

INTELLECTUAL PROPERTY APPELLATE BOARD

Guna Complex, Annexe-1, 2nd Floor, 443, Anna Salai,
Teynampet, Chennai – 600 018.

OA/7/2014/GI/CH

FRIDAY, THIS THE 5th DAY OF FEBRUARY, 2016

HON'BLE SHRI. JUSTICE K.N. BASHA

: CHAIRMAN

HON'BLE SHRI SANJEEV KUMAR CHASWAL

**: TECHNICAL MEMBER
(TRADE MARKS)**

Basmati Growers Association
House No.45, Usman Block,
New Garden Town, Lahore,
PAKISTAN.

.... Appellant

(Represented by Shri Sanjay K. Sharma)

Vs.

1. The Agricultural & Processed Food
Products Export Development Authority(APEDA)
3, NCUI BUILDING, Siri Institutional Area
August Kranti Marg,
New Delhi 110 016.

.... 1st Respondent

(Represented by Shri Rajendra Kumar)

2. The Assistant Registrar of Geographical Indications,
Intellectual Property Building,
G.S.T. Road, Guindy,
Chennai-600 032.

.... 2nd Respondent

ORDER (No.7/2016)

HON'BLE MR. JUSTICE K.N. BASHA, CHAIRMAN

1. Originally this appeal has been posted for hearing at the Principal Bench, Chennai along with the other connected appeals OAs/1 to 6/2014/GI/CH, OAs 8 & 9/2014/GI/CH. After the conclusion of the hearing and the arguments advanced in respect of the said batch of appeals arising out of a common order dated 31.12.2013, the present appeal in OA/7/2014/GI/CH was mutually agreed by the learned counsel for both sides to advance their arguments before the Circuit Bench at New Delhi. Accordingly, this appeal has been taken up for hearing the arguments at Circuit Bench, New Delhi challenging a separate order

dated 31.12.2013 passed by the Assistant Registrar of Geographical Indications Registry in opposition TOP No.18.

2. The appellant has come forward with this appeal challenging the order passed by the 2nd respondent, the Assistant Registrar of Geographical Indications Registry, Chennai dt.31.12.2013 dismissing the Appellant's opposition (TOP No.18) as 'abandoned' under Rule 44 (2) of the Geographical Indications of Goods (Registration & Protection) Rules, 2002 (Hereinafter referred to as "the GI Rules"). Consequently, the Assistant Registrar, GI Registry allowed the interlocutory petition No.1 in TOP No.18 filed by the first respondent/applicant The Agricultural & Processed Food Products Export Development Authority hereinafter referred to as (APEDA).

3. APEDA filed an application to register 'BASMATI' as a Geographical Indication in Class 30 under the Geographical Indications of Goods (Registration & Protection) Act, 1999 ('the GI Act') with Geographical Indications Registry, Chennai ('the GI Registry'). The said application was numbered as '145' and was eventually advertised in the GI Journal No.34 dated May 31, 2010. On 25, October, 2010 the first respondent was served with a copy of a notice of opposition dated September 29, 2010 filed by the Appellant herein, objecting to the said respondent's application on the grounds set out therein. On 16th December, 2010 the first respondent filed the counter statement within the prescribed period of two months under Rule 43 (1) of "the GI Rules". On 13th January, 2011 the Appellant was served with a copy of the counter statement filed by the first respondent. The second respondent through its letter dated 10.01.2011 advised appellant/opponent to file its evidence in the opposition No.TOP 18 within the mandate of Rule 44 of "the GI Rules".

