

## Legal Issues in ‘Service by Registrar in Counter-Statement’

Issue: Is the Applicant obligated to serve the Counter-Statement upon the Opponent in a Trade Marks Opposition proceeding?

## Relevant Legal Provisions

- **The Trade Marks Act, 1999 –**

***Section 21. 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.*

*(3) If the applicant sends such counter-statement, the Registrar shall serve a copy thereof on the person giving notice of opposition.” (emphasis supplied)*

## Relevant Legal Provision

- **Trade and Merchandise Marks Rules, 1959 –**

*“Rule 53. Evidence in support of opposition :- (1) **Within two months from the service on him of a copy of the counter- statement by the Registrar**, 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.” (emphasis supplied)*

- **Trade Marks Rules, 2002 –**

*“Rule 50. Evidence in support of opposition.- (1) **Within two months from services on him of a copy of the counterstatement or within such further period not exceeding one month in the aggregate thereafter as the Registrar may on request allow**, 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.” (emphasis supplied)*

- **Trade Marks Rules, 2017 –**

*“Rule 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.” (emphasis supplied)*

## Relevant Judicial Decisions

❖ *Sun Pharma Laboratories Ltd. v. Dabur India Ltd. & Anr. [2024:DHC:946]*

*“25. ...Under Rule 50 of the 2002 Rules, the counter statement is to be served by the Applicant itself and not by the Registrar. Under Rule 45 of the 2017 Rules, again service of counter statement is by the Applicant itself and not by the Registrar.”*

*“35. ...Thus, the time gap or delay between service by the Applicant of the counter statement and by the Registrar of the same counter statement was also sought to be bridged and plugged.”*

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## Relevant Judicial Decisions

- ❖ *Pidilite Industries Limited v. The Registrar of Trade Marks, The Trade Marks Registry and Ors.*  
(19.03.2008 - IPAB) : OA/3/2006/TM/AMD

“15. Section 21 of the Act provides that the Registrar shall serve a copy of counter-statement to the opponent and any evidence upon which the opponent and the applicant may rely shall be submitted to the Registrar in the prescribed manner and within the prescribed time.”

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## Relevant Judicial Decisions (Conti.)

❖ *Cadila Healthcare Ltd. v. Union Of India And Ors. [AIR 1999 GUJ 40]*

*“5. ...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. Under sub-Section (3) of Section 21, if the applicant sends such counter-statement, the Registrar shall serve a copy thereof on the person giving notice of opposition.” (emphasis supplied)*

*“6. Through Rule 53 dealing with the 'evidence in support of opposition', it has been provided in sub-Rule (1) that within two months from the service on him of the copy of the counter statement by the Registrar, 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”*

## Relevant Legal Provision

- **Trade and Merchandise Marks Rules, 1959 –**

*“Rule 52...A copy of the counter-statement shall be served by the Registrar on the person giving notice of opposition..”*

- **Trade Mark Rules, 2002 –**

*“Rule 49...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.” (emphasis supplied)*

- **Trade Mark Rules, 2017 –**

*“Rule 44...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.” (emphasis supplied)*

## Relevant Judicial Decisions

❖ ***Union Of India & Anr v. Hemraj Singh Chauhan 2010 (4) SCC 290***

*“42. ...The word `ordinarily' must be given its ordinary meaning. While construing the word the Court must not be oblivious of the context in which it has been used.*

*“43. The word `ordinarily' would convey the idea of something which is done `normally' ... and `generally' subject to special provision...In such a situation the word `ordinarily' has to be construed in order to fulfill the statutory intent for which it has been used.”.*

❖ ***M/S Eicher Tractors Ltd., Haryana v. Commissioner Of Customs, Mumbai [2001 (1) SCC 315]***

*“6. ...The word 'ordinarily' necessarily implies the exclusion of "extraordinary" or "special' circumstances.”*



## Relevant Judicial Decisions (Conti.)

### *Interpretation of “shall” and “ordinarily” vis-a-vis 2002 and 2017 Rules*

❖ *Subramanian Swamy v. Union Of India, AIR 2016 SC 2728*

*“195. ...Whereas “shall” brings a mandatory requirement, the word “ordinarily” brings a situational variation which results in an interpretation that the case may be tried as per the further provisions of the Chapter”*

❖ *Shivji Khetshi Thacker vs. Commissioner of Dhanbad Municipality Tarak Nath Mistri vs. University of Calcutta and ors. AIR 1978 SC 836*

*“24. The word "ordinarily", tones down the force of "shall" which immediately precedes it...”*

## Relevant Judicial Decisions (Conti.)

- ❖ ***St. Johns Teachers Training Institute v. Regional Director, National Council for Teacher Education and Anr. [AIR 2003 SC 1533]***

*“10. The power to make subordinate legislation is derived from the enabling Act and it is fundamental that the delegate on whom such a power is conferred has to act within the limits of authority conferred by the Act. Rules cannot be made to supplant the provisions of the enabling Act but to supplement it.”*

- ❖ ***Kerala State Electricity Board and Ors. vs. Thomas Joseph and Ors. [C.A. NOS. 9252-9253 OF 2022 ]***

*“80. Rules or regulation cannot be made to supplant the provisions of the enabling Act but to supplement it. What is permitted is the delegation of ancillary or subordinating legislative functions, or, what is fictionally called, a power to fill up details.”*

## Conclusion

- ❖ In the 2002 and 2017 Rules, the expression “...*shall be ordinarily served by the Registrar...*”, therefore, brings a mandatory requirement upon the Registrar to ensure service of the Counter-Statement within two months ordinarily.
- ❖ Interpretation of the removal of the term “by the Registrar” in the Rules, should be construed such that it gives effect to the objectives and intent of the parent statute and interconnected provisions, i.e., harmonious reading of Rule 45 of the 2017 Rules vis- a vis Section 21(3) of the parent act.

**THANK YOU!**

**Questions?**

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