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

\+ C.A.(COMM.IPD-TM) 39/2022 & I.A. 179/2023

M/S V-GUARD INDUSTRIES LTD ..... Appellant
Through: Ms. Babna Das, Mr. Mukul Kumar and Mr. Vizzy George, Advs.

versus

THE REGISTRAR OF TRADEMARKS & ANR.. Respondents
Through: Mr. Harish Vaidyanathan Shankar, CGSC with Mr. Srish Kumar Mishra, Mr. Gagar Mehlawat, Mr. Alexander Mathai Paikaday, Advs. for R-1
Mr. Jithin M. George and Mr. Udit Tewari, Advs. for R-2

CORAM:
HON'BLE MR. JUSTICE C. HARI SHANKAR

J U D G M E N T (ORAL)

% 06.01.2023

1. This appeal assails the following order dated 30th August 2018, passed by the learned Deputy Registrar of Trademarks in Application No. 2772497 filed by Respondent 2 M/s Livguard Energy Technologies Pvt Ltd. seeking registration of their mark "LIVGUARD ZING" in respect of batteries, invertors and like goods:

> " Proceedings were initiated under Section 21 of the Trade Mark Act, 1999, by the above named opponent to oppose the registration of trade mark applied for by the above named applicant and whereas the Counter Statement was filed by the applicant and the same was served to the opponent on and whereas within the time prescribed under the rules, neither any evidence in support of opposition was filed nor any statement was submitted on behalf of the opponent to the effect that the opponent does not desire to adduce evidence but wants to rely on the facts mentioned in the Notice of Opposition. The above mentioned opposition is, therefore, deemed to have been abandoned under Rule 45(2) of the Trade Marks Rules 2017.Thc above mentioned application shall proceed further as per rules.

IT IS HEREBY FURTHER ORDERED that there shall be no order as to cost of these proceedings."

2. Given the nature of the controversy in the present case, it is not necessary to enter into the specifics of the application seeking registration.

3. Suffice it to state that the application for registration was filed by Respondent 2 on 11th July 2014, and was published in the Register of Trade Marks on 15th February 2016 inviting opposition and that, on 2nd June 2016, notice of opposition was filed by the appellant before the learned Registrar. Counter statement, in response to the notice of opposition filed by the appellant was filed by the Respondent 2 on 7th March 2018. It is an admitted position that, on the same day i.e., 7th March 2018, the notice of counter statement filed by Respondent 2 was served electronically on the appellant.

4. Rule 45 of the Trade Marks Rules reads thus:

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

5. At a plain glance, Rule 45 is very unhappily worded. It uses the expression "leave with the Registrar". This is an expression to which

no legal interpretation can possibly be given.

6. My attention has been invited to Rule 8 of the Trade Mark Rules which deals with "leaving of documents" etc. and reads thus:

> "8. **Leaving of documents, etc**.— All applications, notices, statements or other documents or any fees authorised or required by the Act or the rules to be made, served, left or sent or paid at or to the Trade Marks Registry in relation to a trademark on the Register of trademarks on the notified date or for which an application for registration is pending on, or is made on or after the notified date, shall be made, served, left or sent or paid to the appropriate office of the Trade Marks Registry:
>
> Provided that the Registrar may, by notification in the journal, permit the filing of certain forms or documents, other than the application for the registration of a trademark in any other office of the Trade Marks Registry."

7. Unfortunately, Rule 8 of the Trade Mark Rules is just as nebulous as Rule 45. It requires the opponent, opposing the registration of a trade mark, to "leave with the Registrar", evidence by way of affidavit. It is difficult to understand the expression "leave with the Registrar". At any rate, it is not an expression which should ordinarily find place in a legislative document.

8. The case of the appellant, as argued by Ms. Bhabna Das, learned Counsel for the appellant, and as set out in the present appeal, is that 7th May 2018 being the last date by which the evidence in opposition was required to be filed by the appellant, attempts were made to upload the evidence on the website of the Registrar of Trade Marks, but that, as the website was non-functional, this could not be done. As a result, submits Ms. Bhabna Das, the evidence was sent to the office of the Registrar by courier. It is an admitted position that the evidence in opposition as sent by the appellant was, in fact, received by the office of the learned Registrar on 10th May 2018, i.e.,

mere three days beyond the last date for "leaving" of the evidence.

9. As is apparent, the impugned order has proceeded on the premise that, as the evidence in terms of Rule 45 of the Trade Mark Rules had not been *filed* within two months from the service of the counter statement of Respondent 2 on the appellant, the opposition of the appellant was deemed to have been abandoned by application of sub-rule (2) of Rule 45.

10. At a bare glance, the impugned order is incorrect, as Rule 45(1) does not use the expression "filed". What Rule 45(1) requires is that the evidence must be "left with the Registrar". Where the statute is ambiguous, the benefit of ambiguity has to go to the citizen. This would be especially so where the statute confers a valuable commercial right on the citizen. It cannot be gainsaid that, having submitted the notice of opposition, opposing the application of Respondent 2 for registration of the Trade Mark, the tendering of evidence in support of the opposition was a valuable commercial right which enured in favor of the opponent/appellant. There is no conceivable reason as to why, having filed the notice of opposition, the appellant would abandon the opposition. That the appellant did not, in fact, do so, is manifest by the fact that, on 28th August 2018, the appellant filed an application for extension of time, purportedly under Section 131 of the Trade Marks Act read with Rule 109 of the Trade Mark Rules, in Form TM-M, as required by the said rules.