4. The appellant/opponent claimed that the counter statement filed by the first respondent APEDA did not contain copies of annexure 21, 22 & 23 relied by them. The appellant/opponent wrote a letter dated 10.02.2011 *inter alia requested* the second respondent to provide copies of the missing Annexures so

as to enable the appellant/opponent to prepare and file the evidence by way of affidavit within the stipulated time. On not receiving any response from the office of the second respondent to the letter dated 10.2.2011 for copies of the missing Annexures, the appellant/opponent sent a letter dated 25.02.2011 to the second respondent seeking extension of time in filing the evidence up to 13th April, 2011 since various Annexures No.21, 22 and 23 were not provided to the Appellant/opponent by APEDA/first respondent. However, the second respondent informed the appellant/opponent to file the application seeking extension of time in the prescribed form i.e., the FORM GI 9C, and accordingly the appellant/opponent submitted the FORM GI 9C with the second respondent on 03.03.2011 seeking extension of time in filing evidence on the grounds that the appellant/opponent was not served with complete set of documents viz., Annexures 21, 22 & 23 with the counter statement filed by the APEDA/first respondent. The appellant/opponent filed another FORM GI 9C on 07.04.2011 seeking further extension for filing of evidence. The appellant/opponent applied for photocopy of aforementioned Annexures 21, 22 & 23 on 08.04.2011 with the Geographical Indications Registry, Chennai and the same were made available to the appellant/opponent on the same date. Thereafter the appellant/opponent filed its evidence by way of affidavit to the counter statement of the APEDA/first respondent on 22.04.2011.

5. In view of the above said sequence of events, and more particularly there is an admitted delay of 9 days in filing the evidence in support of opposition the first respondent APEDA filed an interlocutory petition on 25.05.2011 contending that the evidence in support of the opposition was not filed by the appellant within the stipulated time under Rule 44 and further the affidavit filed by the appellant on 22.04.2011 was not in compliance of the prescribed format and sought for an order treating the opposition filed by the appellant/opponent as 'abandoned' under Rule 44 (2) of "the GI Rules".

6. The appellant/opponent filed their reply to the interlocutory petition on 17.06.2011 contending that copies of the Annexures forming part of the counter statement were not provided to the appellant/opponent by the APEDA/first respondent and the same was procured by the appellant/opponent by filing an application for supply of the Annexures 21, 22 and 23 on 08.04.2011 before G.I. Registry and were provided by the G.I. Registry on the same day and the Appellant/opponent filed the evidence by way of affidavit on 22.04.2011 and hence the period of filing the evidence should be computed from the date when the appellant/opponent was provided with the copy of the Annexures by the G.I. Registry.

7. Considering the arguments of both sides, and placing reliance on the provisions of the Act and Rule 44 of the GI Rules coupled with the reliance of two cases viz., (No.1) reported in **SUNRIDER CORPORATION Vs. HINDUSTAN LEVER LTD & ANOTHER** {2007 (35) DEL} and No.2 in **ALLIED BLENDERS AND DISTILLERS PVT. LTD. Vs. INTELLECTUAL PROPERTY APPELATE BOARD & OTHERS** {2010 (42) PTC 57 (Mad.) (DB)} and also pointing out the defects and infirmities in the affidavits filed in the opposition proceedings which are not in conformities to the form prescribed in Rule 93 of GI Rules and holding such affidavits cannot be regarded as evidence within the meaning of Rule 44(2) of GI Rules and ultimately allowed the interlocutory application and treating the opposition TOP No.18 as 'abandoned' under Rule 44 (4) of GI Rules. Hence the present appeal.

8. Mr. Sanjay K.Sharma the learned counsel for the appellant would contend that the impugned order is patently wrong and against the facts as well as law and put forward the following contentions:-

(i) The counter statement filed by APEDA was received by the appellant/opponent on 13.1.2011 and the same was incomplete as it did not contain the copies of Annexures relied upon by APEDA and as such the appellant sought for the furnishing of the copies of the missing Annexures enabling the appellant/opponents to file their evidence within the stipulated time.

(ii) The appellant/opponent sought for extension of time for filing evidence as per their letter dt.25.2.2011 since Annexures 21, 22 and 23 were not provided by them.

