Rule 45 was not filed in original accordingly, it was sent back.*

- b. *Whether a copy of the evidence affidavit in support of opposition was sent along with the aforesaid cover letter?*

*As the Respondent No. 1 did not "receive" or took the Evidence "on Record", the same was sent back to the Petitioner. The Respondent No. 1 does not have the copy of the Evidence Affidavit sent along with the cover letter. The Evidence in "Original" which was sent later on is with the Respondent No. 1.*

- c. *Whether the handwritten endorsement on the aforesaid cover letter was made by the Trade Marks Registry?*

*It is a standard practice that the Trademark Registry does not accept the documents which are not filed in original. In the present case, the handwritten note seems to be from the concerned person from the Trademark Registry who sent the Evidence Affidavit back to the petitioner. However, no record is maintained by the Trademarks Registry of such communications except the speed post details.*

- III. *Whether the envelope at page no.142 of the appeal paper book allegedly containing the aforesaid cover letter with the handwritten endorsement was sent by the Trade Marks Registry to the appellants?*

*Yes, the envelope on Page 142 was sent by the Respondent No. 1. The letter was sent on 21.06.2023 with the reference AD-593.*

7. *With respect to the Evidence under Rule 45 submitted to the*



*Respondent No. 1 by the Appellant in Opposition proceeding bearing Opposition No. 1032117, it may be stated that the said evidence was not acknowledged as received by the Registry as the same was the photocopy of the Original Affidavit. Therefore, it may be stated that it “cannot be deemed to have been received”.*

6. The extracted portions of the aforesaid affidavit would show the following:

- (a) The respondent no.1 has admitted that the letter dated 30<sup>th</sup> March 2023 (page no.141 of the appeal paperbook) was sent on behalf of the appellant, which was within the prescribed period of two months for filing the EISO.
- (b) However, it has been admitted that the EISO was not taken on record by the respondent no.1 and the same, along with the aforesaid letter dated 30<sup>th</sup> March 2023, was sent back to the appellant since the original EISO was not sent by the appellant.
- (c) It is also been admitted that the handwritten noting on the letter seemed to have been put by the concerned person from the Trade Marks Registry who sent the EISO back to the appellant.
- (d) It has also been admitted that the envelope at page no.142 of the appeal paperbook was sent by the respondent no.1 on 21<sup>st</sup> June 2023 with the reference no. ‘AD-593’.

7. The stand taken by the respondent no.1 in the aforesaid affidavit is that as per its standard practice, the Trade Marks Registry did not take the EISO sent by the appellant with the covering letter dated 30<sup>th</sup> March 2023 on record as the EISO was not filed in original. Therefore, as per the respondent no.1, it cannot be accepted that the appellant had filed the EISO within the prescribed timeline.

8. Undoubtedly, there was a mistake on the part of the appellant in not



filing the original EISO at the first instance. However, it is undisputed that a photocopy of the EISO was duly sent by the appellant to the respondents within the prescribed timeline.

9. Further, as soon as the appellant was informed of this mistake, by way of the aforesaid noting/ handwritten instruction received by the appellant on 21<sup>st</sup> June, 2023, the appellant sent the original EISO to the respondent no.1 within one week, *i.e.*, on 28<sup>th</sup> June 2023 and the same was uploaded on the e-portal of the respondent no.1 on 3<sup>rd</sup> July 2023.

10. The filing of a photocopy of the EISO clearly shows that the intent of the appellant was to contest the matter on merits.

11. A Coordinate Bench of this Court in ***V-Guard Industries v. Registrar of Trademarks***, 2023 SCC OnLine Del 59, while deciding an appeal against the order of the Trade Marks Registry abandoning an opposition under Rule 45(2) of the Rules, made the following observations:

*“23. Even otherwise, it is well-settled, while procedural provisions are required to be accorded their due deference, they cannot be interpreted so rigidly as to result in evisceration of substantive rights vested in the citizens. The right to oppose registration of a trade mark is just as sacrosanct as the right to seek registration. In the peculiar facts of the present case once the application for opposition had actually been filed by the appellant, it would be entirely unfair for this Court to uphold the decision of the learned Deputy Registrar to treat the opposition as having been abandoned only because the evidence in support of the opposition was received three days late, especially as, prima facie, the appellant did make efforts to “leave” the evidence in support of the opposition with the office of the learned Registrar within the time stipulated in that regard in Rule 45(1) of the Trade Marks Rules.”*

12. In the facts and circumstances of the present case, in my considered view, the appellant cannot be condemned unheard on account of its non-compliance with the ‘*standard practice*’ of the respondent no.1, as stated in the affidavit dated 18<sup>th</sup> March 2025, that the Trade Marks Registry does not



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accept the documents which are not filed in original. As is also evident from the Rules, the Trade Marks Registry accepts e-filing of documents, therefore, insistence on filing documents in the original form at the first instance seems to be unnecessary. Needless to state, the Registry is free to ask for the original documents to be furnished by the parties at any later stage.

13. In view of the above, there was no occasion for the respondent no.1 to give a finding that the opposition is deemed to have been abandoned under Rule 45(2) of the Rules.

14. It is also an admitted position that based on the copy of the EISO received by the respondent no.2, it filed its EISA in the opposition proceedings. Therefore, no prejudice would be cause to the respondent no.2 if the EISO is taken on record.

15. Accordingly, the impugned order is set aside and the registration granted in favour of the respondent no.2 in the subject application is cancelled. The respondent no.1 shall take the EISO filed on behalf of the appellant on record and shall proceed further with the opposition proceedings in the subject application as per the Rules.

16. Accordingly, the appeal, along with pending applications, is disposed of in the aforesaid terms.

17. 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](mailto:llc-ipo@gov.in), for compliance.

**AMIT BANSAL, J**

**APRIL 21, 2025/at**