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

+ C.A.(COMM.IPD-TM) 113/2022

ITC LIMITED OF VIRGINIA HOUSE Appellant
Through: Mr. Rajshekhar Rao, Sr. Adv.
with Ms. Debjyoti Sarkar, Mr. Afzal B.
Khan and Mr. Vishal Nagpal, Advs.

versus

THE DEPUTY REGISTRAR OF TRADEMARKS AND ORS.
..... Respondents
Through: Mr. Harish Vaidyanathan
Shankar, CGSC with Mr. Srish Kumar
Mishra, Mr. Sagar Mehlawat, Mr. Alexander
Mathai Paikaday, Mr. M. Sriram and Mr.
Krishnan V., Advs.

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

J U D G M E N T (O R A L)

% **10.10.2023**

1. Application No. 905000 was filed by M/s Godfrey Phillips India Ltd. (GPI) for registration of the mark "LUCKY NINE".

2. The petitioner ITC Ltd. (ITC) filed an opposition, to the registration of the mark, on 27 November 2006. GPI filed a counter statement on 20 July 2007. The counter statement was served on ITC on 28 July 2008. Even as per the impugned order, the copy of the counter statement was received by ITC on 2 August 2008.

3. It is noted, in the impugned order, thus:



“In this matter, the counter statement filed by the applicant on 20/07/2007 was served upon the opponent on 28/7/2008, which was admittedly received by the opponent on 02/08/2008 and he was required to file the evidence in support of his opposition or to place reliance on the contents of notice of opposition within the prescribed period of two months or within such further period not exceeding one month which might have been allowed by the Registrar on request filed on TM-56 under Rule 50(2).”

4. Even as per the impugned order, therefore, the petitioner had, with it, two months from 2 August 2008, within which it was required to be file either evidence in support of its opposition or to place reliance on the contents of the notice of opposition.

5. Mr. Rajshekhar Rao, learned Senior Counsel for the petitioner, points out that, on 29 September 2008, ITC addressed the following letter to the Registrar of Trade Marks:

“The Registrar of Trademarks
Trademarks Registry,
DELHI

via-Courier
September 29, 2008

Dear Sir,

Re: Opposition No. DEL - 248179 To
Application No. 905000 in Class 34
Applicant: GODFREY PHILLIPS INDIA LIMITED
Opponent: ITC LIMITED
Our Ref: TGG/1291/AKC/MK/Y201108

In connection with the aforesaid subject, we submit herewith on behalf of the opponent:

[√] Form TM 56 for extension of one month's time to file 'Evidence in support of Opposition'.

[√] Fee of Rs. 500/- (Consolidated Cheque of Rs. 1,000/- bearing No., 669563 dated 29.09.2008 drawn on Standard Chartered Bank, Kolkata - 700 001 payable at par at all branches of Standard Chartered Bank in India).”



In the event the Ld. Registrar is not willing to grant the extension of time as requested, the opponent intends to rely on the grounds of the notice of opposition and reserves their right to file evidence at the later stage of the proceedings along with an Interlocutory petition.

The application may be taken on record and the extension may be granted for the interest of justice.”

(Emphasis supplied)

6. It appears that, after the said letter, further extension of time was sought by the petitioner to file evidence in support of its notice of opposition. The petitioner came to file supportive evidence after a delay of about one and a half years. By the impugned order, the learned Registrar has held treated the petitioner’s opposition as abandoned on the ground of belated filing of evidence in support of opposition, beyond the period of two months available in law.

7. It appears that no response was issued, by the office of the Registrar, accepting or rejecting the petitioner’s prayer for permission to file evidence in support of the opposition, or addressing the alternative request for permission to rely on the grounds contained in the notice of opposition. After waiting for two years, the petitioner moved an interlocutory application before the learned Registrar, praying that the evidence which the petitioner desired to lead may be permitted to be taken on record.

8. Even that request did not meet with any response from the Registrar. Seven years thereafter, on 8 December 2016, the petitioner was granted an opportunity of hearing and six months thereafter, the



impugned order came to be passed on 19 June 2017.