(iii) As the second respondent informed the appellant to file the application seeking extension of time in the prescribed form G.I. 9C and accordingly the appellant submitted the said form on 3.3.2011 seeking extension of time for filing their evidence.

(iv) The appellant/opponent filed another form G.I. 9C on 7.4.2011 seeking further extension of time for filing the evidence and thereafter applied for photo copies of the Annexures 21, 22 and 23 on 8.4.2011 and received the said copies on the same date and filed the evidence by way of affidavit to the counter statement of APEDA on 22.4.2011 and as such the appellant/opponent filed the evidence diligently after the receipt of the complete set of counter statement.

(v) The second respondent mechanically applied Rule 44 of the G.I. Rules for overlooking the facts that the counter statement is incomplete as Annexures 21, 22 and 23 have not been furnished.

(vi) The prescribed period filing evidence is to be computed from the date of issuing Annexures 21, 22 and 23 i.e., from 8.4.2011.

(vii) The second respondent failed to exercise power under Section 64 of the Act conferring power on the second respondent to extend the time for sufficient cause and Rule 44 of the G.I. Rules being a subordinate legislation cannot override the main legislation of Section 64 of the Act.

(viii) The second respondent failed to send intimation regarding the passing of order in extension of time application.

(ix) The Assistant Registrar without considering the contentions of the appellants passed the impugned order by placing reliance on the two decisions relied by first respondent/APEDA.

(x) The second respondent failed to consider the Rules of procedures framed in furtherance of the Act are intended to obtain substantial justice and not defeat it altogether.

The learned counsel for the appellant would also place reliance on the following two decisions viz., (No.1) reported in **SARDAR OURUDAS SINGH BEDI Vs. UNION OF INDIA & OTHERS** {2006 SCC OnLine Bom 494: (2007) 2 Bom CR 504: (2006) 6 AIR Bom R 50 (DB): (2006) 33 PTC 321 (DB)} and (No.2) **WYETH HOLDINGS CORPN. AND ANOTHER Vs. CONTROLLER GENERAL PATENTS, DESIGNS AND TRADE MARKS AND OTHERS** {MANU/GJ/8491/2006 : 2007 (34) PTC1 (Guj)}.

9. Mr. Rajendra Kumar, the learned counsel for the first respondent/APEDA would contend that there is no illegality or infirmity in the impugned order. It is submitted on 31.1.2011 itself the counter statement of the first respondent was served with the appellant by the first respondent and as per Rule 44 (1) of the G.I. Rules it is mandatory for the appellant to submit their evidence in support of the opposition within the period upto 13.3.2011 which was extendable for a further period of one month in the aggregate i.e., up 13.4.2011. It is pointed out that the appellant sent a letter dated 10.2.2011 to the second respondent to provide it with copies of certain missing Annexures but no explanation was offered by the appellant as to the steps taken by it within the period from 13.1.2011 to 10.2.2011 to obtain the copies of missing Annexures.

10. It is further contended by the learned counsel for the respondent/APEDA that the appellant addressed a letter dated 25.02.2011 to the second respondent seeking extension of time for filing evidence in support of opposition on the purported ground that the Annexures in question had not been provided to the appellant and even the said request was not made in a prescribed form GI-9C as per G.I. Rules. It is contended that the appellant again submitted a formal request on Form GI-9C to the second respondent seeking extension of time till 13.4.2011. Thereafter the appellant sought another extension of month's time on the same ground once again in Form GI-9C on 7.4.2011 but there is no provision under the G.I. Act or the G.I. Rules for second extension of time for filing the evidence of opposition. The appellant applied for the copies of Annexures 21, 22

