

Legal Issues in ‘Service by Registrar in Opposition Proceedings’

Topic: ‘Whether Service by Registrar in an Opposition Proceeding is Deemed Proper upon dispatch of Electronic Mail?’

Relevant Legal Provisions

❖ Rule 18, Trade Marks Rules, 2017

“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 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 supplied)*

Relevant Legal Provisions (Contd.)

❖ Section 21, The Trade Marks Act, 1999

“Opposition to 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.” (Emphasis supplied)*

Relevant Legal Provisions (Contd.)

❖ Rule 45, Trade Marks Rules, 2017

“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.**” (Emphasis supplied)*

Relevant Judicial Decisions

❖ **Ramya S. Moorthy v. Registrar Of Trade Marks [W.P.(IPD). Nos. 3 & 4 of 2023, Madras High Court]**

*“5. Rule 18(2) incorporates a legal fiction with regard to service of notice by post and e-mail. As regards service of notice by e-mail, it provides that notice would be deemed to be served “at the time of sending the e-mail”. If construed literally, this would mean no more than proof of transmission of the e-mail. Especially in the context of the non-incorporation of the provision for deemed receipt in the statute, if so construed, Rule 18(2) would not be in consonance with Section 21(2) which provides that the time limit for filing the counter statement would run from the date of receipt by the applicant of the notice of opposition. In this regard, it should also be borne in mind that the substantive right of an applicant seeking registration of trademarks is at stake. Therefore, I conclude that the prescribed **time limit would only run from the date of receipt of the e-mail...**” (Emphasis supplied)*

Relevant Judicial Decisions (Contd.)

❖ **Praveen Kumar Maakar v. Union of India [2017/DHC/6658]**

*“11. Plainly, if the petitioner was not served with the Notice of Opposition, the question of the petitioner abandoning his application for registration of the trademark does not arise as the **period of two months provided for responding to such opposition commences only from the receipt of notice of opposition.**”*

“12., the conclusion that the applicant is deemed to have abandoned his application can only follow once the notice of opposition is served on the applicant and he fails to respond to the same.” (Emphasis supplied)

6

Relevant Judicial Decisions (Contd.)

❖ **Praveen Kumar Maakar v. Union of India [2017/DHC/6658] (Contd.)**

*“45. It is possible that Ms Lakshmi is correct in her submission that an incorrect entry had been recorded in the Despatch Register and the notice was, in fact, sent to the correct address. However, there is no material which would substantiate the same. It is equally possible that there is no error in the Despatch Register and the notice of opposition was, in fact, dispatched to M/s Delhi Registration Service erroneously. **Further, given that the petitioner has affirmed that he had never received the Notice of Opposition, the same has to be accepted.**” (Emphasis supplied)*

7

Relevant Judicial Decisions (Contd.)

❖ **Munira Virani v. Registrar of Trade Marks and Ors. [OA/1/2018/TM/MUM]**

- *“31.There are two versions available on record on behalf of both the parties. The first one is the appellants that copy of the same has not been received and once the copy is not received, the question of running the time prescribed under the rules does not arise. The other second version is of the respondents who state that the copy was duly sent by courier at the correct address.”*
- *“45. It is clear that receiving of copy by the appellant is an important stage of the proceeding, the evidence would **only trigger once the copy is served**, the appellant is to file the evidence under Rule 51 and thereafter the stage of evidence under Rule 52 of the Trade Mark Rules, 2002 will commence.” (Emphasis supplied)*

Conclusion

- It can be concluded that service should not merely be construed as dispatching an email, in a trademark opposition proceeding.
- It is imperative to ensure actual receipt of the document to protect the Party's substantive rights in law.
- The legal stance taken recently by the Courts have put the controversy on hold and have held that the literal interpretation of Rule 18 will lead to the departure from Section 21(2), which provides that the time limit for filing the Counter-Statement would run from the date of receipt of the Notice by the Applicant of the Notice of Opposition.

Thank you!
Questions?

Shivanshi Gupta, Trainee Associate

10

© ALG India Law Offices LLP, 2023.

Disclaimer: Views, opinions, and interpretations are solely those of the presenters, not of the firm (ALG India Law Offices LLP) nor reflective thereof.

This presentation hosted at: https://www.algindia.com/wp-content/uploads/2023/09/LIS_Shivanshi-Gupta_v4.pdf