9. Mr. Rajshekhar Rao, learned Senior Counsel for the petitioner submits, on instructions that, his client is willing not to rely on the evidence which was belatedly filed by it and, instead, chooses to rely on the grounds of notice of opposition.

10. The impugned order itself discloses that within the period of two months envisaged in the law, the petitioner could either file evidence in respect of its opposition or state that it was willing to rely on the grounds contained in the notice of opposition. The letter dated 29 September 2008, which was filed within the said period of two months, specifically conveyed the willingness of the petitioner, in the event that the learned Registrar was unwilling to grant extension of time to file supportive evidence, to rely on the grounds contained in the notice of opposition. To that extent, therefore, the said request was made within the period of two months envisaged in the impugned order.

11. In view of the fact that, within the period of two months available to it, the ITC had expressed its willingness – in the event of the Registrar not acceding to ITC’s request for extension of time to file supportive evidence – to rely on the grounds contained in the notice of opposition, the learned Registrar could not legitimately have treated the opposition filed by ITC as having been abandoned.



12. I am also persuaded, in my decision, by the fact that the office of Registrar of Trade Marks took no decision on the petitioner's application dated 29 September 2008 till the passing of the impugned order on 19 June 2017, i.e. for almost nine years. In the meanwhile, the petitioner had filed the interlocutory application for permission to take its evidence on record on 21 January 2010, after nine letters seeking extension of time had been submitted to the Registrar. Even that application has come to be decided only by the impugned order after a further period of seven years.

13. Clearly, the petitioner cannot be denied its right to rely on the grounds of its notice of opposition, which request was made within the initially available period of two months of service on the petitioner of the counter statement of GPI, on 29 September 2008. The impugned order, however, does not even notice this request.

14. Accordingly, the impugned order is quashed and set aside.

15. The opposition filed by ITC is restored.

16. However, it is made clear that ITC would not be permitted to rely on the evidence in opposition which was belatedly filed, but may rely on the grounds contained in the notice of opposition which was filed by it, by way of response to application no. 905000 of GPI.

17. It is pointed out that, in the interregnum, GPI's mark has proceeded to registration.



18. Despite notice having been served on GPI *dasti*, and proof of service along with affidavit thereof having been placed on record by ITC in the present proceedings, GPI has not chosen to appear.

19. On 24 April 2023, the learned Joint Registrar (Judicial) noted that GPI had been served on 23 January 2023 and had not, nonetheless, chosen to file its reply. Accordingly, GPI's right to file reply was closed. Nonetheless, in the interests of justice, on 9 May 2023, this Court directed fresh service to be effected on GPI by all modes including *dasti*. Affidavit of service along with proof thereof, evidencing personal receipt of the notice regarding the present proceedings by the representative of the GPI has been placed on record by ITC. Nonetheless, GPI has chosen not to appear in the matter when it has been called out today.

20. Accordingly, I am of the view that GPI has been granted adequate opportunity in this case and the Court need not await GPI's convenience to enter appearance before this Court.

21. Mr. Rao, learned Senior Counsel for the petitioner, has drawn my attention to an order dated 3 March 2023, passed by a Coordinate Bench of this Court in *Medicon Eg Chirugiemechanikar-Genossenschaft v. The Registrar of Trademarks*¹ in which, similarly, while the appeal against the rejection of the notice of opposition as abandoned, by the Registrar, was pending before this Court, the



respondent's mark proceeded to registration. This Court has, while allowing the appeal and restoring the petitioner's opposition to the Registrar for *de novo* consideration, also proceeded to cancel the registration granted to the defendant while the appeal against the rejection of the petitioner's opposition was pending before this Court, and has directed the Registry of Trade Marks to issue an appropriate notification in this regard.

22. Following the said precedent, the registration of the mark "LUCKY NINE" granted to GPI, *vide* Registration No. 905000 dated 21 February 2000, is cancelled.

23. The Registry of Trade Marks is also directed to issue an appropriate order/notification to that effect.

24. The petition stands allowed in the aforesaid terms.

C. HARI SHANKAR, J.

OCTOBER 10, 2023

dsn

¹ CA (Comm. IPD-TM) 59/2021