and 23 on 8.4.2011 and on the same day the said Annexures were served on the appellant by the G.I. Registry, Chennai and the evidence of opposition was filed on 22.4.2011 and the appellant does not dispute a delay of 8 days in filing its evidence of opposition. It is contended that the Annexure 21 consists of copies of 3 European Commission Regulation, Annexure 22 consists of bilateral agreement which India and Pakistan entered into European Community on 28.8.2004 and Annexure 23 comprises a copy of the Code of Practice on Basmati Rice agreed by the 'Rice Association', the 'British Rice Millers Association' and the 'British Retail Consortium' in consultation with the 'Local Authorities Coordinators of Regulatory Services (LACORS)' etc., and as such those documents are in the public domain, which are readily available for any one to access and therefore the explanation offered by the appellant is an afterthought and an excuse to cover up its gross negligence in prosecuting its opposition. The learned counsel would further point out that the appellant relied the missing documents Annexures 21 to 23 in TOP 18, which itself belies the purported explanation of non availability of those Annexures.

11. The learned counsel for the first respondent/APEDA would strenuously contend that Rule 44 (2) of G.I. Rules is mandatory and in the event of the opponent failing to comply with the time stipulated under Rule 44 (1) of G.I. Rules for filing the evidence by way of affidavit in support of its opposition, he shall be deemed to have abandoned its opposition.

12. In support of his contention the learned counsel for first respondent/APEDA would also place reliance on the two decisions viz., (No.1) reported in **SUNRIDER CORPORATION Vs. HINDUSTAN LEVER LTD & ANOTHER** {2007 (35) PTC 388 (DEL)} and No.2 in **ALLIED BLENDERS AND DISTILLERS PVT. LTD. Vs. INTELLECTUAL PROPERTY APPELATE BOARD & OTHERS** {2010 (42) PTC 57 (Mad.) (DB)}.

13. We have given our careful and anxious consideration to the rival contentions put forward by either side and thoroughly scrutinized the entire materials available on record coupled with the perusal of the impugned order.

14. The crux of the question involved in this matter is whether Rule 44 (2) of G.I. Rules is mandatory and whether the non compliance of the time stipulated under Rule 44 (1) & (2) of G.I. Rules for filing the evidence by way of affidavit in support of opposition would amount the opposition deemed to have been abandoned in terms of the provision of Rule 44 (1) & (2) of G.I. Rules?

15. Before proceeding to consider the above said crux of the question, it is relevant to consider the conduct of the appellant in filing opposition TOP 18 against G.I. applications 145 filed by first respondent/APEDA and thereafter pursuing the opposition proceedings. At the risk of repetition it is to be reiterated that the appellant filed the notice of opposition dt.29.09.2010 for the G.I. Application No.145 filed by the first respondent/APEDA on 26.11.2008 to register 'BASMATI' as a Geographical Indication in Class 30 of the G.I. Act. On 16.12.2010 the first respondent/APEDA filed its counter statement within the prescribed period of two months under Rule 43(1) of the G.I. Rules. The said counter was served with the appellant on 13.01.2011. Therefore the appellant ought to have filed their evidence in support of the opposition within the period upto 13.03.2011 which was extendable for a further period of one month in the aggregate, i.e., upto 13.04.2011 as per Rule 44 (1) of G.I. Rules. It is pertinent to note on 10.02.2011 the appellant sought for furnishing the missing Annexures 21 to 23 and there is absolutely no explanation for not taking any steps to obtain the missing Annexures for a period of a month.

16. It is relevant to note that on 25.02.2011 almost after a fortnight from 10.02.2011 the appellant addressed a letter dated 25.2.2011 to the second respondent seeking extension of time for filing its evidence of support i.e., upto 13.04.2011. The said request was not made on Form GI-9C as prescribed under the G.I. Rules. On 7.03.2011 the appellant submitted Form G.I. 9C seeking

extension of time till 13.04.2011. Once again as second application for seeking extension of time for filing the evidence in support of opposition on the same purported grounds of non furnishing Annexures 21 to 23 on 07.04.2011. At this juncture, it is to be stated that there is no provision under the G.I. Act to grant second extension. It is seen that the appellant applied for certified copies of the Annexures 21 to 23 and the same were furnished to the appellant on the same day. This step could have been taken by the appellant much earlier, but there is no explanation.