11. The application has not been considered by the learned Deputy Registrar while passing the impugned order. In the application, it was specifically submitted that the website of the learned Registrar of

Trade Marks was non-functional on 7th May 2018, as a result of which, on 8th May 2018, the evidence in opposition was sent by the appellant by courier.

12. As already noticed, it is an admitted position that the evidence in opposition was indeed received by the office of the learned Registrar on 10th May 2018.

13. The issue before the court is whether, in these circumstances and in the backdrop of the existing statutory scenario as contained in the Trade Marks Act and Trade Marks Rules, this Court should sustain the decision of the learned Deputy Registrar, *vide* the impugned order dated 30th August 2018, to treat the opposition filed by the appellant, to the application of Respondent 2 seeking registration of the "LIVGUARD ZING" mark, as having been abandoned.

14. Having heard Ms. Bhabna Das, learned Counsel for the appellant and Mr. Jithin M George, learned Counsel for Respondent 2, in my considered opinion, the answer to this query has necessarily to be in the negative.

15. Two issues would arise for consideration. The first is whether there was, in fact, delay on the part of the appellant in complying with the requirement of Rule 45 of the Trade Mark Rules. The second is whether, assuming there was any such delay, the learned Registrar was empowered to condone the delay or to extend the time for compliance with Rule 45.

16. Addressing the first issue first, Rule 45 (1) stipulates that,

within two months from service of the copy of the counter statement filed by the trade mark applicant, the opponent opposing the registration of the mark is required to leave, with the Registrar, evidence by way of affidavit in support of the opposition. Rule 45(1) further requires the opponent to the registration of the trade mark to deliver, to the applicant seeking registration, copies of the affidavit left with the Registrar and to intimate the Registrar in that regard.

17. Rule 8 of the Trade Mark Rules states that all documents, which are required "to be made, served, left or sent or paid at or to the Trade Marks Registry", in respect of a Trade Mark in respect of which an application seeking registration is pending, "shall be made, served, left, or sent or paid to the appropriate office of the Trade Marks Registry".

18. As already observed, the provision is as nebulous as can be. The Rule, envelops, in one parenthesis, the expressions "made" "served", "left", "sent" and "paid" and refers to such making, serving, leaving, sending, or paying "to the appropriate office of the Trade Marks Registry".

19. Given the nature of these provisions and the fact that they affect a valuable right vested in an opponent who seeks to oppose the registration of a trade mark, I am of the considered opinion that, in the facts of the present case, the appellant won't be entitled to the benefit of the ambiguity inherent in this provision.

20. The appellant, in its application seeking extension of time as filed before the learned Deputy Registrar, as well as in the present

appeal, has stated, on affidavit, that the attempts at e-filing of the evidence in support of the appellant's objections, on 7th May 2018, could not succeed as the website of the learned Registrar of Trade Marks was non-functional. The impugned order does not seek to discountenance this assertion. Notice was issued in the present appeal, and there is no affidavit filed by way of response, denying this fact.

21. There is no reason, therefore, for this Court to disbelieve the appellant and presume that, in fact, no attempt was made by the appellant to e-file the objections on 7th May 2018, especially as, on the very next day i.e., 8th May 2018, the objections were in fact sent by courier. This is not, therefore, a case in which the appellant exhibited any callous or negligent indolence. The fact that, on 8th May 2018, the appellant did indeed courier the evidence in support of the opposition to the office of the learned Registrar of Trade Marks, compels this Court to believe the assertion, in the present appeal, also contained in the application for extension of time filed before the learned Registrar with the evidence in support of the opposition was in fact forwarded to the office of the learned Registrar electronically on 7th May 2018, but that the attempt could not succeed as the website was non-functional.

22. Such an attempt, in my view, would fall within the broad embrace of the expression "made, served, left, sent or paid to the appropriate office of the Trade Marks Registry", as employed in Rule 8 of the Trade Marks Rules.

23. Even otherwise, it is well-settled that, 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.

24. In that view of the matter, this Court is not required to examine the somewhat more nuanced issue of whether, where the evidence in opposition is not "left" with the office of the learned Registrar within two months as envisaged in Rule 45(1), any discretion vests in the learned Registrar to extend the time therefor. That would involve a juxtaposed interpretation of Section 131 of the Trade Marks Act and Rules 8, 45 and 109 of the Trade Marks Rules, which may be left for another sunny evening.

25. In the facts of the present case, therefore, the impugned order dated 30th August 2018 would stand set aside.

26. Resultantly, the learned Deputy Registrar is directed to take into account the evidence in opposition filed by the appellant and take a view thereon.

27. I am informed that, after the impugned order was passed, the mark of Respondent 2 has proceeded to registration.

28. Needless to say, in view of the decision taken today, the registration of the Trade Mark shall remain subject to the outcome of the view to be taken by the learned Deputy Registrar on the opposition filed by the appellant.

29. In order that equities are not unnecessarily prejudiced, the learned Deputy Registrar is directed to take a decision on the appellant's notice of opposition, after following due process in that regard, within a period of three months from today.

30. For this purpose, both sides are directed to present themselves before the office of the learned Deputy Registrar of Trade Marks on 16th January 2023 at 11:00 a.m.

31. The learned Deputy Registrar would proceed with the matter with all due expedition.

32. Both sides are directed not to seek any adjournment from the learned Deputy Registrar.

33. The appeal stands allowed accordingly with no order as to costs.

C. HARI SHANKAR, J.

JANUARY 6, 2023
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