17. The fact remains that the appellant filed its evidence in support of the opposition on 22.04.2011 and admittedly there was a delay of 8 days in filing its evidence in support of opposition. The claim of the appellant that they have not been served with the Annexures 21 to 23 and that is the reason for the delay in filing the evidence in support of opposition is untenable and unacceptable for the simple reason the appellant placed reliance on the said Annexures 21 to 23 in their grounds of notice of opposition dated 29.09.2010 in TIOP No.18. Therefore it is abundantly clear that the appellant is not diligent and vigilant in pursuing the opposition proceedings initiated by them. We are constrained to state that the appellant is careless in complying with the mandatory requirements contemplated under Rule 44 (1) & (2) of the G.I. Rules. At this juncture, it is to be stated that the Geographical Indications Act is a special Act with special provisions of rules and as such it is incumbent on the appellant to strictly comply with the mandatory requirements. The appellant has no other alternative except to follow the prescribed procedures within the prescribed time as contemplated under the Act and Rules.

18. In order to test and examine and thereafter to arrive at the conclusion that whether Rule 44 (2) of GI Rules is mandatory, it is relevant to refer the similar provision under The Trade Marks Act, 1999 and its Rules. It is seen that the principles of law laid down under the Trade Marks Act, 1999 are directly applicable to those under the G.I. Acts and Rules. It is suffice for us to refer

the similar and identical Rule 50 of the Trade Marks Rules, 2002 as that of Rule 44 of the G.I. Rules, 2002 through the following comparative table:

<u>The Geographical Rules, 2002</u>	<u>The Trade Marks Rules, 2002</u>
<p><u>Section 14</u></p> <p>Opposition to registration.-</p> <p>4. Any evidence upon which the opponent and the applicant may rely shall be submitted in such manner and within such time as may be prescribed to the Registrar, and the Registrar shall give an opportunity to them to be heard, if they so desire.</p> <p><u>Rule 44</u></p> <p>Evidence in support of opposition by the Opponents:-</p> <p><u>(1) Within two months from services on him of a copy of the counter statement 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.</u> He shall deliver</p>	<p><u>Section 21</u></p> <p>Opposition to registration.-</p> <p>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.</p> <p><u>Rule 50</u></p> <p>Evidence in support of opposition:-</p> <p><u>(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 or 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.</u> He shall deliver to the applicant copies of any evidence that he leaves with the Registrar under this sub-rule and intimate the Registrar in writing of such delivery.</p>

<p>to the applicant copies of any evidence that he leaves with the Registrar under this sub-rule and intimate the Registrar forthwith in writing of such delivery.</p> <p><u>(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.</u></p> <p>(3) An application for the extension of the period of one month mentioned in sub-rule (1) shall be made in Form GI-9 accompanied by prescribed fees before the expiry of the period of two months mentioned therein.</p>	<p><u>(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.</u></p> <p>(3) An application for the extension of the period of one month mentioned in sub-rule (1) shall be made in Form TM-56 accompanied by the prescribed fee before the expiry of the period of two months mentioned therein.</p>
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19. The reading of the above said two provisions arising under the G.I. Rules 2002 and Trade Mark Rules, 2002 would make it abundantly clear that both the provisions are similar and identical. Mr. Rajendra Kumar the learned counsel for first respondent/APEDA has rightly placed reliance on a learned single Judge's decision of the Delhi Court decision reported in **SUNRIDER CORPORATION Vs. HINDUSTAN LEVER LTD & ANOTHER** {2007 (35) DEL}. The learned single Judge has dealt with Rule 50 of the Trade Mark Rules, 2002 and held hereunder:-

"7. Reading Rule 50, it is clear that the evidence by way of affidavit in support of an opposition to the registration of a trade mark has to be filed within two months of the service of a copy of the counter-statement on the opponent. **This period of two months is further extendable by a period of one month in the aggregate thereafter as the Registrar may on request allow. (Emphasis supplied by us)**

Clearly, in the first instance, the evidence affidavit has to be filed within two months Page 2117 of the receipt of a copy of the counter-statement. The Registrar may extend this period by a further one month in the aggregate if a request for the same is made in time. Sub-rule (2) of Rule 50 makes it clear that if an opponent takes no action under sub-rule (1) within the time mentioned therein, he shall be deemed to have abandoned his opposition. It is also interesting to note that sub-rule (3) refers to the application for extension of the period of one month mentioned in sub-rule (1). It is also stipulated that such an application has to be made in Form TM-56 accompanied by the prescribed fee before the expiry of the period of two months mentioned therein. So, it is clear that a strict regimen has been prescribed for the filing of evidence by way of affidavit in support of an opposition. **A plain reading of the provisions makes it abundantly clear that the evidence has to be filed within two months in the first instance and, if an appropriate application for extension of time is made before the expiry of the period of two months and if such application is allowed by the Registrar, then latest by a further month. (Emphasis supplied by us)**

In other words, under no circumstances can the evidence affidavit be filed beyond the maximum three months prescribed under the said rule. In case the opponent has not taken steps within the prescribed time, **then there is no option left with the Registrar but to deem that the opponent has abandoned his opposition. (Emphasis supplied by us)**

8. In Chief Forest Conservator (supra), the Supreme Court held:

It is now well-settled that when rules are validly framed, they should be treated as a part of the Act.

There is no doubt that Rule 50 of the 2002 Rules has been validly framed in exercise of the Central Government's rule making powers under [Section 157\(1\)](#) in general and [Section 157\(2\)\(vii\)](#) in particular. In this background, it can be safely stated that the time and manner prescribed in Rule 50 of the 2002 Rules should be treated as having been prescribed by the 1999 Act itself.

9. The decisions referred to in the cases of Delta Impex (supra), Pranam Enterprises (supra) and Popular Construction (supra) all clearly indicate that where the statute itself prescribes a maximum condonable period, then it would not be open to the authorities under that statute to extend the period for doing an act beyond the prescribed maximum condonable period. It is, therefore, clear that the Registrar does not have any power to extend the time for filing the evidence affidavit beyond the maximum period of one month after the initial period of two months.

15. In Ramachandra (supra), the Supreme Court observed that in Taylor v. Taylor 1875 (1) Ch D 426, Jessel M.R. adopted the rule that where a power is given to do a certain thing in a certain way, the thing must be done in that way or not at all and that other methods of performance are necessarily forbidden. (Emphasis supplied by us)

The Supreme Court further observed that this rule had stood the test of time. In that very case [Ramachandra (supra)], the Supreme Court placing reliance on Craies on Statute Law, 7th Edn. observed that with regard to the question as to whether a provision was mandatory or directory, no uniform rule could be laid down as to whether mandatory enactments should be considered directory only or obligatory with an implied nullification for disobedience. The Supreme Court further observed that it is the duty of Courts of justice to try to get at the real intention of the legislature by carefully attending to the whole scope. Such intention of the legislature is, therefore, to be ascertained upon a review of the language, subject-matter and importance of the provision in relation to the general object intended to be secured, the mischief, if any, to be prevented and the remedy to be promoted by the Act. Considering the provisions and making a comparative study of the old and the new Act as well as the old and the new rules, it is more than clear that specific words have been introduced in the new provisions and / or removed from the old provisions. Such additions and deletions are significant and bring out the true intention of the legislature. For instance, Rule 53 of the 1959 Rules did not prescribe any maximum period of extension of time. Whereas Rule 50 of the 2002

Rules specifically provides for extension of time not exceeding one month in the aggregate. This introduces a clear stipulation that the Registrar's powers to grant extension of time are limited to one month in the aggregate beyond the two months prescribed under the said Rule. This limitation was not there in the earlier Rule, but it is definitely there in Rule 50 of the 2002 Rules. The second instance is that the words "unless the Registrar directs" have been consciously deleted from sub-rule (2) of Rule 53 in its new incarnation in Rule 50 (2). It is obvious that the legislature wanted to make the provision Page 2122 mandatory and did not want to give any discretion to the Registrar in this connection. The object is apparent that the delays be cut down in deciding the application for registration of a trade mark.

17. Lastly, I would like to observe that the Intellectual Property Appellate Board in arriving at the conclusion that it did was under the impression that the Registrar had discretion in the matter and was exercising a discretionary power. This premise is not correct. **The provisions of Rule 50 (2) are mandatory and the Registrar has no discretion. If the evidence affidavit has not been filed within the time prescribed, the opposition would have to be deemed to have been abandoned. (Emphasis supplied by us) (Emphasis supplied by us)** The Registrar has also no discretion in extending the time beyond the maximum period of one month prescribed under Rule 50(1).

It is submitted that the above said decision was challenged before the Division Bench of the Delhi High Court, by filing an appeal which was also dismissed.

20. The learned counsel for the first respondent/APEDA has also rightly placed reliance on yet another decision rendered by the Division Bench of the Madras High Court reported in . **ALLIED BLENDERS AND DISTILLERS PVT. LTD. Vs. INTELLECTUAL PROPERTY APPELATE BOARD & OTHERS** {2010 (42) PTC 57 (Mad.) (DB)}. The Division Bench of the Madras High Court has held :

“22. In **Seiko Cables of India v. Hattori Seiko Company Ltd. Reported in 2002 (24) PTC 558 (Del.)** a learned single Judge of the Delhi High Court was concerned with the situation where the counter statement under section 21 (2) was filed within the prescribed period, but was deficient in fee by Rs.20/- and it was not made good in time. Relying upon the dicta in **Hastimal Jain** (Supra) the learned single Judge held that the Registrar was justified in making an order about abandonment. This view also stands to reason for the simple reasons otherwise it will mean that there will be a separate and extended time limit for filing prescribed fee. As seen earlier the Form TM-5 clearly states at the top of it that the fee prescribed is Rs.2,500/-. **It is a special Act and one has to be vigilant and careful about one’s right and steps to be taken. To oppose the registration of a trade mark, one has to go in the particular manner as prescribed under the Act.**

23. **This is also in consonance with the proposition long laid down in Taylor v. Taylor, 1875 (1) Ch. D. 426 where Jessel, M.R. laid down that where a power is given to do a certain thing in a certain way, the thing must be done in that way or not at all, and that other methods of performance are necessarily forbidden. (Emphasis supplied by us)** This dicta has been followed in a number of judgments and to cite one, in Ramachandra Keshav Adke v. V.Govind Jyoti Chavare reported in AIR 1975 SC 915, the question before the Apex Court was with respect to surrender of a tenancy by a tenant in order to be valid and effective under the Bombay Tenancy and Agricultural Lands Act, 1948. The Apex Court held that the surrender had to be done in the manner prescribed under the act and then only it would be effective.

24. The other submission of Mr.P.S.Raman, learned Advocate General for the petitioner was that this was a fit case where period of limitation deserved to be extended. We are afraid that it will be difficult to accept this proposition when considered on the touchstone of Section 29 (2) of the Limitation Act.

Section 29 (2) of the Limitation Act lays down that where a special Act provides a period of limitation different from the period specified under the Limitation Act, the provisions of Section 4 to 24 of the Limitation Act will apply only so far as and to the extent to which, they are not expressly excluded by such special or local law to the suits, appeals or applications under the special Law.

25. In **Mukri Gopalan v. Cheppilat Puthanpurayil Aboobacker reported in (1995) 5 SCC 5** the Apex Court was concerned with the special provision of limitation provided under Section 18 of the Kerala Rent Control Act. Although there was no express exclusion of any provision, in view of this special provision the Apex Court held that the provisions of the Special Rent Act on limitation will apply.

26. Similarly, in **Union of India v. Popular Construction Company reported in (2001) 8 SCC 470** while considering the limitation under Section 34 (3) and its proviso as occurring in the Arbitration and Conciliation Act, 1996, the Apex Court held that the express exclusion can also be inferred from the scheme and objectives of the Act, one of which was to restrict judicial intervention in arbitral matters as much as possible.

27. In the instant case, the Trade Marks Act, **1999 is a special Act. It gives a special right to the parties who want their goods and services to be protected by getting a registration of the trade mark. Anybody who is keen to oppose any such registration has also to be vigilant and has to oppose the registration in the prescribed manner, in the prescribed time, and on payment of prescribed fee within the time provided for that purpose. (Emphasis supplied by us)**

The counter statement is also to be filed in the prescribed time and in the prescribed manner. The notice of opposition and the counter statement are

like the plaint and the written statement of the proceeding. If the Special Act provides for specific time, manner and fees for filing of the plaint, it has to be so done in compliance and the requirements cannot be relaxed. Sub-section 21 (7) of the Act provides only for amendment of the notice of opposition and counter statement, but that cannot be construed as a provision to cure any deficiency in the requirement of Section 21 (1) and 21 (2) of the Act. Section 131 and Rule 53 can also not be pressed into service, since that Section will apply only where time is not expressly provided under the statute and Rule 53 is concerning the time for leading the evidence. It cannot apply to filing of notice of opposition or the counter statement. Any other interpretation will defeat the objective of the Act, and hence, cannot be accepted.”

21. The principles laid down in the decisions cited supra, are squarely applicable to the issue involved in this matter as Rule 44 of G.I. Rules 2002 is similar and identical as that of Rule 50 of Trade Marks Rules, 2002. Further as held by the Division Bench of the Madras High Court that The Geographical Indications of Goods (Registration and Protection) Act, 1999 is also a Special Act and if any one initiating opposition proceedings should scrupulously follow the mandatory requirements contemplated under the Act and Rules in the manner prescribed and in the prescribed time. We prefer to place reliance on the above said two decisions than the two decisions cited supra relied on by the appellant, as the said decisions are not directly applicable to the core issue involved in the instant appeal.

22. Therefore we have no hesitation to hold that Rule 44 (2) of G.I. Rules 2002 is mandatory and as the appellant miserably failed to comply with the mandatory requirements of filing the evidence in support of opposition within the time frame stipulated under Rule 44 (1) of G.I. Rules, 2002, the opposition shall be deemed to have been abandoned by the appellant. The Assistant Registrar has rightly held by following the decisions cited supra, in which the decisions of the Hon'ble

Apex Court has also been relied that Rule 44 (1) & (2) of G.I. Rules 2002 are mandatory and in the event of not filing the evidence of affidavit in support of opposition within the prescribed time the opposition would have been abandoned. The Assistant Registrar also rightly held that the affidavits filed in opposition proceedings are not in conformity with the prescribed form under Rule 93 stating that the affidavit was signed only by the counsel and he is neither Notarized nor Stamped in terms of Rule 93 and such an affidavit cannot be regarded as evidence within the meaning of Rule 44 (2) of the GI Rules.

23. In view of the aforesaid reasons, we have arrived at the irresistible and inevitable conclusion that there is no infirmity or illegality warranting our interference in the impugned order dated 31.12.2013 made in Interlocutory Petition. No.1 in TOP No.18 against G.I. Application No.145 and accordingly the appeal is hereby dismissed. No costs.

(SHRI SANJEEV KUMAR CHASWAL)
Technical Member
(Trade Marks)

(JUSTICE K.N. BASHA)
Chairman

Reportable:Yes/No

ksr